

## **ADMINISTRATIVE PANEL DECISION**

Decathlon v. ico zure, ico zure  
Case No. D2024-0001

### **1. The Parties**

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

The Respondent is ico zure, ico zure, Grenada.

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

The disputed domain name <decathlonag2r.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 2, 2024. On January 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 2, 2024, 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 (Contact Privacy Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 3, 2024, 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 January 4, 2024.

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 January 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 29, 2024. The Respondent sent email communications to the Center and the Complainant on January 9 and January 12, 2024, indicating its willingness to explore settlement with the Complainant by offering to sell the disputed domain name to the Complainant. The Center sent a possible settlement email on January 11, 2024, and the Complainant indicated that it would accept an amicable solution if the Respondent would transfer the disputed domain name for free to the Complainant on January 12, 2024. On January 31, 2024, the Center informed the Parties that it would proceed with panel appointment.

The Center appointed Antony Gold as the sole panelist in this matter on February 5, 2024. 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-based manufacturer and retailer which specializes in the design and sale of sporting and leisure goods. The Complainant was established in July 1976 and now has 105,000 employees and 1,747 stores worldwide, with annual sales of EUR 11.4 billion.

The Complainant's principal brand is DECATHLON and it owns many trade marks in multiple jurisdictions to protect this trading style. These include, by way of example, European Union Trade Mark, registration number 000262931, registered in multiple classes on April 28, 2004. The Complainant also owns many domain names which comprise or include its DECATHLON mark, including <decathlon.com> and <decathlon.fr>, which resolve to websites providing information about its goods and services. The Complainant has recently entered into a partnership with a French insurance company, AG2R La Mondiale ("AG2R"), for the joint sponsorship of a cycling team.

The disputed domain name was registered on November 27, 2023. It has previously resolved to a website which purported to be an official website of the Complainant's and AG2R's cycling team. The home page of the website opened with the claim; "The Decathlon AG2R Team is a new force in professional cycling, blending Decathlon's innovation with AG2R's experience". The disputed domain name presently resolves to a blank web page.

Following the commencement of these proceedings, on January 9, 2024, the Respondent sent an email to the Center and the Complainant stating that it wished to "engage in an amicable discussion about this matter" and explaining that "I would like to propose a possible sale of the domain to your organization. I am open to negotiations and would welcome any proposals you may have in this regard". The Complainant responded on January 12, 2024, indicating that it required the transfer to it of the disputed domain name free of charge. On the same day the Respondent replied stating; "Regarding your request for a free transfer of the domain, I believe a sale is a more appropriate course of action. [...] The domain has garnered significant attention and, as such, possesses a market value that cannot be overlooked. In the digital age, domain names can be substantial assets, and their transfer, especially in cases involving notable names, often involves financial consideration". The Complainant did not respond to the Respondent's email.

#### **5. Parties' Contentions**

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Notably, the Complainant contends that:

- the disputed domain name is confusingly similar to a trade mark in which it has rights in that it identically reproduces its DECATHLON mark and adds the term "ag2r", being the name of the company with whom the Complainant has recently partnered for its cycling team;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not, and has never been, known by the name "decathlonag2r". The Complainant has no business relationship with the Respondent and the Complainant has never licensed, authorized or otherwise permitted the Respondent to register a domain name incorporating its trade marks, nor to make any use of them. Moreover, the Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services;

- the disputed domain name was registered and is being used in bad faith. Given the repute of the Complainant's DECATHLON mark, it is highly likely that the Respondent was aware of it as at the date of registration of the disputed domain name and that it was thereby registered in bad faith. The disputed domain name is also being used in bad faith in that it has resolved to a website which bears the Complainant's mark and purports to be an official DECATHLON/AG2R website.

## **B. Respondent**

The Respondent did not submit a formal response to the Complaint, but sent email communications as set out above and discussed further below.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements in order to succeed in its Complaint:

(i) the disputed domain name is identical or confusingly similar to a trade mark 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**

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 trade mark and the disputed domain name; see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of its DECATHLON trade mark for the purposes of the Policy; see [WIPO Overview 3.0](#), section 1.2.1. As a technical requirement of registration, the generic Top-Level Domain ("gTLD"), that is ".com" in the case of the disputed domain name, is usually disregarded when assessing confusing similarity. As explained at section 1.7: "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". The Complainant's DECATHLON mark is reproduced in its entirety within the disputed domain name and is recognizable within it. The additional characters in the disputed domain name, namely "ag2r", do not prevent it from being found confusingly similar to the Complainant's mark for the purposes of the Policy; see [WIPO Overview 3.0](#), section 1.8.

For the above reasons, based on the available record, the Panel finds that 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 by which a respondent may demonstrate rights or legitimate interests in a domain name. Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element; see [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. Its response to the Complaint has been solely to attempt to sell the disputed domain name to the Complainant. The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; see paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2. The only use made by the Respondent of the disputed domain name has been to resolve to a website which purports to be an official website of the Complainant and AG2R. Previous UDRP panels have held that the use of a domain name for illegal activity, including phishing, distributing malware, impersonation/passing off, or other types of fraud, which would include the Respondent's use of the disputed domain name, as described above, can never confer rights or legitimate interests on a respondent; see section 2.13.1 of the [WIPO Overview 3.0](#).

Finally, the present use of the disputed domain name, namely, to resolve to a blank page, self-evidently does not comprise use in connection with a bona fide offering of goods and services;

- there is no evidence in the record that the Respondent has been commonly known by the disputed domain name; see paragraph 4(c)(ii) of the Policy and [WIPO Overview 3.0](#), section 2.3;

- the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue; see paragraph 4(c)(iii) of the Policy and [WIPO Overview 3.0](#), section 2.4;

- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name.

For the above reasons, based on the available record, the Panel finds the second element of the Policy has been established.

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

The record shows that, within a few weeks after the Respondent's registration of the disputed domain name in November 2023, it resolved to a website which masqueraded as that of the Complainant and the co-operator of its cycling team, AG2R. This establishes both an awareness by the Respondent of the Complainant's DECATHLON mark as at the date of registration of the disputed domain name and an intention on its part to take unfair advantage of it. It is well-established under the Policy that registration of a domain name by an unconnected party with knowledge of a complainant's trade mark registration and where the domain name is put to a misleading use establishes bad faith; see, for example, *The Frankie Shop LLC v. xi bing*, WIPO Case No. [D2023-3311](#). The Respondent's registration of the disputed domain name is accordingly in bad faith.

Paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by a panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The circumstance set out in paragraph 4(b)(iv) of the Policy is if a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. The use to which the Respondent has put the disputed domain name falls within this circumstance in that the content of its website will have misled

Internet users into believing that it was operated by the Complainant and AG2R. Such a belief will have been reinforced because of the confusing similarity between the disputed domain name and the Complainant's DECATHLON mark.

So far as the current, inactive use of the disputed domain name is concerned, prior UDRP panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details and (iv) the implausibility of any good faith use to which the domain name may be put by the respondent; see [WIPO Overview 3.0](#), section 3.3 and, by way of example, *Decathlon v. Fannie Baraka, Ovolution*, WIPO Case No. [D2022-0282](#).

Applying these factors to the circumstances of these proceedings: (i) the Complainant has established the widespread repute of its DECATHLON mark; (ii) save for its offer to sell the disputed domain name to the Complainant, the Respondent has not provided a response to the Complaint nor is there any evidence of actual or contemplated good faith use of the disputed domain name; (iii) the disputed domain name was originally registered through use of a privacy service; and (iv) there is no plausible good faith use to which the disputed domain name can be put by the Respondent. In the circumstances of this case, the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy. See also, for example, *Alstom v. Contact Privacy Inc. Customer 1244065242 / Michelle Chung, Chung Limited Co*, WIPO Case No. [D2019-2718](#).

Finally, the Respondent's correspondence with the Center and the Complainant, summarized above, indicates a desire by the Respondent to sell the disputed domain name to the Complainant for possible commercial gain.

For the above reasons, based on the available record, the Panel finds that 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 name <decathlonag2r.com> be transferred to the Complainant.

*/Antony Gold/*

**Antony Gold**

Sole Panelist

Date: February 19, 2024