

ADMINISTRATIVE PANEL DECISION

Cairn Sport v. DSd DSd
Case No. D2023-0604

1. The Parties

The Complainant is Cairn Sport, France, represented by Cabinet Germain & Maureau, France.

The Respondent is DSd DSd, Hong Kong, China.

2. The Domain Names and Registrars

The disputed domain names <cairnsale.com> and <cairnstore.com> are registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2023. On February 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 13, 2023, 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 (Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 17, 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 February 22, 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 March 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 27, 2023.

The Center appointed Torsten Bettinger as the sole panelist in this matter on March 30, 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, domiciled in France, designs and manufactures sportswear since 1938.

The Complainant is the registered owner of the trademark CAIRN for classes 9, 18, 25, and 28 across numerous jurisdictions, including the following:

- French trademark No. 17 4372413 CAIRN + Design registered on October 20, 2017;
- European Union Trade Mark No. 011623279 CAIRN, registered on July 31, 2013;
- International trademark No. 1404142 CAIRN + Design, registered on February 14, 2018 designating the Republic of Korea;
- International trademark No. 1270772, CAIRN, registered on July 27, 2015, designating China, United Kingdom, Iran (Islamic Republic of), Japan, Republic of Korea, Kazakhstan, Russian Federation and Türkiye.

The Complainant is running an online retail store at <cairn-sport.com>.

The Respondent registered the disputed domain names on August 31, 2022. The disputed domain names resolve to websites offering sportswear under the brand “cairn” at discount prices.

5. Parties' Contentions

A. Complainant

The Complainant claims that CAIRN is a fancy name, inherently distinctive and well-known and that the trademark CAIRN enjoys a considerable reputation in the field of sportswear in France but also abroad.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain names pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that the disputed domain name is confusingly similar to its registered trademark CAIRN as:

- the mere addition of the terms “sale” and “store” to the Complainant’s trademark does not negate the confusing similarity between the disputed domain name and the Complainant’s trademark under the Policy but lead the Internet users to believe that the disputed domain names are used for the Complainant’s online-shops;
- the confusion between the Complainant’s trademark CAIRN and the disputed domain names is reinforced by the fact that they resolve to websites selling sportswear which is the Complainant’s core activity.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the Respondent has no rights or legitimate interests into the disputed domain names;
- there is no business affiliation between the Complainant and the Respondent;
- the Complainant has not given permission or license to the Respondent to use the term CAIRN in any manner;
- the Complainant holds rights in the word CAIRN that predate the Respondent’s registration of the disputed domain names;
- the Respondent’s use of the disputed domain names for websites offering sportswear likely mislead consumers into believing that the disputed domain names originate from the Complainant or affiliated companies.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the disputed domain names have been used for the sale of counterfeiting goods, some of which are identical to the CAIRN goods;
- the disputed domain names are used for online shops which offer identical goods to those marketed by the Complainant under the CAIRN trademarks;
- the Respondent offers the sportswear at discount prices in order to attract consumers;
- some of the pictures used by the Respondent are reproduction of those used on the Complainant online store;
- the use of the mark CAIRN on the websites, e.g., in the title or description of the goods, necessarily leads Internet users to believe that CAIRN is associated with or sponsors the websites at issue, or that there is some sort of connection between the Respondent and the Complainant, even though there is no connection, sponsor, or affiliation between them;
- the Respondent seeks to exploit the CAIRN mark on the Internet for commercial gain by confusing Internet users about the origin of goods offered for sale, and the fake online store are designed to obtain personal information such as email addresses and credit card numbers.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns multiple trademark registrations for the mark CAIRN prior to the registration of the disputed domain name on August 31, 2022.

It is well-established that the test of identity or confusing similarity between the trademark and the disputed domain name under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases (see sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In this case, the disputed domain names contain the Complainant's trademark CAIRN in its entirety and only differs from the Complainant's trademark CAIRN by the addition of the term "sale" and "store".

The Panel notes that it has long been established under the UDRP case law that the addition of descriptive wording to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of [WIPO Overview 3.0](#)). The Panel therefore agrees with the Complainant's assertion that the addition of the terms "sale" and "store" do not prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademark CAIRN.

Furthermore, it is well accepted under the UDRP case law that the specific generic Top-Level Domain ("gTLD") such as ".com", ".net", ".org" is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable Top-Level suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#) section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain names are confusingly similar to the Complainant's CAIRN trademark.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

“(i) before any notice to you [the Respondent] of the dispute, your 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) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [the Respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Complainant stated that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized by the Complainant to register and use the disputed domain names. Furthermore, the Complainant stated and provided screenshots that show that the disputed domain names which except for the addition of the designation “store” and “sale” contain the Complainant's trademark in its entirety resolve to websites which appear to offer counterfeit sportswear under the Complainant's brand CAIRN and to provide false addresses.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names.

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 disputed domain names. If the respondent fails to submit 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 chose not to contest the Complainant's allegations and has failed to come forward with any evidence to refute the Complainant's *prima facie* showing that the Respondent lacks rights or legitimate interests.

From the record in this case, the Respondent has also not used the disputed domain names in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use, in contrary the Respondent used the disputed domain names to sell products which may be counterfeit or compete with those of the Complainant, considering they are offered at discounted prices.

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](#).

On this basis the Panel concludes that the Respondent lacks rights and legitimate interests in the disputed domain names and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances 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 the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to

the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed 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; or

(iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed 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 the Respondent's website or location.

Bad faith registration

The Complainant holds multiple trademark registrations for the CAIRN trademark in various countries that predate the registration of the disputed domain names. The CAIRN mark is distinctive and clearly associated with the Complainant and its products and services through widespread use.

Given that the disputed domain names contain the Complainant's trademark CAIRN in its entirety with the addition of the terms "sale" and "store" and that the disputed domain names resolve to online stores which offer sportswear that appears to be counterfeiting, the Panel has no doubt that the Respondent registered the disputed domain names with actual knowledge of the Complainant's rights in the CAIRN mark.

The Panel thus finds that the Respondent registered the disputed domain names in bad faith.

Bad faith use

To prove bad faith use of the disputed domain names, the Complainant provided evidence that indicates that the Respondent has used the disputed domain names to resolve to online stores offering sportswear which competes with those offered by the Complainant and may be counterfeiting, considering the products are offered at discounted prices.

Such use constitutes bad faith as it indicates that the Respondent intentionally registered and is using the disputed domain names in order to disrupt the Complainant's business, in accordance with paragraph 4(b)(iii) of the Policy, and to attract, for commercial gain, Internet users to its website in accordance with paragraph 4(b)(iv) of the Policy.

The Panel is therefore satisfied that the Complainant has shown that the disputed domain name has been registered and is being used in bad faith satisfying the third limb 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, <cairnsale.com> and <cairnstore.com>, be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: April 12, 2023