

ADMINISTRATIVE PANEL DECISION

The Gap, Inc., and Athleta, Inc. v. zhang jian guo
Case No. D2023-1435

1. The Parties

The Complainants are The Gap, Inc. (“First Complainant”), and Athleta, Inc. (“Second Complainant”), both of the United States of America (“United States”), represented by Fross Zelnick Lehrman & Zissu, PC, United States.

The Respondent is zhang jian guo, China.

2. The Domain Name and Registrar

The disputed domain name <athletasaleshop.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on April 3, 2023. On the following day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 6, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainants on April 6, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint in English on April 10, 2023.

On April 6, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On April 10, 2023, the Complainants confirmed their request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 April 17, 2023. In accordance with the Rules, paragraph 5,

the due date for Response was May 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 9, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on May 16, 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 First Complainant is the parent company of the Second Complainant, which markets the ATHLETA brand of women's apparel. The Second Complainant has over 210 retail stores in the United States. The Second Complainant owns multiple trademark registrations for ATHLETA in multiple jurisdictions, including the following:

- United States trademark registration number 2,474,894, registered August 7, 2001 with a claim of first use in commerce in May 1998 for goods in class 25. This registration notes that the English translation of "athleta" is "athlete";
- United States trademark registration number 3,931,221, registered March 15, 2011 with a claim of first use in commerce on May 1, 1998, specifying certain retail store services in class 35; and
- United States trademark registration number 4,202,561, registered September 4, 2012 with a claim of first use in commerce on August 31, 2007, specifying goods in class 28.

The above trademark registrations are current. The Second Complainant registered the domain name <athleta.com> that redirects to <athleta.gap.com>, which is used with an online store within the First Complainant's website. The online store prominently displays ATHLETA as its title alongside a pinwheel logo and it offers for sale clothing and accessories under the ATHLETA trademark.

The Complainants assert trademark rights in multiple other jurisdictions, including Chinese trademark registrations numbers 59844686 and 59855155, both for a semi-figurative mark comprising three stars and the name ATHLETA, both held by Athleta SA of Japan, registered on April 7, 2022 and July 7, 2022, respectively, and specifying goods in classes 26 and 9, respectively. However, nothing in the record demonstrates that Athleta SA, a sporting equipment manufacturer, has any relationship with the Complainants.

The Respondent is an individual based in China.

The disputed domain name was registered on February 2, 2023. It resolves to a website in English for "Hot Sale Athleta Store" that prominently displays ATHLETA as its title alongside a butterfly logo. The site offers for sale women's clothing, accessories, including phone cases, jewelry, watches and party supplies. According to evidence presented by the Complainants, the site reproduces at least one image of a garment that appears on the Complainant's own website. The website contact address is in the United States.

5. Parties' Contentions

A. Complainants

The disputed domain name is confusingly similar to the Complainants' ATHLETA mark. The disputed domain name was registered long after the Complainants had developed rights in their ATHLETA mark and had registered it in the United States, China, and around the world.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has no connection with the Complainants and has never been authorized by the Complainants to use or register the disputed domain name. There is no indication that the Respondent has ever actually been known by the disputed domain name. The Respondent has not developed legitimate interests in the disputed domain name through *bona fide* use. It is clear that the Respondent is not using the disputed domain name to sell genuine Athleta merchandise and is actually selling a number of non-Athleta products. The Respondent's use of the disputed domain name, coupled with the website's prominent use of the ATHLETA trademark, undoubtedly gave consumers the impression that the Respondent's website was authorized by the Complainants, when it was not.

The disputed domain name was registered and is being used in bad faith. The Respondent's lack of connection to the Complainants or to any legitimate use of their ATHLETA mark is in itself evidence of bad faith. Given the fame of the Complainants' trademarks and the fact that the disputed domain name so clearly references the Complainants' business, any visitors to the Respondent's website are likely to believe, mistakenly, that it is owned by, related to, or associated with, the Complainants. The website associated with the disputed domain name lacks any sort of disclaimer that would in any way negate the immediate impression that the site is associated in some way with the Complainants.

The Complainants request that the disputed domain name be transferred to the First Complainant.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Procedural Issues

A. Multiple Complainants

The Complaint was filed by two complainants against a single respondent. Both Complainants form part of the same corporate group as the First Complainant is the parent company of the Second Complainant. Both Complainants use the ATHLETA trademark on the Second Complainant's online store within the First Complainant's website. The Complainants are jointly represented in this proceeding. The Panel finds that the Complainants have a common grievance against the disputed domain name registrant and that it is efficient to permit the consolidation of their complaints. Therefore, the Complainants are referred to below collectively as "the Complainant" except as otherwise indicated.

B. Language of the Proceeding

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". The Registrar confirmed that the Registration Agreement for the disputed domain name is in Chinese.

The Complainant requests that the language of the proceeding be English. Its main arguments are that the website associated with the disputed domain name references the United States, the products are priced in dollars, and the website uses the English language exclusively.

Paragraph 10(b) and (c) of the Rules require the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO

Case No. [D2006-0593](#); and *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. ltd.*, WIPO Case No. [D2008-0293](#).

The Panel observes that the Complaint and amended Complaint in this proceeding were filed in English. The website to which the disputed domain name resolves is in English, from which it is reasonable to infer that the Respondent understands that language. Moreover, despite the Center having sent an email regarding the language of the proceeding, and the notification of the Complaint in both Chinese and English, the Respondent did not comment on the language of the proceeding or express any interest in otherwise participating in this proceeding. Therefore, the Panel considers that requiring the Complainant to translate the Complaint into Chinese would create an undue burden and delay whereas accepting the Complaint in English does not cause prejudice to either Party.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English. The Panel would have accepted a Response in Chinese, but none was filed

6.2 Substantive Issues

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

- (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.

A. Identical or Confusingly Similar

Based on the evidence presented, the Panel finds that the Complainant has rights in an ATHLETA trademark.

The disputed domain name wholly incorporates the Complainant's ATHLETA trademark as its initial element. It adds the English words "sale" and "shop" but these additional words do not prevent a finding of confusing similarity because the ATHLETA mark remains clearly recognizable within the disputed domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

The only additional element in the disputed domain name is a generic Top-Level Domain ("gTLD") (".com"). As a standard requirement of domain name registration, a gTLD may be disregarded in the comparison with a mark for the purposes of the first element of paragraph 4(a) of the Policy unless it has some impact beyond its technical function, which is not the case here. See [WIPO Overview 3.0](#), section 1.11.

For the above reasons, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first condition in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to [the respondent] 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, even if [the respondent has] acquired no 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.

With respect to the first and third circumstances set out above, the disputed domain name, which combines the Complainant's ATHLETA trademark with the words "sale" and "shop", resolves to an online store that prominently displays that mark, albeit with a butterfly logo different from the Complainant's pinwheel logo. The Complainant submits that the Respondent has no connection with itself and that it has never authorized the Respondent to use or register the disputed domain name. The Respondent's website offers for sale a range of products, including what are purported to be the Complainant's products. Regardless of whether those products are genuine or counterfeit, the Respondent's website does not sell the Complainant's products only. Nor does it display a disclaimer that the Respondent has no relationship with the Complainant. Accordingly, this does not constitute a use of the disputed domain name in connection with a *bona fide* offering of goods and services. See *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and [WIPO Overview 3.0](#), section 2.8.1. Given that the Respondent's website is clearly commercial, this does not constitute a legitimate noncommercial or fair use of the disputed domain name either.

With respect to the second circumstance set out above, the Respondent's name is listed in the Registrar's Whois database as zhang jian guo, not the disputed domain name. Nothing on the record indicates that she has been commonly known as the disputed domain name.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because she did not respond to the Complaint.

Therefore, based on the record of this proceeding, the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

- (iv) by using the [disputed] domain name, [the Respondent has] intentionally attempted 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.

The Respondent registered the disputed domain name in 2023, years after the Complainant obtained its trademark registrations in the United States. Although there is no evidence on the record that the Complainant owns trademark rights in the country where the Respondent is based (*i.e.*, China), the Panel notes that the disputed domain name wholly incorporates the Complainant's ATHLETA trademark and combines it with the words "sale" and "shop". The disputed domain name resolves to a website that purports to be a shop for the Complainant's products, and it reproduces a photograph of a garment from the

Complainant's website. These circumstances give the Panel reason to find that the Respondent was aware of the Complainant and its ATHLETA trademark at the time when she registered the disputed domain name and deliberately chose to register it as part of the disputed domain name.

The Respondent uses the disputed domain name, which is confusingly similar to the Complainant's ATHLETA trademark, in connection with a website that offers for sale a range of products, including some that are purported to be the Complainant's products. Despite the fact that the Respondent uses the ATHLETA trademark with a logo different from the Complainant's logo, these circumstances and the findings in Section 6.2B above give the Panel reason to find that this use of the disputed domain name intentionally attempts to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of the products on that website as described in paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) 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 name <athletasaleshop.com> be transferred to the First Complainant, The Gap, Inc.

/Matthew Kennedy/

Matthew Kennedy/

Sole Panelist

Date: May 30, 2023