

ADMINISTRATIVE PANEL DECISION

Northwave s.r.l. v. zhang xiaoshan
Case No. D2024-0355

1. The Parties

The Complainant is Northwave s.r.l., Italy, represented by Dr. Modiano & Associati S.p.A., Italy.

The Respondent is zhang xiaoshan, China.

2. The Domain Name and Registrar

The disputed domain name <northwaveoutlet.com> (the “Disputed Domain Name”) is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 26, 2024. On January 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 28, 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 (My Domain Provider) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 29, 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 30, 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 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 21, 2024.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on February 23, 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, Northwave s.r.l., is an Italian company with a history dating back to 1971 and operating in the field of sport clothing, footwear and apparel.

The Complainant is the owner of several trademarks, including the following:

- NORTHWAVE, Italian word mark registered under No. 0001333363 on September 16, 2010, in class 25;
- NORTHWAVE, International word mark registered under No. 1039647 on March 30, 2010, in class 25.

The Complainant is the owner of the domain name <northwave.com>, which resolves to the Complainant's official website.

The Disputed Domain Name was registered on June 5, 2023. The Panel observes that the Disputed Domain Name resolves to a website:

- displaying the Complainant's NORTHWAVE trademark in the same font as on the Complainant's official website; and
- offering sportswear products for sale at discounted prices bearing the Complainant's logo as used on the Complainant's official website.

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 identical or confusingly similar to a trademark in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant contends that:

- no agreements, authorisations or licenses have been granted to the Respondent to use the Complainant's trademarks;
- the registration and/or use of the Disputed Domain Name containing the Complainant's entire mark makes it difficult to infer a legitimate use of the Disputed Domain Name by the Respondent;
- there is no evidence that the Respondent has trademarks or company activities registered under the NORTHWAVE brand;
- the Disputed Domain Name is used for a website which mimics the Complainant's official website, and where purported products under the NORTHWAVE trademark are sold at discounted prices. It therefore appears that the Respondent is trying to impersonate the Complainant, and thus is not making any legitimate use of the Disputed Domain Name;

- based on the available information, the Respondent has never made any bona fide use of the Disputed Domain Name;
- based on the available information, the Respondent has never been known under the NORTHWAVE name.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant:

- the Respondent registered the Disputed Domain Name with full knowledge of the Complainant's trademarks;
- the Disputed Domain Name is used to attract Internet users by creating a likelihood of confusion with the Complainant;
- the Respondent's concealment of its contact details is further inference of bad faith registration and use of the Disputed Domain Name.

B. Respondent

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

6. Discussion and Findings

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 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 a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel observes that the entirety of the NORTHWAVE mark is reproduced within the Disputed Domain Name. In such cases, the domain name will normally be considered confusingly similar to the incorporated mark for purposes of UDRP standing. [WIPO Overview 3.0](#), section 1.7.

Additionally, the Panel finds that the addition of another term – here, "outlet" – does not prevent a finding of confusing similarity between the Disputed Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is well established that generic Top-Level-Domains ("gTLDs"), here ".com", may be disregarded when considering whether the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights.

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 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 notes that the Respondent has not apparently been commonly known by the Disputed Domain Name, and that the Respondent does not seem to have acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is “zhang xiaoshan”. The Respondent’s use and registration of the Disputed Domain Name was not authorized by the Complainant.

Fundamentally, a respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner. The correlation between a domain name and the complainant’s mark is often central to this inquiry. Even where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

The Disputed Domain Name incorporates the Complainant’s NORTHWAVE trademark in its entirety and merely adds the descriptive term “outlet”. In the Panel’s view, the term can be easily linked to the Complainant’s clothing business, e.g., to refer to an outlet store of the Complainant. Therefore, the Panel finds that the Disputed Domain Name carries a risk of implied affiliation with the Complainant and cannot constitute fair use.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, including the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not. [WIPO Overview 3.0](#), sections 2.5.2 and 2.5.3

The Disputed Domain Name resolves to a website offering sportswear products similar to the Complainant’s products for sale at discounted prices and displaying the NORTHWAVE trademarks in the same font as on the Complainant’s official website. The Panel finds that this does not amount to a bona fide offering of goods or services, or a legitimate noncommercial or fair use of the Disputed Domain Name. Moreover, the Respondent does not accurately and prominently disclose its (absence of) relationship with the Complainant. As a result, the Respondent fails the so-called “Oki Data test” for legitimate resellers, distributors or service providers of a complainant’s goods or services. *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and [WIPO Overview 3.0](#), section 2.8.1.

The Respondent had the opportunity to demonstrate his rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

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 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.

As established above, the Disputed Domain Name resolves to a website offering sportswear products similar to the Complainant's products for sale at discounted prices and displaying the NORTHWAVE trademarks and logo as used on the Complainant's official website. In the Panel's view, this clearly indicates that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

[WIPO Overview 3.0](#), section 3.2.4.

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.

In the present case, the Panel finds that the Respondent must have been aware of the Complainant and its trademark rights when it registered the Disputed Domain Name as:

- the Disputed Domain Name incorporates the Complainant's distinctive trademark in its entirety, and combines it with a term which can be easily linked to the Complainant's clothing business;
- the Disputed Domain Name appears to resolve to a website displaying the Complainant's NORTHWAVE marks and logo as used on the Complainant's official website;
- the Respondent seems to offer for sale products identical or at least similar to the Complainant's products;
- some of the Complainant's marks predates the registration of the Disputed Domain Name by more than a decade, including in China where the Respondent appears to be located.

Finally, the Respondent did not formally take part in the administrative proceedings. According to the Panel, this serves as additional indication of the Respondent's bad faith.

Based on the available record, 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 <northwaveoutlet.com> be transferred to the Complainant.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: March 8, 2024