

ADMINISTRATIVE PANEL DECISION

Skechers U.S.A., Inc. II v. Client Care, Web Commerce Communications Limited

Case No. D2023-2174

The Parties

The Complainant is Skechers U.S.A., Inc. II, United States of America (“United States”), represented by D Young & Co LLP, United Kingdom.

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

2. The Domain Name and Registrar

The disputed domain name <skecherssko-outlet.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 17, 2023. On May 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 22, 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 Domain Holder) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 23, 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 24, 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 June 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 6, 2023.

The Center appointed Halvor Manshaus as the sole panelist in this matter on August 3, 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 a member of the Skechers group of companies, operating within the lifestyle and performance footwear industry. The Skechers group's products are sold in more than 170 countries, including Denmark, and through department stores, specialty stores, athletic specialty shoe stores, independent retailers, and Internet retailers worldwide. The Skechers group was established in 1992, in California, United States.

The Complainant is the owner of several trademark for SKECHERS in several jurisdictions, including the following:

- The United States trademark registration no. 1851977, SKECHERS, registered on August 30, 1994;
- The United Kingdom trademark registration no. 2143082, SKECHERS, registered on February 20, 1998;
- The European Union trademark registration no. 002992535, SKECHERS, registered on September 29, 2004;
- The European Union trademark registration no. 004307691, SKECHERS, registered on April 12, 2006;
- The European Union trademark registration no. 007421746, SKECHERS, registered on June 16, 2009;
- The European Union trademark registration no. 008706806, SKECHERS, registered on May 4, 2010;
- The European Union trademark registration no. 008827487, SKECHERS, registered on July 13, 2010;
- The European Union trademark registration no. 014466131, SKECHERS, registered on December 10, 2015;
- The Danish trademark registration no. VR199307880, SKECHERS, registered on November 5, 1993.

The Skechers group has used the SKECHERS trademark in its marketing and on its products, and has received recognition through publications, awards and accolades.

The Complainant and its group of companies holds several domain names containing the SKECHERS trademark, among other <skechers.com> and <skechers.dk>, on which the Skechers group sells its products.

The disputed domain name was registered on June 10, 2022, and reverts to a website offering footwear under the Complainant's trademark.

5. Parties' Contentions

A. Complainant

The Complainant contends that disputed domain name is confusingly similar to the Complainant's SKECHERS trademark as it comprises of the SKECHERS trademark in its entirety. Further, the Complainant holds that the disputed domain name targets Danish customers by using the Danish word for "shoe", and that the inclusion of the generic word "outlet" does not remove the disputed domain name from the realm of confusingly similarity. Further, the Complainant argues that the generic Top-Level Domain ("gTLD") ".com" to the disputed domain name shall be disregarded as it does not avoid confusion and will merely be viewed as a standard registration requirement.

The Complainant submits that the Respondent lacks any rights or legitimate interests in respect of the disputed domain name. The Respondent is neither a licensee, authorized retailer, nor distributor of the Complainant's products. Additionally, the Complainant contends that the Respondent is not authorized to use the name or the SKECHERS trademark for any purpose and that the Respondent has no connection or affiliation with the Complainant. Furthermore, the Respondent is not commonly known by the disputed domain name and is not making use of the disputed domain name in connection with a *bona fide* offering of goods or services, nor legitimate noncommercial or fair use of the disputed domain name.

The Complainant argues that the Respondent is using the disputed domain name as pretext for commercial gain given that the disputed domain name directs to a website vending footwear under the SKECHERS mark. Moreover, the Complainant submits that the products available on the website that the disputed domain name reverts to are suspected counterfeit products as the products are significantly cheaper than those offered on the Complainant's website. Additionally, the Complainant holds that the Respondent unlawfully uses the Complainant's copyrighted material on the website thereby misleading customers into presuming that the Respondent's site is an official extension of the Complainant's, displaying products originating from the Complainant.

The Complainant argues that the Respondent registered and is using the disputed domain name is bad faith. Firstly, the Complainant submits that the Respondent knowingly registered the disputed domain name confusingly similar to the SKECHERS trademark to exploit the familiarity customers have with the Complainant's trademark by offering products that falsely claim to be associated with the Complainant. The Complaint further argues that the registration of the Complainant's trademarks predates the registration of the disputed domain name indicating that the Respondent knew of the Complainant's rights to the trademark. Lastly the Complainant contends that the mark SKECHERS is unique and arbitrary and that it is unlikely that the Respondent devised the term on its own.

B. Respondent

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

6. Discussion and Findings

The Complainant has, in accordance with paragraph 4(a) of the Policy, requested that the disputed domain name be transferred to the Complainant.

In accordance with paragraph 4(a) of the Policy, in order to succeed in this proceeding and have the disputed domain name transferred, the Complainant must establish that the three following elements are satisfied for the disputed domain name:

(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.

Pursuant to paragraph 15 (a) of the Rules, the Panel shall decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable. Furthermore, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

On the basis of the evidence submitted by the Complainant and, in particular, with regards to the content of the relevant provisions of the Policy (paragraph 4(a), (b), and (c)), the Panel concludes as follows:

A. Identical or Confusingly Similar

Under the first element of paragraph 4 (a) of the Policy, the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The disputed domain name comprises of the Complainant's trademark in its entirety, with the inclusion of the word "sko", a hyphen, and the term "outlet". The gTLD ".com" is not taken into consideration when assessing the similarity between a disputed domain name and a complainant's trademark.

Despite the presence of the hyphen and the terms "sko" and "outlet," the Panel finds that the confusing similarity between the disputed domain name and the Complainant's trademark remains unaffected.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks in which the Complainant has rights. The Panel therefore concludes that the requirements under paragraph 4(a) of the Policy have been satisfied.

B. Rights or Legitimate Interests

For the Complainant to prevail under paragraph 4(a)(ii) of the Policy, the Complainant is required to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. If such a *prima facie* case is established by the Complainant, the burden of presenting evidence shifts to the Respondent. This principle is outlined in section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0").

From the Panel's perspective, the evidence provided by the Complainant suffices to construct a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Panel has not been presented with, or discovered, any evidence that i) the Respondent has received a license or other permission to use the Complainant's trademark or any domain name incorporating this mark; (ii) the Respondent is commonly known by the disputed domain name; (iii) the Respondent has acquired trademark rights to use the disputed domain name; or (iv) the Respondent is making legitimate noncommercial or fair use of the disputed domain name.

The Panel notes the nature of the disputed domain name, that the website hosted on the disputed domain name employs the Complainant's trademark and that the Respondent offers the same goods as the Complainant on the website, resulting in a misleading impression of affiliation with the Complainant.

The Panel concludes that the Complainant has satisfied the requirements in paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

For the Complainant to prevail under the third element of paragraph 4(a) of the Policy, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith. Given that the Complainant's trademark registration predates the registration of the disputed domain name and the fact that the disputed domain name incorporates the complete SKECHERS trademark, the Panel finds it unlikely that the Respondent was unaware of the Complainant's trademark registrations.

The Panel finds that the website hosted on the disputed domain name is evidently designed to draw in Internet users for the purpose of financial gain, as the website provides similar products to those of the Complainant while also incorporating the Complainant's trademark. Consequently, the Respondent's actions give rise to a misleading belief that the website is linked to the Complainant. When coupled with the absence of a response filed by the Respondent in these proceedings, the Panel concludes that the Complainant has effectively demonstrated that the Respondent both registered and uses the disputed domain name in bad faith.

The Panel therefore concludes that the Complainant has satisfied the requirements of paragraph 4(b) 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, <skecherssko-outlet.com>, be transferred to the Complainant.

/Halvor Manshaus/

Halvor Manshaus

Sole Panelist

Date: August 17, 2023