

ADMINISTRATIVE PANEL DECISION

Decathlon v. Manlidy
Case No. D2024-3550

1. The Parties

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

The Respondent is Manlidy, Singapore.

2. The Domain Name and Registrar

The disputed domain name <kalenjiathleticwear.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 2, 2024. On September 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 4, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 September 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 30, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 1, 2024.

The Center appointed Beatrice Onica Jarka as the sole panelist in this matter on October 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 DECATHLON, a major French manufacturer specialized in the conception and retailing of sporting and leisure goods, dating from 1976.

The Complainant designs and manufactures several lines of its own which are marketed under twenty dedicated "Passion Brands". Most of the products sold in store are provided under the "Passion Brands", among which the Complainant uses the KALENJI brand, dedicated to jogging, road and trail running, and athleticism.

The Complainant is the registered owner of a large number of trademarks consisting of the word KALENJI in France and abroad, notably in Singapore, where the Respondent alleges being located. These rights have been continuously used in commerce since their registration and the trademark KALENJI benefits from a reputation that has notably been recognized by past decisions under the UDRP.

The Complainant offers for sale its sporting and leisure goods online, through its official websites notably located at "www.kalenji.fr" and "www.decathlon.com", and uses its trademark as domain name to promote its activities online.

The Complainant has registered numerous trademarks throughout the world, including the following trademarks:

- French word trademark KALENJI No. 3284911, filed on April 8, 2004 (duly renewed) for goods and services in classes 09, 14, 18, 21, 25 and 28 (live);
- European Union word trademark KALENJI No. 6781025, filed on March 13, 2008 (duly renewed) for goods and services in classes 09, 18 and 25;
- International word trademark KALENJI No. 867267, filed on October 7, 2004 (duly renewed) for goods and services in classes 09, 14, 18, 21 and 25 (live)

All these trademarks predate the registration of the disputed domain name, registered on June 27, 2024.

The Respondent appears to be Manlidy, based in Singapore. No specific physical address was provided in the registration details. The disputed domain name was registered on June 27, 2024.

The disputed domain name resolves to a website reproducing the Complainant's well-known trademarks and passing off as an official DECATHLON site.

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 Complainant's trademarks and domain names as it identically reproduces the term "kalenji", with the addition of the generic terms "athleticwear";
- the sole addition of a generic term, when the trademark is recognizable in the domain name, cannot prevent a finding of confusing similarity;
- the Respondent is not currently and has never been known under the name "kalenjiathleticwear";
- the Respondent is not known to the Complainant and in any way related to its business as the Respondent is not one of its distributors and does not carry out any activity for or have any business with them;

- 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 its 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;
- the use of the disputed domain name is fraudulent, since the Complainant has not authorized the Respondent to use its trademarks and domain names;
- the Complainant has previously demonstrated the strong reputation and the leading position of its trademark KALENJI throughout the world in the field of selling goods and products related to sport;
- given the reputation of Complainant's trademark in the field of retail of sport and leisure articles is such, it is highly likely that the Respondent knew the existence of the Complainant's prior intellectual property rights at the time the domain name was registered;
- the Respondent is using the disputed domain name to resolve to a website reproducing the Complainant's well-known trademarks and passing off as an official Decathlon site, where it sells counterfeit products, similar to the ones the Complainant markets, which indicates bad faith use of the domain name at issue since the Respondent has attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, creating an idea of an affiliation or endorsement of the Respondent's website.

B. Respondent

Although properly summoned, 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, by documenting several trademark registrations which predate the registration of the disputed domain name. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the Complainant has established unregistered trademark or service mark rights for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.3.

The disputed domain name reproduces the trademark KALENJI, with the addition of the descriptive terms "athleticwear".

The sole addition of a descriptive term, when the trademark is recognizable in the domain name, cannot prevent a finding of confusing similarity.

Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. and 1.8.

Therefore, 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 recognised 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.

In this sense, the Panel is persuaded by the Complainant’s contentions, according to which:

- the Respondent is not currently and has never been known under the name “kalenjiathleticwear”;
- the Respondent is not known to the Complainant and in any way related to its business as the Respondent is not one of its distributors and does not carry out any activity for or have any business with them;
- 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 its own business.

Considering also the fact that the Respondent appears to use the disputed domain name to resolve to a website reproducing the Complainant’s well-known trademarks and passing off as an official Decathlon site where it purportedly sells counterfeit products, similar to the ones the Complainant markets, the Panel holds, as prior UDRP panels before it, that the use of the disputed domain name for illegal activity (e.g., the sale of counterfeit goods and impersonation/passing off) can never confer rights or legitimate interests on the Respondent. [WIPO Overview 3.0](#), section 2.13.1.

Accordingly, 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 Respondent likely knew the existence of the Complainant’s prior intellectual property rights at the time the disputed domain name was registered, given the reputation of Complainant’s trademark in the field of retail of sport and leisure articles.

Moreover, it appears that the Respondent is using the disputed domain name to resolve to a website reproducing the Complainant’s well-known trademarks and pass off as an official Decathlon site where it sells purportedly counterfeit products, similar to the ones the Complainant markets, which is a clear indication of 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.

Panels have held that the use of a domain name for illegal activity, here, claimed sale of counterfeit goods and impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy, since the Respondent appears to have attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, creating an idea of an affiliation or endorsement of the Respondent's website, and passing off as or impersonating the Complainant.

Accordingly, 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 <kalenjiathleticwear.com> be transferred to the Complainant.

/Dr. Beatrice Onica Jarka/

Dr. Beatrice Onica Jarka

Sole Panelist

Date: October 16, 2024