

## **ADMINISTRATIVE PANEL DECISION**

New Balance Athletics, Inc. v. Natalia Novikova  
Case No. D2023-1830

### **1. The Parties**

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

The Respondent is Natalia Novikova, Ukraine.

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

The disputed domain name <newbalanceknoxville.com> (the “Domain Name”) is registered with Danesco Trading Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 19, 2023. On April 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 26, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 May 10, 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 May 16, 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 May 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 16, 2023.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on June 26, 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 athletic footwear and apparel company. It has numerous registrations, both in the U.S. and international for NEW BALANCE and NB trademarks, for example U.S. Reg. No. 1,053,241 NEW BALANCE registered on November 23, 1996, and No. 2690233 NEW BALANCE, registered on February 25, 2003. It has used its trademark since 1974 to identify its footwear and apparel products.

The Domain Name was registered on April 15, 2013. It has resolved to a webpage featuring numerous Pay-Per-Click ("PPC") advertisement links and also links to information about the history of NEW BALANCE, and various photos depicting genuine NEW BALANCE products affixed with the NB trademark.

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

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

The Complainant provides evidence of trademark registrations and argues that its trademark is well known. The Domain Name is confusingly similar to the Complainant's trademark. The Domain Name incorporates the Complainant's trademark in its entirety. The added geographic term "knoxville" does nothing to distinguish the Domain Name from the Complainant's trademark.

The Complainants argue that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent has not made any demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services. The Respondent had not acquired or owned any trademark or service mark rights in the names "new balance" or "new balance knoxville" and had not been commonly known by the Domain Name. The Respondent is not making a legitimate noncommercial or fair use of the Domain Name.

The Complainant argues that the Domain Name is confusingly similar to the Complainant's widely known trademark, and this creates in itself a presumption of bad faith. The Respondent has engaged in intentionally attempting to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trademark. The Respondent registered the Domain Name comprising the Complainant's trademark to freeride off of the Complainant's goodwill. The Respondent's use of a privacy proxy service to shield its true identity, is in the view of the Complainant further evidence of bad faith.

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

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

#### **6. Discussion and Findings**

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

The test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Domain Name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has established that it has rights in the trademark NEW BALANCE. The Domain Name incorporates the Complainant's trademark, with the addition of the term "knoxville". The addition of this term

does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8. For the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domain (“gTLD”) “.com”; see [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a Domain Name. While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that 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.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name.

The Respondent is not affiliated or related to the Complainant. There is no evidence that the Respondent has registered the Domain Name as a trademark or acquired trademark rights. There is no evidence of the Respondent’s 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. The Respondent’s use of the Domain Name is evidence of bad faith, see below.

Furthermore, the inclusion of the NEW BALANCE trademark in the Domain Name combined with the geographical term “knoxville”, location where the Complainant deploys its activities, carry a risk of implied affiliation, and cannot constitute fair use as it indicates the Respondent’s intention to create a risk of affiliation or association with the Complainant and its trademark.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The composition and use of the Domain Name make it probable that the Respondent was aware of the Complainant and its prior rights when the Respondent registered the Domain Name. The Respondent has failed to provide any evidence of actual or contemplated good-faith use of the Domain Name. The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s trademark. Based on the case file, the Panel cannot see any possible good faith use to which the Domain Name may be put by the Respondent.

For the reasons set out above, the Panel concludes that the Domain Name was registered and is being used in bad faith, within the meaning of paragraph 4(a)(iii) of the Policy. The third element of the Policy has been established.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders the Domain Name <newbalanceknoxville.com> be transferred to the Complainant.

*/Mathias Lilleengen/*

**Mathias Lilleengen**

Sole Panelist

Date: July 15, 2023