

ADMINISTRATIVE PANEL DECISION

Decathlon v. LEE JONG

Case No. D2024-1308

1. The Parties

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

The Respondent is LEE JONG, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <decath1on.com> is registered with Squarespace Domains II LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 27, 2024. On March 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 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. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 2, 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 April 2, 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 April 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2024.

Due to an administrative oversight, it appears that the written notice was not sent on April 12, 2024. The Center sent the written notice on May 6, 2024, and granted the Respondent a five-day period, through May 11, 2024, to indicate whether it wishes to participate in the proceeding. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 15, 2024.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on May 27, 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 company incorporated in 1980 and operating internationally in the field of development, production, and sale of sport articles. In 1986, the Complainant opened its first shop outside France. In 1988, the Complainant opened its first production office in Asia. Nowadays, 35 percent of the Complainant's stores are located in France, while the remaining 65 percent are located abroad. At the end of the 2017 the Complainant employed 87,000 employees worldwide with annual sales of EUR 11 billion. In January 2022, the Complainant was operating 1,747 stores worldwide.

The Complainant holds numerous trademarks for DECATHLON on a worldwide basis, inter alia:

- DECATHLON (word mark), French Trademark registration No. 1366349, registered on January 16, 1987;
- DECATHLON (word mark), European Union Trademark registration No. 000262931, registered on April 28, 2004; and
- DECATHLON (figurative mark), International Trademark registration No. 613216, registered on December 20, 1993.

In order to check whether DECATHLON would also have been registered as a trademark in the United States of America, as the Respondent appears to be located in the United States, the Panel accessed the website of the United States Patent and Trademark Office.¹ This revealed that the trademark DECATHLON has been filed in the United States on October 28, 2014, and has been registered on March 22, 2016, Trademark registration No. 4920538.

The registrations have been duly renewed and are still valid and will hereafter together referred to in singular as the "Trademark".

The Complainant offers for sale its sporting and leisure goods online, through its official websites notably located at "www.decathlon.fr" (registered since June 29, 1995) and "www.decathlon.com" (registered since May 30, 1995) and uses its Trademark as domain name to promote its activities online.

The disputed domain name was first registered on October 31, 2023. It does not resolve to an active 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 confusingly similar to the Trademark as it identically reproduces the term DECATHLON with the sole substitution of the letter "l" to the number "1" which is hardly noticeable.

¹See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8: "Noting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. This may include ... accessing trademark registration databases."

The Respondent has no rights or legitimate interests in respect of the disputed domain name. To the Complainant's best knowledge, the Respondent is not currently and has never been known under the name "decath1on". The Complainant did not know the Respondent and ascertains that the Respondent is not in any way related to his business, is not one of his distributors and does not carry out any activity for or have any business with them. Furthermore, the right to use such mark as a basis for a domain name requires an express authorization. In this case, the Complainant has never licensed, authorized, or otherwise permitted the Respondent to register a domain name incorporating its Trademark. Thus, the Respondent is intentionally creating confusion in order to divert consumers from the Complainant's websites to its own website, which is not used to promote a bona fide offering of goods or services, nor to serve a noncommercial legitimate purpose but to host a parked page. Since the Complainant has not authorized the Respondent to use his Trademark and domain names, this use can only be fraudulent, and certifies that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Lastly, the Complainant maintains that the Respondent registered and is using the disputed domain name in bad faith.

As far as registration in bad faith is concerned, the Complainant contends that the Trademark was registered long before the registration of the disputed domain name and enjoys strong reputation throughout the world in the field of retail of sport and leisure articles. The domain name is confusingly similar to the Complainant's Trademark since it reproduces its DECATHLON Trademark with the mere substitution the letter "l" to the number "1". Any search against the Trademark conducted through an Internet search engine, would have led to websites relating to the Complainant and its products. It is therefore most likely that the Respondent registered the disputed domain name having the Complainant's Trademark and domain name in mind. As far as use in bad faith is concerned, the Complainant contends that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding.

There is no justification for the Respondent to reserve the disputed domain name substantially similar to the well-known Complainant's prior rights over the name "decathlon".

The Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements in order to succeed in its Complaint:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(ii) 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.

The burden of proof of each element is borne by the Complainant. The Respondent's default does not by itself mean that the Complainant is deemed to have prevailed. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 4.3.

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 disputed domain name reproduces the Trademark DECATHLON with the sole substitution of the letter "I" to the number "1". This substitution by a similar-appearing character is hardly noticeable as a clear example of typosquatting. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.9.

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 Complainant has not licensed or authorized the usage of its Trademark to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name. The Respondent has not indicated any reason to justify why it has chosen the specific term "decath1on" to compose the disputed domain name.

The disputed domain name reproduces the Trademark DECATHLON with the sole substitution of the letter "I" to the number "1". This substitution by a similar-appearing character is hardly noticeable. The typosquatting nature of the disputed domain name therefore carries a risk of misleading the consumers and diverts them to the Respondent's website, in order to create a commercial gain which cannot amount to fair use nor confer rights or legitimate interests upon the Respondent.

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.

Given that the disputed domain name consists of an intentional misspelling of the widely-known Trademark, the Respondent was more likely than not aware of the Complainant's Trademark at the time of the registration of the disputed domain name. (See Section 3.1.4 of the [WIPO Overview 3.0](#) that states that "the mere registration of a domain name that is identical or confusingly similar (particularly domain name comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith".)

As mentioned above the composition of the disputed domain name is also ideally suited to misleading the public and suggests that the disputed domain name is affiliated with the Complainant. .

Furthermore, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, or to this Complaint is further evidence of bad faith, given all the circumstances of the case. [WIPO Overview 3.0](#), section 3.2.

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 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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's Trademark, the composition of the disputed domain name and the Respondent's failure to participate in this proceeding 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.

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 <decath1on.com> be transferred to the Complainant.

/Richard C.K. van Oerle/

Richard C.K. van Oerle

Sole Panelist

Date: June 6, 2024