

ADMINISTRATIVE PANEL DECISION

Puma SE v. Client Care, Web Commerce Communications Limited
Case No. D2022-1806

1. The Parties

The Complainant is Puma SE, Germany, represented by Göhmann Rechtsanwälte, Germany.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <puma-belgium.com>, <puma-germany.com>, <puma-indonesia.com>, <puma-nl.com>, <puma-philippines.com>, <puma-portugal.com>, and <puma-uae.com> are 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 May 19, 2022. On May 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 23, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 24, 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 May 25, 2022, and an amended Complaint on May 31, 2022.

The Center verified that the Complaint together with the amendment to the Complaint and amended 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 June 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 22, 2022.

The Center appointed Tuukka Airaksinen as the sole panelist in this matter on July 1, 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 one of the leading global manufacturers in the sport and sport-lifestyle sector. The Complainant owns the trademark PUMA, which is registered in many countries all over the world, for example European Union Trade Mark No. 017971686, registered as of February 9, 2019. The Complainant's trademark has also acquired substantial reputation.

The disputed domain names <puma-philippines.com>, <puma-uae.com>, and <puma-indonesia.com> were registered on March 31, 2022 whereas the disputed domain names <puma-belgium.com>, <puma-germany.com>, <puma-nl.com>, and <puma-portugal.com> were registered on April 1, 2022.

The websites to which the disputed domain names resolve offer clothing articles. The websites use the same images and are also otherwise very similar to each other in the overall impression they convey.

5. Parties' Contentions

A. Complainant

The disputed domain names are confusingly similar to the Complainant's trademark as they include the trademark PUMA entirely. The second part of each of the disputed domain names appear as an independent word since they are separated by a hyphen from the Complainant's trademark. The second part of each of the disputed domain name is easily understood as a reference to a country and will be seen as an intention to refer to a country version of the Complainant's website at "www.puma.com".

The elements "philippines", "b", "germany", "indonesia", and "portugal" of the disputed domain names directly refer to respective countries. The term "uae" is the official abbreviation for the United Arab Emirates and the term "nl" for the Netherlands. This means that the only distinctive part of the disputed domain names is the Complainant's trademark.

There is no evidence of the Respondent's use of the disputed domain names in connection with a *bona fide* offering of goods or services. The Respondent has not been commonly known by the disputed domain names. The Respondent offers counterfeit goods and uses the Complainant's trademark illegally.

B. Respondent

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

6. Discussion and Findings

In order to obtain the transfer of a domain name, a complainant must prove the three elements of paragraph 4(a) of the Policy, regardless of whether the respondent files a response to the complaint or not. The first element is that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. The second element a complainant must prove is that the respondent has no rights or legitimate interests in respect of the domain name. The third element a complainant must establish is that the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires that the Complainant establish that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. Consequently, the Complainant must prove that it has rights to a trademark, and that the disputed domain names are identical or confusingly similar to this trademark.

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), “[t]he applicable Top Level Domain (‘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 confusing similarity test”.

Furthermore, “[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 nature of such additional term(s) may however bear on assessment of the second and third elements”. See section 1.8 of the [WIPO Overview 3.0](#).

The disputed domain names are confusingly similar to the Complainant’s trademark, which is clearly recognizable in each of the disputed domain names. The addition of the different geographical terms – easily understood by Internet users – to the Complainant’s trademark does not prevent the confusing similarity with the Complainant’s trademark.

This means that the disputed domain names are confusingly similar with the Complainant’s trademark and hence the first element of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests to the disputed domain names.

It is widely accepted among UDRP panels that once a complainant has made a *prima facie* case showing the absence of the respondent’s rights or legitimate interests in a disputed domain name, the burden of production shifts to the respondent to come forward with evidence of such rights or legitimate interests. If the respondent fails to do so, the complainant is deemed to have satisfied the second element of the Policy. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#), and section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has credibly submitted that the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register the disputed domain names, that the Respondent have no rights or legitimate interests in the disputed domain names, and that the Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain names and is not commonly known by the disputed domain names in accordance with paragraph 4(c)(ii) of the Policy.

Furthermore, because the Respondent is using the disputed domain names to sell apparently counterfeit goods under the Complainant’s trademark, it is impossible to conceive any legitimate future use of the disputed domain names by the Respondent. Here, noting the Complainant’s contentions and supporting circumstantial factors, such as the goods being offered disproportionately below market value, the Panel finds it more likely than not that such goods are counterfeit. However, even if the offered goods were legitimate products of the Complainant, the use of the Complainant’s trademark to suggest an affiliation with the Complainant for commercial gain, as well as the lack of any explanation of the lack of relationship between the Parties, preclude a finding that such use could be considered a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use. See sections 2.8 and 2.13 of the [WIPO Overview 3.0](#).

Moreover, the Panel finds that the nature of the disputed domain names carries a risk of implied affiliation with the Complainant’s trademark. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Complainant has made a *prima facie* case that has not been rebutted by the Respondent. Considering the Panel's findings below, the Panel finds that there are no other circumstances that provide the Respondent with any rights or legitimate interests in the disputed domain names. Therefore, the Panel finds that the second element of the Policy is fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant establish that the disputed domain names have been registered and are being used in bad faith. Paragraph 4(b) of the Policy provides that the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that [the respondent has] registered or has 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 respondent’s] 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 or competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] 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 [the respondent’s] website or location.”

The Panel is of the opinion that the Complainant’s trademark PUMA is a distinctive and well-known trademark, which, together with the use of the disputed domain names for the sale of counterfeit goods under the Complainant’s trademark means that it is inconceivable that the Respondent would not have been aware of the Complainant’s trademark when registering the disputed domain names. Instead, it is evident that the Respondent has specifically targeted the Complainant’s trademark with the disputed domain names.

The disputed domain names are used to sell counterfeit goods under the Complainant’s trademark. Moreover, the Respondent has used the disputed domain names to intentionally attract, for commercial gain, Internet users to the Respondent’s websites by creating a likelihood of confusion with the Complainant’s trademark.

Therefore, the Panel finds that the third element of the Policy is fulfilled.

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 names, the disputed domain names, <puma-belgium.com>, <puma-germany.com>, <puma-indonesia.com>, <puma-nl.com>, <puma-philippines.com>, <puma-portugal.com>, and <puma-uae.com>, be transferred to the Complainant.

/Tuukka Airaksinen/

Tuukka Airaksinen

Sole Panelist

Date: July 14, 2022