

ADMINISTRATIVE PANEL DECISION

ABG-Tretorn, LLC v. Client Care, Web Commerce Communications Limited Case No. D2022-2617

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 Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <tretornaustralia.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 July 18, 2022. On July 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 21, 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 July 25, 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 July 26, 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 August 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 24, 2022.

The Center appointed Mihaela Maravela as the sole panelist in this matter on August 31, 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.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is the owner of the Swedish outdoor-lifestyle inspired brand Tretorn, which is used since 1891. The TRETORN trademark has expanded from shoes to other categories that include rubber boots, outerwear, hosiery, tennis balls and accessories, bags, loungewear and others. The Tretorn products are currently sold around the world in North America, Europe, and Asia through prominent retailers.

The Complainant has registered several trademarks consisting of TRETORN, including the International Trademark No. 747228 registered on December 8, 2000, with protection in Classes 18, 25, and 28. The Complainant is the registrant of the domain name <tretorn.com>, reflecting its trademark, that resolves to its official website.

The disputed domain name was registered on August 8, 2021. At the date of the Decision the disputed domain name does not resolve to an active website. According to evidence submitted by the Complainant, the disputed domain name resolved prior to the filing of the Complaint to a website offering for sale Tretorn branded products at discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is identical or confusingly similar to the Complainant's registered trademarks, as it includes the Complainant's trademark TRETORN followed by the term "Australia".

With respect to the second element, the Complainant argues that 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. Additionally, there is no evidence of fair use or of a *bona fide* offering of goods or services. On the contrary, the Complainant argues that the Respondent has been actively using the TRETORN trademarks to promote its website at the disputed domain name to operate a fake Tretorn website offering counterfeit Tretorn goods.

In what concerns the third element, the Complainant argues that the Respondent was well aware of the Complainant's trademark at the time it registered the disputed domain name as the Complainant's trademarks are well known around the world and the Respondent registered the disputed domain name at least 30 years after the Complainant established registered trademark rights in the TRETORN trademark. Additionally, 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 dispute. Moreover, the Respondent seems to be selling counterfeit Tretorn goods on its website at the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Matters

No communication has been received from the Respondent in this case. However, given that notice of the Complaint was sent to the relevant addresses disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules and to draw inferences from the Respondent’s failure to file any Response.

The applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”, and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

6.2 Substantive Matters

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

- (i) that the disputed domain name is 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 disputed domain name; and
- (iii) that the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has provided evidence of its rights in the TRETORN trademarks. The trademark TRETORN is reproduced in its entirety in the disputed domain name. The addition of “australia” does not prevent a finding of confusing similarity with the Complainant’s trademark TRETORN, which is recognizable in the disputed domain name. The fact that a domain name wholly incorporates a complainant’s trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such trademarks. The addition of an additional term (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

It is well accepted by UDRP panels that a generic Top-Level Domain (“gTLD”), such as “.com”, is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark. See section 1.11 of the [WIPO Overview 3.0](#).

This Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademarks and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

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 name.

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

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademark TRETORN and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name. There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, according to the unrebutted evidence of the Complainant, the website at the disputed domain name was used to offer for sale TRETORN goods at a discounted price – approximately 50% price reduction. Under these circumstances it is reasonable to infer that the products offered on the website at the disputed domain name are counterfeit products. As a result, the Panel finds on balance of probabilities that the website to which the disputed domain name resolved offered counterfeits of the Complainant's products. Even if the products were genuine, the lack of any disclaimer on the website at the disputed domain name as to the registrant's relationship with the trademark owner or the lack thereof, would falsely suggest to Internet users that the website to which the disputed domain name resolved is owned by the Complainant or at least affiliated to the Complainant (as per the Oki Data principles outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)).

Also, there is no evidence that the Respondent is commonly known by the disputed domain name.

Furthermore, the characteristics of the disputed domain name are apt to suggest an affiliation or connection with the Complainant, which prevents any use of it by the Respondent from being considered fair. In this respect, section 2.5.1 of the [WIPO Overview 3.0](#) provides that "[...] where a domain name consists of a trademark plus an additional term (at the second- or top-level), 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".

The Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because the Respondent did not respond to the Complainant's contentions.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The Complainant's registration and use of the relevant trademarks predate the date at which the Respondent registered the disputed domain name. The disputed domain name resolved to a website reproducing the Complainant's trademark and mentioning its foundation date (1891) and purportedly offering for sale the Complainant's products but at a much lower price. Given the distinctiveness and renown of the Complainant's trademark, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks, and to target those trademarks.

The use of the term "australia" reinforces the impression that the disputed domain name is the Complainant's website for the Australian market. The inherently misleading disputed domain name resolved to a website, which ostensibly offered the Complainant's products at a much lower price. As such, the disputed domain name suggests affiliation with the Complainant in order to attract consumers and offer products that appear to be counterfeit.

It appears that the disputed domain name no longer resolves to an active website. The Panel finds that the passive holding of the disputed domain name does not in the circumstances of this case prevent a finding of bad faith. There is no evidence of a legitimate use of the disputed domain name. The trademark of the Complainant is distinctive and widely used in commerce. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known

trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

Moreover, the Respondent has not formally participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good-faith use and indeed none would seem plausible.

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary. Consequently, the Panel concludes that the condition of paragraph 4(a)(iii) of the Policy is fulfilled.

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

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: September 14, 2022