

## **ADMINISTRATIVE PANEL DECISION**

**PUMA SE v. Domain Admin, Whoisprotection.cc / Pfaff Christian**  
Case No. D2022-0443

### **1. The Parties**

The Complainant is PUMA SE, Germany, represented by RNA, Technology and IP Attorneys, India.

The Respondent is Domain Admin, Whoisprotection.cc, Malaysia / Pfaff Christian, Germany.

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

The disputed domain name <pumastoreindia.com> is registered with Mat Bao Corporation (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2022. On February 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 11, 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 February 21, 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 February 25, 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 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 21, 2022.

The Center appointed Theda König Horowicz as the sole panelist in this matter on April 26, 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 company organized and existing under the laws of Germany. For over 65 years, the Complainant is engaged in the business of manufacturing and marketing a wide range of products, *inter alia* sports shoes, apparel, and accessories. It is one of the world leaders in this field and it is active in a wide series of sport types such as football, running, training and fitness, golf, and motorsports.

The Puma Group has affiliated companies worldwide including in India where it operates under the company name Puma Sports India Private Limited which was incorporated in 2005.

The Complainant is also known for being a sponsor of major soccer teams and is associated with famous soccer players, other athletes, and prominent celebrities. Its PUMA brand is widely advertised in different type of media.

The Puma Group owns a wide range of brands including the word mark PUMA and PUMA with logo. The trademark PUMA was created in 1948 by Rudolf Dassler and was officially filed on October 1, 1948 (see German trademark registration no. 608870 for PUMA, registered on July 9, 1951). Due to its popularity and its continuous and extensive use worldwide (including India), the PUMA trademark is well-known. The well-known character of the mark was recognized by various jurisdictions, including by the Indian Trade Mark Registry.

The trademark PUMA is registered in several countries including in India where it is has been extensively used since 1982.

The Complainant is also the owner of many domain names comprising PUMA including <puma.com> which was registered in 1997 and which is used for its official online presence. The Complainant also has extensive presence on social media.

The disputed domain name was registered on January 18, 2021. The disputed domain name was linked to a website reproducing the logo of the Complainant and selling goods bearing the Complainant's trademark and logo for amounts indicated in Indian rupees. The website's content was in English.

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

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

The Complainant alleges to have prior trademark rights on PUMA around the world including in India. The disputed domain name is nearly identical to the Complainant's PUMA mark save for the words "store" and "india" which do not serve to distinguish the disputed domain name from the Complainant's trademark. The disputed domain name contains the Complainant's well-known PUMA trademark in its entirety.

The Complainant further alleges that the Respondent could not ignore the well-known PUMA trademark when registering the disputed domain name. There is no credible legitimate reason for which the Respondent has chosen the disputed domain name. According to the Complainant the disputed domain name was chosen to use the fame of its PUMA mark in order to generate web-traffic and to confuse internet users who might be looking for the Complainant's famous goods. The disputed domain name would be used by the Respondent in order to illegally offer the products under the PUMA brand thus creating a likelihood of confusion as to the sponsorship, affiliation or endorsement of the website. The Complainant did not authorize the Respondent to use its famous mark.

The Complainant is of the opinion that the Complainant had registered and is using the disputed domain name in bad faith considering the well-known character of the PUMA trademark and brand. Furthermore, the Complainant submits that the disputed domain name has been chosen by the Respondent in order to derive unfair monetary advantage by offering PUMA branded products without the Complainant's authorization from the Complainant. The registration and use of the disputed domain name is made in order to divert traffic by using the Complainant's well-known PUMA trademark.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under the Policy, in order to prevail, a complainant must prove the following three elements for obtaining the transfer of a domain name:

- (i) that the disputed domain name 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 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 showed to have trademark rights in PUMA through several registrations worldwide, including in Germany where the Respondent is based and in India.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test 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. In 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.

Furthermore, according to 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 does not prevent a finding of confusing similarity.

The disputed domain name contains the PUMA trademark in its entirety. The addition in the disputed domain name of the term "store" and the name of the country "india", does not prevent confusing similarity, as the PUMA trademark remains clearly recognizable in the disputed domain name.

Under these circumstances, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's mark.

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

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in the use of a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services;

(ii) being commonly known by the domain name; or

(iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made several submissions in order to demonstrate that the Respondent would have no rights or legitimate interests in the disputed domain name. More specifically, the Complainant has shown that the disputed domain name was used in relation to a website extensively using without authorization the famous PUMA Trademark and logo, thus wrongly giving the impression to be associated or affiliated with the Complainant.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case and the burden of production shifts to the Respondent who has chosen not to reply.

The Panel notes that the case file does not show that the Respondent would be known as “puma”, that he would be genuinely active in the selling of PUMA goods or that he would not try to misleadingly divert consumers for commercial gain.

Given the nature of the disputed domain name which fully incorporates the Complainant’s famous PUMA trademark along with the terms “store” and “india”, the false impression was indeed given that the Respondent would be operating a legitimate business of PUMA goods in India. Such composition cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#).

Furthermore, it could not have been clear to Internet users visiting the Respondent’s website that it was not operated by the Complainant considering the extensive use on the website of the PUMA logo, the descriptions of the goods sold on the website which are all referring to the Complainant’s PUMA brand, and the fact that there is no disclaimer as to the lack of relation to the Complainant. See sections 2.5.2 and 2.8 of the [WIPO Overview 3.0](#).

In addition, the website was obviously of commercial nature since all goods bore a description each time containing a reference to the PUMA brand and a specific price in Indian rupees. See section 2.5.3. of the [WIPO Overview 3.0](#).

Consequently, the Panels finds that the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

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

The Panel notes that the Complainant’s trademark PUMA is a registered trademark which has been widely used by the Complainant in many countries for several decades in relation notably to sport apparel and sport accessories. As evidenced by the Complainant, the trademark PUMA has acquired the status of a well-known trademark in many countries, notably in its home country Germany where the Respondent is based and in India where the trademark PUMA is listed as a well-known trademark in the Indian Trademark Registry.

There can be no doubt that the Respondent knew about the PUMA brand when registering the disputed domain name. See section 3.2.2 of the [WIPO Overview 3.0](#).

Furthermore, the Complainant has established that the Respondent’s intent in registering the disputed domain name was in fact to profit from or otherwise exploit the Complainant’s trademark because the website which was used in relation to the disputed domain name was set up in a way to create a likelihood of

confusion with the Complainant, notably by widely using the PUMA logo on the said site which falsely insinuates a connection with the Complainant's business and brand. See section 3.1.4 of the [WIPO Overview 3.0](#).

The Panel further notes that the Respondent has hidden its identity by using a privacy service when registering the disputed domain name and chosen not to respond, which are other indications of bad faith in the present circumstances.

All these circumstances indicate that the Respondent's intent in registering and using the disputed domain name was in fact to profit in some fashion from or otherwise exploit the Complainant's well-known trademark. See section 3.1.1 of the [WIPO Overview 3.0](#).

In light of the above, the Panel finds that the Respondent has registered and used is using the disputed domain name in bad faith and that the Complainant has established its case under 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 <pumastoreindia.com> be transferred to the Complainant.

*/Theda König Horowicz/*

**Theda König Horowicz**

Sole Panelist

Date: May 13, 2022