

ADMINISTRATIVE PANEL DECISION

All Star C.V. and Converse, Inc. v. Client Care, Web Commerce Communications Limited
Case No. D2022-3487

1. The Parties

The Complainants are All Star C.V. and Converse, Inc., United States of America (“United States”), represented by Stobbs IP Limited, United Kingdom.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <conversesouthafrica.com> 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 September 20, 2022. On September 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 22, 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 Complainants on September 22, 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 September 23, 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 September 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 19, 2022.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on October 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 in the footwear, clothing, apparel and bags business. They were founded in 1908 as a rubber company and since 1909 began manufacturing and selling shoes. Since that time the Complainants, including their authorized partners, sell products under the CONVERSE brand in many countries.

The Complainants own numerous registrations for the CONVERSE trademark in many countries, including the following:

Germany: Trademark Registration No. 2030313 CONVERSE, registered on February 15, 1993, in classes 16 and 28;

Denmark: Trademark Registration No. VR 1992 07393 CONVERSE, registered on August 7, 1992, in class 16;

Finland: Trademark Registration No. 123330 CONVERSE, registered on November 20, 1992, in class 16;

Finland: Trademark Registration No. 59249 CONVERSE, registered on March 6, 1972 in classes 25 and 28;

Sweden: Trademark Registration No. 245550 CONVERSE, registered on January 15, 1993, in class 16;

Sweden: Trademark Registration No. 129023 CONVERSE, registered on November 14, 1969, in class 25;

Spain: Trademark Registration No. M1234841 CONVERSE, registered on July 5, 1990;

Austria: Trademark Registration No. 86339 CONVERSE, registered on September 6, 1977.

The Complainants own the domain name <converse.com> which was registered on August 9, 1995 and resolves to a website through which they sell and promote shoes, clothing and accessories under their CONVERSE trademark.

The disputed domain name was registered on July 30, 2021 and while it currently does not resolve to an active website, the evidence produced by the Complainants shows that at one time it was used to offer goods similar to the goods offered by the Complainants.

5. Parties' Contentions

A. Complainants

The Complainants claim that the disputed domain name is confusingly similar with the trademark CONVERSE in which the Complainants have rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, the Complainants claim that they have developed the CONVERSE trademark into a famous brand selling footwear, apparel and bags around the world for over hundred years.

Annual revenue from the Complainants' worldwide sales more than tripled between 2007 and 2021 from USD 564 million to a peak of more than USD 2 billion.

The Complainants' CONVERSE trademark, in particular, the Chuck Taylor All Star sneaker, is widely regarded and consistently ranked as one of the "coolest" and most iconic sneakers of all time.

The disputed domain name features a live website that includes the Complainants' CONVERSE logo and offers for sale clothing under the Complainants' trademarks, utilizing the Complainants' copyrighted images.

The Respondent has never been known as "CONVERSE" at any point in time.

The Complainants believe that the disputed domain name has been registered for the sole reason of commercial gain by means of misleadingly diverting consumers seeking the Complainants to the Respondent's website.

Finally, the Complainants request the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainants.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainants must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with a trademark or service mark in which the Complainants have rights; and
- (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

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainants' CONVERSE trademark.

The disputed domain name incorporates the Complainants' trademark CONVERSE in its entirety with the addition of the geographical term "south africa", which certainly does not prevent a finding of confusing similarity. Section 1.8 of [WIPO Overview 3.0](#) provides that when the relevant trademark is recognizable within the disputed domain name - as it occurs in this case - the addition of a geographical term would not prevent a finding of confusing similarity under the first element.

The ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark CONVERSE in which the Complainants have rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

(i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once 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 deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

Likewise, and as further discussed under section 6.C of this Decision, it does not seem that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name, but rather that it intends to use the disputed domain name for the purpose of deriving unfair monetary advantage by confusing Internet users and leading them to believe that the site to which the disputed domain name relates is an official site of the Complainants.

As established in section 2.5 of [WIPO Overview 3.0](#): "Fundamentally, a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry." Here, the nature of the disputed domain name carries a risk of implied affiliation.

The Panel finds that the Complainants have made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

As acknowledged by previous panels in UDRP cases, the trademark CONVERSE has a distinctive character, is commonly known worldwide and has a significant amount of goodwill attached to it.

The Panel is satisfied that the Respondent must have been aware of the Complainants' CONVERSE trademark when it registered the disputed domain name on July 30, 2021. By that time the Complainants had been selling shoes with the CONVERSE trademark for more than one hundred years and registered the trademark CONVERSE in many countries, at least since 1969. Moreover, the disputed domain name contains the Complainant's mark and the website offers to sell the Complainants' products.

The Respondent when registering the disputed domain name was targeting the Complainants and their business by incorporating the trademark CONVERSE and the geographic term "south africa", which leads Internet users to think that the website to which the disputed domain name resolves is the official website of the Complainants in South Africa and thereby capitalize on the fame of the CONVERSE trademark for its own monetary benefit.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name is also a significant factor to consider that the disputed domain name was registered and is being used in bad faith, as stated in section 3.2.1 of [WIPO Overview 3.0](#).

Pursuant to section 3.3 of [WIPO Overview 3.0](#), the fact that the disputed domain name does not resolve to an active webpage at the time of writing this decision does not prevent a finding of bad faith under the doctrine of passive holding. See also *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

For the above reasons, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

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 <conversesouthafrica.com> be transferred to the Complainants.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

Date: November 7, 2022