

ADMINISTRATIVE PANEL DECISION

ABG-Tretorn, LLC v. Web Commerce Communications Limited Case No. D2022-1066

1. The Parties

Complainant is ABG-Tretorn, LLC, United States of America (“United States”), represented by Authentic Brands Group, United States.

Respondent is Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name is <tretorndanmarkshop.com>, which 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 March 28, 2022. On March 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 30, 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 those in the Complaint. The Center sent an email communication to Complainant on March 31, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. On March 31, 2022, Complainant filed an amendment to the Complaint.¹

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”).

¹ The Whois report attached to the Complaint did not show the registrant’s name or organization and thus Complainant referred to “John Doe” as registrant. The amendment to the Complaint added Respondent as the respondent, as per the information disclosed by the Registrar.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on April 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on April 29, 2022.

The Center appointed Gerardo Saavedra as the sole panelist in this matter on May 25, 2022. This Panel finds that it was properly constituted. This 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

Complainant is engaged in the marketing of products under its TRETORN mark, namely sneakers, rubber boots, outerwear, hosiery, tennis balls and accessories, bags, loungewear and others.

Complainant has rights, among others, over the TRETORN mark for which it holds the European Union Registration No. 000910240, granted on November 26, 1999, in classes 18, 25 and 28, and International Registration No. 923053, granted on February 15, 2007, in classes 3, 9 and 14.

The disputed domain name was registered on December 22, 2021. At the time the Complaint was filed, the website associated with the disputed domain name showed, among others, "Lowest Price Guarantee", "LADY MISTER CHILDREN", "TRETORN", "EST. 1891 SWEDEN", a background image of a girl and "CHILDREN RAINCOAT SHOP HERE".

5. Parties' Contentions

A. Complainant

Complainant's assertions may be summarized as follows.

Complainant is the owner of the world-famous TRETORN mark, a Swedish outdoor-lifestyle brand founded in 1891. TRETORN products are currently sold around the world in North America, Europe and Asia through TRETORN stores and select department stores, as well as on Complainant's website "www.tretorn.com".

The disputed domain name is identical or confusingly similar to Complainant's registered marks. The disputed domain name consists of "tretorn", followed by the geographic term "danmark" and the descriptive word "shop". Where the relevant mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, meaningless, or otherwise) would not prevent a finding of confusing similarity.

Respondent has not been licensed or otherwise permitted by Complainant in any way to use the TRETORN mark or to apply for any domain name incorporating said mark, nor has Complainant acquiesced in any way to such use by Respondent. Respondent has not been commonly known by the disputed domain name and is not making a legitimate noncommercial or fair use of the disputed domain name.

There is no evidence that Respondent is using or plans to use the TRETORN mark or the disputed domain name for a *bona fide* offering of goods or services. Respondent has been actively using the TRETORN mark in the disputed domain name for illegitimate commercial gains by operating a fake TRETORN website offering counterfeit TRETORN goods. Such unauthorized use of the TRETORN mark is likely to trick consumers into erroneously believing that Complainant is somehow affiliated with Respondent or endorsing its commercial activities while in fact, no such relationship exists.

Complainant's marks are well-known around the world. Based on the extensive range of mark registrations for TRETORN, Respondent was well aware of Complainant's mark at the time Respondent registered the disputed domain name, which is proof of bad faith. Respondent registered the disputed domain name at least 30 years after Complainant established registered trademark rights in the TRETORN mark. A gap of several years between registration of a mark and registration of a domain name containing such a mark can indicate bad faith registration.

Respondent seems to be selling counterfeit TRETORN goods on the website linked to the disputed domain name. Respondent has no reason to use the TRETORN mark in the disputed domain name other than to attract Internet users for commercial gain. Several UDRP decisions have established bad faith where the respondent sells counterfeit merchandise.

Respondent used a privacy shield to mask its identity. The use of privacy shields or similar services which mask Respondent's identity are an indication of bad faith. Further, Complainant sent a cease-and-desist letter to Respondent asking Respondent to disable and transfer the disputed domain name to Complainant.² Respondent did not reply to Complainant's letter, showing bad faith on Respondent's part, and continued to use the disputed domain name, which has been found to constitute bad faith.

Complainant requests that the disputed domain name be transferred to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

The lack of response from Respondent does not automatically result in a favorable decision for Complainant (see *Berlitz Investment Corp. v. Stefan Tinculescu*, WIPO Case No. [D2003-0465](#), and section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The burden for Complainant, under paragraph 4(a) of the Policy, is to show: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is undisputed that Complainant has rights over the TRETORN mark.

Since the addition of a generic Top-Level Domain (*i.e.* ".com") in a domain name is technically required, it is well established that such element may be disregarded where assessing whether a domain name is identical or confusingly similar to a mark. The disputed domain name identically reflects the TRETORN mark, albeit followed by the characters "danmarkshop". It is clear to this Panel that the TRETORN mark is recognizable in the disputed domain name and that the addition of such characters in the disputed domain name does not avoid its confusing similarity with said mark (see sections 1.7 and 1.8 of the [WIPO Overview 3.0](#)).

Thus, this Panel finds that Complainant has satisfied paragraph 4(a)(i) of the Policy.

² Annex 8 of the Complaint, letter sent to the Registrar's "abuse contact email".

B. Rights or Legitimate Interests

Complainant contends that Respondent is not commonly known by the disputed domain name and that it has not authorized Respondent to use the TRETORN mark or to register a domain name incorporating such mark.³

Complainant asserts that the website associated with the disputed domain name conveys the false impression that Complainant is somehow affiliated with Respondent or endorsing its commercial activities. Complainant provided screenshots of such website and of Complainant's "us.tretorn.com", which on their face corroborate Complainant's assertion: the website associated with the disputed domain name has a heading showing "TRETORN" followed by "EST. 1891 SWEDEN" in the same style as they appear at Complainant's "us.tretorn.com".⁴ That demonstrates neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name.

Complainant assumes that the products offered in the website linked to the disputed domain name are counterfeits, although no evidence or more elaborated argument were provided on that specific subject.⁵

This Panel considers that Complainant has established *prima facie* that Respondent has no rights or legitimate interests in the disputed domain name (see *Intocast AG v. Lee Daeyoon*, WIPO Case No. [D2000-1467](#), and section 2.1 of the [WIPO Overview 3.0](#)). In the case file there is no evidence of circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances, giving rise to rights or legitimate interests in the disputed domain name by Respondent.

Based on the aforesaid, this Panel concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The evidence in the file shows that Respondent deliberately targeted Complainant's TRETORN mark at the time it obtained the disputed domain name.

Taking into consideration that the registration and use of said mark preceded the creation of the disputed domain name by a number of years, the uncontested recognition of said Complainant's mark and the content of the website linked to the disputed domain name, this Panel is of the view that Respondent must have been aware of the existence of Complainant's TRETORN mark and the goods marketed thereunder at the time it obtained the registration of the disputed domain name.

As set forth above, the website associated with the disputed domain name conveys the false impression that it is somewhat associated with Complainant, and there is no evidence of a disclaimer disassociating such website from Complainant. It seems to this Panel that in using the disputed domain name, Respondent has sought to create a likelihood of confusion with Complainant's TRETORN mark as to the sponsorship, source, affiliation, or endorsement of said website, when in fact there is no such connection. All that is indicative of bad faith.

³ See *Casio Keisanki Kabushiki Kaisha (Casio Computer Co., Ltd.) v. Jongchan Kim*, WIPO Case No. [D2003-0400](#): "There is no evidence that the Complainant authorized the Respondent to register the disputed domain name or to use the CASIO trademark, with or without immaterial additions or variants. These circumstances are sufficient to constitute a *prima facie* showing by the Complainant of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent".

⁴ See *Houghton Mifflin Co. v. The Weathermen, Inc.*, WIPO Case No. [D2001-0211](#): "Respondent used Complainant's mark, including its distinctive lettering style and a drawing of the Curious George character, as the large-font title of the page [...] As a result of the content of the page, a visitor to Respondent's site would be likely to believe that it was Complainant's official site. Such a confusing commercial use cannot be 'legitimate' under the Policy".

⁵ See *Koninklijke Philips Electronics N.V. v. Relson Limited*, WIPO Case No. [DWS2001-0003](#): "Mere "assertions" are nothing more than argument and must in each case be based on facts proved through evidence". See also section 2.13.2 of the [WIPO Overview 3.0](#).

Further, Respondent's failure to reply to Complainant's cease and desist letter may also be indicative of bad faith (see *Ebay Inc. v. Ebay4sex.com and Tony Caranci*, WIPO Case No. [D2000-1632](#)).

Thus the overall evidence shows that Respondent registered and used the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of such website.⁶

In this Panel's view, the lack of response is also indicative that Respondent lacks arguments and evidence to support its holding of the disputed domain name.

In light of the above, this Panel finds that Complainant has satisfied 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, this Panel orders that the disputed domain name <retorndanmarkshop.com> be transferred to Complainant.

/Gerardo Saavedra/

Gerardo Saavedra

Sole Panelist

Date: June 8, 2022

⁶ See *Lilly ICOS LLC v. East Coast Webs, Sean Lowery*, WIPO Case No. D2004-1101: "registration of a domain name in order to utilize another's well-known trademark by attracting Internet users to a website for commercial gain constitutes a form of bad faith".