

## ADMINISTRATIVE PANEL DECISION

On AG and On Clouds GmbH v. Qiu Xiaofeng; BAUER Ines; Kathy Metoyer; Ben Harrison; Milene Rafia Faridi; MarkoFreud; Harvir Besal; Client Care, Web Commerce Communications Limited; Kim Mineo; and Jan Weissmuller  
Case No. D2023-3454

### 1. The Parties

The Complainants are On AG and On Clouds GmbH, Switzerland, represented by Rentsch Partner AG, Switzerland.

The Respondents are Qiu Xiaofeng, China; BAUER Ines, Germany; Kathy Metoyer, United States of America (“United States”); Ben Harrison, United States; Milene Rafia Faridi, United States; MarkoFreud, Germany; Harvir Besal, Canada; Client Care, Web Commerce Communications Limited, Malaysia; Kim Mineo, United States; and Jan Weissmuller, Germany.

### 2. The Domain Names and Registrars

The disputed domain names <oncloudmonstergreece.com>, <oncloudmonsterjapan.com>, <oncloudmonstermalaysia.com>, <oncloudmonstersingapore.com>, <oncloudmonstersouthafrica.com>, <oncloudmonstersverige.com>, <oncloudmonsteruae.com>, <oncloudshoesdubaimall.com>, <oncloudshoesmelbourne.com>, <oncloudshoesnzoutlet.com>, <oncloudshoesoutletuk.com>, and <scarpeonrunning.com> are registered with Alibaba.com Singapore E-Commerce Private Limited.

The disputed domain names <onrunningaustralia.com>, <onrunningcanada.com>, <onrunningcloudportugal.com>, <onrunningcloudsuomi.com>, <onrunningcloudturkiye.com>, <onrunningkuwait.com><sup>1</sup>, <onrunningnorway.com>, <onrunningtilbud.com>, <onrunningtrainersireland.com>, and <tenisonrunningmexico.com> are registered with Paknic (Private) Limited.

The disputed domain name <oncloudmonsterturkiye.com> is registered with Key-Systems GmbH.

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<sup>1</sup> On September 5, 2023, the Center informed the Parties about the expiration of some of the disputed domain names. Subsequently to discussions between the Complainant and the Registrar Paknic (Private) Limited, the disputed domain name <onrunningkuwait.com> was not renewed by the Parties, and consequently was deleted by the Registrar Paknic (Private) Limited after the domain expiration date. The disputed domain name is now registered with another Registrar PDXPrivateNames.com LLC, and is no longer part of this proceeding.

The disputed domain name <onrunnersuomi.com> is registered with NETIM SARL.

(Alibaba.com Singapore E-Commerce Private Limited, Paknic (Private) Limited, Key-Systems GmbH, and NETIM SARL are hereinafter referred to as the “Registrar”)

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 10, 2023. On August 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 16, August 18, and August 24, 2023, respectively, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondents (Redacted/ Whols Agent, Web Domains By Proxy) and contact information in the Complaint.

The Center sent an email communication to the Complainant on August 24, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed an amended Complaint on August 29, 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”).

On September 5, 2023, the Center informed the Parties about the expiration of the disputed domain names <onrunningtilbud.com>, <onrunningcloudportugal.com>, <onrunningcloudsuomi.com>, <tenisonrunningmexico.com>, <onrunningnorway.com>, <onrunningcloudturkiye.com>, <onrunningaustralia.com>, <onrunningkuwait.com>, <onrunningcanada.com>, and <onrunningtrainersireland.com>. Subsequently to discussions between the Complainant and the Registrar Paknic (Private) Limited, the Registrar confirmed on November 2, 2023, the renewal of all the disputed domain names except for the disputed domain name <onrunningkuwait.com> which was not renewed by the Parties and consequently, was deleted after the expiration date by the Registrar Paknic (Private) Limited.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondents of the Complaint, and the proceedings commenced on September 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 24, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on October 2, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on October 12, 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 Complainants exploit the high-end sports apparel and shoes, in particular running shoes, which are sold in over 50 countries as well as through the Complainants’ online shop available at <on-running.com> and promoted by various sports celebrities such as Roger Federer (who became an investor in the Complainants) and Dwayne “The Rock” Johnson, also having the Complainants’ become an “official partner” of the Swiss Olympic team.

The Complainant On Clouds GmbH is the owner, amongst several others, of the following trademark registrations:

- International trademark registration No. 1050016 for the mark ON, registered on April 21, 2010, subsequently renewed, covering products in classes 25 and 28;
- International trademark registration No. 1185372 for the mark ON RUNNING, registered on October 25, 2013, covering products in classes 25 and 28;
- International trademark registration No. 1361124 for the mark CLOUD, registered on November 11, 2022, covering products in classes 25 and 28;
- International trademark registration No. 1640069 for the mark ON CLOUD, registered on November 17, 2021, covering products in class 25;
- International trademark registration No. 1690468 for the mark ON CLOUD SHOES, registered on August 19, 2022, covering products in class 25;
- International trademark registration No. 1690464 for the mark ON SHOES, registered on August 19, 2022, covering products in class 25;
- International trademark registration No. 1690465 for the mark CLOUD SHOES, registered on August 19, 2022, covering products in class 25; and
- International trademark registration No. 1647337 for the mark CLOUDMONSTER, registered on October 5, 2021, covering products in class 25.

The disputed domain names were registered on and are presently used in connection with:

<b>Disputed Domain Name</b>	<b>Registration Date</b>	<b>Present Use</b>
<oncloudmonstergreece.com>	August 9, 2022	No active webpage.
<oncloudmonsterjapan.com>	August 9, 2022	No active webpage.
<oncloudmonstermalaysia.com>	August 8, 2022	No active webpage.
<oncloudmonstersingapore.com>	August 8, 2022	No active webpage.
<oncloudmonstersouthafrica.com>	August 8, 2022	No active webpage.
<oncloudmonstersverige.com>	August 9, 2022	No active webpage.
<oncloudmonsterturkiye.com>	August 9, 2022	Online shop reproducing the Complainant's mark and products.
<oncloudmonsteruae.com>	August 8, 2022	No active webpage.
<oncloudshoesdubaimall.com>	May 10, 2023	No active webpage.
<oncloudshoesmelbourne.com>	August 8, 2022	No active webpage.
<oncloudshoesnzoutlet.com>	August 8, 2022	No active webpage.
<oncloudshoesoutletuk.com>	August 8, 2022	No active webpage.
<onrunnersuomi.com>	March 17, 2022	No active webpage.
<onrunningaustralia.com>	August 23, 2022	Fraud alert is displayed when attempting to access the website.
<onrunningcanada.com>	August 23, 2022	No active webpage.
<onrunningcloudportugal.com>	August 20, 2022	No active webpage.
<onrunningcloudsuomi.com>	August 20, 2022	No active webpage.
<onrunningcloudturkiye.com>	August 20, 2022	No active webpage.
<onrunningkuwait.com>	August 23, 2022	Fraud alert is displayed when attempting to access the website.
<onrunningnorway.com>	August 20, 2022	No active webpage.
<onrunningtilbud.com>	August 20, 2022	Online shop reproducing the Complainant's mark and products.
<onrunningtrainersireland.com>	August 23, 2022	No active webpage.
<scarpeonrunning.com>	August 29, 2022	No active webpage.
<tenisonrunningmexico.com>	August 20, 2022	No active webpage.

In the past, the disputed domain names were used in connection to online shops depicting the Complainants' trademarks and what appear to be counterfeit products.

## **5. Parties' Contentions**

### **A. Complainants**

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainants contend that the disputed domain names are subject to common control and the consolidation of multiple Respondents would be fair and equitable to all Parties given that the websites that used to be available at the disputed domain names were essentially identical purportedly selling counterfeit products.

According to the Complainants, the disputed domain names that consist merely of the Complainants' trademarks and the addition of geographic or descriptive terms ("greece", "japan", "malaysia", "singapore", "southafrica", "sverige", "turkiye", "uae", "dubai", "mall", "melbourne", "nz", "outlet", "uk", "suomi", "australia", "canada", "portugal", "kuwait", "norway", "tilbud", "trainers", "ireland", "scarpe", "tenis", and "mexico") which are closely linked and associated to the Complainants' trademarks and only serve to increase the confusing similarity between the disputed domain names and the Complainants' trademarks given the use made of the disputed domain names in connection with online shops depicting the Complainants' trademarks and purportedly offering counterfeit products, suggesting the Respondents' intention to cause consumer confusion.

As to the absence of rights or legitimate interests, the Complainants argue that the Respondents do not have any *bona fide* interest on the disputed domain names in view of the Complainants' well known trademarks.

In what it relates to the bad faith registration and use of the disputed domain names, the Complainants assert that the Respondents' knowledge of the Complainants' trademarks is evident given the reproduction of their logotype and products in the online shops that were available at the disputed domain names purportedly offering counterfeit products, making it only possible to conclude that the Respondents knew about the Complainants' trademark and reputation, and used them to their advantage in bad faith.

### **B. Respondents**

The Respondents did not reply to the Complainants' contentions.

## **6. Discussion and Findings**

### **6.1 Procedural matter - Consolidation of Multiple Respondents**

The Complaint was filed in relation to nominally different domain name registrants. The Complainants allege that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainants request the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainants' request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainants' request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Panel notes that: (i) the disputed domain names share a similar domain name pattern comprising of reproduction of one of the Complainants' trademarks and the addition of geographic and/or terms; (ii) the disputed domain names were used in connection to online shops presenting the Complainant's copyright-protected official product images and marketing materials depicting the Complainants' trademarks and what appear to be counterfeit products; and (iii) 22 of the 23 disputed domain names were registered within a few days interval (*i.e.*, August 8, 2022 - August 29, 2022).

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants in a single proceeding.

## **6.2 Substantive matter**

Paragraph 4(a) of the Policy sets forth the following three requirements which the Complainant must meet in order for the Panel to order the transfer of the disputed domain names:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (ii) the Respondents have no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain names. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms ("greece", "japan", "malaysia", "singapore", "southafrica", "sverige", "turkiye", "uae", "dubai", "mall", "melbourne", "nz", "outlet", "uk", "suomi", "australia", "canada", "portugal", "kuwait", "norway", "tilbud", "trainers", "ireland", "scarpe", "tenis", and "mexico") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which a respondent may demonstrate rights or legitimate interests in a disputed domain name.

While 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. [WIPO Overview 3.0](#), section 2.1.

Paragraph 4(c) of the Policy provides a nonexclusive list of circumstances that may indicate the Respondents’ rights to or legitimate interests in the disputed domain names. These circumstances are:

- (i) before any notice of the dispute, the Respondents’ use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondents (as individuals, businesses, or other organizations) have been commonly known by the disputed domain names, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondents are making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondents, in not responding to the Complaint, have failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to or legitimate interests in the disputed domain names. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainants to make a *prima facie* case against the Respondents.

In that sense, the Panel notes that the Complainants have made out a *prima facie* case that the Respondents lack rights or legitimate interests in the disputed domain names. Also, the lack of evidence as to whether the Respondents are commonly known by the disputed domain names or the absence of any trademarks registered by the Respondents corresponding to the disputed domain names, corroborates the indication of an absence of rights or legitimate interests in the disputed domain names.

The use made of the disputed domain names cannot be characterized as a *bona fide* offering of goods or services, given that the Respondents’ websites prominently featured the Complainants’ trademarks in connection with what appear to be counterfeit products without any explanation of the lack of relationship between the Respondents and the Complainants, which increases the likelihood of confusion amongst Internet users who might think that the disputed domain names are owned, related, or otherwise endorsed by the Complainants, which is not true.

Therefore, the Panel finds that the Respondents lack rights or legitimate interests in the disputed domain names. The second element of the Policy has also been met.

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

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other online location, by creating a likelihood of confusion with a complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, the use of the disputed domain names in connection with websites that reproduce the Complainants' trademarks, logo, and characteristics, purportedly offering what appear to be counterfeit products characterizes the Respondents' intent of commercial gain by profiting from the Complainants' trademarks.

Other indications of the Respondent's bad faith lie in the indication of what appear to be false contact details, not having the Center been able to deliver the written notice to the Respondents and the pattern of the Respondents targeting the Complainants' trademarks (noting the registration of confusingly similar disputed domain names in the present dispute).

Considering the totality of the circumstances in case, the Panel finds the present inactive use of some of the disputed domain names does not prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.3.

For the reasons above, the Panel finds that the Respondents have registered and used the disputed domain names in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

## 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 names <oncloudmonstergreece.com>, <oncloudmonsterjapan.com>, <oncloudmonstermalaysia.com>, <oncloudmonstersingapore.com>, <oncloudmonstersouthafrica.com>, <oncloudmonstersverige.com>, <oncloudmonsterturkiye.com>, <oncloudmonsteruae.com>, <oncloudshoesdubaimall.com>, <oncloudshoesmelbourne.com>, <oncloudshoesnzoutlet.com>, <oncloudshoesoutletuk.com>, <onrunnersuomi.com>, <onrunningaustralia.com>, <onrunningcanada.com>, <onrunningcloudportugal.com>, <onrunningcloudsuomi.com>, <onrunningcloudturkiye.com>, <onrunningnorway.com>, <onrunningtilbud.com>, <onrunningtrainersireland.com>, <scarpeonrunning.com>, and <tenisonrunningmexico.com> be transferred to the Complainants.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: October 26, 2023