

## **ADMINISTRATIVE PANEL DECISION**

Allbirds, Inc. v. Domain Admin, Whoisprotection.cc  
Case No. D2022-1346

### **1. The Parties**

Complainant is Allbirds, Inc., United States of America, represented by Red Points Solutions, S.L., Spain.

Respondent is Domain Admin, Whoisprotection.cc, Malaysia.

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

The disputed domain name <allbirdussale.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 April 14, 2022. On April 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 15, 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 Complainant on April 20, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 22, 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 Respondent of the Complaint, and the proceedings commenced on April 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2022. Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 16, 2022.

The Center appointed Gabriel F. Leonardos as the sole panelist in this matter on May 27, 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

Complainant, Allbirds, Inc., is a San Francisco based company founded in 2014, which produces and sells products related to footwear, combining comfort and the use of natural materials to produce environmentally friendly shoes.

Complainant currently commercializes a variety of footwear related products both in physical stores in the USA, United Kingdom, Netherlands, Germany, China, Japan, and South Korea as well as online, through Allbirds' online stores (<allbirds.com>; <allbirds.co.nz>; <allbirds.com.au>; <allbirds.ca>; <allbirds.co.uk>; <allbirds.eu>; <allbirds.cn>; <allbirds.jp>; and, <allbirds.co.kr>).

Complainant owns trademark registrations for the sign "ALLBIRDS" and for an Allbirds logo, as can be seen on the examples below:

Registration No.	Trademark	Jurisdiction	International Class(es)	Date of Registration
5056125		USA	25	October 4, 2016
5932322		USA	25	December 10, 2019
TMA1024316		Canada	25	June 10, 2019
1303983		International	25	April 15, 2016
1523654	ALLBIRDS	International	9, 25, 35	February 14, 2020
018197291	ALLBIRDS	EU	9	July 11, 2020
018185725	ALLBIRDS	EU	25, 35	November 24, 2020
27456170A	ALLBIRDS	China	9	November 21, 2018

Further, Complainant owns a list of domain names, such as <allbirds.asia>, <allbirds.shoes>, <allbirdsfootwear.com>, <allbirdsoutlet.com>, and <allbirdsshoes.com>. A complete list of Complainant's registered domain names can be found at Annex 4 to the Complaint.

The disputed domain name was registered on May 7, 2021, and resolves to a website which allegedly sells Allbirds products.

## 5. Parties' Contentions

### A. Complainant

Complainant pleads that the disputed domain name <allbirdussale.com> is confusingly similar to its registered trademark ALLBIRDS, since it fully incorporates the referred trademark with the sole subtraction of the letter "s" and the addition of the words "us" and "sale".

Complainant affirms that Respondent creates a confusion, especially considering that the disputed domain name would be very similar to its trademark ALLBIRDS, as consumers may believe that the disputed domain name is linked to Complainant. Complainant also notes that the words "us" and "sale" are inherently associated with Complainant and its activities, since Complainant commercializes its products through online stores in the USA; and that the word "allbird" is phonetically identical to its trademark ALLBIRDS.

Therefore, according to Complainant, the disputed domain name presents a high risk of confusion to consumers, who will likely believe it is linked with Complainant's trademark ALLBIRDS, fulfilling paragraph 4(a)(i) of the Policy and paragraph 3(b)(viii) and 3(b)(ix)(1) of the Rules.

In addition, Complainant states that Respondent does not have any rights or legitimate interests in respect of the disputed domain name, nor is Respondent commonly known by the disputed domain name. Further, Respondent has not been authorized, or licensed to use Complainant's trademark ALLBIRDS as a domain name nor is Respondent associated with Complainant.

Complainant claims that Respondent impersonates Complainant in the website which resolves from the disputed domain name, not only using Complainant's trademarks, but also adopting the same trade dress as Complainant's official website. Complainant finds that this attitude has the aim of attracting consumers and causing the impression of the disputed domain name being an official Allbirds website.

Further, Complainant indicates that it has tried to amicably contact Respondent in order to resolve this conflict, without success, which would represent another indicative of Respondent's bad faith and lack of legitimate interests in respect of the disputed domain name.

Complainant also notes that Respondent would be taking advantage of Complainant's trademark ALLBIRDS international reputation and respected products, by allegedly selling them at the disputed domain name, generating a likelihood of confusion as to the affiliation of the disputed domain name to Complainant's official websites.

Complainant affirms that Respondent is using the disputed domain name to obtain commercial gain by attracting consumers misleading them into believing that they are in an official and authorized website for the distribution of Complainant's products. Also notes that previous UDRP Panels have found that the impersonation of a Complainant's online presence could indicate bad faith, as in *Walgreen Co. v. Muhammad Azeem / Wang Zheng, Nicenic International Group Co., Limited* (WIPO Case No. [D2016-1607](#)).

This way, Complainant states that no legitimate use of the disputed domain name could be reasonably argued by Respondent, thus paragraph 4(a)(ii) of the Policy and paragraph 3(b)(ix)(2) of the Rules has been fulfilled.

In addition, Complainant pleads that Respondent used a privacy protection service for registration of the disputed domain name, which would indicate that it was registered and is being used in bad faith, as previously recognized by UDRP Panels – see *Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service* (WIPO Case No. [D2011-1753](#)).

According to Complainant, it is not possible that Respondent was not aware of the well-known reputation of the trademark ALLBIRDS, as it is internationally recognized and was a registered trademark prior to the date in which the disputed domain name was registered in 2021, and that Complainant's domain name

<allbirds.com> has a registration date of 9 of January of 2002, while Respondent's domain was registered on May 7, 2021.

Finally, Complainant indicates that Respondent owns a variety of other domain names which include third parties' trademarks, such as Under Armour, On Cloud, and Asics, which would suggest a finding of bad faith in Respondent's actions, considering that it has (i) proactively registered different domain names that include third-party registered trademarks from the footwear industry which have the same domain structure "trademark" + "geographic area"; (ii) used the same layout in all the websites, including the contact forms, display of products and pricing; (iii) included the distinctive signs of each of the registered trademarks in such sites; and (iv) offers for sale the shoes of each of the brands in the corresponding website.

Thus, the requirements for the identification of a bad faith use of the domain name would have been fulfilled, which constitutes registration and use in bad faith pursuant to paragraphs 4(a)(iii) and 4(b)(iv) of the Policy.

## **B. Respondent**

Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

To succeed in a UDRP complaint, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) 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.

The burden of proving these elements is upon Complainant.

Respondent had 20 days to submit a response in accordance with paragraph 5(a) of the Rules and failed to do so. Paragraph 5(f) of the Rules establishes that if a respondent does not respond to the complaint, in the absence of exceptional circumstances, the panel's decision shall be based upon the complaint.

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

Complainant has duly proven that it owns prior registered and unregistered rights for the trademark ALLBIRDS, and that the disputed domain name is constituted by the term "allbird" – which is closely similar to its registered trademark ALLBIRDS – accompanied by the words "us" and "sale".

The absence of the letter "s" of "ALLBIRDS", as used on the disputed domain name, does not prevent a finding of confusing similarity with Complainant's trademark – as both words are phonetically and visually similar, and therefore the trademark is easily recognizable within the disputed domain name.

Also, the term "allbird" is followed by the words "us" and "sale", which would seem to represent (i) a purely geographical term (for the USA), a territory where Complainant provides its products and services; and (ii) a word that inevitably has a connection with Complainant's activities – these together refer to the scope of Complainant's services, suggesting a connection with the products and services offered by the Complainant which is explored under the second and third elements.

Thus, the Panel finds that the disputed domain name is confusingly similar to Complainant's trademarks, and so the requirement of the first element of paragraph 4(a) of the Policy is satisfied.

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

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") as follows: "[w]hile the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

In this case, noting the facts and contentions listed above, the Panel finds that Complainant has made out a *prima facie* case showing that Respondent lacks rights or legitimate interests in the disputed domain name, so the burden of production shifts to Respondent. As Respondent has not replied to Complainant's contentions, the Panel has considered Complainant's un rebutted *prima facie* case to be sufficient to demonstrate that Respondent has no rights or legitimate interests in the disputed domain name <allbirdussale.com>.

Furthermore, Respondent has not used the disputed domain name in the context of a *bona fide* that could demonstrate legitimate interests, since the evidence shows that the disputed domain name resolves to a website in which Respondent tries to impersonate Complainant to divert consumers into believing that this is an official ALLBIRDS website, as duly proven by the Annex 08 to the Complaint.

Lastly, the term "allbird" is followed by the words "us" and "sale", which represent a geographical term where Complainant provides its products, and a term that covers its core offering; this intentionally creates a risk of confusion and/or suggests a connection with Complainant which does not exist – neither would support a claim to rights or legitimate interests on the part of Respondent.

Therefore, the Panel finds that the requirement of the second element of paragraph 4(a) of the Policy is also satisfied.

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

Paragraph 4(b) of the Policy lists a number of circumstances that, without limitation, are deemed evidence of registration and use of a domain name in bad faith.

Respondent has registered the disputed domain name that incorporates Complainant's trademark ALLBIRDS (with the sole absence of the letter "s", which does not prevent a finding of confusing similarity, as concluded on item 6.A), plus the addition of the words "us" and "sale". The Panel finds that it is duly demonstrated that Respondent was aware of Complainant's rights to the trademark ALLBIRDS at the time of the registration – as Complainant enjoys a worldwide reputation with the use of the referred trademarks.

With that in sight, Panel finds that Respondent registered the disputed domain name with the intention of attracting Internet users and consumers in search of authentic ALLBIRDS products.

Moreover, Panel finds that the words "us" and "sale" that accompany the term "allbird" in the disputed domain name, consists of a reference to the goods provided by Complainant in a way that suggests an affiliation which does not exist.

In addition, Complainant has duly proven that the use of the disputed domain name in the present circumstances allows a finding of bad faith registration since Respondent is using the disputed domain name to impersonate Complainant and divert Internet users and consumers into believing that they are dealing

with official products and services from Complainant by allegedly offering Complainant's products and using the same aesthetics as Complainant's official website (Annex 08).

As discussed in *G4S Plc v. Domain Administrator, See PrivacyGuardian.org / Thomas Roberts* (WIPO Case No. [D2020-0159](#)), the intention to impersonate Complainant in order to confuse its clientele into believing that they are facing an official Complainant's website suggests bad faith use: "As described above, the Respondent has used the disputed domain name to resolve to a website that reproduces the contents of the Complainant's website [ ]. The Panel finds that the Complainant has provided clear evidence that the Respondent has sought to impersonate the Complainant. The Respondent has not filed a Response in the present proceeding, and there is no other evidence on record to suggest that the services purportedly offered via the Respondent's website are *bona fide*. The Panel considers it likely that the Respondent's website is a public-facing aspect of a broader illegitimate scheme aimed at targeting the Complainant's clients. Prior UDRP panels have found that such behavior is manifestly considered evidence of bad faith, given that the use of a domain name for *per se* illegitimate activity can never confer rights or legitimate interests on a respondent; see [WIPO Overview 3.0](#), section 3.1.4. The Panel finds that the Respondent is using the disputed domain name in bad faith."

Further, the lack of response by Respondent to Complainant's prior letter and the use of privacy services for the registration of domain names, here indicates bad faith. This is what the Panel concluded in *Stockpile, Inc. v. Privacy Service Provided by Withheld for Privacy ehf / Richard Smith, Quantum Tech*, WIPO Case No. [D2021-4193](#):

"Finally, the Respondent has not replied to the Complainant's cease and desist letter, nor the Complaint, except for one informal email on December 21, 2021. The Respondent has not provided any evidence of good-faith use. The Respondent's use of a privacy service to conceal his identity may under the circumstances of this case further indicate bad faith."

With that in sight, considering that the circumstances indicate an attempt of Respondent to impersonate Complainant to unfairly obtain profit by diverting its clientele, this Panel finds that, in this case, the use of a privacy service to register the disputed domain name also indicates bad faith.

In light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith. Therefore, the requirement of the third element of paragraph 4(a) of the Policy is satisfied.

## 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, <allbirdussale.com> be transferred to the Complainant.

*/Gabriel F. Leonardos/*

**Gabriel F. Leonardos**

Sole Panelist

Date: June 13, 2022