

ADMINISTRATIVE PANEL DECISION

Decathlon and Projetclub v. Michael Nava, Domain Nerdz LLC Case No. D2022-5021

1. The Parties

The Complainants are Decathlon, France and Projetclub, France (the “Complainant”), represented by AARPI Scan Avocats, France.

The Respondent is Michael Nava, Domain Nerdz LLC, United States of America.

2. The Domain Names and Registrar

The disputed domain names <aptonia.xyz>, <artengo.xyz>, <caperlan.xyz>, <elops.xyz>, <geonaute.xyz>, <inesis.xyz>, <itiwit.xyz>, <kalenji.xyz>, <kipsta.xyz>, <nabaiji.xyz>, <outshock.xyz>, <oxylane.xyz>, <solognac.xyz>, <subea.xyz>, <tarmak.xyz>, <tribord.xyz>, <wedze.xyz> are registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 29, 2022. On December 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Privacy Protection) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 3, 2023, 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 January 4, 2023.

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 January 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 14, 2023.

The Center appointed Daniel Peña as the sole panelist in this matter on February 24, 2023. 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 Projetclub is a company business support services. This company is a Decathlon subsidiary, administered by Decathlon.

The Complainant has registered numerous trademarks throughout the world, among others, the following trademarks:

- French word mark INESIS filed on August 12, 1997, (duly renewed) under No. 97691386;
- French word mark SOLOGNAC filed on November 26, 2012, (duly renewed) under No. 3963695;
- French word mark APTONIA filed on January 15, 1999, (duly renewed) under No. 99769160;
- French word mark ITIWIT filed on April 29, 2011, (duly renewed) under No. 3827285;
- French word mark OXYLANE filed on July 1, 2002, (duly renewed) under No. 3171812;
- French word mark SUBEA filed on March 11, 2009, (duly renewed) under No. 3635666;
- French word mark KALENJI filed on April 8, 2004, (duly renewed) under No. 3284911;
- French word mark TRIBORD filed on March 10, 2006, (duly renewed) under No. 3415655;
- French word mark TARMAK filed on July 7, 2017, under No. 4374801;
- French word mark NABAIJI filed on July 21, 2008, (duly renewed) under No. 3589454;
- French word mark WED'ZE filed on November 26, 2012, (duly renewed) under No. 3963716;
- French word mark ELOPS filed on April 18, 2018, (duly renewed) under No. 4447003;
- French word mark KIPSTA filed on November 26, 2012, (duly renewed) under No. 3963760;
- French word mark ARTENGO filed on November 26, 2012, (duly renewed) under No. 3963796;
- French word mark OUTSHOCK filed on April 17, 2015, (duly renewed) under No. 4174451;
- French word mark GEONAUTE filed on December 18, 1997, under No. 97709563;
- French word mark CAPERLAN filed on November 20, 2012, (duly renewed) under No. 3962253.

The disputed domain names were registered on September 6, 2022. The disputed domain names lead to a page informing that they are offered for sale.

5. Parties' Contentions

A. Complainant

The Complainant Decathlon is a major French manufacturer specialized in the conception and retailing of sporting and leisure goods.

On July 27, 1976, Michel Leclercq opened a self-service supermarket dedicated to sport and leisure products near Lille, north of France. The name used is "Decathlon".

In 1986, while the subsidiary Decathlon Production was created with the mission to ensure the design and manufacture of articles marked Decathlon, the Complainant opened its first store outside of French territory, in Germany.

From 1988, production is becoming more international with the opening of the first production office in Asia.

In 2003, the international development of the Complainant takes a new dimension with the opening of the first Chinese store in Shanghai.

Since 2008, the Complainant runs two main activities: the creation of sports products on the one hand and local commerce and other online on the other hand. Companies involved in Decathlon Group intervene therefore in different levels of the product development: research and development to sales through design, production and logistics.

The Complainant and other brand sales, local or online, broadcast the branded products of the network, such as Starboard, Quechua, Domyos, B'Twin, Solognac or materials developed through the component brands, such as Novadry or Equarea Stratermic, but also the products of international brands.

The Complainants claim that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainants assert the Respondent is not currently and has never been known under the Complainants' trademarks. The disputed domain names are not used to promote a *bona fide* offering of goods or services, not to support a noncommercial legitimate use.

The Complainants have not authorized the Respondent to use their trademarks and domain names.

The Complainants have strong reputation throughout the world in the field of selling goods and products related to sport. It is likely that the Respondent knew the Complainants and its well-known trademarks dedicated to sport related products and services when filing application for the disputed domain names. It is therefore highly unlikely that the Respondent was unaware of the existence of the Complainants and its well-known reputation and trademarks. On the contrary, considering (i) the identity between the disputed domain names and the Complainants' prior trademarks and (ii) the high similarity between the disputed domain names and the Complainants' domain names, it is most likely that the Respondent registered the disputed domain names having the Complainants' trademarks and domain names in mind.

The disputed domain names lead to a page informing that the disputed domain names are for sale for USD 2,988 each. Such use of the disputed domain names reveals that the Respondent has never intended to use them in good faith but has been willing, from the beginning, to resell them and make profit out of them.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

To succeed, the Complainants must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights; (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and (iii) the disputed domain names have been registered and are being used in bad faith. Considering these requirements, the Panel rules as follows:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainants to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights. The Complainants have provided evidence of its rights in the trademarks INESIS, SOLOGNAC, APTONIA, ITIWIT, OXYLANE, SUBEA, KALENJI, TRIBORD, TARMAK, NABAIJI, WED'ZE, ELOPS, KIPSTA, ARTENGO, OUTSHOCK, GEONAUTE, CAPERLAN on the basis of its trademark registrations in France.

The trademark registration provides a clear indication that the rights in the trademark belong to the Complainants (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, "[WIPO Overview 3.0](#)", section 1.2.1). It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is identical or confusingly similar to a trademark. Such findings were confirmed, for example, within section 1.7 of [WIPO Overview 3.0](#). The Panel finds that the disputed domain names are identical to the Complainants' trademarks. The Respondent's incorporation of the Complainant's marks in full in the disputed domain names is evidence that the disputed domain names are confusingly similar to the Complainant's marks. Furthermore, the addition of the generic Top-Level Domain ("gTLD") ".xyz" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Panel is satisfied that the disputed domain names are identical to the Complainants' trademarks and the Complainants have satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainants must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainants argue that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainants bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainants to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent, will lead to this ground being set forth.

Refraining from submitting any Response, the Respondent has brought to the Panel's attention no circumstances from which the Panel could infer that the Respondent has rights to or legitimate interests in the disputed domain names. The Panel will now examine the Complainants' arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain names. The Complainants claim that the Respondent has no connection or affiliation with the Complainants and have not received any license or consent, express or implied, to use the Complainants' trademarks in a domain name or in any other manner. Furthermore, the disputed domain names direct to a parked page listing the disputed domain names for sale. The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain names, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

In addition, the Panel finds that the disputed domain names carry a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain names and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith: (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location.

In the Panel's view, a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name. In this case, the Complainants submit that at the date of registration of the disputed domain names the Respondent would have had constructive, if not actual knowledge of the Complainant's trademarks INESIS, SOLOGNAC, APTONIA, ITIWIT, OXYLANE, SUBEA, KALENJI, TRIBORD, TARMAK, NABAIJI, WED'ZE, ELOPS, KIPSTA, ARTENGO, OUTSHOCK, GEONAUTE, and CAPERLAN.

The Panel's finding is reinforced given the construction of the disputed domain names, which reproduces entirely the Complainants' trademarks. The Panel is satisfied that by offering the disputed domain names for sale, the Respondent registered the disputed domain names for the purpose of selling them to the Complainants or a third party for valuable consideration likely in excess of its documented out-of-pocket costs. In addition, the Complainant points out that the Respondent is hiding its identity behind a Whois privacy wall. It is well-established that this, too, can be further *prima facie* evidence of bad faith in certain circumstances.

Having considered the Complainant's submissions and in the absence of a Response, the Panel accepts the Complainants' submission that on the evidence there is no plausible circumstance under which the Respondent could legitimately register and use the disputed domain names. Consequently, the Panel finds that the disputed domain names were registered and used by the Respondent in bad faith within 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 names, <aptonia.xyz>, <artengo.xyz>, <caperlan.xyz>, <elops.xyz>, <geonaute.xyz>, <inesis.xyz>, <itiwit.xyz>, <kalenji.xyz>, <kipsta.xyz>, <nabajji.xyz>, <outshock.xyz>, <oxylane.xyz>, <solognac.xyz>, <subea.xyz>, <tarmak.xyz>, <tribord.xyz>, <wedze.xyz> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: March 10, 2023