

ADMINISTRATIVE PANEL DECISION

ABG-Tretorn, LLC v. Zhang Fei, na
Case No. D2024-2827

1. The Parties

The Complainant is ABG-Tretorn, LLC, United States of America (“United States”), represented by Abion AB, Sweden.

The Respondent is Zhang Fei, na, China.

2. The Domain Name and Registrar

The disputed domain name <tretornnorge.com> (the “Disputed Domain Name”) is 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 July 11, 2024. On July 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 12, 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 (n/a) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 12, 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 amendment to the Complaint on July 12, 2024.

The Center verified that the Complaint together with the amendment to the 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 July 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 9, 2024.

The Center appointed Nicholas Weston as the sole panelist in this matter on August 14, 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 United States incorporated company that operates a Swedish outdoor lifestyle brand business dating back to 1891 with products such as rubber boots and tennis balls. The Complainant holds numerous registrations for the trademark TRETORN and variations of it globally, including, inter alia, Norway Registration No. 8973 for TRETORN, dated November 7, 1921, and International Trademark No. 747228 for TRETORN (that also designates China), registered on December 8, 2000.

Amongst others, the Complainant operates the domain names <tretorn.com> and <tretorn.no> as online retail websites.

The Disputed Domain Name was registered on January 15, 2022. The Disputed Domain Name resolves to a website displaying the TRETORN trademark and products that appear to be the same or similar to those of the Complainant.

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 cites its trademark registrations around the world for the mark TRETORN and variations of it, as prima facie evidence of ownership.

The Complainant submits that its rights in that the mark TRETORN mark predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name is comprised of the TRETORN trademark with the word "norge" (a geographical term meaning Norway), and that the addition of the word "norge" is not sufficient to avoid the confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because the Respondent has not been authorized by the Complainant to register or use the Disputed Domain Name and that none of the circumstances set out in paragraph 4(c) of the Policy apply.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules having regard to the prior use and well-known nature of the Complainant's trademark, and advances the argument that the use of the Disputed Domain Name to purport to imitate the Complainant's website demonstrates an attempt to mislead the public and is use in bad faith.

B. Respondent

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

6. Discussion and Findings

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

- (i) that the Disputed Domain Name is 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 Name; and
- (iii) that the Disputed Domain Name has been registered and is 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 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. 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 TRETORN in numerous countries including the Respondent's jurisdiction, China.

Turning to whether the Disputed Domain Name is identical or confusingly similar to the TRETORN trademark, the Panel observes that the Disputed Domain Name is comprised of: (a) the Complainant's trademark TRETORN; (b) followed by the geographical term "norge" (meaning Norway); (c) followed by the generic Top-Level Domain ("gTLD") ".com".

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. The relevant comparison to be made is with the second-level portion of each of the Disputed Domain Name, specifically: "tretornnorge".

The Panel finds that the mark is recognizable within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the word "norge", may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

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 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 the evidence that the Disputed Domain Name resolved to a webpage that imitates the Complainant's branding and content, and finds that this does not represent a bona fide offering of goods or services, or a legitimate noncommercial or fair use, given the evidenced reputation and goodwill of the Complainant's mark and the capacity to mislead Internet users. Impersonating use in this manner can never confer rights or legitimate interests upon a respondent. [WIPO Overview 3.0](#), section 2.13.

The Panel also notes that the Disputed Domain Name contains the word "norge", which this Panel finds that this creates the false impression that the Respondent's website is related to, authorized by, or affiliated with the Complainant, particularly considering the Scandinavian roots of the business the Complainant is engaged in and carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

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.

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 Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name, containing as it does the geographical term "norge", and the distinctive nature of the Complainant's trademark, the Panel is satisfied that the Respondent knew of and targeted the Complainant's trademark TRETORN when it registered the Disputed Domain Name (see *ABG-Tretorn, LLC v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0639](#) ("The Complainant's trade mark TRETORN is well-known throughout the world"); *ABG-Tretorn, LLC v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-2617](#) ("the distinctiveness and renown of the Complainant's trademark")).

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Name 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) may further support a finding of bad faith registration. In this case, the Respondent registered the Disputed Domain Name at least 100 years after the Complainant established registered trademark rights in the TRETORN mark.

On the issue of use, the Complainant's evidence is that the Disputed Domain Name resolved to a website where Internet users can supposedly purchase TRETORN branded goods.

In assessing whether the Respondent's registration of the Disputed Domain Name is in bad faith, the Panel has also taken into account: (i) the Disputed Domain Name incorporates the Complainant's mark plus a geographic term "norge", that corresponds to the Complainant's Scandinavian origins, (ii) the chosen gTLD that corresponds with a global market, (iii) the content of the website to which the Disputed Domain Name directed being apparently lifted or copied from the Complainant's own websites, and (iv) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the Disputed Domain Name. The evidence suggests that the Respondent has targeted the Complainant. [WIPO Overview 3.0](#), section 3.2.1.

In assessing whether the Respondent's use of the Disputed Domain Name is in bad faith, the Panel has taken into account the website that resolved from the Disputed Domain Name, which purported to be from the Complainant and displayed content copied from the Complainant's own website. This deceptive use indicates an intent to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark, and falls within the meaning of bad faith as set forth in paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), section 3.1.4.

In the circumstances, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitute bad faith under the Policy.

Moreover, the Panel notes the Disputed Domain Name does not appear to currently resolve to an active website. 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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the Complainant's distinctive 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 <tretornnorge.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: August 23, 2024