

ADMINISTRATIVE PANEL DECISION

Sebago S.r.l. and Basic Net S.r.l. v. Dong Dou, Kristin SCHWARZ, Client Care, Web Commerce Communications Limited, and Julius Bergman
Case No. D2022-3756

1. The Parties

The Complainants are Sebago S.r.l. and Basic Net S.r.l., both in Italy, represented by Studio Sindico e Associate, Italy.

The Respondents are Dong Dou, China; Kristin SCHWARZ, Germany; Client Care, Web Commerce Communications Limited, Malaysia; and Julius Bergman, France.

2. The Domain Names and Registrars

The disputed domain names <sebagoayakkabiturkiye.com>, <sebago-canada.com>, <sebagochileoutlet.com>, <sebagocolombia.com>, <sebagodanmark.com>, <sebagofactoryoutlet.com>, <sebagofrancesoldes.com>, <sebagoitaliaoutlet.com>, <sebagonederland.com>, <sebagonzs.com>, <sebagoutletespana.com>, <sebagoutletmadrid.com>, <sebagoutletsuomi.com>, <sebagoutletuk.com>, <sebagoportugaloutlet.com>, <sebagosalecanada.com>, <sebagoschuheoutlet.com>, <sebagoshoescanadas.com>, <sebagoshoesireland.com>, <sebagoshoessouthafrica.com>, <sebagoshoesuae.com>, <sebagoshoesuk.com>, <sebagoshoesusa.com>, <sebagosingaporeoutlet.com>, <sebagoskonorge.com>, <sebagoskooslo.com>, <sebagoskorrea.com> and <sebagoturkiyetr.com> are registered with Alibaba.com Singapore E-Commerce Private Limited.

The disputed domain name <sebagodiscount.com> is registered with Name.com, Inc.

The disputed domain name <sebagonz.com> is registered with NETIM SARL.

The disputed domain name <sebagosnz.com> is registered with 1API GmbH.

Alibaba.com Singapore E-Commerce Private Limited, Name.com, Inc., NETIM SARL, and 1API GmbH are collectively referred to hereinafter as the “Registrars”.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 7, 2022 involving the disputed domain names and the domain name <sebagoboathoes.com>. On October 7, and 9,

2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On October 9, 10, and 11, 2022, the Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on October 11, 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 two amended Complaints on October 12 and 24, 2022, including a request to remove the domain name <sebagoboatsshoes.com> from the proceedings.

The Center verified that the Complaint together with the amended Complaints 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 Respondents of the Complaint, and the proceedings commenced on October 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on November 16, 2022.

The Center appointed Marilena Comanescu as the sole panelist in this matter on November 21, 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 Sebago S.r.l. (previously known as Tos S.r.l.), and the Complainant Basic Net S.r.l. are part of the BasicNet Group, a manufacturer of clothing, footwear and accessories, mostly sportswear and leisurewear. The Complainants' goods are available in many countries around the world, including in the United States of America and Europe. Since the Complainants are part of the same group, they will be collectively referred to as the "Complainant" hereinafter.

The Complainant holds trademark registrations for SEBAGO worldwide, such as the following:

- the European Union Trademark registration no. 017995573 for the word SEBAGO, filed on December 4, 2018 and registered on April 26, 2019, and covering goods in Nice classes 18, 24, and 25; and
- the International Trademark registration no. 1510256 for the word SEBAGO, registered on November 26, 2019, designating many jurisdictions worldwide, and covering goods in Nice classes 18, 24 and 25.

The Complainant holds numerous domain names incorporating the SEBAGO mark, such as <sebago.com>, <sebago.cc>, <sebago.md>, <sebago.com.au>, <sebagocanada.com>, or <sebago-germany.com>.

According to the information provided by the Registrars, the disputed domain names were registered as follows:

- <sebagodiscount.com> was registered in the name of Dong Dou on July 21, 2022;
- <sebagonz.com> was registered in the name of Kristin SCHWARZ on October 23, 2021;
- <sebagosnz.com> was registered in the name of Julius Bergman on January 21, 2022;

The rest of the disputed domain names were registered in the name of Client Care, Web Commerce Communications Limited on the following dates:

- <sebagofactoryoutlet.com> was registered on January 12, 2022;
- <sebagodanmark.com>, <sebagocolombia.com>, <sebago-canada.com>, <sebagonederland.com>, and <sebagoshoesuk.com> were registered on January 19, 2022;
- <sebagoutletuk.com> was registered on January 22, 2022;
- <sebagosalecanada.com> was registered on February 9, 2022;
- <sebagoshoescanadas.com> was registered on March 29, 2022;
- <sebagonzs.com> was registered on July 8, 2022;
- <sebagoutletsuomi.com>, <sebagoutletespana.com>, <sebagochileoutlet.com>, <sebagoschuheoutlet.com>, <sebagoitaliaoutlet.com>, <sebagoshoesireland.com>, <sebagoportugaloutlet.com>, <sebagoskooslo.com>, <sebagosingaporeoutlet.com>, <sebagoskorrea.com>, <sebagofrancesoldes.com>, <sebagoyakkabiturkiye.com>, <sebagoskonorge.com>, <sebagoshoesouthafrica.com>, <sebagoturkiyetr.com>, and <sebagoutletmadrid.com> were registered on August 11, 2022;
- <sebagoshoesusa.com> was registered on August 12, 2022, and;
- <sebagoshoesuae.com> was registered on August 20, 2022.

At the time of filing the Complaint, according to evidence provided in Annex 45 to the Complaint, some of the disputed domain names were used in connection with websites that closely resemble to the Complainant's official website, presenting the Complainant's goods, SEBAGO trademark and other elements referable to the Complainant, such as advertising posters or official images present on the Complainant's social profile pages, and the disputed domain name <sebagodiscount.com> promoted third party products. The Panel further notes that some of the disputed domain names did not resolve to any active websites.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to its well-known SEBAGO trademark, the Respondent has no rights or legitimate interests in the disputed domain names, and the Respondent registered and is using the disputed domain names in bad faith. The Complainant requests the transfer of the disputed domain names to it.

B. Respondents

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

6. Discussion and Findings

In view of the absence of a Response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Preliminary Procedural Issue: Consolidation of Multiple Disputed Domain Names and Respondents

According to the provisions of paragraph 10(e) of the Rules, the Panel has the power to decide the consolidation of multiple domain names disputes. Further, paragraph 3(c) of the Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In the present case, there are 31 disputed domain names, and apparently four Respondents, as listed in section 4 above. They will be collectively referred to as the "Respondent".

The disputed domain names (i) were registered on the same day or in a short space of time; (ii) were created in a similar manner: reproducing the Complainant's trademark plus geographical and/or dictionary terms; and (iii) were used in a similar manner for most of the disputed domain names, for websites impersonating the Complainant, presenting the Complainant's products, official images and the SEBAGO trademark.

Furthermore, (i) the Respondents Client Care, Web Commerce Communications Limited and Julius Bergman were involved together in a prior UDRP dispute with the Complainant - see *Basic Net S.p.A. and Tos S.r.l. v. Julius Bergman, Tim BEICH, and Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0684](#); and (ii) the disputed domain name <sebagonz.com>, registered in the name of Kristin SCHWARZ redirects to the disputed domain name <sebagonzs.com>, registered in the name of Client Care, Web Commerce Communications Limited.

The Respondent had the opportunity to comment on the consolidation request made by the Complainant but it chose to remain silent.

For the above, the Panel finds, more likely than not, that the disputed domain names are subject to common control and it would be equitable and procedurally efficient to decide the consolidation of the multiple disputed domain names and registrants in the present procedure. See also section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

B. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the SEBAGO trademark.

All of the disputed domain names incorporate the trademark SEBAGO in its entirety and as prefix with additional terms. However, such additions do not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain names.

Numerous UDRP panels have considered that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) to trademarks in a domain name would not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

Further, it is well established in decisions under the UDRP that the generic Top-Level Domain ("gTLD") (e.g., ".com", ".site", ".info") may typically be disregarded for the purposes of consideration of confusing similarity

between a trademark and a domain name. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain names are confusingly similar to the trademark SEBAGO, pursuant to the Policy, paragraph 4(a)(i).

C. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license, or authorization whatsoever to use the mark SEBAGO, that the Respondent is not commonly known by the disputed domain names and that the Respondent has not used the disputed domain names in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods or services.

Under the Policy, “where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element”. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not replied to the Complainant’s contentions and has not come forward with relevant evidence to rebut the Complainant’s *prima facie* case.

At the time of filing the Complaint, some of the disputed domain names were used in connection with commercial websites offering for sale SEBAGO branded goods.

In certain cases, panels have recognized that resellers, distributors using a domain name containing a complainant’s trademark to undertake sales related to complainant’s goods may be making a *bona fide* offering of goods and thus have a legitimate interest in such domain name. Accordingly, in this case, assuming that the goods promoted under some of the disputed domain names are genuine SEBAGO products, the key question under this element is whether the Respondent’s use some of the disputed domain names amount to a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy.

The current state of UDRP panel consensus in relation to this issue is helpfully summarized in the section 2.8 of the [WIPO Overview 3.0](#), based on panel decisions such as *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). According to the “Oki Data test”, several cumulative requirements will be applied in the specific conditions of a UDRP case, including the fact that the site must accurately and prominently disclose the registrant’s relationship with the trademark holder (the complainant) and that the respondent must use the site to sell only the trademarked goods or services. In this case, according to the available record, on the websites corresponding to some of the disputed domain names there was no indication regarding the relationship between the Parties, in fact the lack thereof. Therefore, the Panel finds that this is not an activity falling under the circumstances listed by paragraph 4(c)(i) of the Policy as demonstrating the Respondent’s rights or legitimate interests in the disputed domain names.

The Panel further notes that some of the disputed domain names were inactive, and the disputed domain name <sebagodiscount.com> promoted third party products.

In addition, and without prejudice to the above, the nature of the disputed domain names, comprising the Complainant’s well-known trademark in combination with a descriptive and/or geographical terms, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

For these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain names, pursuant to the Policy, paragraph 4(a)(ii).

D. Registered and Used in Bad Faith

The Complainant holds trademark rights in SEBAGO since at least 1980. This Panel accepts the Complainant's evidence that the SEBAGO trademark is distinctive and gained reputation in relation to footwear and clothing.

The disputed domain names were all registered in late 2021 or in 2022, and incorporate the Complainant's mark in its entirety together with descriptive terms or geographical indicators.

Given the fact that the mark is well known and distinctive, the Panel finds that it is impossible to believe that the Respondent chose to register the disputed domain names randomly with no knowledge of the SEBAGO mark. The websites at some of the disputed domain names also feature the Complainant's trademark, logo and depict images of the Complainant's products.

For the above, the Panel finds that the disputed domain names were registered in bad faith with the Respondent's knowledge of the Complainant and targeting its trademark.

At the time of filing the Complaint, for some of the disputed domain names, the Respondent was using, without permission, the Complainant's distinctive trademark in order to get traffic on its web portals and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain names incorporate the Complainant's trademark in its entirety together with geographical indicators or descriptive terms and the websites operated under some of the disputed domain names display the Complainant's trademarks, visuals, product images and has no disclaimer, indeed in this Panel's view, the Respondent intended to attract Internet users accessing the websites corresponding to the disputed domain names who may be confused and believe that the websites are held, controlled by, or somehow affiliated or related to the Complainant, for commercial gain. This activity may also disrupt the Complainant's business and tarnish its trademark.

The use of the disputed domain name <sebagodiscount.com> for promoting third party products also falls squarely into bad faith under paragraph 4(b)(iv) of the Policy.

Although some of the disputed domain names were inactive, the Panel finds that it does not prevent a finding of bad faith under the doctrine of "passive holding" in this case. See section 3.3 of the [WIPO Overview 3.0](#).

Paragraph 4(b)(ii) of the Policy provides another circumstance of bad faith registration and use when the respondent registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. The Panel finds that registering for more than 30 disputed domain names reflecting the Complainant's trademark can be considered a pattern of abusive conduct and registration of the disputed domain names in bad faith. See also *Basic Net S.p.A. and Tos S.r.l. v. Julius Bergman, Tim BEICH, and Client Care, Web Commerce Communications Limited*, *supra*.

Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar to a third party's well-known trademark can, by itself, constitute a presumption of bad faith for the purpose of Policy. See section 3.1.4 of the [WIPO Overview 3.0](#).

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain names in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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 names <sebagoayakkabiturkiye.com>, <sebago-canada.com>, <sebagochileoutlet.com>, <sebagocolombia.com>, <sebagodanmark.com>, <sebagodiscount.com>, <sebagofactoryoutlet.com>, <sebagofrancesoldes.com>, <sebagoitaliaoutlet.com>, <sebagonederland.com>, <sebagonz.com>, <sebagonzs.com>, <sebagoooutletespana.com>, <sebagoooutletmadrid.com>, <sebagoooutletsuomi.com>, <sebagoooutletuk.com>, <sebagoportugaloutlet.com>, <sebagosalecanada.com>, <sebagoschuheoutlet.com>, <sebagoshoescanadas.com>, <sebagoshoesireland.com>, <sebagoshoessouthafrica.com>, <sebagoshoesuae.com>, <sebagoshoesuk.com>, <sebagoshoesusa.com>, <sebagosingaporeoutlet.com>, <sebagoskonorge.com>, <sebagoskooslo.com>, <sebagoskorrea.com>, <sebagosnz.com>, and <sebagoturkiyetr.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: December 5, 2022