

ADMINISTRATIVE PANEL DECISION

Basic Trademark S.R.L, BASIC NET S.p.a v. Yhetgb OjfeK, Rhdsj Ojdjsd, Nadine Gruenewald, Martin Saenger, Ute Schwartz, Steffen Vogt, Dieter Hoffmann, Julia Loewe, Claudia Rothstein, Client Care, Web Commerce Communications Limited, Domain Admin, Whoisprotection.cc, Max Vogler, Katja Jaeger, Lucas Lehmann, Katharina Naumann, Birgit Kalb, Leon Engel, Alexander Rothschild, Kalb Daniel, Kuhn Maik, Alexander RICHTER, Ralf METZGER, Brigitte SAENGER, Yaomine EKSTROM, Stephan Kaiser
Case No. D2022-2669

1. The Parties

The Complainants are Basic Trademark S.R.L, Italy, and BASIC NET S.p.a, Italy, represented by Sindico e Associate., Italy.

The Respondents are Yhetgb OjfeK, Hong Kong, China, Rhdsj Ojdjsd, Hong Kong, China, Nadine Gruenewald, Germany, Martin Saenger, Germany, Ute Schwartz, Germany, Steffen Vogt, Germany, Dieter Hoffmann, Germany, Julia Loewe, Germany, Claudia Rothstein, Germany, Client Care, Web Commerce Communications Limited, Malaysia, Domain Admin, Whoisprotection.cc, Malaysia, Max Vogler, Germany, Katja Jaeger, Germany, Lucas Lehmann, Germany, Katharina Naumann, Germany, Birgit Kalb, Germany, Leon Engel, Germany, Alexander Rothschild, Germany, Kalb Daniel, Germany, Kuhn Maik, Germany, Alexander RICHTER, Germany, Ralf METZGER, Germany, Brigitte SAENGER, Germany, Yaomine EKSTROM, Germany, and Stephan Kaiser, Germany.

2. The Domain Names and Registrars

No.	Disputed Domain Names	Registrars
1	supergagr.com	1API GmbH
2	supergaonlineshop.com	
3	supergashoessale.com	
4	supergaau.com	Alibaba.com Singapore E-Commerce Private Limited
5	supergabarcelona.com	
6	supergabelgie.com	
7	supergabr.com	
8	supergabutty.com	
9	supergacipo-outlet.com	

10	supergadanmark.com	Alibaba.com Singapore E-Commerce Private Limited	
11	superga-denmark.com		
12	superga-greece.com		
13	supergahvitesko.com		
14	supergaisrael.com		
15	supergaistanbul.com		
16	supergaitaliaoutlet.com		
17	superga-malaysia.com		
18	supergamexico.com		
19	superganorge.com		
20	supergaonlineschweiz.com		
21	supergaoutletargentina.com		
22	supergaoutletmadrid.com		
23	superga-ph.com		
24	supergaphshop.com		
25	superga-pl.com		
26	supergaroma.com		
27	superga-romania.com		
28	supergasg.com		
29	supergashoesindonesia.com		
30	supergashoesmalaysia.com		
31	supergashoesnz.com		
32	supergashoesphilippines.com		
33	supergashoesportugal.com		
34	supergaskleppolska.com		
35	supergasmexico.com		
36	supergasneakerscanada.com		
37	supergasouthafrica.com		
38	supergastockists.com		
39	supergastoredeutschland.com		
40	supergastoremadrid.com		
41	superga-sverige.com		
42	supergasverige.com		
43	supergatenisky.com		
44	supergatokyo.com		
45	supergausashoes.com		
46	supergawhitecanada.com		
47	supergawhiteshoes.com		
48	supergawhitesneakers.com		
49	superga-za.com		
50	superga2750.com		
51	tiendassupergachile.com		
52	siyahsuperga.com		Mat Bao Corporation
53	supergaie.com		
54	supergaschwarz.com		
55	storesuperga.com		Name.com, Inc.
56	supergasale.com		
57	supergasneakers.com		
58	supergaargentina.com		NameSilo, LLC
59	supergahungary.com		
60	supergasalegreece.com		
61	supergatennarit.com		
62	supergauk.com		

63	ucuzsuperga.com	NameSilo, LLC
64	supergamagyarorszag.com	NETIM SARL
65	supergasalesnz.com	
66	supergashoesireland.com	
67	tiendasupergamadrid.com	
68	supergaemportugal.com	Web Commerce Communications Limited dba WebNic.cc
69	supergahrvatska.com	
70	supergaph.com	
71	supergashoessingapore.com	
72	supergaturkiyemagazalari.com	

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 20, 2022. On July 21, 2022, the Center transmitted by email to the Registrars requests for registrar verification in connection with the disputed domain names. On July 21, 22, 23, 25, and 28, 2022, the Registrars transmitted by email to the Center the verification responses disclosing registrant and contact information for the disputed domain names which differed from the named Respondents (Domain Administrator, See PrivacyGuardian.org, United States of America (“United States”), Whois Agent, Domain Protection Services, Inc., United States) and contact information in the Complaint. The Center sent an email communication to the Complainants on July 28, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on August 2, 2022. On October 17, 2022, the Complainants requested withdrawal of the Complaint in respect of thirty-two expired disputed domain names.

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 October 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 9, 2022. On October 20, 2022, the Center received an email communication from one of the Respondents. Accordingly, the Center notified the commencement of panel appointment process on November 10, 2022. On November 17, 2022, the Complainants requested withdrawal of three expired disputed domain names.

The Center appointed John Swinson as the sole panelist in this matter on November 25, 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 Complainants are companies from Italy.

The Complaint contends Basic Trademark S.r.l. is a prominent Italian company and it is part of the BasicNet Group, which is involved in the design and marketing of clothing, footwear, and accessories, mostly sportswear or leisurewear.

In this decision, unless otherwise stated, the Panel will use the term “Complainant” to refer to both Complainants.

The Complainant owns several trademark registrations for SUPERGA. These include European Union Trade Mark No. 003181492 for SUPERGA that was filed on May 23, 2003 and with a registration date of December 10, 2004.

The Complainant uses the SUPERGA trademark in respect of casual footwear.

This dispute concerns 72 disputed domain names and lists over 20 Respondents. The Respondents did not file a formal Response, so little is known about the Respondents.

The disputed domain names were registered on various dates, from May 21, 2019 to March 28, 2022.¹

At the present time, some of the disputed domain names do not resolve to websites and so do.

The Panel has reviewed all 72 of the disputed domain names and will use four as examples. The others have similarities to the four examples discussed below.

As a first example, the disputed domain name <supergastockists.com> currently resolves to a website that looks like it could be the Complainant's website. It includes the Complainant's logo, displays many of the Complainant's shoes, and has functionality that allows consumers to order and pay for the Complainant's shoes. The meta-tag description for this website states: "Superga South Africa Sale, Shop From The Latest And Trendy Collection Of Shoes With Different Style And Colours At Best Price."

As a second example, the disputed domain name <supergaau.com> resolves to a website that is similar to the <supergastockists.com> website, but with many of the same elements arranged in a different layout. The privacy notice on the "supergaau.com" website is the same as the privacy notice on the "supergastockists.com" website. The meta-tag description for the <supergaau.com> website states: "Superga Australia Sale Trends That Are Versatile Enough For Every Occasion, Superga 2790 Platform Shoes Cheap New Product, Superga Sneakers Sale And Free Shipping."

As a third example, the disputed domain name <ucuzsuperga.com> resolves to a website in the Turkish language that has a very similar look to the above two websites. For example, the privacy notice is in Turkish, but appears to be the same as on the two websites discussed above, and the capitalization mistakes in all three privacy notices are the same. The meta-tag description for the <ucuzsuperga.com> website states: "Ucuz Superga Ayakkabı Nereden Alınır, Birbirinden Şık Superga Ayakkabılara En İyi Fiyat Garantisiyle Sahip Olmak İçin Hemen Tıklayın!" which approximately translates to "Cheap Superga Shoes, where can you buy from, each smarter than the other, to get best price guarantee click here!"

As a fourth example, the disputed domain name <tiendasupergamadrid.com> resolves to a website in Spanish that has a very similar look to the Turkish website referred to above. Again, the privacy notice (which is in Spanish, but appears to be the same as on the three websites discussed above) has the same capitalization mistakes as on the above three websites.

According to the Registrar's records, these four example disputed domain names are owned as follows:

<supergastockists.com> - Client Care, Web Commerce Communications Limited, Malaysia;

<supergaau.com> - Domain Admin, Whoisprotection.cc, with approximately the same contact details as the disputed domain name <supergastockists.com>;

<ucuzsuperga.com> - Claudia Rothstein, Germany;

<tiendasupergamadrid.com> - Yaomine EKSTROM, Germany.

¹ The Panel notes that all of the disputed domain names are active at the time of drafting this Decision, however, one disputed domain name, <supergaschwarz.com>, is currently pendingDelete.

The Respondent Client Care, Web Commerce Communications Limited of Malaysia has been involved many disputes under the Policy involving shoes which have similar fact patterns to the present case. Examples include *Alpargatas S.A., Alpargatas Europe, S.L.U. v. Quinton Baker, Jovin Lim, Web Commerce Communications Limited, Client Care*, WIPO Case No. [D2022-1500](#) (and the cases cited therein); and *C. & J. Clark International Ltd v. Drescher Karin; Schulze Stefanie; Hoffmann Florian; Name Redacted; Henrik Tess; Wulf Susanne; Fischer Thorsten; Baier Johanna; benjamin vogt; Baer Barbara; Stephanie Werfel; David Bader; Web Commerce Communications Limited, Client Care; Whoisprotection.cc, Domain Admin; Torsten GRUNEWALD; Gabriele ACKERMAN; Uwe Achen; Steffen Schuster; Sven Eisenhauer; Eric Koehler; Lea Muench; Christina Kuster; ming dian; Manuela Ziegler; matilda allen; Paul Fried; Nataliia Kuripko; Andreas Kirsch; David Boehm; Markus Schroder; Felix Fuhrmann; Daniel Beyer; Johanna Barth; Katja Kirsch; Sara Moench; Brigitte Kuester; Yvonne Grunewald; Annett Roth; Uta Weiss; Dennis Bohm; Katrin Winkel; Sophie Adler; Mike Schweizer; Jens Jager; Torsten Kuhn; Jens Keller; Eric Kuster; Juliane Fassbinder; Sabrina Furst; Monika Kaufmann; Mike Klug; Andrea Moench; Simone Luft; Kerstin Eichelberger; Doreen Koch; Marcel Ebersbach; Dieter Hahn; Alexander Schneider; Michelle Baier; Florian Weber; Lena Duerr; Mike Braun; Kevin Eisenhauer; Maria Schaefer; Anna Frey; Maik Wulf*, WIPO Case No. [D2022-0817](#) (and the cases cited therein).

5. Parties' Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The Complainant is the holder of several trademarks worldwide protecting SUPERGA in classes 3, 9, 14, 16, 18, and 25.

The SUPERGA trademarks have been used extensively in Europe and all over the world. At least in Europe, SUPERGA is one of the most famous brands in the sector of casual footwear.

The Complainant has high turnover through its e-commerce channels and sales made on its official website at "www.superga.com".

The disputed domain names are all confusingly similar to the trademark SUPERGA as they all fully include the SUPERGA trademark. Most of the disputed domains contain the SUPERGA trademark coupled with geographical terms.

The trademark SUPERGA is clearly recognizable in the disputed domain names and it is the only distinctive element; all other elements (geographical terms, terms with clear reference to the product or to sales activity or colors) are devoid of any distinctive character.

The Complainant has never authorized any third party to register any domain names including the trademark SUPERGA.

As a result of the fame and distinctiveness of the trademark SUPERGA all over the world, the registration of the disputed domain names qualifies as being made in bad faith *per se*.

The Respondents' primary purpose in registering and maintaining the disputed domain names has always been abusive. By using the disputed domain names, the Respondents intentionally attempted to attract for commercial gain, Internet users to the Respondents' websites, by creating a likelihood of confusion with the Complainant's trademark.

B. Respondent

The Respondents did not formal reply to the Complainant's contentions. However, the Center received an email communication from the Respondent Client Care, Web Commerce Communications Limited, stating "We have notified the respective parties to investigate this issue and take the necessary action".

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondents have 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 onus of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

6.1 Preliminary Issue: Consolidation

The Complainant requests the consolidation of the proceedings in respect of the disputed domain names, maintaining that they are under common control because the websites to which the disputed domain names resolve are the same or very similar, the naming structure of the disputed domain names are the same or similar (e.g. superga + descriptive term + country, or superga + country) and the disputed domain names have all been registered within a short period of time (and often in groups).

Paragraph 10(e) of the Rules grants a panel the power to consolidate multiple domain name disputes, and paragraph 3(c) of the Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. Where a complaint is filed against multiple respondents, UDRP panels typically will look at whether the domain names or corresponding websites are subject to common control, and whether the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

The Center has discharged its duties to notify the persons listed as registrants of the disputed domain names. None of the listed registrants of the disputed domain names has submitted a formal Response or objected to the consolidation request of the Complainant.

The Respondents have not advanced any reasons why it may not be equitable to allow the consolidation of the disputes, nor have they denied that the disputed domain names are not under common control. Consolidation would lead to greater procedural efficiency, and the Panel is not aware of any reasons why the consolidation would not be fair and equitable to all parties.

The Panel has also reviewed prior decisions involving the same Respondents (including those cited above in section 4). The fact patterns on those cases are very similar to the present case. In those cases, consolidation was considered appropriate.

The above satisfies the Panel that the consolidation of the Respondents and the disputes related to the disputed domain names in a single proceeding is justified and appropriate in the circumstances.

Therefore, the Panel decides to allow the consolidation of the disputes in relation to all of the disputed domain names in the present proceeding.

6.2 Substantive Issues

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

As set out above, the Complainant owns trademark registrations for the SUPERGA trademark.

The Panel considers that on a side-by-side comparison, the disputed domain names are confusingly similar to the Complainant's SUPERGA trademark.

The disputed domain names include the entirety of the trademark SUPERGA, and add a geographical term or terms related to the sale of the Complainant's products (such as "store", "shoes", "sneakers" or "sale", or non-English words with similar relevant meanings).

When a domain name wholly incorporates a complainant's registered mark, that is sufficient to establish confusing similarity for purposes of the Policy. *Cox Enterprises, Inc. v. Miguel Delsel*, WIPO Case No. [D2020-2676](#).

The addition of terms in the disputed domain names does not prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademark under the Policy. See also *Alpargatas S.A., Alpargatas Europe, S.L.U v. Sabrina Diederich / Web Commerce Communications Limited*, WIPO Case No. [D2022-0942](#) (the "*Diederich case*").

The Complainant succeeds on the first element of the Policy in relation to the disputed domain names.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondents have no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which a respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the respondent] of the dispute, [the respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the respondent] has acquired no trademark or service mark rights; or
- (iii) [the respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant asserts that the Complainant has never authorized any third party to register any domain names including the trademark SUPERGA.

Prior UDRP panels have held that the use of a domain name like the disputed domain names here, attempting to attract Internet users through misuse of a well-known trademark, and the provision of content which promote goods and services impersonating and competitive to the complainant cannot be considered use in connection with a *bona fide* offering of goods or services under Paragraph 4(c)(i). See *The Clorox Company v. WhoisGuard Protected, WhoisGuard, Inc. / Enos Villanueva, Melissa Rosenberg, Yang Ming*, WIPO Case No. [D2021-0603](#).

Several of the disputed domain names are currently inactive, but they reflect the same naming pattern and are under common control. Therefore, without any plausible explanation for their registration, they appear as part of an attempt to “corner the market” in domain names that reflect the SUPERGA trademark. See the *Diederich case, supra*.

The Panel finds that the Respondents have failed to produce any evidence to establish rights or legitimate interests in the disputed domain names. None of the circumstances listed in paragraph 4(c) apply in the present circumstances. Accordingly, the Panel finds the Respondents have not established rights or any legitimate interests in the disputed domain names.

The Complainant succeeds on the second element of the Policy in relation to the disputed domain names.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondents have registered and used the disputed domain name in bad faith.

In the present circumstances, the Panel concludes that the registration and use of the disputed domain names are in bad faith.

The Respondents’ conduct demonstrates the Respondents’ knowledge of the Complainant and its trademark. By registering many domain names that include the Complainant’s well-known trademark, and then by using the disputed domain names to impersonate the Complainant, demonstrates that the Respondents specifically knew of and targeted the Complainant.

On multiple occasions in 2021 and 2022 alone, some of the Respondents or the controlling mind of the Respondents have 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 also *New Balance Athletics, Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0908](#) where a similar finding was made.

The current status of some of the disputed domain names (not resolving to an active website) does not prevent a finding of bad faith, given the Respondents’ failure to participate in this proceeding, and the Respondents’ attempt to corner the market (as discussed above) in respect of domain names involving the SUPERGA trademark. See section 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Based on the facts in the Complaint, which the Respondents do not rebut, the Panel finds that both paragraphs 4(b)(ii) and (iv) of the Policy apply in the present case.

The Complainant succeeds on the third element of the Policy in relation to the disputed domain names.

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, <siyahsuperga.com>, <storesuperga.com>, <supergaargentina.com>, <supergaau.com>, <supergabarcelona.com>, <supergabelgie.com>, <supergabr.com>, <supergabuty.com>, <supergacipo-outlet.com>, <supergadanmark.com>, <supergadenmark.com>, <supergaempportugal.com>, <supergagr.com>, <superga-greece.com>, <supergahrvatska.com>, <supergahungary.com>, <supergahvitesko.com>, <supergaie.com>, <supergaisrael.com>, <supergaistanbul.com>, <supergaitaliaoutlet.com>, <supergamagyarorszag.com>, <superga-malaysia.com>, <supergamexico.com>, <superganorge.com>, <supergaonlineschweiz.com>, <supergaonlineshop.com>, <supergaoutletargentina.com>, <supergaoutletmadrid.com>, <superga-ph.com>, <supergaph.com>, <supergaphshop.com>, <superga-pl.com>, <supergaroma.com>, <superga-romania.com>, <supergasale.com>, <supergasalegreece.com>, <supergasalesnz.com>, <supergaschwarz.com>, <supergasg.com>, <supergashoesindonesia.com>, <supergashoesireland.com>, <supergashoesmalaysia.com>, <supergashoesnz.com>, <supergashoesphilippines.com>, <supergashoesportugal.com>, <supergashoessale.com>, <supergashoessingapore.com>, <supergaskleppolska.com>, <supergasmexico.com>, <supergasneakerscanada.com>, <supergasneakers.com>, <supergasouthafrica.com>, <supergastockists.com>, <supergastoredeutschland.com>, <supergastoremadrid.com>, <superga-sverige.com>, <supergasverige.com>, <supergatenisky.com>, <supergatennarit.com>, <supergatokyo.com>, <supergaturkiyemagazalari.com>, <supergauk.com>, <supergausashoes.com>, <supergawhitecanada.com>, <supergawhiteshoes.com>, <supergawhitesneakers.com>, <superga-za.com>, <superga2750.com>, <tiendassupergachile.com>, <tiendasupergamadrid.com>, and <uczsuperga.com>, be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: December 9, 2022