

ADMINISTRATIVE PANEL DECISION

Spyder Active Sports, Inc. v. Client Care, Web Commerce
Communications Limited
Case No. D2023-3688

1. The Parties

The Complainant is Spyder Active Sports, Inc., United States of America, represented by Authentic Brands Group, United States of America.

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

2. The Domain Name and Registrar

The disputed domain name <spyderoutletaustralia.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 September 1, 2023. On September 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 5, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 5, 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 September 5, 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 26, 2023. The Respondent *did not submit any response*. Accordingly, the Center notified the Respondent’s default on September 29, 2023.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on October 4, 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, Spyder Active Sports, Inc. operates the trademark SPYDER which has been used for more than 40 years for promoting and selling winter sports apparel, outerwear, and other sporting goods.

Spyder Active Sports, Inc. holds more than 150 trademarks worldwide, including the following two Australian registrations:

- SPYDER, Australian trademark registered under No. 1039391, in Class 25, on January 27, 2005;

-  (SPYDER logo), Australian figurative trademark registered under No. 1008037 in Class 25, on June 24, 2004.

The disputed domain name <spyderoutletaustralia.com> was registered on March 13, 2023.

It resolves to an active website that purports to sell goods under the SPYDER trademark and ostensibly displays the Complainant's SPYDER logo and trademark as a header.

5. Parties' Contentions

A. Complainant

The Complainant's arguments in support of its Complaint can be summarized as follows:

First, the Complainant contends that the disputed domain name is identical or confusingly similar to its trademark SPYDER. It incorporates the word SPYDER in full; the addition of the descriptive word "outlet" and the geographical indicator "Australia" cannot exclude a likelihood of confusion. Moreover, the use of the generic and descriptive term "outlet" which relates to the Complainant's type of goods only increase the risk of confusion.

Second, the Complainant indicates that the Respondent has no rights or legitimate interests in the disputed domain name. It has not been licensed, contracted or otherwise permitted to use the trademark SPYDER or to apply for any domain name incorporating this trademark. Moreover, there is no evidence that the Respondent is commonly known by the name "Spyder Outlet Australia" or make a fair use of it. Actually, the Respondent has been actively using the Complainant's trademarks SPYDER on the physical website to trick customers into believing that this website is somehow affiliated with, or endorsed by, the Complainant, while in fact no such relationship exists.

Third, the Complainant asserts that the disputed domain name was registered and is being used in bad faith because: (1) the trademarks SPYDER are well-known around the world, (2) the Respondent registered the disputed domain name at least 40 years after the Complainant established its first rights in the trademark SPYDER, (3) the Respondent has set up a website in an attempt to pass it off as an official Spyder website, presenting unauthorized goods, and creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation and endorsement of the Respondent's website and products, (4) the Respondent used a privacy shield to mask its identity.

For the reasons described above, the Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

For the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of the probabilities that:

- (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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant, under the first requirement of paragraph 4(a) of the Policy, needs to establish that the disputed domain name is confusingly similar to a trademark or a service mark in which it has rights. This is primarily a standing requirement.

The Panel notes that the Complainant has shown rights over the trademark SPYDER, which is fully reproduced as the first element of the disputed domain name.

The addition of the elements "outlet" and "australia" after the trademark SPYDER, does not prevent a finding of confusing similarity as the Complainant's trademark remains recognizable - see section 1.8 of the [WIPO Overview 3.0](#) which states that "[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 is therefore confusingly similar to the Complainant's trademarks.

The Complainant is deemed to have satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the Policy, a Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the Respondent carries the burden of production of evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant has a worldwide presence and has garnered substantial media attention for its products using the trademark SPYDER. The Complainant did not license or otherwise authorize the Respondent to use this trademark.

Besides, the Respondent is using the disputed domain name to operate a website ostensibly displaying the Complainant's SPYDER trademark and logo as a header, and apparently offering for sale products bearing the trademark SPYDER, without the Complainant's authorization.

In this respect, there is a consensus view that a reseller using a domain name containing a complainant's trademark to undertake sales related to a complainant's goods may constitute a *bona fide* offering of goods and services and thus has a legitimate interest in the domain name if the following cumulative requirements are met (see [WIPO Overview 3.0](#), section 2.8):

- (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.

Here, the Panel notably finds that the Respondent's website seeks to create an impression of association with the Complainant, by using the word SPYDER in its domain name and by prominently displaying the Complainant's Spyder Logo and trademark in its content, but does not accurately and prominently disclose its (lack of) relationship with the Complainant.

In these conditions, even assuming that the Respondent would be offering for sale genuine SPYDER goods, it would not be able to claim any rights or legitimate interests in the disputed domain name.

Section 2.1 of [WIPO Overview 3.0](#) provides that "where a complainant makes out 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 Respondent did not respond to the Complaint and thus has failed to rebut the *prima facie* case of its lack of rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

In order to prevail under the third element of paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy lists a number of circumstances which, without limitation, are deemed to be evidence of the registration and use of a domain name in bad faith. These are:

- (i) circumstances indicating that [a respondent has] registered or acquired a disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant or to a competitor of the 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 complainant from reflecting the complainant's trademark or service 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.

With regards to the registration criterion, the Respondent necessarily had the Complainant's trademark in mind when registering the disputed domain name. Indeed, the Complainant's SPYDER trademarks have been recognized for many years in the sportswear trade. Also, the addition of the words "outlet" and "Australia" implies that the Respondent configured the disputed domain name so as to inform users that they accessed an outlet online store associated with the Complainant and aimed at consumers in Australia.

With regards to the use of the disputed domain name, it resolves to a website displaying the Complainant's trademark and logo without authorization, and pretending to sell goods bearing the trademark SPYDER as though it is associated with the Complainant. This suggests an intent to defraud the Complainant's customers and also falls within the scope of bad faith envisioned under paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the third element of paragraph 4(a) of the Policy is satisfied.

The Complaint succeeds.

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, <spyderoutletaustralia.com>, be transferred to the Complainant.

/Benjamin Fontaine/

Benjamin Fontaine

Sole Panelist

Date: October 18, 2023