

ADMINISTRATIVE PANEL DECISION

Skechers U.S.A., Inc. II v. Whoisprotection.cc
Case No. D2022-0556

1. The Parties

The Complainant is Skechers U.S.A., Inc. II, United States of America (“United States” or “USA”), represented by D Young & Co LLP, United Kingdom.

The Respondent is Whoisprotection.cc, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <skecherssalg.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 February 17, 2022. On February 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 18, 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 18, 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 18, 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 March 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 4, 2022.

The Center appointed Knud Wallberg as the sole panelist in this matter on May 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 member of the Skechers group of companies (“Skechers group”), a multi-billion-dollar global business in the lifestyle and performance footwear industry, established in 1992 in Manhattan Beach, California, United States. Skechers group footwear products are sold in more than 170 countries and territories around the world, in over 3,000 Skechers group retail stores and online through Skechers group website at “www.skechers.com”. Skechers group footwear products are also available through department stores, specialty stores, athletic specialty shoe stores, independent retailers, and Internet retailers worldwide. The Complainant is a wholly owned subsidiary of Skechers U.S.A., Inc. The Complainant owns multiple trademark registrations throughout the world for the word trademark SKECHERS, including United States Trademark Registration No. 1,851,977 registered on August 30, 1994, and United Kingdom Trademark Registration No. 00002143082 applied on August 27, 1997, and registered February 20, 1998, for goods in International Class 25.

The Complainant and companies in Skechers group are registrants of a significant portfolio of domain names incorporating the SKECHERS trademark, including <skechers.com>, <skechers.co.uk>, <skechers.com.au>, and <skechers.com.hk>.

The disputed domain name <skecherssalg.com> was registered on April 21, 2021. At the time of the filing of the disputed domain name resolved to a website that purportedly offered sale of goods bearing the SKECHERS trademark.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to the Complainant’s SKECHERS trademark. The disputed domain name includes the SKECHERS trademark in its entirety with the addition of the term “salg”. The website associated with the disputed domain name targets Norwegian consumers as its default language is Norwegian and the default currency is Norwegian Krone. Therefore, the average Norwegian consumer would understand “salg” within the disputed domain name as meaning “sale”. The inclusion of the descriptive word “sale” in the disputed domain name does not remove the disputed domain name from the realm of confusing similarity.

The Complainant submits that none of the circumstances, which are specified in Paragraph 4(c) of the Policy as demonstrating the Respondent’s rights to, or legitimate interests in the disputed domain name are present in this instance. The Respondent registered the disputed domain name on November 14, 2021, over 25 years after the Complainant registered and began using the SKECHERS trademark. SKECHERS is an arbitrary term, which has no meaning outside its use as a means to identify the Complainant as the source of the relevant products. The Complainant is the proprietor of the SKECHERS trademark in relation to *inter alia* footwear. The Respondent is not a licensee, authorized retailer, or distributor of the Complainant’s products. Nor is the Respondent otherwise authorized to use the name or the SKECHERS trademark for any purpose and has no connection or affiliation with the Complainant, just as there is no evidence in the record to suggest that the Respondent was commonly known by the disputed domain name.

The Complainant further submits that it is clear that the Respondent is not making use of the disputed domain name in connection with a *bona fide* offering of goods/services (as per paragraph 4(c)(i) of the Policy) or legitimate noncommercial or fair use of the disputed domain name in accordance with paragraph 4(c)(iii) of the Policy given that the Respondent is operating the disputed domain name to gain commercially

from falsely suggesting an affiliation with the Complainant. The Respondent uses the SKECHERS trademark on its website to sell suspected counterfeit products that compete directly with the Complainant's business. The Complainant suspects that these are counterfeit products on the basis that shoes sold on the Respondent's website are significantly cheaper than those sold through the Complainant's website. Furthermore, the Respondent used multiple logos and promotional images, the copyright in which is owned or exclusively licensed to the Complainant, without authorization and in breach of copyright. As a result, unsuspecting consumers may have been duped into believing that the Respondent's website was an official website and the products displayed originate from the Complainant, when that is not the case. In addition, the Complainant's representative conducted a test purchase from the website on the January 27, 2022. Funds were withdrawn from the bank account however no order confirmation email or shipping notification was received. At the time of submitting this Complaint, the goods ordered had not yet been received. This suggests that the website may be is being used to obtain the card details or to steal money from consumers for illicit purposes.

The Complainant finally submits that the very nature of the Respondent's registration of the disputed domain name evidence bad faith. The Complainant thus submits that upon information and belief, the Respondent knowingly registered the disputed domain name containing a confusingly similar reproduction of the well-known SKECHERS trademark to capitalize on consumer recognition of the SKECHERS trademark. The Complainant is engaged in the business of designing, developing, and marketing footwear and apparel products, and the Respondent is using the disputed domain name to mislead consumers into purchasing shoes, which the consumer believes are genuine products when such products actually may not exist or are suspected to be counterfeit products. As mentioned, the Complainant's representative conducted a test purchase from the website on the January 27, 2022, and the goods have not yet been received. This suggests that the website may be used to obtain the card details or to steal money from consumers for illicit purposes. Therefore, the Complainant submits that the disputed domain name is used in bad faith for the purpose of misleading and causing loss to consumers and damaging the Complainant's valuable goodwill.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following:

- (i) that the domain name registered by the respondent are 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 domain name; and
- (iii) that the domain name have been registered and is being used in bad faith.

Paragraph 4(a) of the Policy states that the burden of proving that all these elements are present lies with the Complainant. At the same time, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules, or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar (in the sense of the Policy) to the

Complainant's registered trademark SKECHERS, since the disputed domain name contains this mark in its entirety. The addition of the term "salg", which is a term in Norwegian and in Danish meaning "sale", does not prevent confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The generic Top-Level Domain ("gTLD") ".com" is a standard registration requirement and as such they are generally disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

The Panel finds that the conditions in paragraph 4(a)(i) of the Policy are therefore fulfilled in relation to the disputed domain name.

B. Rights or Legitimate Interests

It is obvious from the Complaint, that the Complainant has not licensed or otherwise permitted the Respondent to use the trademark SKECHERS.

Further, given the circumstances of this case, the Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not rebutted this. Furthermore, the way the Respondent is using the confusingly similar disputed domain name to mislead Internet users for the purpose of charging or collecting payment information, supports a finding that the Respondent lacks rights or legitimate interests in the disputed domain name.

Consequently, the Panel finds that the conditions in paragraph 4(a)(ii) of the Policy are also fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the complainant to prove both registration and use of a domain name in bad faith. Paragraph 4(b) of the Policy provides examples of circumstances, which shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the 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 holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the 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 domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the 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 holder's website or location.

Accordingly, for the Complainant to succeed, the Panel must be satisfied that the disputed domain name has been registered and is being used in bad faith.

Given the circumstances of the case, including the coined nature of the of the Complainant's trademark SKECHERS and the way that the disputed domain name has been used, it is obvious to the Panel in the

current circumstances that the Respondent registered the disputed domain name in bad faith.

The disputed domain name has been used for a website, which, *inter alia* by reproducing the Complainant's logo, clearly gave the Internet user the impression that the website was an official website of the Complainant. Not only is this not the case, but the Complainant has furnished evidence that indicates that some of the goods that were offered for sale on the websites may be counterfeited SKECHERS goods and that the disputed domain name may be used to obtain the card details or deceive money from consumers who attempts to buy products from the website. The Panel therefore finds that there can be no doubt that the disputed domain name has been used in bad faith to intentionally attempt "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". The fact that the website appears to be unavailable at present does not alter this finding.

Noting that the disputed domain name incorporates the Complainant's distinctive trademark SKECHERS and the gTLD ".com"; that the Respondent has not replied to the Complainant's contentions; and that there appears to be no conceivable good faith use that could be made by the Respondent of the disputed domain name, and considering all the facts and evidence of the case, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy are also fulfilled in this case.

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

/Knud Wallberg/

Knud Wallberg

Sole Panelist

Date: May 16, 2022