

ADMINISTRATIVE PANEL DECISION

Johnson Outdoors Inc. v. Gbcds Ybsfs
Case No. D2023-1255

1. The Parties

The Complainant is Johnson Outdoors Inc., United States of America, represented by Reinhart Boerner Van Deuren P.C., United States of America.

The Respondent is Gbcds Ybsfs, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <scubaprosale.com> (the “Disputed Domain Name”) is registered with Name.com, Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 22, 2023. On March 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 23, 2023, 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 (Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 24, 2023 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 March 24, 2023.

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 March 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 18, 2023.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on May 3, 2023. 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 a corporation organized under the laws of the United States (“U.S.”) producing outdoor recreational products, including watercrafts, diving equipment, water sports equipment, dive clothing, watersports clothing, fishing gear, outdoor clothing, and camping gear. The Complainant has operations in ten countries across four continents, covering for example Japan, Australia, France, and Germany.

According to the Complaint, the Complainant has used word and figurative trademarks for or containing “SCUBAPRO” (“the Complainant’s Trademark”) since as early as June of 1962 in the U.S. The relevant trademarks include, *inter alia*, U.S. Trademark Registration No. 777307 for “SCUBAPRO” in Class 22

registered on September 22, 1964, and U.S. Trademark Registration No. 3579015 for the mark ‘’ in Classes 8, 9, 18, 25, and 28, registered on February 24, 2009. Apart from the U.S. trademark registrations, the Complainant holds a large number of trademark registrations for or containing the Complainant’s Trademark around the globe, including in Hong Kong, China, where the Respondent is apparently located.

The Complainant’s Trademark is also fully incorporated in the Complainant’s domain name <scubapro.com> which resolves to the Complainant’s website at “https://scubapro.johnsonoutdoors.com/us” (the “Complainant’s Website”).

The Disputed Domain Name was registered by the Respondent on July 26, 2022, which is over 60 years after the Complainant first used the Complainant’s Trademark. The Disputed Domain Name resolves to a website featuring the Complainant’s Trademark, the Complainant’s  trademark, and the Complainant’s product images and offering purported SCUBAPRO products for sale at discounted prices (the “Website”).

5. Parties’ Contentions

A. Complainant

The Complainant’s primary contentions can be summarized as follows:

- (a) The Disputed Domain Name is identical or confusingly similar to the Complainant’s Trademark. The Complainant’s Trademark is reproduced in its entirety in the Disputed Domain Name. Apart from the Complainant’s Trademark, the only element in the Disputed Domain Name is the word “sale” which does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant’s Trademark.
- (b) The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not obtained any authorization from the Complainant to use the Complainant’s Trademark as part of a domain name or otherwise. Furthermore, the Complainant believes that the Respondent has been passing off the Website as belonging to the Complainant by using the Complainant’s trademarks (including the Complainant’s Trademark), product names and images on the Website. The Respondent’s products are identical to the Complainant’s products displayed on the Complainant’s Website. There is a clear intent to confuse consumers into believing that the Respondent and the Disputed Domain Name are associated with the Complainant and the suspected counterfeit SCUBAPRO products offered on the Website. Moreover, the Complainant claims that the Website deceives customers into providing their personal and financial information. Such use of the Disputed Domain Name cannot be considered as legitimate noncommercial or fair use without the intent for commercial gain.
- (c) Both the Respondent’s registration of and use of the Disputed Domain Name establish the Respondent’s bad faith. Given the history of the SCUBAPRO brand and the goodwill and reputation that the Complainant has acquired in the Complainant’s Trademark, the Respondent must have been fully aware of the existence of the Complainant’s rights in the Complainant’s Trademark when the Respondent registered and used the Disputed Domain Name. The Website attempts to pass off as the Complainant’s Website in order to attract Internet users to the Website for the sale of competing and suspected counterfeit goods and lure them into divulging their personal and financial information.

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 is required to prove each of the following three elements:

- (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 by the Respondent in bad faith.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in the Complainant's Trademark based on various trademark registrations listed in Section 4 and in the Complaint.

It is well established that in making an enquiry as to whether a trademark is identical or confusingly similar to a domain name, the addition of a descriptive, geographical, pejorative, or meaningless term would not prevent a finding of confusing similarity under the first element. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Panel therefore finds that the mere addition of the term "sale" does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Trademark. Furthermore, it is well established that the generic Top-Level Domain ("gTLD"), ".com" in this case, may be disregarded. See 1.11.1 of the [WIPO Overview 3.0](#).

As such, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark, and accordingly, paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

The Panel accepts that the Complainant has not authorized the Respondent to use the Complainant's Trademark. There is no relationship between the Complainant and the Respondent, which would otherwise entitle the Respondent to use the Complainant's Trademark. Accordingly, the Panel is of the view that a *prima facie* case has been established by the Complainant and it is for the Respondent to show rights or legitimate interests in the Disputed Domain Name.

Once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent in a disputed domain name, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent did not submit a formal Response. The fact that the Respondent did not submit a formal Response does not automatically result in a decision in favor of the Complainant. However, the Respondent's failure to file a formal Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (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 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.

The Panel agrees with the Complainant that there is no evidence to show that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name.

There is no evidence to suggest that the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name, is in connection with a *bona fide* offering of goods or services. The goods offered for sale on the Website, while clearly unauthorized by the Complainant, are suspected to be counterfeit products of the Complainant's genuine SCUBAPRO products and seek to take unfair advantage of the Complainant's Trademark and reputation (see *Prada S.A. v. Chen Mingjie*, WIPO Case No. [D2015-1466](#); *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#)). Even if the goods were genuine SCUBAPRO products, the Website does not display any disclaimer of a lack of relationship between the Complainant and the Respondent.

Accordingly, the Panel agrees with the Complainant that the Respondent's use of the Disputed Domain Name cannot constitute a *bona fide* offering of goods or be regarded as legitimate noncommercial or fair use. In particular, the Respondent would likely not have adopted the Complainant's Trademark and applied the Complainant's product names and images, if not for the purpose of creating an impression that the Website and the goods offered on the Website are associated with the Complainant, or otherwise taking advantage of the goodwill and reputation in the Complainant's Trademark. The reinforcement of Internet users' impression that a domain name belongs to the complainant or that a website is presented as if it is the official website of the complainant cannot be a *bona fide* offering of goods and service (See *L'Oréal SA v. PrivacyProtect.org/ WangShanShan*, WIPO Case No. [D2014-0295](#)). In this regard, the Panel also notes that the nature of the Disputed Domain Name, which incorporates the Complainant's Trademark in its entirety with the addition of the term "sale", carries a risk of implied affiliation. See Section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety. After reviewing the supporting evidence submitted by the Complainant, the Panel agrees with the Complainant that the Complainant's Trademark appears to be well-known. A quick Internet search conducted by the Panel shows that the top search results returned for the keyword "SCUBAPRO" are the Complainant's Website and third-party websites providing information about the Complainant and/or its products. Therefore, the Panel agrees that the Respondent must have been aware of the Complainant and its rights in the Complainant's Trademark when registering and using the Disputed Domain Name.

In addition, the Panel finds that the following factors support a finding that the Disputed Domain Name was registered and has been used by the Respondent in bad faith:

- (i) The Respondent registered and is using the Disputed Domain Name to mislead and divert Internet users to the Website for commercial gain by creating a likelihood of confusion with the Complainant's Trademark as to the source, the Complainant's sponsorship, affiliation, or endorsement of the Website. See section 3.1 of the WPO Overview 3.0. The fact that the Respondent added the term "sale", which is commonly used in retail business to identify discounted products, to the Disputed Domain Name supports this finding.
- (ii) It is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that the Disputed Domain Name is confusingly similar to the Complainant's Trademark and that the Website is being used to sell suspected counterfeit SCUBAPRO products at discounted prices. Without any form of disclaimer or other mention of a lack of connection with the Complainant, the Website has applied the Complainant's trademarks (including the Complainant's Trademark), copyrighted images and names of the Complainant's products.
- (iii) The Respondent registered the Disputed Domain Name using a privacy shield to conceal the Respondent's identity (see *Primonial v. Domain Administrator, PrivacyGuardian.org / Parla Turkmenoglu*, WIPO Case No. [D2019-0193](#)).

The Panel also notes that the Respondent failed to respond to the Complainant's contentions and has provided no evidence of any actual or contemplated good faith use of the Disputed Domain Name. This further supports a finding of bad faith registration and use of the Disputed Domain Name.

In the circumstances, the Panel finds that the Respondent registered and is using the Disputed Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

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, <scubaprosale.com>, be transferred to the Complainant.

/Gabriela Kennedy/
Gabriela Kennedy
Sole Panelist
Date: May 17, 2023