

ADMINISTRATIVE PANEL DECISION

Reebok International Limited v. Client Care, Web Commerce
Communications Limited
Case No. D2023-2105

1. The Parties

The Complainant is Reebok International Limited, United States of America, represented by Authentic Brands Group, United States of America.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <reebok-uae.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 11, 2023. On May 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 15, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 17, 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 May 17, 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 May 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 9, 2023.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on July 6, 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 leading manufacturers of athletic footwear, apparel, and sport, exercise, and fitness equipment under the REEBOK trademark. The Complainant began using its REEBOK trademark for footwear at least as early as 1965. The Complainant expanded its use of the REEBOK trademark for apparel at least as early as 1985, and for sporting equipment as least as early as 1988. In the 1980s, the Complainant also began using the REEBOK trademark in connection with fitness instruction, and health and fitness club services.

The Complainant has a global portfolio of more than 2,000 REEBOK trademarks covering a wide variety of goods and services, including several trademarks in the United Arab Emirates, the Trademark Registration No. 146678 in international class 25 registered on May 18, 2011 being among these national registrations.

The Complainant is also the owner of the domain name <reebok.com> which resolves to the Complainant's official website.

The disputed domain name was created on July 6, 2022 and redirects and resolves to a commercial website at the separate domain name <reebokuae.com> (registered with the same Registrar in June 2022), purporting to offer for sale discounted shoes under the Complainant's REEBOK trademark.

5. Parties' Contentions

A. Complainant

Identical or Confusingly Similar

The Complainant alleges that the disputed domain name is confusingly similar to the REEBOK trademark which it contains in its entirety with the addition of the geographical term "uae". The addition of the term "uae" does not detract from the identical or confusing similarity between the disputed domain name and the Complainant's REEBOK trademark.

No rights or legitimate interests

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant claims that they it has not licensed or authorized the Respondent to register or use the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

The Complainant asserts that the Respondent has been actively using the REEBOK trademark in the disputed domain name and on the physical website to which the disputed domain name resolves to promote its website for illegitimate commercial gains, more specifically, by operating a fake REEBOK website offering counterfeit goods bearing the REEBOK trademark.

The Complainant contends that there is no evidence of any 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 any *bona fide* offering of goods or services, that the Respondent has not been commonly known by the disputed domain name, and that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

Registered and used in bad faith

The Complainant contends that the disputed domain name has been registered and is being used in bad faith.

The Complainant asserts that the Respondent knowingly chose the disputed domain name incorporating the Complainant's REEBOK trademark, long after the Complainant registered and used its REEBOK trademark.

The Complainant further claims that the Respondent used a privacy shield to mask its identity, while the use of privacy shields or similar services which mask the Respondent's identity are an indication of bad faith.

The Complainant contends the Respondent has no reason to use the REEBOK trademark in the disputed domain name other than to attract Internet users to its site for commercial gain.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

According to section 1.1.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the term "trademark or service mark" as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of [WIPO Overview 3.0](#). The Complainant submitted evidence that the REEBOK trademark enjoys protection under national trademark registrations. Thus, the Panel finds that the Complainant's rights in the REEBOK trademark have been established pursuant to the first element of the Policy.

The disputed domain name consists of the Complainant's REEBOK trademark followed by the term "uae" written through the hyphen followed by the generic Top-Level Domain ("gTLD") ".com".

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term may however bear on assessment of the second and third elements.

Under section 1.7 of the [WIPO Overview 3.0](#), while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the gTLD, see section 1.11.1 of the [WIPO Overview 3.0](#).

It is the view of the Panel that it is readily apparent that the Complainant's REEBOK trademark remains recognizable in the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the REEBOK trademark in which the Complainant has rights.

The first element of paragraph 4(a) of the Policy is therefore satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production of evidence shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Based on the Complainant's contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its REEBOK trademark. See, e.g., *Suncor Energy Inc. v. Whois Privacy Protection Service, Inc./andre bechamp*, WIPO Case No. [D2012-2123](#) (noting that, "in the absence of any license or permission from a complainant to use well-known trademarks, no actual or contemplated *bona fide* or legitimate use of the domain name could reasonably be claimed"); *SanofiAventis v. Abigail Wallace*, WIPO Case No. [D2009-0735](#) (finding that complainant had established a *prima facie* case that respondent did not have rights or legitimate interests "due to the fact that the Complainant has not licensed or otherwise permitted the Respondent to use [Complainant's] trademark.").

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

The evidence provided by the Complainant shows that the disputed domain name resolves to an active website seemingly impersonating the Complainant by featuring the Complainant's trademark, logo, and copyrighted images of the Complainant's trademarked goods. While resellers and distributors may have certain limited rights to use a complainant's trademark for nominative fair use purposes, the lack of any authorization by the Complainant and similarly, the lack of any accurate and prominent disclosure of the Respondent's relationship with the Complainant on the website at the disputed domain name, renders any fair use safe harbor inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#) and also *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Above all, the nature of the disputed domain name incorporating the Complainant's trademark and the geographical term "uae" in relation to the Complainant's trademark carries a risk of implied affiliation, especially when considering the impersonating nature of the content exhibited at the disputed domain name, and as such cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

There is no evidence to suggest that the Respondent's use of, or demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name, is in connection with a *bona*

fide offering of goods or services. The goods offered for sale on the website to which the disputed domain resolves, while clearly unauthorized by the Complainant, are suspected to be counterfeit products of the Complainant's genuine REEBOK products. Thus, the Panel may draw the inferences that the Respondent seeks to take unfair advantage of the Complainant's REEBOK trademark and reputation (see *Prada S.A. v. Chen Mingjie*, WIPO Case No. [D2015-1466](#); *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#)). Even if the goods were genuine REEBOK products, the website to which the disputed domain name resolves does not display any disclaimer of a lack of relationship between the Complainant and the Respondent, and given the composition of the disputed domain name (the mark plus a geographical term) this would not be considered a fair use.

Respectively, based on the case records the Panel can draw the inference that the Respondent's use of the disputed domain name is not in connection with the *bona fide* offering of goods and services such as to confer on the Respondent rights or legitimate interests for the purposes of the Policy. On the contrary, its use of the disputed domain name takes unfair advantage of the reputation of the Complainant's REEBOK trademark, and of the confusing similarity of the disputed domain name with the Complainant's REEBOK trademark, in order to divert Internet users seeking information about the Complainant and its goods, to the Respondent's website and the goods promoted through it. In making this finding, the Panel takes into account that if the Panel assumes that although the website to which the disputed domain name resolves has been used to sell the Complainant's original REEBOK footwear, there are other factors that affect the legitimacy of the Respondent's use, namely that the website does not accurately disclose the Respondent's relationship with the Complainant, that the website includes use of copyright protected material from the Complainant's original website without permission, that there might be the case of deceptive persuasion of the customers by the Respondent to provide their personal and financial information under the false perception that the Respondent is somehow affiliated with the Complainant, and that the combination of a trademark plus a geographic term is usually understood to not support a claim to fair use.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain names. In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain names, the Panel finds that the Complainants have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith. The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or a product or service on [respondent's] website or location".

The Complainant has been benefitting from the trademark protection for REEBOK. Moreover, the Complainant's REEBOK trademark is distinctive and enjoys a substantial reputation in the sport fashion industry. Given the worldwide fame of the Complainant and its REEBOK trademark, the fact that the disputed domain name incorporates that mark verbatim plus a geographic term, and the impersonating nature of the content of the website at the disputed domain name, it is obvious that the Respondent had actual knowledge of the Complainant and its REEBOK trademark.

Under the third element, the Complainant alleges that the Respondent is trying to pass off as the Complainant's website to sell competing and unauthorized goods.

The Panel draws the inference that the disputed domain name featuring the Complainant's REEBOK trademark and the geographic term "uae" is likely to attract visitors looking for the REEBOK products. Thus, on arriving at the Respondent's website those visitors or a sufficiently significant proportion of them are likely to believe that they have arrived at a website of or authorized by the Complainant. This impersonation of the Complainant will have been deliberate. The Respondent was clearly concerned to ensure that the visitors with whom they conducted business should think that they were dealing with the Complainant or an entity authorized by the Complainant, when they were not.

In the Panel's view, the use of the disputed domain name for such activity, clearly with a view to commercial gain, amounts to paradigm bad faith registration and use for the purposes of the Policy, paragraph 4(b)(iv).

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

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 <reebok-uae.com> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: July 26, 2023