

## **ADMINISTRATIVE PANEL DECISION**

Sportsgirl Pty. Ltd. v. Kevin Todd  
Case No. D2023-1173

### **1. The Parties**

The Complainant is Sportsgirl Pty. Ltd., Australia, represented by Dentons Australia Limited, Australia.

The Respondent is Kevin Todd, United States of America (“United States”).

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

The disputed domain name <sportsgirl-outlet.shop> is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 16, 2023. On March 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 16, 2023, 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 (Domain Administrator, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 20, 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 amendment to the Complaint on March 21, 2023.

The Center verified that the Complaint together with the amendment to the 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 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 13, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on May 2, 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 an Australian designer and retailer of women's clothing, accessories, shoes, bags, and beauty products, operating more than 120 physical retail stores throughout Australia.

The Complainant's official website is available at "www.sportsgirl.com.au" where the Complainant's products are available. In addition to that, the Complainant is the owner, amongst many others, of the Australian trademark registration No. 192015 for the word mark SPORTSGIRL, registered on December 24, 1964, subsequently renewed, in class 25 (Annex 7 to the Complaint).

The disputed domain name was registered on December 22, 2022, and presently does not resolve to an active webpage. The disputed domain name has been used in connection with an online shop that reproduced the Complainant's trademark, product images, product names, and product descriptions which had been copied from the Complainant's website (Annex 11 to the Complaint). On January 24, 2023, the Complainant made a purchase at the Respondent's website but the items that were purportedly ordered and paid for have not been received. Instead, on February 20, 2023, a package was received containing a fake Cartier ring, which was not the item that was ordered (Annex 13 to the Complaint).

On February 24, 2023, the operator of the ".shop" Top Level Domain ("TLD"), determined that the content hosted on the disputed domain name warranted placement of a server hold on it.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant asserts to have first opened a retail store in Melbourne, Australia, in 1948, having been operating continuously since that time and continuously and extensively using the SPORTSGIRL trademark since 1964.

The Complainant further asserts that the SPORTSGIRL trademark is exclusively associated with the Complainant, and that, in addition to its use online, the Complainant's advertising and promotional activities featuring the SPORTSGIRL trademark includes print advertising, billboard advertising, event based promotion, give-away items, social media promotion (including on Facebook, Twitter, Instagram and Pinterest), participation in fashion shows, and collaborations with other designers.

Under the Complainant's view, the disputed domain name incorporates the Complainant's well-known SPORTSGIRL trademark with the addition of a hyphen and of the dictionary term "outlet", what however does not affect the confusing similarity under the first element of the Policy.

Regarding the absence of the Respondent's rights or legitimate interests, the Complainant argues that:

- i) the Respondent has used the disputed domain name in connection with an online shop that reproduced the Complainant's trademark, product images, product names, and product descriptions which had been copied from the Complainant's website (Annex 11 to the Complaint), what does not characterize a *bona fide* offering of goods or services under the disputed domain name;
- ii) the Respondent is not commonly known by the disputed domain name and has not acquired any trademark rights in the disputed domain name;
- iii) the Respondent is not licensed or authorized by the Complainant to use the Complainant's trademark; and
- iv) the Respondent has not provided any evidence of use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or service before or after any notice of the dispute herein, there being clear evidence that the Respondent registered the disputed domain name for fraudulent purposes.

As to the registration and use of the disputed domain names in bad faith, the Complainant asserts that the use of the disputed domain name in connection with the commercial website described above, displaying the Complainant's trademark and offering for sale the Complainant's branded products, clearly indicates that the Respondent's purpose in registering and using the disputed domain name was to intentionally attempt to attract Internet users seeking the Complainant's branded products to its own website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of their websites and the goods offered and promoted on said website, according to paragraph 4(b)(iv) of the Policy.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

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

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

### **A. Identical or Confusingly Similar**

The Complainant has established rights over the SPORTSGIRL trademark.

The disputed domain name reproduces in its entirety the Complainant's SPORTSGIRL trademark. The addition of a hyphen and of the "outlet" suffix does not prevent a finding of confusing similarity under the Policy which, as recognized by past UDRP panels, involves a "side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name" (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7).

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a nonexclusive list of circumstances that may indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are:

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

- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. This entitles the Panel to draw any inferences from such default, as it considers appropriate, pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make at least a *prima facie* case against the Respondent under the second UDRP element.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent whom has not been commonly known by the disputed domain name and is neither licensed or authorized by the Complainant to use the Complainant's trademark.

Also, the lack of evidence as to any trademarks registered by the Respondent corresponding to the disputed domain name, corroborates the indication of an absence of rights or legitimate interests in the disputed domain name.

Moreover, according to the evidence submitted by the Complainant, the use made of the disputed domain name in connection with an online shop mimicking the Complainant's official webpage and reproducing the Complainant's trademark, product images, product names, and product descriptions and where no disclaimer was provided as to the lack of affiliation between the Respondent's website and the Complainant, clearly does not constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name in these circumstances.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

### **C. Registered and Used in Bad Faith**

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, both the registration and use of the disputed domain name in bad faith can be found pursuant to Policy, paragraph 4(b)(iv), in view of the reproduction of the Complainant's trademark and the purported offer of the Complainant's products at the online shop available at the webpage relating to the disputed domain name, which creates a likelihood of confusion with the Complainant's marks as there is a clear attempt to mimic the Complainant's official webpage and take unfair advantage of the Complainant's trademark for commercial gain.

Moreover, in these circumstances, bad faith of the Respondent is also supported here by (i) the choice to retain a privacy protection service in an attempt to conceal the Respondent's true identity; (ii) the lack of reply by the Respondent invoking any rights or legitimate interests; (iii) the fact that the products purportedly ordered via the site to which the disputed domain name resolved were not delivered, and (iv) the indication of false or incomplete information used by the Respondent for registering the disputed domain name, since the Written Notice was undeliverable to the Respondent by courier service.

For the reasons above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(b)(iv) of the Policy. The third element of the Policy has therefore been met.

## 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 <sportsgirl-outlet.shop> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: May 15, 2023