

ADMINISTRATIVE PANEL DECISION

Hi-TEC Sports International Holdings B.V. v. Thomas Birch, Finlay Nolan,
Anna Akhtar, Tyler Reynolds, Keira Donnelly
Case No. D2024-1891

1. The Parties

The Complainant is Hi-TEC Sports International Holdings B.V., Netherlands (Kingdom of the), represented by Chiever B.V., Netherlands (Kingdom of the).

The Respondents are Thomas Birch, Finlay Nolan, Anna Akhtar, Tyler Reynolds and Keira Donnelly, Italy.

2. The Domain Names and Registrar

The disputed domain names <hi-tecargentina.net>, <hi-tecaustralia.net>, <hi-tecbelgie.com>, <hi-tecbelgique.com>, <hi-tecbrasil.com>, <hi-tecbulgaria.com>, <hi-teccanada.com>, <hi-techchile.net>, <hi-teccolombia.net>, <hi-teccz.com>, <hi-tecdanmark.com>, <hi-teceesti.com>, <hi-tecfrance.com>, <hi-tecgreece.com>, <hi-techdeutschland.com>, <hi-techrivatska.com>, <hi-tecireland.com>, <hi-tecisrael.com>, <hi-tecitalia.com>, <hi-tecjapan.com>, <hi-teckuwait.com>, <hi-teclatvija.com>, <hi-teclietuva.com>, <hi-tecnederland.com>, <hi-tecnorge.com>, <hi-tecnz.net>, <hi-tecpolska.com>, <hi-tecportugal.com>, <hi-tecromania.net>, <hi-tecslovenija.com>, <hi-tecslovensko.com>, <hi-tecsouthafrica.com>, <hi-tecsuisse.com>, <hi-tecsuomi.com>, <hi-tecsverige.com>, <hi-tecuae.com>, <hi-tecuk.com>, and <hi-tecuruguay.com> (the “Disputed Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 29, 2024. On May 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On May 9, 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 (Registry Registrant ID: *Not Available*) and contact information in the Complaint.

The Center sent an email communication to the Complainant on May 14, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint for the Disputed Domain Names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity

and/or that all domain names are under common control. The Complainant filed an amended Complaint on May 22, 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 Respondents of the Complaint, and the proceedings commenced on May 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 17, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on June 25, 2024.

The Center appointed Nicholas Weston as the sole panelist in this matter on July 2, 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 incorporated in the Netherlands (Kingdom of) and since 1974 has been operating a business producing and selling outdoor clothing, footwear, and accessories globally. The Complainant holds registrations for the trademark HI-TEC and variations of it in numerous countries, including, inter alia, German Trademark Registration No. 1058233 for HI-TEC, registered on January 10, 1984; and European Union Trademark Registration No. 000209304 for HI-TEC and design, registered on May 10, 2001.

The Complainant owns the domain names <hi-tec.com> and <hi-tec.co.uk> from where its main websites operate.

The Disputed Domain Names were registered on August 29, 2023. The vast majority of the Disputed Domain Names resolve to websites that prominently displaying the HI-TEC trademark and the Complainant's logo, and purport to sell HI-TEC branded hiking boots and shoes. A small cohort of the Disputed Domain Names are inactive.

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.

The Complainant requests to consolidate the multiple domain names in this proceeding on the basis that the registrants of the Disputed Domain Names are under common control and (it contends) "share the common elements, within the same registry, follow the same naming pattern (<mark-country> or <mark-goods-country>), have the same location of the registrant and use the same nameserver... are registered with one Registrar ... were registered on the same day, [and] ...all domain names referring to an active website use substantially the same template and serve the same purpose, specifically the sale of hiking boots/shoes".

The Complainant cites its trademark registrations internationally as prima facie evidence of ownership of the mark HI-TEC.

The Complainant submits that its rights in the mark HI-TEC predate the Respondents' registration of the Disputed Domain Names. The Complainant submits that the Disputed Domain Names are confusingly

similar to its trademark, because each of the Disputed Domain Names incorporates the HI-TEC trademark, and that the confusing similarity is not removed by the relevant country name or ISO code, or the generic Top-Level Domain (“gTLD”) “.com” or “.net”.

The Complainant contends that the Respondents have no rights or legitimate interests in respect of each of the Disputed Domain Names because “[t]he Respondents have no connection or affiliation of any kind with the Complainant, nor has the Complainant ever granted the Respondents license or consent, express or implied, to use the HI-TEC trademark in any manner” and none of the circumstances set out in paragraph 4(c) of the Policy apply. The Complainant also contends that neither the inactive Disputed Domain Names nor “the [active] websites under the Disputed Domain Names are imitations/copies of the authorized website under the Domain Name of Complainant” are not uses of the Disputed Domain Names in connection with a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy.

Finally, the Complainant alleges that the registration and use of each of the Disputed Domain Names was, and currently is, in bad faith, contrary to the Policy and the Rules having regard to the prior use and targeting of the Complainant’s trademarks “given [in relation to the active Disputed Domain Names] that the logo’s, names, and products are replicated from the Complainant’s website”. The Complainant also submits that “[t]he remaining domain names currently not referring to an active website share the common elements, within the same registry, follow the same naming pattern (<markcountry> or <mark-goods-country>), have the same location of the registrant and use the same nameserver” which taken as a whole constitutes, it submits, “a systematic pattern of fraudulent activities by the Respondents”.

B. Respondents

The Respondents did not reply to the Complainant’s contentions.

6. Discussion and Findings

6.1 Preliminary Matter – Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant’s request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant’s request, the Panel will consider whether (i) the Disputed Domain Names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.11.2.

The Complainant has pointed to a pattern of irregularities that suggest that the Disputed Domain Names are under common control. All of the Disputed Domain Names were registered on the same date; all use Venice, Italy in their registrant details. There is a pattern of using country names in English or the local language or an ISO code representing a country name in each of the Disputed Domain Names that suggests a similar modus operandi. The Disputed Domain Names are held with the same Registrar and use the same nameserver.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as “the Respondent”) in a single proceeding.

6.2 Substantive Matters

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- (iii) that the Disputed Domain Names have been registered and are 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 trademark and the Disputed Domain Names. [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. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country. [WIPO Overview 3.0](#), section 1.2.1. The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark HI-TEC in numerous countries.

Turning to whether the Disputed Domain Names are identical or confusingly similar to the HI-TEC trademark, the Panel observes that each Disputed Domain Name is comprised of: (a) an exact reproduction of the Complainant’s trademark HI-TEC; (b) with, respectively, either country names (in English or the local language or the ISO code representing a country name); (c) followed by the gTLD “.com” or “.net”.

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1. The relevant comparison to be made is with the second-level portion of each of the two Disputed Domain Names, specifically: <hi-tecargentina>, <hi-tecaustralia>, <hi-tecbelgie>, <hi-tecbelgique>, <hi-tecbrasil>, <hi-tecbulgaria>, <hi-teccanada>, <hi-teccchile>, <hi-teccolombia>, <hi-teccz>, <hi-tecdanmark>, <hi-teceesti>, <hi-tecfrance>, <hi-tecgreece>, <hi-techdeutschland>, <hi-techrhvatska>, <hi-tecireland>, <hi-tecisrael>, <hi-tecitalia>, <hi-tecjapan>, <hi-teckuwait>, <hi-teclatvija>, <hi-teclietuva>, <hi-tecnederland>, <hi-tecnorge>, <hi-tecnz>, <hi-tecpolska>, <hi-tecportugal>, <hi-tecromania>, <hi-tecslovenija>, <hi-tecslovensko>, <hi-tecsouthafrica>, <hi-tecsuisse>, <hi-tecsuomi>, <hi-tecsverige>, <hi-tecuae>, <hi-tecuk>, and <hi-tecuruguay>, respectively.

The Panel finds the entirety of the mark is reproduced 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 country names or ISO codes 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 Disputed Domain Names (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.

The Panel notes the evidence that the Disputed Domain Names are either inactive or resolve to webpages that prominently display the Complainant’s trademarks, and purport to sell outdoor clothing and footwear using the Complainant’s branding and content, without any disclaimer disclosing the lack of relationship between the Parties, which supports the Complainant’s submission on that point and finds that these uses do not represent a bona fide offering of goods or services, or a legitimate noncommercial or fair use, given the substantial reputation and goodwill of the Complainant’s mark or capacity to otherwise mislead Internet users.

The Panel also notes that each Disputed Domain Name contains a country name or an ISO code for a country name, suggesting that the Respondent seeks to impersonate the Complainant in a targeted way. The Panel finds that that this creates the false impression that the Respondent’s website is related to, authorized by, or affiliated with the Complainant, particularly considering the nature of the global business the Complainant is engaged in.

Panels have held that the use of a domain name for illegal activity such as impersonation, passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established for all of the Disputed Domain Names.

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.

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.

In the present case, the Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Names in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Names and the well-known nature of the Complainant's trademark, the Panel is satisfied that the Respondent knew of and targeted the Complainant's trademark HI-TEC when it registered the Disputed Domain Names (see *Hi-Tec Sports International Holdings B.V. v. Domain Administrator, PrivacyGuardian.org / Frank Jaeger*, WIPO Case No. [D2022-2956](#) ("its HI-TEC trademark has been extensively used on an international scale over decades").

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Names other than to trade off the reputation and goodwill of the Complainant's well-known trademark. [WIPO Overview 3.0](#), section 3.1.4.

Further, a gap of several years between registration of a complainant's trademark and respondent's registration of a disputed domain name (containing the trademark) can indicate bad faith registration. In this case, the Respondent registered the Disputed Domain Names some 39 years after the Complainant established registered trademark rights in the HI-TEC mark.

On the issue of use, the Complainant's evidence is that each of the Disputed Domain Names are either inactive or resolve to webpage purporting to offer for sale the Complainant's goods.

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 a number of the Disputed Domain Names 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 Complainant's well-known trademark, and the composition of the Disputed Domain Names, and finds that in the circumstances of this case the passive holding of the Disputed Domain Names does not prevent a finding of bad faith under the Policy.

Panels may take into account particular circumstances in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the Disputed Domain Name such as here where a widely-known mark is used, and incorporating an additional term such as a geographic term, (ii) the chosen top-level domain (e.g., particularly where corresponding to the complainant's area of business activity or natural zone of expansion), (iii) the content of that copies the Complainant's own content and branding, (iv) the timing and circumstances of the registration (all on the same day); (v) any respondent pattern of targeting marks along a range of factors, such as a common area of commerce, intended consumers, or geographic location, (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the Disputed Domain Name, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant. [WIPO Overview 3.0](#), section 3.2.1. In the circumstances, the Panel finds the Respondent's registration and use of the Disputed Domain Names constitutes bad faith under the Policy.

Panels have also held that the use of a domain name for illegal activity here, alleged impersonation or passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. In these circumstances also, the Panel finds the Respondent's registration and use of the Disputed Domain Names constitutes 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 <hi-tecargentina.net>, <hi-tecaustralia.net>, <hi-tecbelgie.com>, <hi-tecbelgique.com>, <hi-tecbrasil.com>, <hi-tecbulgaria.com>, <hi-teccanada.com>, <hi-tecchile.net>, <hi-teccolombia.net>, <hi-teccz.com>, <hi-tecdanmark.com>, <hi-teceesti.com>, <hi-tecfrance.com>, <hi-tecgreece.com>, <hi-techdeutschland.com>, <hi-techrvatska.com>, <hi-tecireland.com>, <hi-tecisrael.com>, <hi-tecitalia.com>, <hi-tecjapan.com>, <hi-teckuwait.com>, <hi-teclatvija.com>, <hi-teclietuva.com>, <hi-tecnederland.com>, <hi-tecnorge.com>, <hi-tecnz.net>, <hi-tecpolska.com>, <hi-tecportugal.com>, <hi-tecromania.net>, <hi-tecslovenija.com>, <hi-tecslovensko.com>, <hi-tecsouthafrica.com>, <hi-tecsuisse.com>, <hi-tecsuomi.com>, <hi-tecsverige.com>, <hi-tecuae.com>, <hi-tecuk.com>, and <hi-tecuruguay.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: July 17, 2024