

ADMINISTRATIVE PANEL DECISION

Reebok International Limited v. Web Commerce Communications Limited,
Client Care

Case No. D2022-2738

1. The Parties

Complainant is Reebok International Limited, United States of America (“United States” or “US”), represented by Authentic Brands Group, US.

Respondent is Web Commerce Communications Limited, Client Care, US.

2. The Domain Name and Registrar

The disputed domain name <reebok-nz.com> (the “Domain Name”) 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 26, 2022. That same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 27, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. That same day the Center sent an email communication to Complainant providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on July 27, 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 Respondent of the Complaint, and the proceedings commenced on July 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 18, 2022.

The Center appointed Harrie R. Samaras as the sole panelist in this matter on August 28, 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

Reebok International Limited is currently, and for many years has been, one of the world's leading manufacturers of athletic footwear, apparel and sport, exercise and fitness equipment. It has advertised, marketed, promoted, distributed and sold such its products worldwide under the well-known REEBOK Mark or the "Mark".

Complainant has a global portfolio of more than 2,000 trademarks covering a wide variety of goods and services including the following United States trademark registrations for the Mark: Registration No. 1,133,704 (registered April 22, 1980) and Registration No. 5,530,372 (July 31, 2018).

The Domain Name was registered on November 25, 2021. It resolves to a website that prominently displays the REEBOK Mark at the top of each page ("Respondent's Website"). That website is selling men's, women's, boy's and girl's footwear at a discount, such as sneakers, sandals, boots, flip flops, slides, and specialty shoes (e.g., basketball, casual, crossfit, running, walking, studio, dance, training). The description of each footwear product pictured on Respondent's Website includes the REEBOK Mark (e.g., "Reebok Daytona Dmx – Womens Sneakers" or "Reebok – Mens Boxing Boots – Black – NZ"). Furthermore, the photographs of the footwear on Respondent's Website are very similar to the photographs of the footwear for sale on Complainant's website at <reebok.com> and the design or arrangement of the footwear is similar on both sites.

5. Parties' Contentions

A. Complainant

The Domain Name is identical or confusingly similar to Complainant's REEBOK Mark. Panels have found that additional elements incorporated in disputed domain names (using a complainant's mark) that are generic terms, descriptive terms, numbers, and/or abbreviations, are not sufficiently distinctive or unique as to dispel a likelihood of consumer confusion.

Complainant has not licensed, contracted with, or otherwise permitted Respondent to use the REEBOK Mark to apply for any domain names, nor has Complainant acquiesced in any way to such use or application of the REEBOK Mark by Respondent. Also, there is no evidence of fair use or that Respondent is using or plans to use the REEBOK Mark or Domain Name for a *bona fide* offering of goods or services that is not infringing Complainant's trademark rights. Respondent has been actively using the REEBOK Mark in the Domain Name and on the website associated with the Domain Name to promote its website for illegitimate commercial gains, more specifically, by operating a fake REEBOK website offering counterfeit REEBOK goods. Such unauthorized use of the REEBOK 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.

Respondent was well aware of the REEBOK Mark when registering the Domain Name on November 25, 2021, because the Mark is well-known internationally. Here, Respondent registered the Domain Name at least 50 years after Complainant established registered trademark rights in the REEBOK Mark. And because Respondent seems to be selling counterfeit REEBOK goods on its website it has no reason to use the Mark in the Domain Name other than to attract Internet users to its site for commercial gain, especially since Complainant's site is "www.reebok.com". Other UDRP panels have found bad faith where the respondent sells counterfeit merchandise.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Domain Name is confusingly similar to Complainant's well-known REEBOK Mark because: Complainant's REEBOK Mark is clearly recognizable within the Domain Name; the Top-Level Domain is generally not determinative in establishing whether the Domain Name is confusingly similar to a complainant's mark (See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11; and adding the term "nz" and a hyphen does not prevent a finding of confusing similarity to Complainant's Mark (See, [WIPO Overview 3.0](#), section 1.8 ("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."); see also, *Bayer AG v. Withheld for Privacy Purposes Privacy service provided by Withheld for Privacy ehf / Mukib Mukib*, WIPO Case No. [DCO2022-0011](#) (holding that adding the term "nz" and a hyphen in the domain name <bayer-nz.co> does not prevent a finding of confusing similarity with Complainant's well-known BAYER mark).

For the foregoing reasons, the Panel concludes that Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

It is undisputed that Complainant has not licensed, contracted with, or otherwise permitted Respondent to use the REEBOK Mark to apply for any domain names, nor has Complainant acquiesced in any way to such use or application of the REEBOK Mark by Respondent. Complainant also argues there is no evidence of fair use, or that Respondent is using or plans to use the REEBOK Mark or the Domain Name for a *bona fide* offering of goods or services that is not infringing Complainant's trademark rights. In this regard, Complainant points to evidence showing that Respondent has been using the Domain Name to operate a fake REEBOK website offering counterfeit REEBOK footwear for commercial gain. Complainant argues that such unauthorized use of the REEBOK 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.

Where, as here, Complainant has raised a *prima facie* presumption of Respondent's lack of any rights or legitimate interests in the Domain Name, and Respondent has failed to rebut that presumption, the Panel is satisfied that Complainant has carried its burden of proving that Respondent has no rights or legitimate interests in the Domain Name within the meaning of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

When Respondent registered the Domain Name on November 25, 2021, it is undisputed that Complainant had been using the REEBOK Mark for decades internationally to sell footwear. Given Complainant's long-standing use of the well-known Mark, the Panel finds it is highly unlikely Respondent was unaware of Complainant or the Mark when registering the Domain Name.

Respondent's bad faith registration is also evidenced by the facts that: (1) Respondent has not shown that it has any rights or legitimate interests in the Domain Name; (2) Respondent registered the Domain Name that is effectively the same as Complainant's registered REEBOK Mark with minor differences – adding a hyphen and "nz" neither of which distinguishes the Domain Name from the Mark; (3) the Domain Name <reebok-nz.com> is highly similar to the domain name for Complainant's retail site at <reebok.com>;

(4) Respondent's Website features Complainant's REEBOK Mark prominently throughout the website to sell footwear using photographs that look similar to the photographs that Complainant uses to sell footwear on its website; and (5) on Respondent's Website Respondent uses the Mark to describe the style of each shoe it features. On the uncontroverted evidence, the Panel finds that Respondent registered the Domain Name in bad faith.

Furthermore, Respondent has been using the Domain Name in bad faith to attract consumers to a retail website purporting to offer similar, discounted REEBOK branded footwear using a website with both design and content features similar to Complainant's website. Thus, Respondent registered and was using the Domain Name intentionally for commercial purposes in violation of the Policy.

For the foregoing reasons, the Panel finds that paragraph 4(a)(iii) of the Policy has been 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 Domain Name <reebok-nz.com> be transferred to Complainant.

/Harrie R. Samaras/

Harrie R. Samaras

Sole Panelist

Date: September 5, 2022