

ADMINISTRATIVE PANEL DECISION

SRAM, LLC v. hongwang hu and guiren li

Case No. D2022-3682

1. The Parties

The Complainant is SRAM, LLC, United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondents are hongwang hu and guiren li, China.

2. The Domain Names and Registrar

The disputed domain names <sram-shop.com> and <sramstores.com> (the “Disputed Domain Names”) are registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 4, 2022. On October 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On October 5, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondents are listed as the registrants and providing the contact details.

The Center verified that 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 Respondents of the Complaint, and the proceedings commenced on October 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on November 4, 2022.

The Center appointed Gareth Dickson as the sole panelist in this matter on November 11, 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 a bicycle component manufacturer based in the United States.

The Complainant is the owner of a number of trade mark registrations for SRAM (the “Mark”) around the world, including United States trade mark registration number 2,056,661, registered on April 29, 1997.

The Disputed Domain Names <sram-shop.com> and <sramstores.com> were registered on August 25, 2022. Each of the Disputed Domain Names currently directs Internet users to webpages featuring an online shop which offers bicycle component products for sale (the “Websites”).

5. Parties’ Contentions

A. Complainant

The Complainant argues that it has rights in the Mark by virtue of its ownership of various trade mark registrations for the Mark around the world. It contends that the Disputed Domain Names are confusingly similar to the Mark since they incorporate the Mark (which is recognisable within the Disputed Domain Names) in its entirety with the addition of a hyphen and the word “shop” after the Mark, or the addition of the word “stores” after the Mark, under the generic Top-Level Domain (“gTLD”) “.com”.

The Complainant confirms that the Disputed Domain Names were registered by the Respondents without its permission and that the Respondents are not licensees of the Complainant. It alleges that the Respondents have been using the Disputed Domain Names to falsely suggest that the Websites are connected to the Complainant, in order to disrupt the Complainant’s relationship with consumers or to attempt to attract Internet users for commercial gain, by creating confusing similarity with the Mark, contrary to the Policy.

The Complainant submits that there is no evidence to suggest that the Respondents: have been commonly known by the Disputed Domain Names; are making, or intend to make, a legitimate noncommercial or fair use of the Disputed Domain Names (the services offered on the Websites having been commercial in nature) or have ever used or demonstrated preparations to use the Disputed Domain Names in connection with a *bona fide* offering of goods or services.

The Complainant submits that the Respondents must have known of the Complainant and the Mark when they registered the Disputed Domain Names. The Mark, according to the Complainant, is well known throughout the world, having first been used in a commercial context 34 years ago and registered over 25 years ago. The Respondents’ own use of the Disputed Domain Names (and of the Complainant’s logo on the Websites) to offer products for sale under the Mark further confirms that the Respondents knew of the Mark and the Complainant’s interest in it when they registered the Disputed Domain Names and that they registered them in bad faith.

The Complainant also argues that the use of the Disputed Domain Names for *per se* illegal activity (creating Websites falsely purporting to be the Complainant with an intent to deceive consumers, for commercial gain) is manifest evidence of bad faith use of the Disputed Domain Names.

Together, the Complainant submits that the Respondents registered and are using the Disputed Domain Names in bad faith.

B. Respondents

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

6. Discussion and Findings

6.1 Consolidation of Respondents

The Complainant has requested that its Complaint be "consolidated" into a single Complaint under paragraph 10(e) of the Rules, which states that: "A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules."

Paragraph 4(f) of the Policy permits consolidation "of multiple disputes between [a respondent] and a complainant". Section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), addresses the factors that UDRP panels will typically consider in determining whether or not to permit consolidation. These factors include: the registrants' contact information including email address(es), postal address(es), or phone number(s); the content or layout of websites corresponding to the domain names; the nature of the marks at issue; any naming patterns in the domain names, amongst others. A Panel can also have regard to procedural efficiency in weighing these factors.

In assessing these factors, the Panel notes that the Disputed Domain Names:

- (1) were registered on the same day;
- (2) have the same Registrar;
- (3) host the virtually identical Websites displaying the Mark and purporting to sell cycling products under the Mark;
- (4) host the Websites with nearly identical footers;
- (5) host the Websites with identical "Return & Exchanges" policies, including an identical typographical usage of the word "Rreturns" in the title tags;
- (6) host the Websites which use the same WordPress theme as shown in the HTML source code associated with each Website; and
- (7) were registered by the Respondents using the same email address ending "@lisystem.live".

The Panel has had regard to those provisions and has determined that it is appropriate to determine the Complaint in respect of the Disputed Domain Names in a single proceeding, such consolidation being fair and equitable to all Parties. Therefore, the "Respondents" are hereinafter referred to as the "Respondent".

6.2 Substantive Elements

Under paragraph 4(a) of the Policy, the Complainant bears the burden of proving that:

- a) the Disputed Domain Names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- c) the Disputed Domain Names have been registered and are being used in bad faith.

These criteria are cumulative. The failure of the Complainant to prove any one of these elements means the Complaint must be denied.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant is the owner of, and therefore has rights in, the Mark. Section 1.7 of the [WIPO Overview 3.0](#) provides that: “[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

Section 1.8 of the [WIPO Overview 3.0](#) further provides that: “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.”

The Panel therefore finds that the Disputed Domain Names are confusingly similar to the Mark, since the Disputed Domain Names incorporate the Mark in its entirety. The addition of “-shop” after the Mark in <sram-shop.com> and the addition of “stores” after the Mark in <sramstores.com> do not prevent a finding of confusing similarity between the Disputed Domain Names and the Mark, nor does the addition of the gTLD “.com”.

Accordingly, the Panel finds that the Disputed Domain Names are confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Although a complainant is required to demonstrate that a respondent has no rights or legitimate interests in respect of the domain name, as explained in section 2.1 of the [WIPO Overview 3.0](#), the consensus view of previous UDRP panels is that where a complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The use of a third party’s trade mark to offer genuine goods or services can in some circumstances be evidence of a *bona fide* offering of goods and services and thus constitute a right or legitimate interest in a domain name (also see section 2.8.1 of the [WIPO Overview 3.0](#)). For the purposes of the Policy, those circumstances have been set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“Oki Data”), which sets out four requirements which must all be met for the use to be considered legitimate.

These requirements may be stated briefly as follows:

- The Respondent must actually be offering the goods or services at issue;
- The Respondent must use the site to sell only the trade marked goods;
- The site must accurately disclose the registrant’s relationship with the trade mark owner; and
- The Respondent must not try to corner the market in all domain names, thus depriving the trade mark owner of reflecting its own mark in a domain name.

Even assuming that the goods offered by the Respondent via the Disputed Domain Names are genuine goods first put on the market by the Complainant or with its consent, the Respondent cannot benefit from Oki Data since the Respondent does not appear to have accurately disclosed the lack of any relationship between it and the Complainant, notwithstanding that a commercial relationship will be inferred by the Respondent’s use of the Complainant’s trade mark in the Disputed Domain Names.

In the current proceeding, the Complainant has established its *prima facie* case. The evidence before the Panel is that the Mark is neither generic nor descriptive but enjoys a degree of inherent distinctiveness which, combined with the Complainant’s long-term exclusive use of the Mark, makes a coincidental adoption by the Respondent highly unlikely. The Complainant states that it has not given the Respondent permission to use the Mark, in a domain name or otherwise, and submits that the Respondent has not been commonly

known by the Disputed Domain Names.

There is no evidence that the Respondent has acquired any common law rights to use the Mark, is commonly known by the Mark or has chosen to use the Mark in the Disputed Domain Names in any descriptive manner or is making any use of the Disputed Domain Names that would establish rights or legitimate interests as a result of a legitimate noncommercial or fair use of them.

By not participating in these proceedings, the Respondent has failed to refute the Complainant's *prima facie* case that it has met its burden under the second UDRP element.

As clearly stated in section 2.1 of the [WIPO Overview 3.0](#), "a panel's assessment will normally be made on the basis of the evidence presented in the complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed". Having reviewed and weighed the available evidence, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

C. Registered and Used in Bad Faith

The Panel notes that the Mark has already been the subject of at least two successful UDRP complaints brought by the Complainant.

The Panel also notes that the Disputed Domain Names were registered over 25 years after the Mark was registered and accepts that the Disputed Domain Names were chosen by reference to the Mark.

As a result, and in the absence of evidence from the Respondent that the similarity of the Disputed Domain Names to the Mark is coincidental, the Panel must conclude that the Respondent knew of the Complainant's rights in the Mark when it registered the Disputed Domain Names, particularly considering the Websites purportedly offering for sale products under the Mark.

The Panel therefore finds that the Respondent's registration of the Disputed Domain Names were in bad faith since it attempted to appropriate for the Respondent, without the consent or authorisation of the Complainant, rights in the Complainant's Mark.

The Disputed Domain Names are also being used in bad faith.

They are being used for a commercial purpose that involves redirecting Internet users (in particular those seeking the Complainant) to the Websites associated with the Respondent, whilst, contrary to the fact, representing that there is a connection to the Complainant.

The Respondent has not sought to explain its registration and use of the Disputed Domain Names and has not participated in these proceedings, leaving no basis for the Panel to conclude on the evidence available to it that the Respondent's use of the Disputed Domain Names is justified.

Therefore, the Panel finds that the Respondent's use of the Disputed Domain Names is without justification and is inconsistent with the Complainant's exclusive rights in the Mark. Consideration of these and other factors militates in favour of a finding of bad faith.

The Panel finds that the Respondent has registered and is using the Disputed Domain Names in bad faith.

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, <sram-shop.com> and <sramstores.com>, be transferred to the Complainant.

/Gareth Dickson/

Gareth Dickson

Sole Panelist

Date: November 26, 2022