

ADMINISTRATIVE PANEL DECISION

Spyder Active Sports, Inc. v. Web Commerce Communications Limited, Client Care

Case No. D2022-4304

1. The Parties

The Complainant is Spyder Active Sports, Inc., United States of America, represented by Authentic Brands Group, United States of America.

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

2. The Domain Name and Registrar

The disputed domain name <spdcasale.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 November 11, 2022. On November 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 15, 2022, the Registrar transmitted by email to the Center its verification response:

- (a) confirming the disputed domain name is registered with it;
- (b) confirming the language of the registration agreement is English; and
- (c) 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 November 15, 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 amended Complaint on November 15, 2022.

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 November 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 7, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on December 15, 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

According to the Complaint, the Complainant is one of the world's largest winter sports brands with its products, particularly sports apparel and outerwear, being sold in more than 40 countries. The Complaint also alleges the Complainant has spent millions of dollars promoting its products through extensive advertising and sponsorships such as the United States Ski Team and professional skiers like Chris Davenport, Julia Mancuso, Julian Carr, Tommy Moe and race-car drivers Patrick Dempsey, James Hinchcliffe and Andrew Palmer.

In addition to physical outlets, the Complainant also sells and promotes its products from a website at "www.spyder.com".

The Complaint alleges that the Complainant has more than 150 trademark filings worldwide. It includes evidence of five registered trademarks in Canada. For present purposes, it is sufficient to note:

- (a) Canadian Registered Trademark No. TMA646,376, SPYDER, which has been registered since August 23, 2005, in respect of a range of clothing, hats, caps, boots and shoes;
- (b) Canadian Registered Trademark No. TMA646,360, SPYDER, which has also been registered since August 23, 2005, in respect of a wide range of clothing, outerwear, gloves, guards and protective equipment for ski and snowboard racing; and
- (c) Canadian Registered Trademark No. TMA629,307, Spider device, which has been registered since January 4, 2005, in respect of a range of clothing, footwear and headgear.

Each registration claims to have been used in Canada in respect of the registered goods since "as early 1979".

According to the Whois record, the disputed domain name was registered on May 5, 2022.

When the Complaint was filed, the disputed domain name resolved to a website which presented as offering for sale "Spyder" brand clothing and accessories. The heading banner featured a spider device which looks the same, or almost the same, as the Complainant's registered trademark and the word SPYDER in a similar font to that used on the Complainant's website although not italicized. The website appeared to offer products for sale in Canadian dollars. The footer simply states "Copyright © 2017 spdcasale Powered by Spyder Jacket Canada".

The Complainant contends the products apparently being offered for sale are counterfeit products.

5. Discussion and Findings

No response has been filed. The Complaint and Written Notice have been sent, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules. Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct Whois details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present his or its case.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of at least the five registered trademarks referred to in section 4 above including registrations for SPYDER in respect of clothing.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See *e.g.* WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".com" gTLD, the Complainant contends that the disputed domain name consists of three elements:

- (a) "spd" which the Complainant contends is an abbreviation or contraction for spider;
- (b) "ca" the country abbreviation for Canada; and
- (c) "sales".

Accordingly, the Complainant contends the disputed domain name is identical or confusingly similar to the Complainant's registered trademark.

The Panel can readily accept that the elements "ca" and "sales" can easily be seen as targeting Canada or the Canadian market. The Panel also accepts that "spd" are the first three of the four consonants in the word "spider" or "spyder". As a combination of three letters, however, it could be seen as an acronym for any number of things.

While generally the comparison is simply of the disputed domain name to the Complainant's trademark, panels have accepted that in cases of doubt it is permissible to look at the website to which the disputed domain name resolves and other contextual considerations to ascertain if *prima facie* the Respondent appears to be using the disputed domain name to target the Complainant's trademark. [WIPO Overview 3.0](#), section 1.15.

In the present case, the website clearly presents as offering for sale the Complainant's products by reference to the Complainant's trademark. Accordingly, the Panel accepts that the disputed domain name is targeting the Complainant's trademark. Bearing in mind that this requirement under the Policy is essentially a standing requirement, the Panel finds that the disputed domain name is confusingly similar to the Complainant's SPYDER trademark.

Accordingly, the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name well after the Complainant began using its trademark and also well after the Complainant had registered its trademark.

The disputed domain name is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived.

The website purports to be offering for sale clothing and associated products which, in the context of this case, precludes reliance on paragraph 4(c)(iii).

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The website does claim to be presented by "Spyder Jacket Canada". Given the idiosyncratic spelling and how long the Complainant has had its registered trademarks in Canada and, it appears, has been using its trademark, it does not seem likely that the Respondent has adopted that name independently of the Complainant. Certainly, having regard to those matters, the Panel would not be prepared to conclude that the Respondent had developed and adopted the name independently of the Complainant without some compelling explanation.

As the Respondent is not affiliated with or authorised by the Complainant, moreover, the use of "Spyder" misrepresents an association with the Complainant which, in the absence of some justification (which has not been advanced in this case), does not qualify as a good faith offering of goods or services. That is all the more so if, as the Complainant alleges, the goods being offered for sale are counterfeit.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent, however, has not sought to rebut that *prima facie* case or advance any claimed entitlement. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g. *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Paragraph 4(b) identifies situations which may demonstrate that registration or use of a disputed domain name was not in bad faith under the Policy:

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of [the disputed] domain name in bad faith:

(i) circumstances indicating that [the Respondent] has registered or [the Respondent has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent has] engaged in a pattern of such conduct; or

(iii) [the Respondent has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] website or location or of a product or service on [the Respondent's] web site or location.

The instances of bad faith set out in paragraph 4(b) of the Policy are examples only, intended to illustrate types of conduct which is caught by the Policy. See *Do The Hustle, LLC v Tropic Web*, WIPO Case No. [D2000-0624](#).

Given the short time between registration of the disputed domain name and its resolution to the website, it is reasonable to infer that the disputed domain name was registered for the purpose to which the Respondent has put it. Having regard to the content of the Respondent's website, therefore, there can be little (if any) doubt that the Respondent was well aware of the Complainant's trademark when registering the disputed domain name.

It appears therefore that the Respondent registered the disputed domain name to attract to its website customers and potential customers looking for the Complainant's products. That clearly constitutes registration of the disputed domain name in bad faith under the Policy. Furthermore, the implementation of that arrangement constitutes use in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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, <spdcasale.com>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: December 29, 2022