

ADMINISTRATIVE PANEL DECISION

Decathlon v. NGUYEN THANH AN, Free Mail
Case No. D2023-2002

1. The Parties

Complainant is Decathlon, France, represented by AARPI Scan Avocats, France.

Respondent is NGUYEN THANH AN, Free Mail, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <decathlonweb.online> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 4, 2023. On May 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 5, 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 (Free Mail) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 8, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to Complaint. Complainant filed an amended Complaint on May 9, 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 Respondent of the Complaint, and the proceedings commenced on May 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 31, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 6, 2023.

The Center appointed Gabriel F. Leonardos as the sole panelist in this matter on June 13, 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

Complainant is Decathlon, a French manufacturer and retailer of sporting and leisure goods. Complainant's business runs under the trademark DECATHLON.

Complainant owns a wide portfolio of international trademarks such as:

Registration No.	Trademark	Jurisdiction	International Class	Date of Registration
1366349	DECATHLON	France	03, 04, 05, 08, 09, 12, 13, 14, 16, 18, 20, 21, 22, 24, 25, 28, 32, 33, 35, 37, 39, 40, 42, 43, 44, 45	January 16, 1987
000262931	DECATHLON	European Union	1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42	April 28, 2004
613216	DECATHLON	International Trademark	01, 03, 04, 05, 06, 07, 08, 09, 10, 11, 12, 13, 14, 16, 17, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 35, 36, 37, 38, 39, 42	December 20, 1993

The disputed domain name was registered on December 28, 2022, and, according to the evidence submitted by Complainant, used to resolve to a page selling goods including athleisure. The disputed domain name currently resolves to a webpage without content.

5. Parties' Contentions

A. Complainant

Complainant pleads that the disputed domain name is confusingly similar to the registered trademark DECATHLON, since it fully incorporates Complainant's trademark DECATHLON.

Complainant affirms that the disputed domain name uses the trademark DECATHLON in its entirety with the addition of the term "web" – which would not avoid a confusingly similarity between the disputed domain name and Complainant. The generic Top-Level Domain ("gTLD") ".online" does not affect the similarity between the disputed domain name and trademark.

Therefore, according to Complainant, the disputed domain name is confusingly similar with Complainant's trademark DECATHLON, fulfilling paragraph 4(a)(i) of the Policy and paragraphs 3(b)(viii) and 3(b)(ix)(1) of the Rules.

In addition, Complainant states that Respondent would not have any rights or legitimate interests in respect of the disputed domain name, nor is Respondent commonly known by the disputed domain name. Further, Respondent has not been authorized, or licensed to use Complainant's trademark DECATHLON as a domain name nor is Respondent associated with Complainant.

Complainant observes that Respondent does not make a legitimate noncommercial fair use of the disputed domain name, as it is not used to promote a *bona fide* offering of goods or services, nor to support a noncommercial legitimate use.

This way, Complainant states that no legitimate use of the disputed domain name could be reasonably claimed by Respondent, thus paragraph 4(a)(ii) of the Policy and paragraph 3(b)(ix)(2) of the Rules have been fulfilled.

Finally, Complainant states that Respondent (i) was aware of the trademark DECATHLON at the time of registration; (ii) used to use the disputed domain name for commercial gain by selling competing goods; and (iii) has intentionally chosen the trademark DECATHLON to divert Complainant's authentic customers into the disputed domain name to obtain profit.

Thus, according to Complainant, the requirements for the identification of a bad faith registration and use of the disputed domain name have been fulfilled, pursuant to paragraph 4(b)(iv) of the Policy.

Accordingly, Complainant requests transfer of the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

To succeed in a UDRP complaint, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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 burden of proving these elements is upon Complainant.

Respondent had 20 days to submit a response in accordance with paragraph 5(a) of the Rules and failed to do so. Paragraph 5(f) of the Rules establishes that if a respondent does not respond to the complaint, in the absence of exceptional circumstances, the panel's decision shall be based upon the Complaint.

A. Identical or Confusingly Similar

Complainant has duly proven that it owns prior registered and unregistered rights for DECATHLON, and that the disputed domain name includes the trademark DECATHLON in its entirety with the addition of the term "web".

The addition of the term "web" does not prevent a finding of confusing similarity with Complainant's trademark DECATHLON – since the trademark DECATHLON is fully integrated, and recognizable, in the disputed domain name.

The disputed domain name consists also of the gTLD ".online". The applicable gTLD in a domain name, such as ".online" in this case, is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test (see section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Thus, the Panel finds that the disputed domain name is confusingly similar to Complainant's trademark DECATHLON, and so the requirement of the first element of paragraph 4(a) of the Policy is satisfied.

B. Rights or Legitimate Interests

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the [WIPO Overview 3.0](#) as follows: “[w]hile 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.”

In this case, noting the facts and contentions listed above, the Panel finds that Complainant has made out a *prima facie* case showing that Respondent lacks rights or legitimate interests in the disputed domain name, so the burden of production shifts to Respondent. As Respondent has not replied to Complainant’s contentions, the Panel has considered Complainant’s un rebutted *prima facie* case to be sufficient to demonstrate that Respondent has no rights or legitimate interests in the disputed domain name.

It should be noted that Respondent’s lack of response (in the broader context of the case), according to the above-mentioned guidelines from [WIPO Overview 3.0](#), section 2.1, suggests that Respondent has no rights or legitimate interests in the disputed domain name that it could put forward.

Furthermore, Respondent has not used the disputed domain name in the context of a *bona fide* offering of goods and services that could demonstrate rights or legitimate interests, since the evidence shows that the disputed domain name currently resolves to a website without content, as duly proven by Annex D4 of Complaint. The use of a confusingly similar disputed domain name to mislead unsuspecting Internet users to a website without content, cannot constitute fair use. Moreover, given the previous use of the disputed domain names resolving to a website to sell goods including running shoes by Respondent, as proven by Annex H of Complaint, the disputed domain name is inherently misleading and the term “web” can be recognized by Complainant’s customers as an identification for one of Complainant’s official website dedicated to selling its athleisure goods and it may mistakenly be seen as effectively impersonating or suggesting some connection to Complainant, and accordingly, cannot constitute fair use.

Therefore, the Panel finds that the requirement of the second element of paragraph 4(a) of the Policy is also satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of circumstances that, without limitation, shall be evidence of registration and use of a domain name in bad faith.

Respondent has registered the disputed domain name that fully incorporates Complainant’s trademark DECATHLON, plus the addition of the term “web”, which does not prevent a confusing similarity.

The Panel finds that it was duly demonstrated that Respondent was likely aware of Complainant’s rights to DECATHLON at the time of the registration, as Complainant’s trademark is widely known and enjoys an international reputation. Moreover, the previous use of the disputed domain name to sell competing sports goods (see Annex H of Complaint), affirms the likelihood of Respondent’s knowledge of Complainant’s trademark and a clear intent to take a free ride on the Complainant’s renown trademark. Accordingly, the Panel finds that Respondent has intentionally attempted to attract for commercial gain Internet users to its website by creating likelihood of confusion with Complainant’s trademark as to the source, sponsorship, affiliation or endorsement of the website.

Further, evidence (see exhibit 4D of Complaint) shows that the disputed domain name currently resolves to a website without content. Previous UDRP panels have concluded in similar cases that such non-use does

not prevent a finding of bad faith use by the passive holding doctrine. See *BPCE v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / pascale kiss, cherghi*, WIPO Case No. [D2021-1251](#) and section 3.3 of the [WIPO Overview 3.0](#).

Moreover, it should be noted that, in the circumstances, Respondent's lack of response further reinforces that the disputed domain name most likely was registered and is being used in bad faith. In this sense, the panel found in *Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Alexis Kane*, WIPO Case No. [D2021-0912](#) that:

"The following factors were also considered by the Panel as indicative of bad faith registration and use of the disputed domain name: (i) the Respondent's lack of response to the Complaint. See, *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications*, WIPO Case No. [D2001-0210](#); (ii) the Respondent's lack of response to the cease and desist letter sent by the Complainant. See, e.g. *Intesa Sanpaolo S.p.A. v. Ekkert Ida*, WIPO Case No. [D2018-2207](#); (iii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name as per paragraph 4(b) of the Policy."

In light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith. Therefore, the requirement of the third element of paragraph 4(a) of the Policy is satisfied.

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 <decathlonweb.online> be transferred to Complainant.

/Gabriel F. Leonardos/

Gabriel F. Leonardos

Sole Panelist

Date: June 27, 2023