

## **ADMINISTRATIVE PANEL DECISION**

**New Balance Athletics, Inc. v. Client Care, Web Commerce  
Communications Limited  
Case No. D2022-0908**

### **1. The Parties**

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

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

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

The disputed domain names <nbbrasil.com> and <nbnorway.com> (hereafter referred to as the “Disputed Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private Limited.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 15, 2022. On March 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On March 17, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Disputed Domain Names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 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 March 23, 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 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 25, 2022.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on April 29, 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, New Balance Athletics, Inc., is an athletic footwear and apparel company offering products branded under the NEW BALANCE and NB trademarks in more than 120 countries.

The Complainant holds numerous registered trademarks consisting of or including the sign NB, such as the following:

- NB, word mark registered in the USA under No. 3360160 on December 25, 2007 in class 25;
- below figurative mark registered in Brasil under No. 780252942 on August 3, 1982 in class 25:



- below figurative mark registered in Norway under No. 130596 on November 12, 1987 in classes 18 and 25:



The Disputed Domain Names have been registered on the following dates:

- <nbbrasil.com>: July 15, 2021;
- <nbnorway.com>: October 11, 2021.

According to evidence provided by the Complainant, both Disputed Domain Names referred to websites purporting to sell authentic NEW BALANCE and NB branded footwear at various discounted prices. The Disputed Domain Name <nbnorway.com> still does, while the Disputed Domain Name <nbbrasil.com> appears to have been suspended.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant considers the Disputed Domain Names to be confusingly similar to trademarks in which it claims to have rights. The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. According to the Complainant, there is no evidence to suggest that Respondent owns any trademark or service mark registration for NB, nor any variation thereof, the Respondent does not have license, permission, or authorization from the Complainant to use the NB mark or sell the Complainant's NB branded products, and the Respondent has not made any demonstrable preparation to use the Disputed Domain Names in connection with a *bona fide* offering of services. Finally, the Complainant claims that the Disputed Domain Names were registered and are being used in bad faith. The Complainant contends that the Respondent registered and used the Disputed Domain Names for an illegal activity, namely the sale of counterfeit goods or phishing.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Names. As the proceedings are administrative, the standard of proof is the balance of probabilities.

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

- i. the Disputed Domain Names are 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 Names; and
- iii. the Disputed Domain Names have been registered and are being used in bad faith.

The Panel will deal with each of these requirements in turn.

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

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there are trademarks in which it has rights. The Complainant's NB trademarks have been registered and used in numerous countries in connection to the Complainant's footwear and clothing business.

The Panel observes that both Disputed Domain Names incorporate the Complainant's NB trademark in its entirety, simply adding the terms "brasilia" and "norway" respectively.

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 (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

Additionally, it is well established that generic Top-Level Domains ("gTLDs"), here ".com", may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which a complainant has rights.

In light of the above, the Panel considers the Disputed Domain Names to be confusingly similar to the Complainant's NB trademark.

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

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Names in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel observes that the Respondent does not appear to be commonly known by the Disputed Domain Names and that the Respondent does not seem to have acquired trademark or service mark rights (there being no Response or evidence of any such rights). According to the information provided by the Registrar, the Respondent is named “Client Care” from the organization “Web Commerce Communications Limited”. There are no indications that a connection between the Complainant and the Respondent exists.

Where a domain name consists of a trademark plus an additional term, 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 (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Names incorporate the Complainant’s NB trademark in its entirety and adds the geographical terms “brasilia” or “norway” respectively. Given the Complainant’s global activities, the Panel finds that the Disputed Domain Names carry a risk of implied affiliation with the Complainant and cannot constitute fair use in these circumstances.

Beyond looking at the domain name(s) and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

The Complainant provides evidence showing that both Disputed Domain Names referred or still refer to websites purporting to sell authentic NEW BALANCE and NB branded footwear at various discounted prices. The Panel observes that the websites’ overall appearance, layout, and arrangement were or still are strikingly similar to the Complainant’s official website, and even include(d) copies of the Complainant’s NB figurative marks as depicted above under section 4. The Complainant’s evidence also shows that these websites included a login page. The Panel observes that the website linked to the Disputed Domain Name <nbnorway.com>, which is still active, requires that users create an account by providing their email address and creating a password before being able to pay.

In the Panel’s view, the above elements are indications of illegal activity using the Disputed Domain Names. UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see section 2.13 of the [WIPO Overview 3.0](#)).

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Names. In light of the above, the Complainant succeeds on the second element of the Policy.

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

The Complainant must prove on the balance of probabilities both that the Disputed Domain Names were registered in bad faith and that these are used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exhaustive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 website or location or of a product or service on the website or location.

In the present case, the Panel finds it inconceivable that the Respondent was unaware of the Complainant and its rights in the NB mark when it registered the Disputed Domain Names. Some of the Complainant's NB marks predate the registration of the Disputed Domain Names by more than 30 years. Moreover, the websites linked to the Disputed Domain Names appear(ed) to be similar to the Complainant's official website, include(d) copies of the Complainant's word and figurative marks and purported to sell discounted products of the Complainant. As a result, the Respondent must have had knowledge of the Complainant's rights at the time of registering the Disputed Domain Names. The Panel finds that the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith.

By redirecting Internet users to websites resembling the Complainant's official website and offering for sale products similar to the Complainant's products at a discounted price, the Respondent intentionally aimed to attract Internet users to visit these websites for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location and of the products advertised on the website (see *Simyo GmbH v. Domain Privacy Service FBO Registrant / Ramazan Kayan*, WIPO Case No. [D2014-2227](#)). Moreover, as discussed above, it appears the Respondent's websites were or still are being used for illegitimate activities, such as the sale of counterfeit goods or phishing. In the Panel's view, such illegal activity is manifestly considered evidence of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). The Panel observes that the use of the Disputed Domain Name <nbrasilia.com> has changed: at the time of this Decision, it resolves to an inactive website. However, in the circumstances of the present case, the non-use of this Disputed Domain Name does not prevent the Panel's finding of bad faith (see section 3.3 of the [WIPO Overview 3.0](#)).

In addition, the Complainant shows that on multiple occasions in 2021 and 2022 alone, the Respondent has been found by UDRP panels to have engaged in abusive domain name registrations. In the Panel's view, such pattern of recent abusive conduct, repeatedly registering trademark-abusive domain names, constitutes further evidence of bad faith (see section 3.1.2 of the [WIPO Overview 3.0](#)).

Finally, by failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the Disputed Domain Names were registered and are being used in bad faith. In light of the above, the Complainant also succeeds on the third and last element 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 Names, <nbrasilia.com> and <nbnorway.com>, be transferred to the Complainant.

*/Flip Jan Claude Petillion/*

**Flip Jan Claude Petillion**

Sole Panelist

Date: May 12, 2022