

## **ADMINISTRATIVE PANEL DECISION**

### **Skechers U.S.A., Inc. II v. Werner Petra**

### **Case No. D2023-2260**

#### **1. 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 Werner Petra, Germany.

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

The disputed domain name <skechersudsalg.com> is registered with NETIM SARL (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 24, 2023. On May 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 26, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 26, 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 30, 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 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 22, 2023.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on June 27, 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, a global operating group in the lifestyle and performance footwear industry founded in 1992 in Manhattan Beach. SKECHERS footwear products are sold in more than 170 countries and territories around the world. SKECHERS products are available through SKECHERS retail stores, its online-websites, department stores, specialty stores, athletic specialty shoe stores, independent retailers, and Internet retailers worldwide.

The Complainant is the owner of several trademarks for SKECHERS (“SKECHERS trademark”), including:

- United States Trademark Registration SKECHERS No. 1851977, registered on August 30, 1994;
- United Kingdom Trademark Registration SKECHERS No. 1523265, registered on May 27, 1997;
- European Union Trade Mark Registration SKECHERS No. 002992535, registered on September 29, 2004;
- European Union Trade Mark Registration SKECHERS No. 004307691, registered on April 12, 2006;
- European Union Trade Mark Registration SKECHERS No. 007421746, registered on June 16, 2009;
- European Union Trade Mark Registration SKECHERS No. 008706806, registered on May 4, 2010;
- European Union Trade Mark Registration SKECHERS No. 008827487, registered on July 13, 2010;
- European Union Trade Mark Registration SKECHERS No. 014466131, registered on December 10, 2015; and
- Danish Trademark Registration SKECHERS No. VR199307880, registered on February 8, 1994.

The Complainant is also the owner of numerous domain names including the SKECHERS trademark, such as the domain name <skechers.com>, <skechers.dk>, or <skechers.de>.

The disputed domain name was registered on February 15, 2022. The Complainant has provided evidence showing that the disputed domain name resolved to a website under which the SKECHERS trademark is displayed and footwear is offered. At the time of the decision, the disputed domain name resolves to an inactive website.

#### **5. Parties’ Contentions**

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

On the first element of the Policy, the Complainant claims that the disputed domain name is confusingly similar to the SKECHERS trademark. The disputed domain name includes the entire SKECHERS trademark, with only the addition of the word “udsalg”, which means “sale” in Danish, and the generic Top-Level Domain (“gTLD”) “.com”. The SKECHERS trademark remains recognizable in the disputed domain name and the addition of the descriptive word “udsalg” (“sale” in Danish) does not prevent a finding of confusing similarity.

On the second element of the Policy, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not a licensee, authorized retailer, or distributor of SKECHERS’ products. Nor is the Respondent otherwise authorized to use the name or the SKECHERS trademark for any purpose, and has no connection or affiliation with the Complainant. Upon information and belief, the Respondent is not commonly known by the disputed domain name. There

is no evidence in the record to suggest that the Respondent was commonly known by the disputed domain name. Further, the Respondent is not making use of the disputed domain name in connection with a *bona fide* offering of goods/services or legitimate noncommercial or fair use of the disputed domain name, since the disputed domain name reverts to the website, which offers for sale footwear under the SKECHERS trademark. In addition, the Respondent uses the SKECHERS trademark on its website to sell suspected counterfeit SKECHERS products that compete directly with SKECHERS' business. The Complainant suspects that these are counterfeit products on the basis that shoes sold on the Respondent's website are significantly cheaper than those sold through the Complainant's website.

On the third element of the Policy, the Complainant asserts that the Respondent registered and used the disputed domain name in bad faith. The nature of the Respondent's registration of the disputed domain name evidences bad faith. Upon information and belief, the Respondent knowingly registered the disputed domain name containing a confusingly similar reproduction of the well-known SKECHERS trademark to capitalize on consumer recognition of the SKECHERS trademark. The Complainant is engaged in the business of designing, developing, and marketing footwear and apparel products. The Respondent has chosen to register an identical reproduction of the SKECHERS trademark in the gTLD ".com", is using it in connection with a website that is selling products falsely claiming to be associated with the Complainant, is making unauthorized use of SKECHERS promotional materials, and gives the misleading impression that it is an official SKECHERS website. All of this indicates that the Respondent has actual knowledge of the Complainant and is using the disputed domain name in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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".

It has been a consensus view in previous UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely 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, under the first requirement of paragraph 4(a)(i) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trademark or a service mark in which it has rights.

The Complainant is registered as the owner of several trademarks containing SKECHERS. Suitable

evidence was submitted. Consequently, the Panel finds that the Complainant has proven that it has rights in the SKECHERS trademark.

The disputed domain name contains the SKECHERS trademark entirely with the addition of the term “udsalg”, which means “sale” in Danish, as well as the gTLD “.com”. Section 1.8 of [WIPO Overview 3.0](#) states: “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(s) may however bear on assessment of the second and third elements.” Further, section 1.11.1 of [WIPO Overview 3.0](#) states: “The applicable TLD in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test”. The gTLD “.com” will therefore be disregarded in the Panel’s consideration of confusing similarity.

The Panel finds that the relevant SKECHERS trademark within the disputed domain name is recognizable, so that the term “udsalg” does not prevent a finding of confusing similarity.

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

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

The second element the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Regarding the second element of the Policy, section 2.1 of [WIPO Overview 3.0](#) states, “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, the Respondent did not reply to the Complainant’s contentions.

According to the Complaint, the Complainant has not authorized the Respondent to use the SKECHERS trademark, the Respondent is not commonly known by the disputed domain name, and the Respondent has not used the disputed domain name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Further, the Respondent has not attempted to justify why the disputed domain name was registered. In addition, the Complainant suspects that the Respondent sells counterfeit products on the basis that shoes sold on the Respondent’s website are significantly cheaper than those sold through the Complainant’s website. While this circumstantial evidence, tends to suggest the Respondent is offering counterfeit products, the Panel need not come to a final determination on this matter.

In any event, the Panel finds that the composition of the disputed domain name, adding the term “udsalg”, which means “sale” in Danish, to the SKECHERS trademark, coupled with the use of the disputed domain name, under which the SKECHERS trademark is displayed and footwear is offered, affirms the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the disputed domain name and the Complainant, as to the origin or affiliation of the website at the disputed domain name.

Accordingly, the Panel finds that the Complainant has made a *prima facie* showing of the Respondent’s lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent. The Panel therefore finds that the Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

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

The third element of paragraph 4(a) of the Policy requires that the Complainant demonstrates that the

Respondent registered and is using the disputed domain name in bad faith. Section 3.1 of [WIPO Overview 3.0](#) states, “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”. Section 3.2.2 of the [WIPO Overview 3.0](#) reads: “Noting the near instantaneous and global reach of the Internet and search engines and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.”

Considering the reputation and public presence of the Complainant, it is unlikely that the Respondent had no knowledge of the SKECHERS trademark. The incorporation of the SKECHERS trademark within the disputed domain name as well as the fact that the disputed domain resolved to a website, under which the SKECHERS trademark is displayed and footwear is offered, demonstrates the Respondent’s actual awareness of and intent to target the Complainant. In light of the lack of any rights to or legitimate interests in the disputed domain name by the Respondent and in the absence of any conceivable good faith use, the Panel finds from the present circumstances that the Respondent has intentionally attempted to attract Internet users to its website or affect the commercial activities of the Complainant by creating a likelihood of confusion with the Complainant’s trademarks.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 <skechersudsalg.com> be transferred to the Complainant.

*/Christian Gassauer-Fleissner/*

**Christian Gassauer-Fleissner**

Sole Panelist

Date: July 11, 2023