

ADMINISTRATIVE PANEL DECISION

Big 5 Corp. v. 卢涛 (tao lu)
Case No. D2024-0267

1. The Parties

The Complainant is Big 5 Corp., United States of America (“United States”), represented by Kilpatrick Townsend & Stockton LLP, United States.

The Respondent is 卢涛 (tao lu), China.

2. The Domain Name and Registrar

The disputed domain name <big5-sportinggoods.com> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 22, 2024. On January 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 24, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 24, 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 the amended Complaints in English on February 5, 2024, and February 6, 2024.

On January 24, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On February 5, 2024, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

The Center verified that the Complaint together with the amended Complaints 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 in Chinese and English of the Complaint, and the proceedings commenced on February 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 28, 2024.

The Center appointed Andrew Sim as the sole panelist in this matter on March 6, 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 sporting goods retailer in the United States. It operates physical and online stores selling athletic shoes, apparel, accessories, and equipment for team sports, fitness, camping, hunting, fishing, tennis, golf, winter and summer recreation, and roller sports.

The Complainant is the owner of a number of BIG 5-formative trademarks, including the following trademark registrations in the United States ("BIG 5 Marks"):

- (a) BIG 5 in Class 42, United States Patent and Trademark Office Registration No. 1929798, registered on October 24, 1995; and
- (b) BIG 5 SPORTING GOODS in Class 35, United States Patent and Trademark Office Registration No. 2749742, registered on August 12, 2003.

The Complainant uses the above trademarks in connection with its product offerings. It currently operates more than 432 stores under the "Big 5 Sporting Goods" name. The Complainant maintains its online presence at "www.big5sportinggoods.com".

The disputed domain name was registered on October 9, 2023. Before filing the Complaint, the disputed domain name resolved to a website mimicking the Complainant's website and including an image of the Complainant's former store in Carlsbad. At the time of the Complaint, the disputed domain name resolves to a website mimicking the Alaskan King Crab Company's website. Currently, the disputed domain name resolves to an inactive page.

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 (i) the disputed domain name is identical or confusingly similar to the Complainant's BIG 5 Marks, with the only difference between the Complainant's registered BIG 5 SPORTING GOODS mark and the disputed domain name being the addition of a hyphen; (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and the Respondent's use of the disputed domain name does not relate to a bona fide offering of goods and services or for any legitimate noncommercial or fair purpose; and (iii) the disputed domain name was registered and is being used in bad faith, considering that the disputed domain name was registered well after the Complainant registered the BIG 5 Marks and after the BIG 5 Marks became recognized.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be in English for several reasons. First, the Complainant is based in the United States and conducts its daily operations in English, and would therefore be cumbersome and to the Complainant's disadvantage to be forced to translate the proceedings to Chinese. Second, the disputed domain name, which incorporates the Complainant's BIG 5 mark, is a distinctive term in English and was not used in common parlance, including in Chinese parlance, until the launch of the Complainant's service. Third, the website at the disputed domain name resolves to a homepage in English, which indicates that the Respondent is capable of corresponding in English.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

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 name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has 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 entirety of the mark (despite the hyphen) is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 the Respondent may demonstrate rights or legitimate interests in a disputed 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available 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.

The Panel also notes that the disputed domain name no longer resolves to an active website, and the Respondent is likewise unlikely using the disputed domain name to provide a bona fide offering of goods and services for legitimate noncommercial or fair use.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Complainant has registered the BIG 5 trademark in 1995 and created the "www.big5sportinggoods.com" website for its product offering since 1997. Meanwhile, the disputed domain name was not registered by the Respondent until October 2023. The Panel is satisfied that the BIG 5 Marks are sufficiently recognized and relied upon by online consumers throughout the United States, and that the disputed domain name was registered well after the Complainant had since established its use of its BIG 5 Marks.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The disputed domain name used to resolve to a website with the Complainant's trademark and logo as well as mimicking the Alaskan King Crab Company's website. In view of the Panel, the Complainant has provided sufficient evidence that the Respondent has intentionally tried to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation or endorsement of its website. [WIPO Overview 3.0](#), section 3.1.4.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that 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.

The Panel finds that the Complainant has established the third element 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 <big5-sportinggoods.com> be transferred to the Complainant.

/Andrew Sim/

Andrew Sim

Sole Panelist

Date: March 20, 2024