

ADMINISTRATIVE PANEL DECISION

New Balance Athletics, Inc. v. samdy chen
Case No. D2022-3488

1. The Parties

The Complainant is New Balance Athletics, Inc., United States of America (“United States”), represented by Day Pitney LLP, United States.

The Respondent is samdy chen, China.

2. The Domain Name and Registrar

The disputed domain name <nbsneakersoutlet.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 20, 2022. On September 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 21, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 22, 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 amended Complaint on September 27, 2022.

The Center verified that the Complaint together with the 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 September 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 19, 2022.

The Center appointed Luca Barbero as the sole panelist in this matter on October 24, 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 an athletic footwear and apparel company, offering products under the NEW BALANCE and NB trademarks in more than 120 countries.

The Complainant is the owner of several trademark registrations for NB, including the following, as per trademark certificates submitted as Annexes 6 to the Complaint:

- United States trademark registration no. 3360160 for NB (word mark), registered on December 25, 2007 in international class 25;
- United States trademark registration no. 1065726 for NB (figurative mark), registered on May 17, 1977, in international classes 10 and 25;
- United States trademark registration no. 1260939 for NB (figurative mark), registered on December 13, 1983 in international classes 18 and 25;
- United States trademark registration no. 2909687 for NB (figurative mark), registered on December 14, 2004 in international classes 35, 36 and 41;
- United States trademark registration no. 3427255 for NB (figurative mark), registered on May 13, 2008, in international classes 18 and 25;
- United States trademark registration no. 3475802 for NB (figurative mark), registered on July 29, 2008, in international class 25;

The Complainant is also the owner of the domain name <newbalance.com>, registered on August 07, 1995 and used by the Complainant to promote its products under the trademarks NEW BALANCE and NB.

The disputed domain name <nbsneakersoutlet.com> was registered on August 12, 2021 and is currently not pointed to an active website. According to the screenshots submitted as Annex 2 to the Complaint – which have not been challenged by the Respondent – the disputed domain name was previously pointed to a website displaying the Complainant’s figurative trademark NB and purporting to sell athletic footwear and apparel branded footwear under the trademarks NB and NEW BALANCE at discounted prices.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the trademark NB in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the descriptive terms “sneakers” and “outlet”.

The Complainant highlights that the added terms only serve to increase the likelihood of confusion suggesting to consumers that the website to which the disputed domain name resolves and the products available for sale therein are part of an official NB outlet.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent has not made any demonstrable preparations to use the disputed domain name

in connection with a *bona fide* offering of goods or services since the Respondent has used the disputed domain name to advertise and sell thousands of unauthorized and/or counterfeit NEW BALANCE footwear products and/or to fraudulently collect personal information and payment information at online checkout on the false promise of offering authentic NEW BALANCE footwear at a discount.

The Complainant underlines that the Respondent has never acquired or owned any trademark or service mark rights in the names “Nb”, “Nb sneakers”, or “Nb sneakers outlet”, has in no way been licensed, authorized or permitted by the Complainant to use its trademark in any way and is not commonly known by the disputed domain name.

The Complainant also emphasizes that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent registered the disputed domain name to intentionally attract users to its website for commercial gain, by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation, and/or endorsement of its website and the NEW BALANCE products advertised for purchase therein.

The Complainant emphasizes that the Respondent registered the disputed domain name on August 12, 2021, nearly fifty years after the Complainant first established rights in its trademark NB, and decades after the Complainant’s trademarks achieved worldwide fame and notoriety in connection with athletic footwear. The Complainant thus contends that the Respondent acted with full knowledge of the Complainant and its trademarks, intentionally registering the disputed domain name comprising the Complainant’s famous trademark NB to impersonate the Complainant for profit under fraudulent pretenses.

As to bad faith use, the Complainant underlines that the Respondent’s website at the disputed domain name is being used to (i) sell counterfeit versions of the Complainant’s footwear; and/or (ii) collect personal information and payment information on the false premise of selling authentic NEW BALANCE and NB footwear at a discount.

As additional evidence of the Respondent’s bad faith, the Complainant submits that the Respondent used a privacy proxy service to shield its true identity from suspicious users of its website and provided fictitious contact information in an attempt to avoid giving any indication that the Respondent was not connected, affiliated, or otherwise authorized by the Complainant.

The Complainant informs the Panel that the Respondent has also been found to have engaged in abusive use and registration of other domain names on at least two prior occasions, which further would prove the Respondent’s bad faith intentions.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: “A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark NB based on the trademark registrations cited under section 4 above and the related trademark certificates submitted as Annex 6 to the Complaint.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Moreover, as stated in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

The Panel finds that the disputed domain name is confusingly similar to the trademark NB as it reproduces the trademark in its entirety with the mere addition of the terms “sneakers” and “outlet”, which do not prevent a finding of confusing similarity. Moreover, as indicated in section 1.11 of the [WIPO Overview 3.0](#), the generic Top-Level Domain (gTLD) “.com” can be disregarded when comparing the similarities between a domain name and a trademark.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

“(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 non-commercial 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.”

In the case at hand, by not submitting a Response, the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s trademarks.

Moreover, there is no indication before the Panel that the Respondent is commonly known by the disputed domain name.

In view of the prior use of the disputed domain name made by the Respondent to advertise and offer for sale purported NB products at discounted prices without providing a prominent disclaimer of non-affiliation with the Complainant (as shown in the screenshots submitted as Annex 2 to the Complaint) and the circumstance that the Respondent might have acquired personal information from users visiting the Respondent's website, who might have been confused as to the source or affiliation of the website with the Complainant, the Panel finds that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services, or a legitimate, noncommercial or fair use without intent for commercial gain to misleadingly divert consumers.

Indeed, the Respondent's use did not fulfill the requirements that, according to the "Oki Data test", a reseller or distributor should meet in order to make a *bona fide* offering of goods and services and thus have a legitimate interest in a domain name incorporating a third-party trademark (see the leading case *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), and section 2.8.1 of the [WIPO Overview 3.0](#)). Specifically, the Respondent, besides reproducing on its website the Complainant's trademarks and images of the Complainant's products, has failed to accurately and prominently disclose its lack of relationship with the trademark holder.

As to the current redirection of the disputed domain name to an inactive website, as held *i.a.*, in *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#), "[a]bsent some contrary evidence from Respondent, passive holding of a domain name does not constitute legitimate noncommercial or fair use".

The Panel also finds that the disputed domain name, combining the Complainant's trademark NB with terms ("sneakers" and "outlet") which can be referred to the Complainant's business, carries a high risk of implied affiliation. Indeed, as stated in section 2.5.1 of the [WIPO Overview 3.0](#), "Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner".

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

The Panel finds that, in light of i) the prior registration and use of the Complainant's trademark NB in connection with the promotion and sale of the Complainant's products also online via the Complainant's website "www.newbalance.com" and ii) the composition of the disputed domain name, combining the Complainant's trademark NB with the terms descriptive of the Complainant's products and activity – specifically, the sale of the Complainant's sneakers -, the Respondent very likely registered the disputed domain name having the Complainant's trademark in mind.

The circumstance that the disputed domain name was pointed to a website featuring the Complainant's trademark and images of the Complainant's products demonstrates that the Respondent was indeed well aware of the Complainant and its trademark.

The Panel also notes that, in view of the use of the disputed domain name to divert users to the website described above, advertising and offering for sale purported NB products at discounted prices without providing a clear disclaimer of non-affiliation with the Complainant and inviting users to provide their personal information to finalize purchases, the Respondent intentionally attempted to attract Internet users to its

website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website and the products provided therein, according to paragraph 4(b)(iv) of the Policy.

The disputed domain name is currently not pointed to an active website. As established in a number of prior cases the concept of "bad faith" in paragraph 4(b) of the Policy includes not only positive action but also passive holding. See *i.a.*, the landmark case *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Panel also finds that the Respondent's provision of inaccurate contact details in the Whois records is a further circumstance demonstrating the Respondent's bad faith.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to 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 <nbsneakersoutlet.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: November 8, 2022