

ADMINISTRATIVE PANEL DECISION

Reebok International Limited v. Ping Huang

Case No. D2022-2852

1. The Parties

The Complainant is Reebok International Limited c/o Authentic Brands Group, United States of America (“United States”).

The Respondent is Ping Huang, China.

2. The Domain Name and Registrar

The disputed domain name, <reebokmarches.com> (the “Domain Name”), is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 2, 2022. On August 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 4, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 9, 2022.

The Center appointed Tony Willoughby as the sole panelist in this matter on September 26, 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 a company incorporated under the laws of the United Kingdom with its registered office in London, England, which has for many decades manufactured marketed sportswear under the brand name “Reebok”.

The name “Reebok” is protected by numerous trade mark registrations around the world including European Union Trade Mark Registration No. 000000373 REEBOK (word) registered on June 10, 1998 (application filed on April 1, 1996) for a variety of goods in classes 18, 25 and 28.

The Complainant also uses a complex distinctive logo  which is the subject of many trade mark registrations including French Trade Mark Registration No. 97692183 registered on August 18, 1997, in class 35 for a wide variety of retail services. A United States registration of the same figurative mark bears the following description: “The mark consists of a stylized design of two quadrilaterals with curved sides below and to the left of a triangle with a curved side which is below and to the left of another triangle with curved sides”.

The Domain Name was registered on May 21, 2022, and is connected to a French language website offering for sale what appear to be the Complainant’s products on offer at a substantial discount.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the Complainant’s REEBOK registered trade mark; that the Respondent has no rights or legitimate interests in respect of the Domain Name; and that the Domain Name has been registered and is being used in bad faith.

The essence of the Complainant’s case is that the Respondent is using the Domain Name to connect to a website selling counterfeit REEBOK goods, a website making liberal use of the Complainant’s trade marks, the REEBOK word mark and the logo, both of which are protected by trade mark registrations such as those described in section 4.

B. Respondent

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

6. Discussion and Findings

A. Preliminary Point

The Respondent has not responded to the Complainant’s contentions, but that does not mean that the Complaint automatically succeeds. The burden of proof still rests with the Complainant. Where a complaint is wholly based on unsupported and conclusory allegations the complaint will fail. However, a panel may draw inferences adverse to the respondent in the absence of a response where the circumstances of the case merit it.

The issue is dealt with in greater detail in section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant has asserted in section B.ii. of the Complaint that "[...] Respondent has been actively using the REEBOK trademarks in the domain names [*sic*] and on the physical website to promote its website for illegitimate commercial gains, more specifically, by operating a fake REEBOK website offering counterfeit REEBOK goods". The evidence in support (Annex 5) is a screenshot of the Respondent's website showing prominent use of the Complainant's logo at top left and numerous images of what appear to be the Complainant's REEBOK products on offer at substantial discounts.

Ordinarily, when complainants assert that the products the respondent is selling are counterfeit, some effort is made to assist the panel to make the desired finding. It could be the result of a trap order, or a close analysis of the photographed products featured on the website, or complaints from customers, or even, perhaps, a failure to respond to a cease and desist letter. Here, however, the Panel has nothing to go on apart from the Complainant's bare assertion and the discounted prices.

In *Guccio Gucci S.p.A. v. Zhiyuan Zou, Zouzhi Zhou, Fujian Anfu*, WIPO Case No. [D2012-0888](#), a case involving GUCCI-branded products being sold at a significant discount, the panel in that case had at least one circumstance (other than the discounted prices) pointing to the likelihood that the goods were counterfeit, namely that several of the websites and one of the domain names in issue made express reference to the fact that the products were replica products.

It may of course be that the level of the discounted prices is sufficient to indicate that the products are counterfeit, but the Complainant has not provided any explanation and in the absence of an explanation the Panel is not prepared to assume that the Respondent is offering counterfeit REEBOK products through his website. It may also be that the Panel's investigation into some of the links at the foot of the homepage (see below) might have assisted the Complainant's case, but this was not something that the Complainant thought pursuing.

Additionally, in section C.ii. of the Complaint asserts "More egregiously, Respondent seems to be selling counterfeit REEBOK goods on its website." The use of the word "seems" indicates to the Panel that the Complainant has no idea whether or not the Respondent is selling counterfeit products. It is regrettable that the allegation was made without any evidence.

In the result the Panel will approach the case on the basis that the goods in question are genuine REEBOK goods being sold at a discount.¹

B. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

¹ Since completing this decision, the Panel has issued a decision in *Reebok International Limited v. Bing Yue*, WIPO Case No. [D2022-2855](#) ("Bing Yue"), a case with very similar facts. As can be seen from section 6.A in "Bing Yue", the Panel had reason to believe on the balance of probabilities that the respondent's goods in "Bing Yue" were counterfeit and that the websites in these two cases were under common control. It is probable therefore that the Respondent's goods in this case were, like those in "Bing Yue", counterfeit and had the Complainant established that to the satisfaction of the Panel, clearly the Respondent has no rights or legitimate interests in respect of the Domain Name and clearly for that reason too a finding of registration and use in bad faith is merited.

- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

C. Identical or Confusingly Similar

The Domain Name comprises the Complainant's REEBOK trade mark followed by the French word "marches" (meaning "steps" in English) followed by the ".com" generic Top-Level Domain identifier.

Section 1.7 of the [WIPO Overview 3.0](#) explains the test for identity or confusing similarity under the first element of the Policy and includes the following passage:

"While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The Complainant's REEBOK trade mark is readily recognizable in its entirety in the Domain Name. The Panel finds that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights.

D. Rights or Legitimate Interests

The Complainant recites the circumstances set out in paragraph 4(c) of the Policy, any of which if found by the Panel to be present shall demonstrate rights or legitimate interests for the purposes of this element of the Policy, and contends that none of them is applicable.

The Panel accepts the Complainant's assertion that it has not authorized the Respondent's use of the REEBOK trade mark in this or any other way. However, there are circumstances where the unauthorized use of a third party's trade mark in a domain name may give rise to the acquisition by a respondent of rights or legitimate interests in respect of that domain name. The issue frequently falls to be considered where, as here, the respondent is using the domain name to connect to a website selling the goods of the complainant.

The issue is addressed in section 2.8.1 of the [WIPO Overview 3.0](#):

"Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the 'Oki Data test' [a test derived from the decision in *Oki Data Americas, Inc. v. Asdinc.com*, WIPO Case No. D2001-0903], the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

Here, while the Complainant asserts that the goods on offer on the Respondent's website are counterfeit, for the reasons set out in section 6.A the Panel is working on the basis that the goods are genuine. The Respondent's website appears to be offering for sale nothing but REEBOK goods, thus the website passes the first two elements of the Oki Data test. However, the Respondent's website has the appearance of an official REEBOK website, featuring as it does prominent use of the REEBOK logo at top left of the home page and nothing to indicate that it is not a website authorised by the Complainant. The copyright notice at the foot of the homepage reading: "Droits d'auteur 2022 © www.reebokmarches.com" does nothing to dispel the impression that the website is a website of or authorised by the Complainant.

On investigating the Respondent's website further, the Panel found that the "Termes et conditions" link at the base of the homepage indicated that the owner of the website is "Reebok Soldes 2022". The "Nous contacter" link also at the base of the homepage gave as the contact address an address in New York, United States. None of this information serves to indicate that the website is not a website authorised by the Complainant.

Therefore, the website clearly fails the third element of the Oki Data test and the Panel concludes that Internet users visiting the website are likely to be deceived into believing that the website is a website of or authorised by the Complainant. Those visitors are likely to be attracted to the website by the very nature of the Domain Name (*i.e.*, a combination of the Complainant's primary trade mark followed by a word appropriate for use with the Complainant's footwear), which is potentially indicative of an authorised retailer. On this basis too, independent of the Oki Data test, serious questions are raised as to whether the Respondent can sensibly be said to have rights or legitimate interests in respect of the Domain Name (see section 2.5.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

E. Registered and Used in Bad Faith

The Complainant's contentions under this head are very brief and, as mentioned above, rely to a large extent upon the "fact" that the Respondent "seems" to be selling counterfeit REEBOK products. Aside from the counterfeit allegation, the Complainant contends: "Respondent 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."

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances, which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The Complainant's appears to be relying upon sub-paragraph (iv), which provides: "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

The Panel agrees that the Domain Name featuring the Complainant's REEBOK trade mark and the French word "marches" (meaning "steps" in French) is likely to attract visitors looking for REEBOK products. For the reasons given in section 6.D the Panel agrees that on arriving at the Respondent's website those visitors or a sufficiently significant proportion of them are likely to believe that they have arrived at a website of or authorised by the Complainant. The Panel further agrees that this impersonation of the Complainant will have been deliberate. The Respondent was clearly concerned to ensure that the visitors with whom they conducted business should think that they were dealing with the Complainant or an entity authorised by the Complainant, when they were not.

The Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) 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 Domain Name, <reebokmarches.com>, be transferred to the Complainant.

/Tony Willoughby/

Tony Willoughby

Sole Panelist

Date: October 5, 2022