

## **ADMINISTRATIVE PANEL DECISION**

Reebok International Limited v. Bernd FRUEH

Case No. D2023-1589

### **1. The Parties**

The Complainant is Reebok International Limited, United States of America (“United States”), represented by Authentic Brands Group, United States.

The Respondent is Bernd FRUEH, Germany.

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

The disputed domain name <reeboksshoes-nz.com> (the “Disputed Domain Name”) is registered with NETIM SARL (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 12, 2023. On April 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 13, 2023, 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 (John Doe/Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 13, 2023 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 April 13, 2023.

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”).

On April 18, 2023, the Center sent a communication to the Parties stating that the Disputed Domain Name was set to expire on June 24, 2023. The Center transmitted the information received from the Registrar indicating that locks will remain and that it was necessary for one of the Parties to perform a renewal.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 11, 2023.

The Center appointed Mariya Koval as the sole panelist in this matter on May 19, 2023. 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, founded in 1958, is a fitness footwear and clothing company, that is a part of Authentic Brands Group from 2021. Currently, the Complainant is one of the world's leading manufacturers of athletic footwear, apparel and sport, exercise and fitness equipment.

The Complainant is the owner of numerous REEBOK Trademark registrations (the "REEBOK Trademark") around the world, among which are:

- German Trademark Registration No. 1014280, registered on February 16, 1981, in respect of goods in class 25;
- New Zealand Trademark Registration No. 153152, registered on April 29, 1988, in respect of goods in class 25;
- International Registration No. 1097058, registered on October 19, 2011, in respect of goods in classes 18, 25, 28.

The Complainant has a significant online presence, operating, among others, the domain names <reebok.com> and <reebok.eu> reflecting its REEBOK Trademark in order to sale and promote the Complainant's goods and services; and being active on social-media platforms such as Facebook, LinkedIn, Instagram and YouTube.

The Disputed Domain Name was registered on June 24, 2022. As at the date of this Decision and when the Complaint was filed, the Disputed Domain Name resolves to a commercial website where the Complainant's allegedly counterfeit products are offered for sale.

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

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

The Complainant contends that it has gained national recognition as a fitness brand and has come to signify the quality and reputation of the Complainant's footwear, apparel, sporting equipment, and health and fitness services. Moreover, the Complainant spends millions of dollars marketing its goods and services globally, using the REEBOK Trademark, and has undertaken extensive efforts to protect its name and enforce the Trademark. The Complainant exerts careful control over use of the REEBOK Trademark and imposes strict quality control measures over goods and services offered under its Trademark.

The Complainant claims that the Disputed Domain Name is identical or confusingly similar to the Complainant's registered REEBOK Trademark. The Disputed Domain Name comprises the Complainant's REEBOK Trademark, the descriptive term "shoes", a hyphen, followed by the geographical abbreviation for New Zealand "NZ".

The Complainant further asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Respondent has not been licensed, contracted, or otherwise permitted by the Complainant in any way to use the REEBOK Trademark or to apply for any domain names incorporating the REEBOK Trademark, nor has the Complainant acquiesced in any way to such use or application of the REEBOK Trademark by the Respondent. The Respondent has not been commonly known by the Disputed Domain Name. Additionally, there is no evidence of the Respondent's fair use of the Disputed Domain

Name. Also, there is no evidence that the Respondent is using or plans to use the REEBOK Trademark or the Disputed Domain Name incorporating the REEBOK Trademark for a *bona fide* offering of goods or services that doesn't infringe the Complainant's intellectual property rights. On the contrary, the Respondent has been actively using the REEBOK Trademark in the Disputed Domain Name and on the physical website to promote its website for illegitimate commercial gains, more specifically, by operating a fake website offering counterfeit Reebok products. Such unauthorized use of the REEBOK Trademark is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities while in fact, no such relationship exists.

The Complainant also claims that the Respondent registered and is using the Disputed Domain Name in bad faith since the Complainant's REEBOK Trademark is well-known around the world and Respondent was obviously well aware of the Complainant's Trademark at the time he registered the Disputed Domain Name in 2022.

Additionally, the Respondent used a privacy shield to mask its identity, which makes it difficult for the Complainant to contact the Respondent and amicably settle a domain dispute.

Furthermore, the Respondent is trying to pass off the website under Disputed Domain Name as the Complainant's website to sell competing and unauthorized goods. The Respondent has no reason to use the REEBOK Trademark in the Disputed Domain Name other than to attract Internet users to his website for commercial gain. Thus, the Respondent is intentionally trying to create a likelihood of confusion with the Complainant's REEBOK Trademark as to the source, sponsorship, affiliation, or endorsement.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

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

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

The Complainant has properly asserted its rights in the REEBOK Trademark due to the long use and number of registrations globally. The Panel notes that the registration of the Complainant's REEBOK Trademark significantly predates the registration of the Disputed Domain Name. The Panel also finds that the Complainant has established that the REEBOK Trademark is well-known.

The Disputed Domain Name completely reproduces the Complainant's REEBOK Trademark in combination with the letter "s", dictionary word "shoes", hyphen, geographical term "nz", and the generic Top-Level domain ("gTLD") ".com". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, 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. In this case, the addition of the letter "s", word "shoes", and term "nz", to the REEBOK Trademark does not prevent a finding of confusing similarity.

According to the [WIPO Overview 3.0](#), section 1.11, the applicable gTLD 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.

Pursuant to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

Furthermore, the use of hyphens in the Disputed Domain Name is irrelevant in a finding of confusing similarity, see e.g. *Royale Indian Rail Tours Limited v. Divino Indian Memoirz Tours Pvt. Ltd.*, WIPO Case No. [D2010-2107](#) (“In the present case, the Panel finds that... adding a hyphen between the two words “maharaja” and “express” in the disputed domain name are insignificant modifications that do not reduce the confusing similarity between the disputed domain name and the Complainant’s mark”).

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s REEBOK Trademark pursuant to paragraph 4(a)(i) of the Policy.

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

The Complainant alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy. The Complainant has never authorized in any way or licensed the Respondent to use its REEBOK Trademark.

In accordance with section 2.1 of the [WIPO Overview 3.0](#) while the overall burden of proof in UDRP proceedings is on the Complainant, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is generally deemed to have satisfied the second element.

Taking into account the facts and arguments set out above, the Panel finds that the Complainant has made a *prima facie* case: the Respondent registered the Disputed Domain Name more than 40 years after the REEBOK Trademark had been registered; there is no evidence that the Respondent owns any REEBOK Trademarks, nor that it is commonly known by the Disputed Domain Name. Therefore, the Respondent has failed to come forward with any evidence to rebut such *prima facie* case.

There is no evidence that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name or that before any notice of the dispute the Respondent has made use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services. On the contrary, the Disputed Domain Name is being used to mislead Internet users, by offering counterfeit products for sale under the REEBOK Trademark, for the purpose of making a profit.

According to the [WIPO Overview 3.0](#), section 2.8.1, UDRP panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the “Ok! Data test”, the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

As is seen from the circumstances of this case, the website under the Disputed Domain Name does not disclose the relationship between the Complainant and the Respondent. On the contrary, it creates a false impression that the website under the Disputed Domain Name is the Complainant's official websites or related to the Complainant. Thus, the Respondent does not satisfy the conditions of the Oki Data test.

Moreover, in accordance with the [WIPO Overview 3.0](#), section 2.5.1, 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. The addition of the word "shoes", which refer to the products the Complainant manufactures, and the term "nz", which is the two-letter country code for the New Zealand where the Complainant has its REEBOK Trademark registrations and conducts business, to the Complainant's REEBOK Trademark in the Disputed Domain Name, is further evidence, that the Respondent was very well aware of the Complainant's REEBOK Trademark and business at the time of registration of the Disputed Domain Name and has done so for the only purpose of creating an impression that the Disputed Domain Name is connected with the Complainant's REEBOK Trademark.

The Respondent did not file any response to the Complaint and did not participate in this proceeding, respectively, the Respondent did not present any evidence for supporting any rights or legitimate interests in the Disputed Domain Name.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

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

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that indicate bad faith conduct on the part of the respondent, namely:

"(i) circumstances indicating that the respondent has registered or has acquired the disputed 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 disputed domain name; or

(ii) the respondent has registered the disputed 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed 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 Complainant registered its REEBOK Trademark in 1981 and registered its domain name <reebok.com> in 1994. Thus first use of REEBOK Trademark by the Complainant is more than 40 years before the Respondent registered the Disputed Domain Name. Moreover, the Complainant's REEBOK Trademark is original, highly distinctive and well-known, and it is most unlikely that the Respondent could have registered the Disputed Domain Name, which incorporates the REEBOK Trademark in its entirety, accidentally. In view of this, the Panel is of opinion that the Respondent was likely well aware of the Complainant's Trademark when he registered the Disputed Domain Name in 2022.

The Disputed Domain Name incorporates the Complainant's REEBOK Trademark in its entirety that creates a strong likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name.

In addition, according to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos 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. The Panel is of opinion that it is clear that the Respondent, having registered and used the Disputed Domain Name, which is confusingly similar to the Complainant's well-known REEBOK Trademark, primarily intended to disrupt the Complainant's business and reputation. In view of the absence of any evidence to the contrary and that the Respondent did not file any statement, the Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith.

Moreover, the Respondent's knowledge of the Complainant's Trademark is also supported by the use of the Disputed Domain Name which resolved to the commercial website apparently offering the products under the REEBOK Trademark and containing the Complainant's logo. It should also be noted that the website under the Disputed Domain Name contained no information about the Respondent's relation to the Complainant (or lack thereof). As a result, the Panel finds that the Respondent had the Complainant's REEBOK Trademark in mind and intentionally targeted the Complainant when it registered the Disputed Domain Name. Accordingly, the Panel concludes that the Respondent registered and used the Disputed Domain Name in bad faith to create a likelihood of confusion with the Complainant's REEBOK Trademark. Accessing the Disputed Domain Name, the Internet users would most likely consider that it is related to or associated with the Complainant and the Complainant's business.

Finally, the Respondent, not participating in these proceedings, has failed to indicate any facts and/or evidence, which would show a good faith registration and use of the Disputed Domain Name. Moreover, the Respondent masked its identity in the publicly-available Whois via the use of a privacy service, which, under the circumstances of this proceeding, is a further indication of bad faith.

In view of the foregoing, the Panel finds that paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant and accordingly, the Disputed Domain Name has been registered and is being used 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 Name <reebokshoes-nz.com> be transferred to the Complainant.

*/Mariya Koval/*

**Mariya Koval**

Sole Panelist

Date: June 2, 2023