

## **ADMINISTRATIVE PANEL DECISION**

New Balance Athletics, Inc. v. Client Care, Web Commerce Communications Limited

Case No. D2022-0215

### **1. The Parties**

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

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

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

The disputed domain name <nbonlineuksale.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 January 21, 2022. On January 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 25, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 26, 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 January 28, 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 February 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 23, 2022.

The Center appointed Andrew Brown Q.C. as the sole panelist in this matter on March 2, 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 large athletics footwear and apparel company which has offered such products under the NEW BALANCE and NB trademarks in more than 120 countries.

The Complainant is the owner of a number of trademark registrations in the U.S., European Union (“EU”), and United Kingdom (“UK”) for the trademark NB in both stylized form and in plain capitals. Details are:

Mark	No.	Jurisdiction	Date	Class
NB	3360160	U.S.	December 25, 2007	25
NB	004577771	EU	August 21, 2006	25
NB logo	UK00001093656	UK	April 6, 1978	25

The EU registration covered the UK as that registration was achieved prior to Brexit. Post-Brexit a UK specific registration was created from the EU registration.

The Complainant states that its NB trademark is the subject of numerous international registrations in jurisdictions around the world including in Argentina, Australia, Brazil, Canada, China, Colombia, Costa Rica, Ecuador, Hong Kong, China, India, Indonesia, Japan, Malaysia, Mexico, New Zealand, Norway, Panama, Paraguay, Philippines, Republic of Korea, Russian Federation, Singapore, Switzerland, Taiwan Province of China, Thailand, Turkey, and Uruguay. All of the foregoing registrations of the NB mark in this section are collectively referred to as the NB trademark/trademarks or the Complainant’s Marks.

The Complainant claims to have exclusively and continuously used its NEW BALANCE and NB trademarks since as early 1974 to identify its footwear and apparel products. It also claims “an enormous amount of goodwill and reputation” in connection with these marks.

The disputed domain name was registered on July 15, 2021.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant asserts its rights in the NEW BALANCE and NB trademarks. It contends that the disputed domain name is confusingly similar to the Complainant’s NB trademark. It states that the disputed domain name incorporates the NB trademark in its entirety alongside the descriptive terms “online”, “sale”, and “uk”.

The Complainant states that these added descriptive terms do nothing to distinguish the disputed domain name from the Complainant’s Marks, and, if anything, they increase the likelihood of confusion by suggesting that the website (and products on sale) found at the disputed domain name are part of an NB official online sale in the UK.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the Respondent has not made any demonstrative preparations to use the disputed domain name with a *bona fide* offering of goods or services. The Complainant asserts that a review of the website found at the disputed domain name suggests two possibilities.

- The first is that the Respondent is using the disputed domain name to advertise and sell thousands of

unauthorized and/or counterfeit “NEW BALANCE” footwear products, in some instances for less than half the corresponding retail value;

- The second (“and more likely possibility”) is that the Respondent is using the disputed domain name to fraudulently collect personal information and payment information at online checkout on the false promise of offering authentic “NEW BALANCE” footwear at deep discounts.

The Complainant asserts that the Respondent has not acquired or owned any trademark or service mark rights in “nb” or “nbonline”. Similarly, it has no rights in “nbonlineuk” or “nbonlineuksale” and had not been commonly known by the disputed domain name.

The Complainant states that the Respondent does not have any license, permission or authorization from it to use its trademarks or to apply for a domain name incorporating such trademarks.

Finally, the Complainant contends that the disputed domain name was registered and has been used in bad faith. It points to the worldwide fame and notoriety of its NEW BALANCE and NB trademarks in relation to athletic footwear. It states that the Respondent registered the disputed domain name to impersonate the Complainant for profit under false pretenses.

The Complainant says in summary that the Respondent has used the website at the disputed domain name:

- (i) To sell counterfeit or unauthorized imitations of the Complainant’s footwear; and/or
- (ii) To collect personal information and payment information on the false premise of selling authorized NEW BALANCE and NB footwear at deep discounts.

## **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following elements with respect to the disputed domain name in order to succeed in this proceeding:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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 Complainant has provided evidence of registration of its NB trademark in the U.S., EU, and UK for *inter alia* footwear. It has also provided evidence of extensive use of its NB trademark internationally, in the UK and in some 120 countries commencing in 1974.

It is the Panel’s view that the Complainant has clearly and sufficiently demonstrated its rights in the NB trademark. The Panel is well satisfied that the Complainant is well known by its NB trademark and has extensive goodwill in its NB trademark in relation to footwear and clothing – particularly in the UK.

The disputed domain name incorporates NB in its entirety.

The threshold of showing that a disputed domain name is confusingly similar is a relatively low threshold: *RapidShare AG and Christian Schmid v. Majeed Randi*, WIPO Case No. [D2010-1089](#).

Further, when a disputed domain name incorporates a trademark in its entirety there is sufficient similarity between the Mark and the disputed domain name to render it confusingly similar: *EAuto, L.L.C. v Triple S. Auto Parts D/B/A Kung Fu Yea Enterprises, Inc.*, WIPO Case No. [D2000-0047](#).

As noted in 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”. It is the Panel’s view that the addition of the terms “online”, “sale”, and “uk” to the NB trademark does not prevent a finding of confusingly similarity between the disputed domain name and the Complainant’s NB trademark, which remains clearly recognizable in the disputed domain name.

The Panel finds that the disputed domain name is therefore confusingly similar to the Complainant’s NB trademark and finds in favor of the Complainant.

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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish that it has rights or legitimate interests in the disputed domain name, among other circumstances, by showing any one of the following elements:

- (i) that before any notice of the dispute, the Respondent used or made 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; or
- (ii) that the Respondent has been commonly known by the disputed domain name, even if it had acquired no trademark or service mark rights; or
- (iii) that the Respondent is 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 trademark or service mark at issue.

The overall burden of proof for establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name lies with the Complainant.

There is no evidence of the existence of any rights or legitimate interests on the part of the Respondent in the NB Mark pursuant to paragraph 4(c) of the Policy. The Complainant has (prior) rights in the NB Mark which well precede the Respondent’s registration of the disputed domain name.

The Panel is satisfied that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The fact that the Respondent has reproduced models of the Complainant’s shoes at the website located at the disputed domain name and is using the website for, *inter alia*, phishing activities clearly confirms that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent has failed to show that it has acquired any rights or legitimate interests in respect of the disputed domain name or that the disputed domain name is used in connection with a *bona fide* offering of goods or services. The Respondent had the opportunity to demonstrate its rights or legitimate interests, but it did not reply to the Complainant’s contentions.

The Panel therefore finds that the Complainant has satisfied the burden of establishing a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and accordingly finds that paragraph 4(a)(ii) of the Policy is satisfied in favor of the Complainant.

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

The Panel is also satisfied that the disputed domain name has been registered in bad faith for the following reasons:

- (i) the Panel is satisfied that the Complainant's NB trademark is well known for footwear. Having reviewed the website located at the disputed domain name, the Panel is also satisfied that, with knowledge of the Complainant's NB trademark, the Respondent intentionally registered the disputed domain name (incorporating that well known NB trademark) so as to impersonate the Complainant; and
- (ii) the circumstances of the case and in particular the adoption of the Complainant's NB trademark in a phishing scam to obtain consumer's personal and payment details indicates to the Panel that the Respondent registered the disputed domain name to create a likelihood of confusion with the Complainant's NB trademark for the purposes of financial gain.

The Panel is also satisfied that the disputed domain name has been used in bad faith for the following reasons:

- (i) the fact that the website located at the disputed domain name is used either:
  - (a) to sell counterfeit or unauthorized versions of the Complainant's footwear; or
  - (b) to collect personal information and payment information by false pretenses demonstrate that the Respondent is exploiting the confusion created by unauthorized use of the Complainant's NB Mark within the disputed domain name and at the website to attract Internet users for commercial gain under false pretenses;
- (ii) the Panel accepts the Complainant's submission that such use evidences the Respondent's clear bad faith use of the disputed domain name. It is the Panel's view that such impersonation for financial gain constitutes use of the disputed domain name for fraudulent activity and therefore constitutes bad faith; and
- (iii) further, the Respondent has made no submissions in these proceedings and so the Panel infers that the Respondent has intentionally used the disputed domain name with an intent to confuse Internet users into thinking that it is controlled by the Complainant or an entity affiliated with the Complainant.

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied in favor of the Complainant.

### **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 <nbonlineuksale.com>, be transferred to the Complainant.

*/Andrew Brown Q.C./*

**Andrew Brown Q.C.**

Sole Panelist

Date: March 14, 2022