

ADMINISTRATIVE PANEL DECISION

Decathlon v. John English
Case No. D2023-2933

1. The Parties

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

The Respondent is John English, Philippines.

2. The Domain Name and Registrar

The disputed domain name <promodecathlon.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 9, 2023. On July 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 FOR PRIVACY) and contact information in the Complaint.

The Center sent an email communication to the Complainant on July 11, 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 July 12, 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 July 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 3, 2023.

The Center appointed Theda König Horowicz as the sole panelist in this matter on August 9, 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 French company specialized in the conception and retailing of sporting and leisure goods.

The Complainant has been registered before the Trade and Companies Register of Lille, France on November 16, 1984.

The Complainant has registered the following trademarks which have been duly renewed (thereafter the "DECATHLON trademarks"):

- The French trademark DECATHLON, No. 1366349, registered on April 22, 1986 registered for products and services in classes 3; 4; 5; 8; 9; 12; 13; 14; 16; 18; 20; 21; 22; 24; 25; 28; 32; 33; 35; 37; 39; 40; 42; 43; 44 and 45;
- The international trademark DECATHLON, No. 613216, registered on December 20, 1993 registered for products and services in classes 1; 3; 4; 5; 6; 7; 8; 9; 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 and 42;
- The European Trademark DECATHLON, No. 302265, filed on May 6, 1996 registered on January 22, 2003, for products and services in classes 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 and 42.

Additionally, the Complainant registered several domain names including its name and trademark, including:

- <decathlon.fr> registered since June 30, 1995;
- <decathlon.com> registered since May 31, 1995;
- <decathlon.eu> registered since March 9, 2006.

The disputed domain name was registered on March 16, 2023 and is inactive.

5. Parties' Contentions

A. Complainant

The Complainant alleges that the disputed domain name is confusingly similar to the registered and well-known trademark DECATHLON. Indeed, the disputed domain name uses the trademark DECATHLON in its entirety. The addition of the term "promo" does not avoid a confusing similarity between the disputed domain name and the Complainant's trademark and domain names.

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

The Complainant states that its trademarks and domain names comprising DECATHLON were registered and used prior to the registration of the disputed domain name. Moreover, the mere absence of right or legitimate interest of the Respondent points out that the disputed domain name has not been registered in good faith. Furthermore, the disputed domain name is inactive. The non-use of a domain name does not prevent the conclusion that the Respondent is acting in bad faith under the doctrine of the passive holding. In the light of these circumstances, the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following:

- (i) that the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) that the domain name has been registered and is being used in bad faith.

Paragraph 4(a) of the Policy states that the burden of proving that all these elements are present lies with the Complainant. At the same time, 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.

A. Identical or Confusingly Similar

The Complainant has shown to have obtained trademark rights in DECATHLON in France and in several other countries.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. 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.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark DECATHLON since it contains this mark in entirety. The addition of the term "promo" at the beginning of the disputed domain name does not prevent a finding of confusing similarity as the relevant trademark remains clearly recognizable within the disputed domain name. See section 1.8 of the [WIPO Overview 3.0](#).

The generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement, and as such is typically disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

The Panel therefore finds that the conditions in paragraph 4(a)(i) of the Policy are fulfilled in relation to the disputed domain name.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services; or

- (ii) being commonly known by the domain name; or
- (iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made sufficient statements in order to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name.

In particular, the Complainant has not licensed or otherwise permitted the Respondent to use its trademarks. There is no evidence showing that the Respondent would be commonly known by the disputed domain name or that a legitimate business would be run by the Respondent under the disputed domain name.

The Panel therefore finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and the burden of production shifts to the Respondent who has chosen not to reply.

The Respondent has not rebutted the Complainant's *prima facie* case, and there is no evidence of the types of circumstances set out in paragraph 4(c) of the Policy that might give rise to rights or legitimate interests in the disputed domain name on the part of the Respondent in these proceedings.

As already stated before, nothing is contained in the case file which would show that the disputed domain name has been legitimately noncommercial or fairly used by the Respondent or that the Respondent would have any rights or legitimate interests in the disputed domain name.

Furthermore, the nature of the disputed domain name, incorporating the Complainant's DECATHLON trademark in its entirety with the mere addition of the term "promo" carries a risk of implied affiliation.

The Panel therefore finds that the conditions in paragraph 4(a)(ii) of the Policy are fulfilled in relation to the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the complainant to prove both registration and use of the domain name in bad faith. Paragraph 4(b) of the Policy provides examples of circumstances which shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the holder's respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the holder's respondent's website or location or of a product or service on the holder's respondent's website or location.

Accordingly, for the Complainant to succeed, the Panel must be satisfied that the disputed domain name was registered and is being used in bad faith.

Given the circumstances of the case, including the fact that the disputed domain name identically reproduces the Complainant's DECATHLON trademark, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant's trademark and business which has acquired a high level of notoriety since its creation and which is widely promoted worldwide through the Complainant's official website <decathlon.com>.

Having reviewed the case file, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

The Respondent has not contested the allegations made by the Complainant and his silence in these proceedings is an additional evidence of bad faith in these circumstances. The Panel finds that the disputed domain name was registered and used in bad faith.

The Panel therefore finds that the conditions in paragraph 4(a)(iii) of the Policy is fulfilled in relation to the disputed domain name.

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 <promodecathlon.com> be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: August 23, 2023