

## **ADMINISTRATIVE PANEL DECISION**

**ABG-Tretorn, LLC v. Client Care, Web Commerce Communications Limited**  
**Case No. D2022-2108**

### **1. The Parties**

The Complainant is ABG-Tretorn, LLC, United States of America (“United States”), represented by Authentic Brands Group, United States.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

### **2. The Domain Name and Registrar**

The disputed domain name <tretornshoescanada.com> 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 June 10, 2022. On June 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 13, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 16, 2022 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 June 16, 2022.

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 June 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 13, 2022.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on July 21, 2022. 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 owns the TRETORN trademark that is registered in relation to shoes and other categories of goods including rubber boots, outerwear, hosiery, tennis balls and accessories, bags, and loungewear.

These goods are currently sold around the world, and in Canada the Complainant has the following registered trademarks: the T logo, Registration No. TMA730403, registered on December 9, 2008 in International Classes 9, 18, 25 and 28; TRETORN, Registration No. TMA771926, registered on July 14, 2010 in International Class 9; TRETORN, Registration No. TMA 609802, registered on May 10, 2004 in International Classes 18 and 25; and TRETORN, Registration No. TMA115757, registered on October 30, 1959 in International Classes 17, 21, 25 and 28.

The Complainant also owns and operates a website at “www.tretorn.com”.

The disputed domain name was registered on January 15, 2022 and resolves to a website that displays and purports to offer TRETORN branded goods for sale.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant says that it spends millions of dollars marketing its goods and services globally, using the TRETORN mark, and has undertaken extensive efforts to protect its name and trademark rights. The Complainant also states that it protects its brand and the TRETORN marks by diligently pursuing infringers.

The Complainant contends that the disputed domain name is identical or confusingly similar to its TRETORN registered trademark. The Complainant says that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element.

The Complainant points out that the Respondent has not been licensed, contracted, or otherwise permitted to use the TRETORN trademark or to apply for any domain names incorporating it, and that it has not acquiesced in any way to such use of the TRETORN trademark by the Respondent. The Complainant also says that there is no evidence of fair use, nor that the Respondent is using or plans to use the TRETORN trademark or the domain names incorporating the TRETORN trademark for a *bona fide* offering of goods or services that doesn't infringe TRETORN's intellectual property rights.

The Complainant asserts that the Respondent has been actively using the TRETORN trademarks to operate a fake TRETORN website offering counterfeit TRETORN goods. Consumers will be tricked into thinking that the Respondent is somehow affiliated with the Complainant or that the latter endorses its commercial activities around the world. There is in fact no such relationship, the Complainant confirms.

The Complainant also contends that its TRETORN trademark is well-known around the world and thus the registration of the disputed domain name was in bad faith. Further, the Respondent registered the disputed domain name at least 30 years after the Complainant acquired registered trademark rights in the TRETORN mark. The Complainant also maintains that, in accordance with previous Panel decisions, the use of a privacy shield to mask identity, which makes it difficult for the Complainant to contact the Respondent and amicably settle a domain dispute, indicates bad faith.

Moreover, the Complainant says that more egregiously, the Respondent seems to be selling counterfeit TRETORN goods on its website. The Complainant points out that Panelists in other decisions have found bad faith registration where the respondent sells counterfeit merchandise, according to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The disputed domain name is not identical to the TRETORN registered trademark of the Complainant, but that mark is immediately recognizable in it. The addition of two descriptive terms does not alter or affect the conclusion that the disputed domain name is confusingly similar to the TRETORN trademark of the Complainant.

Therefore the Panel holds that the disputed domain name is confusingly similar to the registered trademark TRETORN of the Complainant.

### **B. Rights or Legitimate Interests**

The Complainant is the owner of the registered trademark TRETORN in numerous jurisdictions, including Canada, and has not authorized or licensed the Respondent to use that mark in any way, including by incorporating it in a registered domain name. There is nothing before the Panel to indicate that the Respondent uses the dispute domain name in any legitimate way or is commonly known by the term TRETORN.

The disputed domain name resolves to an unauthorized website where TRETORN marked goods are depicted and apparently offered for sale, goods the Complainant suspects are counterfeit. Registering and using a domain name to establish a website that looks like a genuine site, and thus purports to be operated by the owner of the trademark incorporated in the domain name without authorization, is an activity aimed at deceiving consumers and therefore not of a kind that results in the acquisition of rights or the recognition of some legitimate interest. There can never be a legitimate interest in operating a fake website that deceives consumers.

Therefore the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

### **C. Registered and Used in Bad Faith**

As indicated above, the disputed domain name resolves to a website that gives the misleading impression of being authorized or established by the Complainant. It offers only apparent TRETORN goods, probably fake according to the Complainant, for sale, and reproduces the TRETORN trademark. The disputed domain name's composition clearly indicates that the Respondent was fully aware of the Complainant's TRETORN trademark and the goodwill that attaches to it, and the kind of goods the mark is used for. When the disputed domain name was registered the TRETORN trademark had already been registered for a long time and had acquired a worldwide reputation in relation to the kind of goods for which it was registered. Then establishing a website that looks like an official TRETORN site, which impersonates the Complainant and does not explain the lack of relationship between the Parties, is clearly in bad faith. It amounts to a deliberate attempt to deceive consumers into making purchases, providing sensitive financial details, or otherwise engaging with a website they would think to be a TRETORN-authorized website, but is in fact not. The Respondent's activities in this regard are calculated and deceitful and therefore clearly in bad faith.

Therefore the Panel holds that the disputed domain name was registered and is used in bad faith.

## **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 <tretornshoescanada.com> be transferred to the Complainant.

*/William A. Van Caenegem/*

**William A. Van Caenegem**

Sole Panelist

Date: August 4, 2022