

## **ADMINISTRATIVE PANEL DECISION**

### **ABG-Tretorn, LLC v. Web Commerce Communications Limited Case No. D2022-2106**

#### **1. The Parties**

The Complainant is ABG-Tretorn, LLC, United States of America, represented by Authentic Brands Group, United States of America.

The Respondent is Web Commerce Communications Limited, Malaysia.

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

The disputed domain name <tretornsneakerscanada.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 June 10, 2022. On June 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 13, 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 June 14, 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 amendment to the Complaint on June 16, 2022.

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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 8, 2022.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on July 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 is the owner of the Swedish outdoor-lifestyle brand TRETORN, which was founded in 1891. The TRETORN brand is currently used in several products, from sneakers to rubber boots, outerwear, hosiery, tennis balls and accessories, bags, loungewear and others.

In order to safeguard its products and activities, the Complainant has registered the TRETORN trademark in numerous countries, including in Canada (registrations Nos. TMA771926, TMA609802, and TMA115757, respectively obtained on July 14, 2010, May 10, 2004, and October 30, 1959).

The Respondent registered the disputed domain name <retornsneakerscanada.com> on April 21, 2022.

The Panel accessed the disputed domain name on August 11, 2022, which was not linked to any active website, basically presenting a message that access was not allowed. However, at the time the Complaint was filed, the Complainant provided evidence that the disputed domain name was resolving to an active website reproducing the Complainant's trademark, logo, and official website, offering numerous items for sale under the TRETORN brand.

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

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

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name consists of the Complainant's trademark TRETORN and the descriptive term "sneakers", followed by the geographical descriptive term "Canada" and the generic suffix ".com". 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.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has not been licensed, contracted, or otherwise permitted by the Complainant in any way to use the TRETORN trademark or to apply for any domain names incorporating the TRETORN trademark, nor has the Complainant acquiesced in any way to such use or application of the TRETORN trademark by the Respondent. The Respondent has not been commonly known by the disputed domain name. There is no evidence of fair use, not even that the Respondent is using or has plans to use the TRETORN trademark or the domain names incorporating the TRETORN trademark for a *bona fide* offering of goods or services that does not infringe TRETORN's intellectual property rights. On the contrary, the Respondent has been actively using the TRETORN trademarks in the disputed domain name to promote its website for illegitimate commercial gains, more specifically, by operating a fake TRETORN website offering counterfeit TRETORN goods. Such unauthorized use of the TRETORN trademarks is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities.

- The disputed domain name was registered and is being used in bad faith. The Respondent was well aware of the Complainant's trademark at the time the Respondent registered the disputed domain name, on April 20, 2022. The Complainant's trademarks are well-known around the world. The Complainant relies on the extensive range of registered TRETORN trademarks. Also, the Respondent used a privacy shield to mask

its identity, which makes it difficult for the Complainant to contact the Respondent and amicably settle a domain name dispute, and is an additional indication of bad faith. More egregiously, the Respondent seems to be selling counterfeit TRETORN goods on its website. The Respondent has no reason to use the mark in the disputed domain name other than to attract Internet users to its site for commercial gain. Panelists in previous WIPO UDRP cases have found bad faith registration where a respondent sells counterfeit merchandise, see *Balenciaga v. liu zhixian, zhixian liu*, WIPO Case No. [D2010-1831](#) and *Chrome Hearts LLC v. James Hart*, WIPO Case No. [DCC2011-0005](#).

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (i) The disputed domain name is 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 name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

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

The Panel has no doubt that "tretorn" is a term directly connected with the Complainant's trademarks.

Annex 4 to the Complaint shows trademark registrations for TRETORN that date as early as in 1959.

The trademark TRETORN is wholly encompassed within the disputed domain name. The disputed domain name differs from the Complainant's trademark TRETORN merely by the inclusion of the suffixes "sneakers" and "Canada", as well as of the generic Top-Level Domain ("gTLD") extension ".com".

Previous UDRP decisions have found that the mere addition of words (such as "sneakers") or geographical terms (such as "Canada") to a trademark in a domain name does not avoid a finding of confusing similarity (see, e.g., *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#); and *Allianz SE v. IP Legal, Allianz Bank Limited*, WIPO Case No. [D2017-0287](#)).

It is also already well established that the addition of a gTLD such as ".com" is typically irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, and that the Complainant has satisfied the first element of the Policy.

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

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the domain name; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

Indeed, the Complainant showed that the disputed domain name is linked to an unauthorized website reproducing the Complainant's trademark, logo, and official website, offering numerous TRETORN items for sale which the Complainant claims are counterfeit products. While the Panel notes that the Complainant has not provided clear evidence that the products are counterfeits, the website does not adequately clarify the relationship between the Respondent and the Complainant, why the Respondent has chosen the specific term "tretornsneakerscanada" to compose the disputed domain name, which naturally induces the visitor to believe it is the Complainant's official e-commerce for Canada. Here, the disputed domain name consists of the Complainant's 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](#).

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

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

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent has registered or 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 documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 its 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2022) the trademark TRETORN was already directly connected to the Complainant's products for several years.

Also, as already referred above, the disputed domain name points to an e-commerce website that reproduces the TRETORN and offers for sale TRETORN products which the Complainant claims are counterfeits.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant’s trademark, as well as that the adoption of the expression “tretornsneakerscanada” together with the gTLD extension “.com” could be a mere coincidence.

In fact, the inclusion of the suffixes “sneakers” (products commonly related to the TRETORN brand) and “Canada” (a country in which the TRETORN brand is frequently commercialized) even serves as a further evidence that the Respondent had the Complainant brand in mind when registered the disputed domain name, in the opinion of this Panel.

Furthermore, by associating the disputed domain name with an e-commerce website targeting the TRETORN brand, the Respondent potentially obtains revenue and deprives the Complainant from selling its products to prospective clients who are clearly looking for the Complainant.

Currently, no active website is linked to the disputed domain name, but this is not enough to avoid the Panel’s findings that the disputed domain name is also being used in bad faith. In the Panel’s view, the circumstances of this case, including:

- (a) the Respondent not presently using the disputed domain name;
- (b) the Respondent not indicating any intention to use the disputed domain name;
- (c) the Respondent not providing justifications for the registration of domain names containing a third-party famous trademark;
- (d) the lack of any plausible good faith reason for the adoption of the term “tretornsneakerscanada” by the Respondent, are enough in this Panel’s view to characterize bad faith registration and use of the disputed domain name in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied the third 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 name <tretornsneakerscanada.com>, be transferred to the Complainant.

*/Rodrigo Azevedo/*

**Rodrigo Azevedo**

Sole Panelist

Date: August 12, 2022