

ADMINISTRATIVE PANEL DECISION

Columbia Sportswear Company v. Name Redacted Case No. D2022-3359

1. The Parties

The Complainant is Columbia Sportswear Company, United States of America, represented by Strategic IP Information Pte Ltd., Singapore.

The Respondent is Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <columbiashoesaustralia.com> is registered with NETIM SARL (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 9, 2022. On September 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 12, 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 September 12, 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 amended Complaint on September 14, 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”).

¹ The Respondent appears to have used the name and postal address of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 25, 2022. The Center received a communication from a third party on October 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the parties that it would proceed to panel appointment on October 27, 2022.

The Center appointed Nayiri Boghossian 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 is specialized in outerwear, sportswear and outdoor equipment sold under the trademark COLUMBIA. The Complainant has been operating for over 80 years and distributes its products globally. The Complainant has rights in many trademark registrations for COLUMBIA such as:

- United States of America trademark registration No. 2,047,397, registered on March 25, 1997.

The disputed domain name was registered on May 31, 2021, and resolves to a website which offers COLUMBIA branded sportswear and sports shoes at heavily discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant's trademark is well known. The disputed domain name incorporates the distinctive part of the Complainant's trademark, *i.e.*, COLUMBIA. The disputed domain name resolves to a website which offers the Complainant's products using the imagery and copyright images of the Complainant, thus, reinforcing an association with the Complainant. This is unjustified use and evidence that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name as the Complainant has exclusive rights to the trademark COLUMBIA. The Respondent is not authorized by the Complainant to use its trademark. The words "shoes" and "australia" do not distinguish the disputed domain name from the Complainant's trademark. This would lead consumers to believe that the website offers legitimate products. The use of the trademark COLUMBIA in the disputed domain name is *mala fide*.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The registration of a domain name that incorporates a well-known trademark by an unaffiliated entity is evidence of bad faith. The registration is done in bad faith and this is further confirmed through the images used on the website, which demonstrates an attempt to pass off the said website as being associated with the Complainant. The Respondent knew of the Complainant's trademark as it is used worldwide and the disputed domain name was registered long after the Complainant's use of its trademark.

B. Respondent

An email was sent by a third party on October 25, 2022, stating that she received the Written Notice, did not understand what the issue is, and that there has been an error and her data should be removed. The Respondent did not file any response.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has established its rights in the trademark registrations for COLUMBIA. The disputed domain name incorporates the Complainant's trademark COLUMBIA in its entirety. It is established by prior UDRP panels that when a domain name incorporates a complainant's registered trademark, such incorporation is sufficient to establish identity or confusing similarity for the purposes of the Policy even if other terms are added as part of the disputed domain name. *E.g., Oki Data Americas, Inc v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*").

The addition of the terms "shoes" and "australia" does not alter the fact that the disputed domain name is confusingly similar to the Complainant's trademark. The generic Top-Level Domain ("gTLD") ".com" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent.

In the instant case, the Complainant asserts that the Respondent is not authorized by the Complainant to use its trademark. The Complainant further asserts that the use of its trademark as part of the disputed domain name is *mala fide*. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests. The Respondent has not provided any evidence to show that it has any rights or legitimate interests in the disputed domain name. However, according to the Policy, the use of the disputed domain name would be legitimate if it is used in connection with a *bona fide* offering of goods or services. The website to which the disputed domain name resolves offers COLUMBIA branded sportswear and sports shoes. It is not clear from the record if these products are genuine products of the Complainant or not.

If these products are genuine products of the Complainant, there may be an argument that the disputed domain name is being used in connection with a *bona fide* offering of products. In line with the *Oki Data* test, a number of requirements have to be met (see *Oki Data, supra*):

- (1) "Respondent must actually be offering the goods or services at issue";
- (2) "Respondent must use the site to sell only the trademarked goods";
- (3) "The site must accurately disclose the registrant's relationship with the trademark owner"; and
- (4) "The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name".

It is sufficient for one of these requirements not be met in order to fail the *Oki Data* test. Requirement No. 3 is not met as the website does not include any statement demonstrating that it does not belong or is not affiliated with the Complainant. On the contrary, the logo and trademark of the Complainant is placed on the webpage, thus, creating the illusion of affiliation. Accordingly, it is the Panel's view that the requirements of the *Oki Data* test have not been met.

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

If the website at the disputed domain name is offering counterfeit products, then this does not constitute a *bona fide* offering of goods or services.

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered or Used in Bad Faith

The Respondent clearly knew of the Complainant's business and trademark as the disputed domain name resolves to a website offering products carrying the Complainant's trademark. The nature of the disputed domain name suggests affiliation with the Complainant as it incorporates the Complainant's trademark in full. The use of the geographical term "australia" creates the impression that the disputed domain name is the Complainant's website for the Australian market. The use of the term "shoes" reinforces the impression of affiliation with the Complainant given the nature of the Complainant's products.

The disputed domain name resolves to a website, which offers products carrying the Complainant's trademark. These products may be genuine products of the Complainant, or counterfeits thereof. Offering counterfeit products is an indication of bad faith. If genuine products are being offered, the Complainant still wins its claim as the requirements of the *Ok! Data* test have not been met, so the Respondent has no rights or legitimate interests in the disputed domain name. The disputed domain name has been registered and used for the Respondent's commercial gain by taking advantage of the goodwill and reputation of the Complainant's trademark and the confusing similarity between the disputed domain name and the Complainant's trademark. Such conduct falls squarely within the meaning of paragraph 4(b)(iv) of the Policy.

Additionally, the Respondent has used the name and postal address of a third party to register the dispute domain name, which in the Panel's view is another indication of bad faith.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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 disputed domain name, <columbiashoesaustralia.com>, be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: November 18, 2022