

ADMINISTRATIVE PANEL DECISION

Decathlon v. Troy Hansen
Case No. D2024-1787

1. The Parties

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

The Respondent is Troy Hansen, United States of America (“United States”).

2. The Domain Names and Registrar

The disputed domain names <decathlon.eu.com> and <decathlonfr.com> are registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 29, 2024. On April 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 29, 2024, 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 Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 30, 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 May 3, 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 May 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 28, 2024.

The Center appointed James Bridgeman SC as the sole panelist in this matter on May 31, 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 manufacturer of sporting and leisure goods on which it uses the DECATHLON mark, for which it owns a portfolio of registrations including the following:

- French registered trademark DECATHLON registration No. 1366349, filed on April 22, 1986, and registered for goods and services in classes 3, 4, 5, 8, 9, 12, 13, 14, 16, 18, 20, 21, 22, 24, 25, 28, 32, 33, 35, 37, 39, 40, 42, 43, 44, and 45;
- European Union trademark DECATHLON, registration No. 000262931, registered on April 28, 2004 for goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, and 42;
- International trademark DECATHLON, registration No. 613216 registered on December 20, 1993, for goods and services in classes 1, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 16, 17, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 35, 36, 37, 38, 39, and 42.

The Complainant has an established Internet presence and has maintained websites at “www.decathlon.com” since May 31, 1995, “www.decathlon.fr” since June 29, 1995; and “www.decathlon.net” since June 23, 1998.

Both of the disputed domain names were registered on May 26, 2023, and both are currently passively held, neither resolving to any active website.

There is no information available about the Respondent.

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 names.

Notably, the Complainant claims rights in the DECATHLON mark based on its ownership of the portfolio of registrations described above and extensive use of the mark in its business as a manufacturer of sporting and leisure goods since it was established in 1986.

It is submitted that since it was established, it has grown extensively to become an international enterprise and as of the year 2023, it employed 101,000 employees in 1,751 stores worldwide with annual sales of EUR 15,6 billion.

The Complainant alleges that the disputed domain names are confusingly similar to its DECATHLON trademark as they identically reproduce the term “decathlon”, with the addition of the two-letter country codes “eu” and “fr”.

Since the entirety of the trademark is reproduced within the disputed domain names, the disputed domain names are confusingly similar to the trademark for the purposes of the Policy.

Prior panels constantly recognize that the identical reproduction of a trademark with the addition of a descriptive or geographical term is confusingly similar to the prior trademarks in which the complainant has rights and cites *Skyscanner Limited v. Shi Lei concerning*, WIPO Case No. [D2023-4342](#).

The Complainant further submits that the addition, for technical reasons, of the generic Top-Level Domain (“gTLD”) extension “.com” at the end of the disputed domain names is irrelevant to the determination of whether the disputed domain names are identical or confusingly similar to a Complainant’s trademark.

The Complainant next alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain names arguing that:

- to the Complainant's best knowledge, the Respondent is not currently and has never been known under the names "decathloneu" and "decathlonfr";
- the Respondent is not in any way related to the Complainant's business and does not carry out any activity for or have any business with the Complainant;
- the right to use the DECATHLON mark as a basis for a domain name requires an express authorization and the Complainant has never licensed, authorized, or otherwise permitted the Respondent to register a domain name incorporating its trademarks, nor to make any use of the trademarks in order to distinguish the Respondent's own business;
- 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;
- since the Complainant has not authorized the Respondent to use its trademarks 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 names.

Next the Complainant alleges that the disputed domain names were registered and are being used in bad faith, arguing that the Complainant has demonstrated the strong reputation and the leading position of its trademark DECATHLON throughout the world in the field of selling goods and products related to sport. Consequently, it is improbable that the Respondent was not aware of the existence of the Complainant's intellectual property rights at the time the disputed domain names were registered.

The Complainant adds that the disputed domain names are highly similar to its DECATHLON trademark and domain names which were registered long before the disputed domain names were registered; and any search for "DECATHLONEU" or "DECATHLONFR" conducted with a search engine such as Google leads in the first place to websites relating to the Complainant as shown in search results that are exhibited in an annex to the Complaint.

It is therefore highly unlikely that the registration of the disputed domain names that incorporate the DECATHLON trademark was accidental.

Furthermore, the screen captures of the web pages to which the disputed domain names resolve which are exhibited in an annex to the Complaint show that the disputed domain names resolve inactive webpages.

In the context of this Complaint, such passive holding of the disputed domain names constitutes use in bad faith for the purposes of the Policy. The Complainant cites *Holding Le Duff "HLD" v. Franck James*, WIPO Case No. [D2019-0150](#).

Further, screen captures of the websites to which the disputed domain names resolved in the past, which are also exhibited in annexes to the Complaint, show that prior to the current use of the disputed domain names, the Respondent was using the disputed domain names to resolve to websites reproducing the Complainant's well-known trademarks and passing off as the Complainant's official DECATHLON websites offering sport equipment's, accessories, and clothes for sale.

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.

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 is reproduced within each of 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.

The Panel finds the mark is recognizable 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.

Although the addition of other terms here, the terms "eu" and "fr" 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.

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 names. 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 names such as those enumerated in the Policy or otherwise.

Firstly, given the Registrar's disclosure of the Respondent's name as "Troy Hansen" and the absence of evidence to the contrary, the Respondent is not currently and has never been known under the names "DECATHLONEU" and "DECATHLONFR".

Secondly, the Respondent is not in any way related to the Complainant's business and does not carry out any activity for or have any business with the Complainant. Despite this, the disputed domain names were previously used for website allegedly offering the Complainant's branded goods, without any apparent disclaimer, which cannot constitute fair use as further explained below. Their current inactive state clearly does not represent any bona fide offering of goods or services.

Thirdly, the Panel notes the composition of the disputed domain names, which carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1. Such affiliation was clearly the intent of the Respondent given the evidence provided in the Complaint regarding the prior use of the disputed domain names to resolve to websites passing off as the Complainant. In this regard, panels have categorically held that the use of a domain name for illegal activity, such as impersonation/passing off) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 Panel notes that the Complainant has a long-established international reputation and goodwill in the DECATHLON mark which it uses in its business as a manufacturer of sports and leisure garments. The Complainant's business has expanded to a global footprint and as of the year 2023, it employed 101,000 employees in 1,751 stores worldwide with annual sales of EUR 15,6 billion.

The evidence shows that the disputed domain names each contains the DECATHLON mark in its entirety as the initial and dominant element to which is affixed a two-letter country code "fr" and "eu", respectively. The evidence provided also indicates that the disputed domain names were previously used to resolve to websites passing off as the Complainant.

Therefore, it is implausible that the Respondent was unaware of the Complainant, its name, mark, and goodwill in the DECATHLON mark when the disputed domain names were registered. The Panel in fact finds that the Respondent has registered and used the disputed domain names in an attempt to attract, for commercial gain, Internet users to its webpages by creating a likelihood of confusion with the Complainant's mark, which amounts to registration and use of the disputed domain name in bad faith as per paragraph 4(b)(iv) of the Policy.

The fact that both the disputed domain names currently do not resolve to any active webpages does not prevent a finding of bad faith in the case.

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 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 and reputation of the Complainant's trademark, the composition of the disputed domain names, the Respondent's failure to come forward with any explanation for the registration of the disputed domain names, and finds that in the circumstances of this case the current passive holding of the disputed domain names 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 names <decathloneu.com> and <decathlonfr.com> be transferred to the Complainant.

/James Bridgeman SC/

James Bridgeman SC

Sole Panelist

Date: June 12, 2024