

## **ADMINISTRATIVE PANEL DECISION**

### **Spyder Active Sports, Inc. v. Web Commerce Communications Limited Case No. D2022-1006**

#### **1. The Parties**

The Complainant is Spyder Active Sports, Inc., United States of America (“U.S.”), represented by Authentic Brands Group, U.S.

The Respondent is Web Commerce Communications Limited, Malaysia.

#### **2. The Domain Name and Registrar**

The disputed domain name <spyderireland.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 23, 2022. On March 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 25, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 30, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on March 30, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 29, 2022.

The Center appointed Cherise Valles as the sole panelist in this matter on May 17, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of

Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is the owner of the world-famous SPYDER brand. For more than forty years, the Complainant has promoted and sold sports apparel, outerwear, and other sporting goods globally and has spent millions of dollars promoting its products through extensive advertising, as well as through its sponsorships of the U.S. Ski Team and professional skiers.

SPYDER is one of the world's largest winter sports brands and its products are sold in more than 40 countries, as well as on the Complainant's official website, "www.spyder.com" (the "Spyder Website") (Annex 4 to the Complaint). The Complainant is the owner of a global trademark portfolio that includes more than 150 trademark filings worldwide for the term "spyder", the Spyder design, and several stylized Spyder logos (collectively, the "SPYDER Trademarks"), as well as a vast portfolio of copyrights for images used in association with the advertising, marketing and sale of SPYDER brand products globally (collectively, the "SPYDER IP Rights").

The Complainant spends millions of dollars marketing its goods and services globally, using the SPYDER Trademarks, and has undertaken extensive efforts to protect its name and enforce such trademarks.

The Complainant owns the following European Union trademarks:

- SPYDER- Registration No. 002342178 in International Classes 9, 25 and 28 (Annex 5.1)
- SPYDER & Design- Registration No. 017255274 in International Classes 18 and 25 (Annex 5.2)
- SPYDER logo- Registration No. 003235769 in International Class 25 (Annex 5.3)
- SPYDER logo- Registration No. 014513394 in International Classes 14, 25 and 35 (Annex 5.4)

The disputed domain name <spyderireland.com> was registered on September 13, 2021.

The disputed domain name is being used to sell counterfeit goods of winter sports apparel.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The disputed domain name is confusingly similar to the Complainant's registered SPYDER Trademarks, in light of the fact that it wholly incorporates the Complainant's mark.

The Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant states that the Respondent should be considered as having no rights or legitimate interests in the disputed domain name. The Complainant has never licensed or otherwise permitted the Respondent to use its trademarks or to register any domain name that included its trademarks.

The disputed domain name has been registered and is being used in bad faith.

The Complainant asserts that the disputed domain name was registered and is being used in bad faith. The mere fact of registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to that mark is itself evidence of bad faith registration and use. Furthermore, the Respondent's competing uses of the disputed domain name is clear evidence of bad faith.

The Complainant requests the Panel to issue a decision finding that the disputed domain name be transferred to the Complainant, in accordance with paragraph 4(i) of the Policy.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

In terms of paragraph 4(a) of the Policy, for a Complaint to succeed, the Complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and,
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Respondent has failed to file a Response in this proceeding. The Panel may draw appropriate inferences from the available evidence submitted by the Complainant.

### **A. Identical or Confusingly Similar**

To prove this element, the Complainant must have relevant UDRP rights in a trademark and the disputed domain name must be identical or confusingly similar to such trademark.

The Complainant submits that the disputed domain name is confusingly similar to the trademarks in which it has rights.

The disputed domain name incorporates the SPYDER Trademark in its entirety with the addition of the term "ireland". Given the Complainant's trademark registration as detailed above, the Panel finds that the Complainant has established its trademark rights in the term "spyder" for the purposes of paragraph 4(a)(i) of the Policy.

As stated in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element".

The disputed domain name incorporates the SPYDER Trademark in its entirety with the addition of the term "ireland". Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See, e.g., *Rakuten, Inc. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Matthew Connor, No Company*, WIPO Case No. [D2019-2983](#).

It is standard practice when comparing a disputed domain name to a complainant's trademark not to take the Top Level Domain ("TLD") into account. See section 1.11.1 of the [WIPO Overview 3.0](#), which states that the "applicable TLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration

requirement and, as such, is disregarded under the first element of the confusing similarity test". In the present case, the TLD ".com" is disregarded under the first element of the confusing similarity test.

In the light of the foregoing, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark and that the Complainant has met its burden with respect to paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy sets out a non-exhaustive set of circumstances, any of which, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy, namely:

"[a]ny of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, whether on the basis of the non-exhaustive examples set out in paragraph 4(c) of the Policy or on any other basis, and the Panel draws inferences from this failure, where appropriate, in accordance with paragraph 14(b) of the Rules.

It is recognised in cases under the Policy that it is sufficient for a complainant to make a *prima facie* case under the second element of the Policy, not rebutted by the respondent, that the respondent has no rights or legitimate interests in the domain name concerned (see, for example, *LinkedIn Corporation v. Privacy service provided by Withheld for Privacy ehf / Scrap LinkedIn*, WIPO Case No. [DIO2021-0019](#); *Bayerische Motoren Werke AG v. Domain Privacy Ltd/ DNS Admin*, WIPO Case No. [DIO2021-0012](#); and the discussion in section 2.1 of the [WIPO Overview 3.0](#)). If a respondent fails to rebut such a *prima facie* case by demonstrating rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy, or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In this case, it appears that the Complainant has established the requisite *prima facie* case. The Respondent has not been licensed, contracted, or otherwise permitted by the Complainant in any way to use the SPYDER Trademarks or to apply for any domain name incorporating the SPYDER Trademarks, nor has the Complainant acquiesced in any way to such use or application of the SPYDER Trademarks by the Respondent. In addition, there is no evidence that the term "spyder ireland" is the name of the Respondent's corporate entity, nor is there any evidence of fair use.

Furthermore, there is no evidence that the Respondent is using, or plans to use, the SPYDER Trademarks or the domain name incorporating the SPYDER Trademarks for a *bona fide* offering of goods or services.

On the evidence before the Panel, it appears that there has never been any relationship between the Complainant and the Respondent. The Respondent does not seem to be licensed, or otherwise authorized, be it directly or indirectly, to register or use the Complainant's SPYDER Trademarks in any manner, including

in, or as part of, the disputed domain name.

Furthermore, the nature of the disputed domain name, consisting of the Complainant's trademark with the addition of the term "ireland", carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Complainant asserts that the Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy in order to demonstrate rights or legitimate interests in the disputed domain name. In particular, the Respondent cannot assert that, prior to any notice of this dispute, he was using, or had made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy.

In light of the foregoing, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and concludes that paragraph 4(a)(ii) of the Policy is satisfied.

### **C. Registered and Used in Bad Faith**

For this element, the Complainant is required to prove that the disputed domain name was registered or that it was used in bad faith. The term "bad faith" is "broadly understood to occur where a respondent takes unfair advantage of, or otherwise abuses, a complainant's mark". See section 3.1 of the WIPO Overview. Paragraph 4(b) of the Policy sets out four non-exhaustive examples of circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, namely:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

In the present case, the Complainant's submissions relate to paragraph 4(b)(iv) of the Policy.

Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typographical errors or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

The Respondent must have been aware of the Complainant's SPYDER Trademarks at the time the Respondent registered the disputed domain name on September 13, 2021. The Complainant's trademarks are well-known around the world based on the extensive range of registered trademarks for the term "spyder". This is proof of bad faith at the time of registration. In addition, a gap of several years between the registration of the complainant's trademark and the respondent's registration of the disputed domain name can indicate bad faith registration (see *Asian World of Martial Arts Inc. v. Texas International Property*

*Associates*, WIPO Case No. [D2007-1415](#)). In this case, the Respondent registered the disputed domain name at least 40 years after the Complainant established registered trademark rights in the SPYDER Trademarks.

The Respondent is selling counterfeit SPYDER goods on a website that mirrors the Complainant's website, in an attempt to pass it off as the official Complainant's website. (Annex 7 to the Complaint includes a screenshot of the Respondent's website). The Respondent has no reason to use the SPYDER Trademarks in the disputed domain name other than to attract Internet users to its site for commercial gain. Panels in other UDRP cases have found bad faith registration where the respondent sells counterfeit merchandise. See *Balenciaga v. liu zhixian, zhixian liu*, WIPO Case No. [D2010-1831](#).

The exploitation of consumer confusion for the purpose of selling counterfeit goods is one of the strongest examples of registration and use in bad faith. *Goyard St-Honoré v. Lin Honghai*, WIPO Case No. [D2012-1165](#).

The sale of counterfeit goods on the site of the disputed domain name suggests that the Respondent registered the disputed domain name with bad faith intent to deceive consumers with its counterfeit products, and intentionally has used it to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and products.

The Respondent has not participated in the administrative proceeding and has not answered the Complainant's contentions. The fact that the Respondent has decided not to provide any legitimate explanation or to assert any alleged good faith motivation in respect of the registration or use of the disputed domain name in the face of the Complainant's contentions can be regarded as an indicator of registration or use in bad faith - see, for example, *Novartis AG. v. Mathew French*, WIPO Case No. [DIO2020-0011](#).

As a final element showing a lack of *bona fides*, the Respondent did not reply to the Cease and Desist letter dated February 10, 2022, sent to the email address listed in the Whois information, which asked the Respondent to disable and transfer the disputed domain name to the Complainant. (Annex 6 to the Complaint includes a copy of the letter). The Respondent did not reply to the Complainant's letter, further showing bad faith on the Respondent's part. See *Encyclopedia Britannica v. Zucarini*, WIPO Case No. [D2000-0330](#).

Accordingly, the Panel concludes that the Complainant has satisfied its burden of showing bad faith registration and use of the disputed domain name under paragraph 4(a)(iii) of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <spyderireland.com> be transferred to the Complainant.

/Cherise Valles/

**Cherise Valles**

Sole Panelist

Date: May 31, 2022