

## **ADMINISTRATIVE PANEL DECISION**

**BABOLAT VS v. Huili Gan, Lu Yufeng, Xiaofen Tan, Fanyuan Tang, Peishun Wang**

**Case No. D2023-0963**

### **1. The Parties**

The Complainant is BABOLAT VS, France, represented by SafeBrands, France.

The Respondents are Huili Gan, Lu Yufeng, Xiaofen Tan, Fanyuan Tang, and Peishun Wang, China.

### **2. The Domain Names and Registrar**

The disputed domain names <babolatsale.com>, <babolatsports.com>, <newbabolattennis.com>, <outletbabolat.com>, <tennis-babolat.com>, <tennisbabolatshop.com>, and <thebabolattennis.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 March 2, 2023. On March 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 5, 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 (Whols Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 17, 2023, providing the registrant and contact information for the multiple underlying registrants disclosed by the Registrar and inviting the Complainant to amend the Complaint by adding the Registrar-disclosed registrants as formal Respondents and providing relevant argument or evidence demonstrating that all named Respondents are, in fact, the same entity and/or that all the disputed domain names are under common control. The Complainant filed an amended Complaint on March 21, 2023, stating that it relied on its arguments for consolidation as set out in the Complaint.

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 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2023. The Respondents did not submit any Response. Accordingly, the Center notified the Respondents' default on April 19, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on April 27, 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 is a French company specialized in sports racquets products, which are currently commercialized in more than 160 countries around the world and sponsored by famous players such as Rafael Nadal, Dominic Thiem, and Jo-Wilfried Tsonga. In 2022, the Complainant became the official racquet service of the Wimbledon Championship, the famous tennis tournament.

The Complainant is the owner of several trademark registrations for BABOLAT, including the following, as per trademark registration details submitted as annexes to the Complaint:

- French trademark registration No. 3143740 for BABOLAT (word mark), filed on January 25, 2002, in classes 07, 18, 25, and 28;
- United States of America trademark registration No. 2802279 for BABOLAT (word mark), filed on July 22, 2002 and registered on January 25, 2002 in international classes 7, 18, 25, and 28;
- International trademark registration No. 794703 for BABOLAT (word mark), registered on July 11, 2002, in international classes 07, 18, 25, and 28.

The Complainant is also the owner of the domain name <babolat.com>, which was registered on January 30, 1997, and is used by the Complainant to promote its products under the trademark BABOLAT.

The disputed domain names were registered on the following dates:

- <babolatsports.com> and <tennis-babolat.com> on November 3, 2022;
- <babolatsale.com> and <outletbabolat.com> on November 5, 2022;
- <thebabolattennis.com> on November 10, 2022;
- <newbabolattennis.com> and <tennisbabolatshop.com> on November 19, 2022.

All the disputed domain names resolve to websites that reproduce the Complainant's trademarks and official images and offer purported BABOLAT products for sale.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain names are confusingly similar to the trademark BABOLAT in which the Complainant has rights as they reproduce the trademark in its entirety with the mere addition of the descriptive or generic terms (namely, "outlet", "tennis", "sports", "shop", "new", "sale", and the article "the") and the generic Top-Level Domain (TLD) ".com".

With reference to rights or legitimate interests in respect of the disputed domain names, the Complainant states that the Respondents are not commonly known by the disputed domain names and do not own any trademarks or corporate trade name corresponding to BABOLAT.

The Complainant contends that the Respondents did not obtain any authorization from the Complainant to use the registered trademark BABOLAT and they are in no way associated with the Complainant.

The Complainant further submits that the Respondents are not using the disputed domain names in connection with a *bona fide* offering of goods or services nor as a legitimate noncommercial or fair use since they are pointing the disputed domain names to websites that reproduce the Complainant's trademarks, copyrighted images and graphic charter and offer to sell heavily discounted goods supposedly coming from the Complainant at the significantly discounted prices, a circumstance suggesting that the products may be counterfeit.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering i) the use of the Complainant's distinctive trademark for over a century, ii) the nature of the disputed domain names which refer with no doubt to the Complainant's products and business and iii) the reputation of the Complainant online, the Respondents could, by no mean, have ignored the existence of the Complainant's trademark at the of registration.

The Complainant emphasizes that, considering the disputed domain names have been pointed to websites offering for sale products supposedly coming from the Complainant, it is unlikely that the Respondents could have ignored the existence of the Complainant's trademark rights at the time of registration of the disputed domain names. The Complainant also submits that the fact that the disputed domain names include the widely known and widely used trademark BABOLAT of the Complainant, registered by the Complainant many years before the Respondents registered the disputed domain names, is a further factor supporting a conclusion of bad faith.

The Complainant underlines that it received a number of reports of actual consumer confusion for many disputed domain names and in particular for the disputed domain names <tennisbabolatshop.com> and <babolatsale.com>. Specifically, it appears that in most cases the supposed BABOLAT products ordered by users from the corresponding websites were never received, despite the fact users' bank accounts were duly debited. The Complainant thus concludes that the Respondents registered and are using the disputed domain names to pass off its websites as websites of, or licensed by, the Complainant for fraudulent purposes. The Complainant also states that the Respondents' conduct is disrupting the Complainant's business.

As a further circumstance evidencing bad faith, the Complainant asserts that, in light of the very low prices at which the purported BABOLAT products are offered on the Respondents' websites, they are likely counterfeit.

Lastly, the Complainant indicates that, despite its efforts to resolve the matter by attempting to shut down the Respondents' websites and resolve the matter amicably with the Respondents since November 2022, neither the hosting providers, nor the Registrar, nor the Respondents collaborated, failing to comply with the Complainant's demands. The Complainant also submits that the Respondents' failure to reply to the Complainant's communications reinforces the inference of bad faith registration and bad faith use.

## **B. Respondents**

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

## 6. Discussion and Findings

### 6.1. Preliminary procedural issue: Consolidation of multiple Respondents.

Paragraph 10(e) of the Rules provides that a panel shall decide a request by a party to consolidate multiple domain name disputes in accordance with the Policy and the Rules.

As stated in section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario. Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s)".

The Complainant asserted that the disputed domain names, although registered in the name of different named registrants, are under common control since:

- i) all disputed domain names have been registered with the same Registrar;
- ii) according to the public WhoIs information, the disputed domain names were registered using the same proxy company, namely Domain Protection Services, Inc.;
- iii) based on the registrant information for the disputed domain names provided by the concerned Registrar to the Center after the filing of the Complaint, all the disputed domain names have been registered with the indication of China as country. Moreover, some of them have similarities, sharing for example the same phone number, the same province or city (Hong-Kong);
- iv) all the disputed domain names are pointing to substantially identical websites which reproduce in the same manner the Complainant's graphic charter, trademarks, logos, and photos in order to sell suspected counterfeit BABOLAT products;
- v) all the websites at the disputed domain names are hosted on the servers of the same provider Cloudflare;
- vi) all the disputed domain names and the corresponding websites target a unique trademark, namely the Complainant's trademark BABOLAT.
- vii) the disputed domain names have been registered in a similar naming pattern, *i.e.* all the disputed domain names are a combination of the Complainant's trademark BABOLAT and a descriptive term which refers to the Complainant's products;
- viii) the disputed domain names were registered within a short period, *i.e.*, on November 3, 5, 10, and 19, 2022.

The Panel finds that the elements highlighted by the Complainant and referenced above demonstrate a common control of the disputed domain names by the Respondents. Indeed, the disputed domain names all incorporate the Complainant's trademark with the mere addition of descriptive terms and have been pointed to websites that reproduce the Complainant's trademarks and official images and are offering for sale purported BABOLAT products at discounted prices.

In view of the above and of the commonalities in the registration information of the disputed domain names, this Panel concludes that the consolidation of the multiple domain names is appropriate in this case and is consistent with the Policy and Rules as well as with prior relevant UDRP decisions in this area (see, amongst others, *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#)).

Therefore, the Panel will now proceed to a decision on the merits of the case.

## 6.2. Substantive Issues

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain names registered by the Respondents are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondents have no rights or legitimate interests in respect of the disputed domain names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

### A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark BABOLAT based on the trademark registrations cited under section 4 above and the related trademark registration details submitted as annex 6 to the Complaint.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between a complainant's trademark and the disputed domain names to assess whether the trademark is recognizable within the disputed domain name (section 1.7 of the [WIPO Overview 3.0](#)).

In the case at hand, the Panel notes that the disputed domain names <babolatsale.com>, <babolatsports.com>, <newbabolattennis.com>, <outletbabolat.com>, <tennis-babolat.com>, <tennisbabolatshop.com> and <thebabolattennis.com> all incorporate the trademark BABOLAT in its entirety with the addition of the descriptive terms "outlet", "tennis", "sports", "shop", "new", "sale", the article "the", and the generic TLD ".com", which the Panel finds do not prevent confusing similarity.

As found in a number of prior cases decided under the Policy, where a trademark is recognizable within a domain name, the addition of generic or descriptive terms does not prevent a finding of confusing similarity under the first element (section 1.8 of the [WIPO Overview 3.0](#)). Moreover, the TLD in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain names are confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

The Complainant must show that the Respondents have no rights or legitimate interests in respect of the disputed domain names. The Respondents may establish a right or legitimate interest in the disputed domain names by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- “(i) before any notice to you 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 (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 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.”

In the case at hand, by not submitting a Response, the Respondents have failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondents and the Complainant. The Respondents are not licensees of the Complainant, nor have the Respondents otherwise obtained an authorization to use the Complainant’s trademarks. Moreover, there is no element from which the Panel could infer the Respondents’ rights or legitimate interests over the disputed domain names, or that the Respondents might be commonly known by the disputed domain names.

As mentioned above, the disputed domain names are pointed to websites that reproduce the Complainant’s trademarks and official images and offer purported BABOLAT products at discounted prices. Irrespectively of the nature of the products offered by the Respondents, the Panel finds that the Respondents’ use of the disputed domain names does not meet the cumulative requirements set forth in the Oki Data test for resellers using a domain name containing the complainant’s trademark to be making a *bona fide* offering of goods and services. Specifically, the websites do not accurately and prominently disclose the Respondents’ (lack of) relationship with the trademark holder. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and section 2.8.1 of the [WIPO Overview 3.0](#).

In view of the above-described use of the disputed domain names, the Panel also finds that the Respondents have not used the disputed domain names in connection with a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark.

Therefore, the Panel finds that the Complainant has proven that the Respondents have no rights or legitimate interests in the disputed domain names according to paragraph 4(a)(ii) of the Policy.

## C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain names were registered and are being used by the Respondents in bad faith.

As to the bad faith at the time of the registration, the Panel notes that, in light of the prior registration and use of the Complainant’s trademark BABOLAT in connection with the Complainant’s products, advertised also online via the Complainant’s website “www.babolat.com”, and recently promoted also via the Complainant’s partnership with the famous Wimbledon tennis tournament, the Respondents were or could have been aware of the Complainant’s trademark.

Moreover, the fact that the disputed domain names have been pointed to websites featuring the Complainant's trademarks and official images and offering purported BABOLAT products, clearly suggests that the Respondents were indeed well aware of the Complainant and its trademark.

Furthermore, in view of the notoriety of the Complainant's trademark, the Panel finds that the Respondents acted in opportunistic bad faith at the time of registration, since the disputed domain names are so obviously connected with the Complainant that their very selection by the Respondents, which have no connection with the Complainant, suggests the disputed domain names were registered with a deliberate intent to create an impression of an association with the Complainant.

As in *Gateway, Inc. v. Lorna Kang*, WIPO Case No. [D2003-0257](#), this Panel shares the view of a number of panel findings of "opportunistic bad faith" in the registration of renowned or even somewhat less famous trademarks. As stated *inter alia* in *DHL Operations B.V v. Net Marketing Group*, WIPO Case No. [D2005-0868](#), "It is obvious that the value and goodwill, of the Complainant's mark DHL which has an extensive world wide recognition, would have been known to the Respondent at the time of registration of the Domain Name. The registration and use of the mark by an entity unconnected to the Complainant gives rise to the presumption of opportunistic bad faith".

The Panel also finds that the Respondents' use of the disputed domain names in connection with websites displaying the Complainant's trademarks and images and offering purported BABOLAT products without displaying disclaimers of non-affiliation with the Complainant amounts to bad faith under paragraph 4(b)(iv) of the Policy, since the Respondents intentionally attempted to attract Internet users to their websites for commercial gain by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the websites and the products offered therein.

Therefore, the Panel finds that the Complainant has also proven that the Respondents registered and are using the disputed domain names in bad faith according to 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 <babolatsale.com>, <babolatsports.com>, <newbabolattennis.com>, <outletbabolat.com>, <tennis-babolat.com>, <tennisbabolatshop.com>, and <thebabolattennis.com> be transferred to the Complainant.

*/Luca Barbero/*

**Luca Barbero**

Sole Panelist

Date: May 13, 2023