

## **ADMINISTRATIVE PANEL DECISION**

### **New Balance Athletics, Inc. v. wai mai**

### **Case No. D2023-1733**

#### **1. The Parties**

The Complainant is New Balance Athletics, Inc., United States of America (“United States”), represented by Day Pitney LLP, United States.

The Respondent is wai mai, United Arab Emirates.

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

The disputed domain name <newbalancewichita.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 19, 2023. On April 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 21, 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 Complainant on April 28, 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 in English on May 3, 2023.

On April 28, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On May 3, 2023, the Complainant submitted its 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 in English and Chinese of the Complaint, and the proceedings commenced on May 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 5, 2023.

The Center appointed James Wang as the sole panelist in this matter on June 9, 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 one of the largest and most recognized athletic footwear and apparel companies in the world, offering products branded under the famous NEW BALANCE and NB trademarks in more than 120 countries.

Since at least as early as 1974, the Complainant has exclusively and continuously used and registered its NEW BALANCE and NB trademarks to identify its footwear and apparel products, and, as a result, has amassed an enormous amount of global reputation and goodwill in connection therewith.

The Complainant is the registered owner of the following trademark registrations in the United States for athletic footwear and/or services related to the sale of athletic footwear:

- United States trademark Reg. No. 1053241 NEW BALANCE, registered on November 23, 1976;
- United States trademark Reg. No. 2690233 NEW BALANCE, registered on February 25, 2003.

The Complainant's NEW BALANCE trademark is also the subject of numerous international registrations in other jurisdictions and territories around the world.

The disputed domain name was registered on April 16, 2022 and previously resolved to a website featuring gambling/betting content. The disputed domain name currently does not resolve to an active website with any content.

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

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

The Complainant contended as follows:

The disputed domain name is identical or confusingly similar to the NEW BALANCE trademark in which the Complainant has rights. The Respondent has no rights or legitimate interests in respect of the disputed domain name. The disputed domain name was registered and is being used in bad faith.

The Complainant requested that the disputed domain name be transferred to the Complainant.

##### **B. Respondent**

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

## 6. Discussion and Findings

### 6.1 Language of Proceeding

Pursuant to the Rules, paragraph 11, unless otherwise agreed by the parties, the default language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise.

In this case, while the language of the registration agreements is Chinese, the Complainant requested that English be the language of the proceeding. Considering the Center has already sent Chinese-English dual language case-related communications to the Parties, including communications regarding the language of the proceeding, and thereby given the Respondent an opportunity to comment on or to oppose the Complainant's request and arguments, and considering the Respondent's default and lack of reaction after having been given a fair chance to comment or oppose, together with the fact that the disputed domain name consists of only Latin letters instead of Chinese characters, the Panel finds it would not be unfair to proceed in English as requested by the Complainant. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1.

### 6.2 Substantive Elements

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (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

The Complainant has provided evidence that it has obtained NEW BALANCE trademark registrations in the United States, as well as in other different jurisdictions.

The disputed domain name incorporates the entirety of the NEW BALANCE trademark. As the NEW BALANCE trademark is recognizable within the disputed domain name, the disputed domain name is confusingly similar to the Complainant's NEW BALANCE trademark. The addition of the term "wichita" into the disputed domain name does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8.

The Panel therefore finds that the Complaint has satisfied paragraph 4(a)(i) of the Policy.

#### B. Rights or Legitimate Interests

Proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See [WIPO Overview 3.0](#), section 2.1.

According to the Complaint, the Respondent does not own any trademark or service mark rights in the names NEW BALANCE or NEW BALANCE WICHITA, and has not been commonly known by the disputed domain name. The Respondent does not have license, permission, or authorization from the Complainant to

use the NEW BALANCE trademark. The disputed domain name previously resolved to a website featuring gambling/betting content and currently does not resolve to an active website with any content. The Respondent has not made any demonstrable preparation to use the disputed domain name in connection with a *bona fide* offering of services.

The Respondent submitted no response or evidence to rebut the allegations of the Complainant, or to establish that the Respondent is making a *bona fide* use, or a legitimate noncommercial or fair use of the disputed domain name.

The Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests, and the Respondent failed to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Panel therefore finds that the Complaint has satisfied paragraph 4(a)(ii) of the Policy.

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

The Complainant has provided evidence that the Complainant's NEW BALANCE trademark has been registered and used for about 50 years. The Complainant's NEW BALANCE mark is highly distinctive and carries a reputation synonymous with the high quality of athletic footwear and apparel around the world.

Given the above, a simple online search could reveal that the trademark NEW BALANCE is in wide use by the Complainant. It would be inconceivable that the Respondent registered the disputed domain name without knowledge of the Complainant or the NEW BALANCE trademark at the time of the registration of the disputed domain name.

Moreover, the fact that the Respondent's contact information lists a street address comprised of random numbers and letters (*i.e.*, "2 23, 102 304 30174 asdasgf ads AE") suggests that the Respondent provided fictitious contact information. The Respondent's use of fictitious contact information is indicative of the Respondent's bad faith.

The Panel finds that the disputed domain name was registered in bad faith.

Meanwhile, as the Complainant has a genuine "New Balance Wichita" location in Wichita, Kansas, United States, the geographic term "wichita" added to the disputed domain name indicates that the Respondent is seeking to cause confusion for the Respondent's commercial benefit or has an intent to profit in some fashion from the Complainant's trademark. The Panel therefore finds that the Respondent is using the disputed domain name in bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

The Panel therefore finds that the Complaint has satisfied 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 name <newbalancewichita.com> be transferred to the Complainant.

/James Wang/  
**James Wang**  
Sole Panelist  
Date: June 23, 2023