

ADMINISTRATIVE PANEL DECISION

Decathlon v. Wu Yu

Case No. D2022-3032

1. The Parties

The Complainant is Decathlon, France, represented by AARPI Scan Avocats, France.

The Respondent is Wu Yu, China.

2. The Domain Name and Registrar

The disputed domain name <decathlon.gifts> (the “Disputed Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 17, 2022. On August 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 24, 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 August 25, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On August 31, 2022, the Center suspended the proceedings on the Complainant’s request. On October 7, 2022, the Center reinstated the proceedings. The Complainant filed an amended Complaint on October 9, 2022.

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 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 2, 2022.

The Center appointed Mariya Koval as the sole panelist in this matter on November 10, 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, founded in 1976, is a major French manufacturer specialized in the conception and retailing of sporting and leisure goods. In June 2021, the Complainant employs 99,165 employees worldwide with annual sales of EUR 11,4 billion, operating 1,714 stores throughout the world. For 40 years, the Complainant has delivered the best value in the retail sports industry by offering high-quality, sustainable and cost-effective products.

The Complainant is the owner of a number of DECATHLON Trademark (the DECATHLON Trademark) registrations throughout the world, among which are:

- French Trademark Registration No. 1366349, registered on January 16, 1987, in respect of goods and services in classes 3, 4, 5, 8, 9, 12, 13, 14, 16, 18, 20, 21, 22, 24, 25, 28, 32, 33, 35, 37, 39, 40, 42, 43, 44, and 45;
- European Union Trademark Registration No. 000262931, registered on April 28, 2004 in respect of goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, and 42;
- International Trademark Registration No. 613216, registered on December 20, 1993, in respect of goods and services in classes 1, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 13 16, 17, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 35, 36, 37, 38, 39, and 42.

The Complainant operates, among others, the domain names <decathlon.com> (registered on May 30, 1995), <decathlon.fr> (registered on June 29, 1995), <decathlon.net> (registered on June 23, 1998) <decathlon.gifts> (registered on December 18, 2014), reflecting its DECATHLON Trademark in order to sell and promote its goods and activities.

The Disputed Domain Name was registered on November 27, 2021. As at the date of this decision, the Disputed Domain Name redirects to the Complainant's local websites (depending on jurisdiction, namely "www.decathlon.fr", "www.decathlon.de" etc.).

5. Parties' Contentions

A. Complainant

The Complainant asserts that considering the long and intensive use of its DECATHLON Trademark and the Complainant's efforts to promote the Trademark, the DECATHLON Trademark benefits from a solid reputation with the French and foreign consumers. Its well-known characters has been recognized repeatedly by the French judicial courts and by some decisions issued under the Policy.

The Complainant contends that the Disputed Domain Name is confusingly similar to its DECATHLON Trademark in view of the Disputed Domain Name contains the Complainant's Trademark in its entirety with simple deletion of the letter "h" from the middle of the word, which will remain unnoticed by Internet users. The Complainant operates the domain name <decathlon.gifts> since December 18, 2014, among others. Thus, the Disputed Domain Name also reproduces almost identically the Complainant's prior domain name <decathlon.gifts> with the mere change of letter (the deletion of the letter "h").

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name in view of the following:

- the Disputed Domain Name does not provide Internet users with any information dealing with the Complainant's historical background, or its commercialized products and services;
- the Disputed Domain Name seems to be used only to attract visitors to the Respondent's website on the Complainant's account and not used for any *bona fide* offering of goods and services;
- the Complainant does not know the Respondent and the Respondent is not in any way related to its business, is not one of its distributors and does not carry out any activity for or have any business with the Complainant;
- the Complainant has never given any authorization or permission whatsoever to the Respondent to register or to use the Disputed Domain Name; and
- the Respondent is not commonly known under the Disputed Domain Name.

The Complainant further contends that the Respondent has registered and is using the Disputed Domain Name in bad faith.

It is highly likely that the Respondent knew the Complainant and its well-known DECATHLON Trademark when registering the Disputed Domain Name at least for the following reasons:

- the DECATHLON Trademark and the Complainant's domain names were registered long before the Disputed Domain Name was registered;
- the Disputed Domain Name is confusingly similar to the DECATHLON Trademark since it merely reproduces its Trademark with the deletion of the letter "h" from the middle of the word; and
- any search for "DECATHLON" conducted with a search engine such as Google leads in the first place to websites relating to the Complainant and its products.

The Disputed Domain Name currently redirects to the Complainant's website, which indicates that the Respondent is trying to impersonate the Complainant. Furthermore, it appears that MX servers have been activated in relation with the Disputed Domain Name: this set-up indicates that the Disputed Domain Name can send and receive emails, suggesting that the Respondent has the intention to use the Disputed Domain Name to support email account. This combination of facts indicates that the Respondent's purpose in using the Disputed Domain Name is to create a phishing campaign aimed at the Complainant's customers.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has properly asserted its rights in the DECATHLON Trademark due to the long use and number of registrations globally. The Panel finds that the Complainant has established that the DECATHLON Trademark is well known.

The Disputed Domain Name resembles the Complainant's registered DECATHLON Trademark with omission of the letter "h" and the generic Top-Level Domain ("gTLD") ".gifts". The Disputed Domain Name is an example of "typosquatting" when the spelling of a trademark has been minimally changed by the omission of one letter. In fact, it seems as if the Respondent intentionally chose to omit the letter "h" for confusing similarity with the Complainant's DECATHLON Trademark. According to the section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), a domain name which consists of a common, obvious, or intentional misspelling of a trademark is normally considered by UDRP panels to be confusingly similar to the relevant mark for purposes of the first element.

According to the [WIPO Overview 3.0](#), section 1.11, the applicable gTLD in a domain name (e.g., ".com", ".club", and ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

In light of the above, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's DECATHLON Trademark, and that the Complainant has established the first condition of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Names pursuant to paragraph 4(a)(ii) of the Policy.

In accordance with section 2.1 of the [WIPO Overview 3.0](#) while the overall burden of proof in UDRP proceedings is on the Complainant, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is generally deemed to have satisfied the second element.

Taking into account the facts and arguments set out above, the Panel finds that the Complainant has made a *prima facie* case. The Respondent registered the Disputed Domain Name more than thirty years after the DECATHLON Trademark had been registered. There is no evidence that the Respondent owns any DECATHLON Trademark, nor that it is commonly known by the Disputed Domain Name. Therefore, the Respondent has failed to come forward with any evidence to rebut such *prima facie* case.

The Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. The Panel notes the composition of the Disputed Domain Name (being a typosquatted version of the Complainant's trademark), that the Disputed Domain Name automatically redirects to the Complainant's local websites and, that the MX servers have been activated in relation to the Disputed Domain Name (Annex I to the Complaint). These circumstances when considered together indicate that the Disputed Domain Name can send and receive emails, and it seems probable that the Respondent may be using the Disputed Domain Name to create a phishing campaign. The Panel cannot consider such use of the Disputed Domain Name as *bona fide* offering goods or services, or a legitimate noncommercial or fair use.

Also, taking into consideration the long use of the Complainant's DECATHLON Trademark (with omission of one letter "h") that has been used long prior to the official registration of the Trademark, it is implausible to assume that the Respondent was unaware of the Complainant's Trademark at the time of registration of the Disputed Domain Name.

The Respondent did not respond to the Complaint and did not participate in this proceeding, accordingly, the Respondent has failed to present any evidence to support any rights or legitimate interests in the Disputed Domain Name.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph

4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy indicates some circumstances, without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you [respondent] have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.

The Panel comes to the conclusion that the Disputed Domain Name was registered and has been used in bad faith in view of the following. Taking into consideration that the DECATHLON Trademark have been in use more than 30 years and that the Complainant has spent huge amounts and efforts for promotion of its DECATHLON Trademark, the Panel considers it is clear that the Respondent was well aware of the Complainant and its DECATHLON Trademark at the time of registration of the Disputed Domain Name. Moreover, the Disputed Domain Name, incorporating the Complainant's DECATHLON Trademark in their entirety with intentional omission of the letter "h", is clearly deceptive for Internet users.

The Disputed Domain Name automatically redirects to the Complainant's local websites and it is plausible that the Respondent is using or intends to use the Disputed Domain Name to create a phishing campaign aimed at the Complainant's customers or impersonating the Complainant in email communications. Use of the Disputed Domain Name incorporating the DECATHLON Trademark by an unauthorized third party to redirect Internet users to either the Complainant's or a competitor's website is evidence of bad faith under paragraph 4(b)(iv) of the Policy. According to section 3.1.4 of the [WIPO Overview 3.0](#) Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: [...] redirecting the domain name to the complainant's (or a competitor's) website [...]. The Respondent redirecting the Disputed Domain Name to the Complainant's websites can establish bad faith insofar as the Respondent retains control over the redirection thus creating a real or implied ongoing threat to the Complainant. See *e.g. Ann Summers Limited v. Domains By Proxy, LLC / Mingchun Chen*, WIPO Case No. [D2018-0625](#).

Also, in accordance with the [WIPO Overview 3.0](#), section 3.4, UDRP Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution (in some such cases, the respondent may host a copycat version of the complainant's website). Many such cases involve the respondent's use of the domain name to send deceptive emails, *e.g.*, to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers. Taking into account the Respondent's use of the Disputed Domain Name to redirect to the Complainant's website, in the furtherance of a possible fraudulent email scheme, such Respondent's

behavior cannot be in any way considered as a good faith.

In addition, according to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is of the opinion that it is clear that the Respondent, having registered and used the Disputed Domain Name, which is confusingly similar to the Complainant's well-known DECATHLON Trademark, intended to disrupt the Complainant's business and confuse Internet users seeking for or expecting the Complainant. In view of the absence of any evidence to the contrary and that the Respondent did not file any response to claim otherwise, the Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith.

Therefore, having examined all the circumstances of the case the Panel finds that the Respondent registered and is using the Disputed Domain Name in bad faith, and accordingly that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant

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, <decatlon.gifts>, be transferred to the Complainant.

/Mariya Koval/

Mariya Koval

Sole Panelist

Date: November 24, 2022