



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1400601
Complainant:	NBA PROPERTIES, INC.
Respondent:	luke deering
Disputed Domain Name(s):	<nbafootwear.com>

1. The Parties and Contested Domain Name

The Complainant is NBA PROPERTIES, INC., of Olympic Tower, 645 Fifth Avenue, New York, 10022, United States.

The Respondent is Luke Deering, of 89 Yawpo Ave, Oakland, New Jersey, 07436, United States.

The domain name at issue is <nbafootwear.com>, registered by Respondent with GoDaddy.com LLC, of 1455 North Hayden Rd, Suite 219, Scottsdale AZ 85260, United States.

2. Procedural History

The Complainant filed a Complaint on April 21, 2014 with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (ADNDRC) (the “Centre”), concerning domain name <nbafootwear.com> (the “disputed domain name”) and naming Luke Deering as Respondent.

On April 22, 2014, the Centre sent an e-mail to GoDaddy.com LLC requesting registrar verification of the disputed domain name. GoDaddy.com LLC e-mailed a response on April 23, 2014, stating that Luke Deering is listed as the registrant.

The Centre sent an e-mail to the Respondent on April 25, 2014, stating that a Complaint had been filed against him concerning the disputed domain name.

The Respondent did not submit a response to the Complaint.

3. Factual background

The Complainant is the owner of numerous registrations at the USPTO for the word trademark NBA, including registration number 1,525,782, dated of February 21, 1989 and registration number 1,505,559, dated of September 27, 1988.

The Complainant serves as the marketing and licensing arm of the National Basketball Association (“NBA”), which it describes as “the preeminent men’s basketball league in North America and one of the most well-known in the world”. Sporting competitions promoted by Complainant under the NBA trademark are viewed by millions of television viewers, including over NBA TV, the association’s own channel. The Complainant maintains an active commercial website at “www.nba.com”, which averages tens of millions of page views per day. The Complainant has provided evidence that its principal website is among the most heavily visited in the United States and worldwide.

The Respondent Luke Deering is the registrant of the domain name <nbafootwear.com>. The domain name was registered on September 20, 2010 and currently redirects to a standard registrar’s page including pay-per-click advertising.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The Complainant contends that the disputed domain name is identical or confusingly similar to the NBA trademark since the disputed domain name incorporates the NBA trademark in its entirety with the mere addition of the term “footwear” which designates a type of products sold on the Complainant’s website.
- ii. The Complainant claims that the Respondent cannot demonstrate that it has any rights to or legitimate interests in the disputed domain name. It has not authorized the Respondent to use the NBA trademark. Also, the Respondent is not using the disputed domain name with a *bona fide* offering of goods or services or for legitimate noncommercial or fair use.
- iii. The Complainant submits that the disputed domain name has, as covered by the Policy, paragraph 4(a)(iii), been registered and is being used in bad faith. Having submitted that its NBA trademark is well-known, the Complainant submits that it is unlikely that the Respondent would have selected and registered the disputed domain name without knowing about the reputation of the NBA trademark.
- iv. The Complainant furthermore contends that the disputed domain name is being used to post a standard registrar’s parking page which attracts customers and generates click-through revenues.

B. Respondent

The Respondent did not reply to the Complainant’s contentions and is therefore in default.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

The Complainant provided sufficient evidence demonstrating that it has numerous registered trademarks in the NBA signs and particularly in the United States and China.

The disputed domain name consists of the Complainant's trademark, in its entirety, together with the term "footwear". It has been held in many previous UDRP cases that incorporating a trademark in its entirety is typically sufficient to establish that a disputed domain name is identical or confusingly similar to a registered trademark (see *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286 and *World Wrestling Federation Entertainment, Inc. v. Ringside Collectibles*, WIPO Case No. D2000-1306).

The only difference between the Complainant's trademark and the disputed domain name is the addition of the descriptive term "footwear". The addition of a word that describes the Complainant's goods or services is even more likely to confuse Internet users (see *Ansell Healthcare Products Inc. v. Australian Therapeutic Supplies Pty. Ltd.*, WIPO Case No. D2001-0110 and *Eveready Battery Company, Inc. v. Oscar Haynes*, WIPO Case No. D2003-1005). The term "footwear" actually reinforces confusion since Complainant offers footwear and related products for sale on its website.

When it comes to the adjunction of gTLD ".com", it is now well established that the generic top-level domain should not be taken into account when evaluating the identity or similarity between a disputed domain name and the Complainant's trademark. See *Research in Motion Limited v. Input Inc., Domain Manager*, WIPO Case No. D2011-2197. Thus, the TLD ".com" is without legal significance since the use of a TLD is technically required to operate the domain name.

In view of the above, the Panel finds that the Complainant's trademark is readily recognizable as such within the disputed domain name despite the addition of the term "footwear" and overall, it is likely to lead to Internet user confusion. The Complainant has proven that the disputed domain name is identical or confusingly similar to the trademark in which it has demonstrable rights.

Therefore the Panel finds that the domain name at issue is confusingly similar to the trademarks of the Complainant. The first condition required to be satisfied under paragraph 4(a)(i) is therefore fulfilled.

B) Rights and Legitimate Interests

Paragraph 4(c) of the Policy sets out how a respondent can demonstrate rights to or legitimate interests in a disputed domain name. In the present case, the Respondent has not filed any submission or evidence to demonstrate its rights to or legitimate interests in the disputed domain name. Consequently, paragraph 14(b) of the Rules allows the Panel, in the absence of exceptional circumstances, to draw such inferences from the absence of Response from the Respondent as it considers appropriate.

The trademark NBA is well-known worldwide. *See for example NBA Properties, Inc. v. Huang Li Technology Corp. c/o Dynadot Privacy*, WIPO Case No. D2013-0011. The Panel finds that the Respondent is trying to benefit from the reputation of the Complainant's well known trademark. The Respondent has chosen to use a domain name that contains the Complainant's trademark in its entirety without authorization of the Complainant.

There is no evidence before the Panel to show that the Respondent was acting in pursuance of any rights or legitimate interests when registering the disputed domain name. In addition, the Complainant has denied having any connection with the Respondent or authorization at all. In *Guerlain S.A. v. Peikang*, WIPO Case No. D2000-0055, the Panel stated that "in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain incorporating those trademarks, it is clear that no actual or contemplated *bona fide* or legitimate use of the domain name could be claimed by the Respondent".

Despite the opportunity provided through this procedure, the Respondent has chosen not to assert any rights or legitimate interests in the disputed domain name.

Based on the above, the Panel considers the Complainant has made a *prima facie* case that the Respondent lacks rights to or legitimate interests in the disputed domain name.

Therefore, the Complainant has shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

C) Bad Faith

To succeed in such a proceeding, the Complainant must show not only that the domain name at issue is identical or confusingly similar to its registered trademark and that Respondent has no rights to or legitimate interests in the domain name, but also that the Respondent registered and used the domain name in bad faith.

The Complainant has submitted ample evidence and argument to support the conclusion that the registration of the disputed domain name was made in bad faith.

In the Panel's view, the Respondent's registration of the disputed domain name represents deliberate disregard of the Complainant's trademark rights. Clearly the Respondent knew of the Complainant's well known trademark at the time of registration as the Complainant's trademark is used in its entirety in the disputed domain name. As stated in *Oakley, Inc. v. Joel Wong/Blue Host.com- INC.*, WIPO Case No. D2010-0100, "it is inconceivable that the Respondent registered the disputed domain name without prior knowledge of the Complainant's rights". Also, as expressed in *Singapore Airlines Limited v. European Travel Network*, WIPO Case No. D2000-0641, where the selection of domain names is so obviously connected to the Complainant's trademark their very use by someone with no connection with the company suggests opportunistic bad faith. Similarly, in *Sony Kabushiki Kaisha (also trading as Sony*

Corporation) v. Inja, Kil, WIPO Case No. D2000-1409, where the respondent registered a number of domain names incorporating a well known trademark in its entirety, the panel stated, “that it is inconceivable that the respondent could make any active use of the disputed domain names without creating a false impression of association with the complainant”.

It was the Respondent’s duty to establish that the registration of the disputed domain name does not infringe any rights or any third party. A quick Internet search would have revealed Complainant’s trademarks to the Respondent. Failure to do such a search is a contributory factor to bad faith.

Therefore, the Panel finds that the Respondent has registered the domain name at issue in bad faith. Under the third UDRP condition, the Complainant has to prove not only that the domain name was registered in bad faith but also that it is used in bad faith.

By using the trademarks held by the Complainant as well as a term designating products that the Complainant offers for sale on its website, the Respondent has, in the Panel’s opinion, used the disputed domain name in bad faith.

The Respondent’s use of the disputed domain name with the intention to attract Internet users for commercial gain is established by the sponsored links on its webpage. The likelihood of confusion as to source, sponsorship, affiliation or endorsement is evidenced by the fact that the disputed domain name is confusingly similar to the Complainant’s trademarks. The Panel therefore finds that the Respondent profited from the goodwill associated with the Complainant’s trademark by collecting click-through fees and that the Respondent used the domain name in bad faith.

Noting that the Respondent has not rebutted any of the Complaint, the Panel considers that the Respondent’s choice of the disputed domain name was a deliberate action to gain a commercial advantage.

On the basis of the above, the Panel is satisfied that the Respondent’s conduct falls within paragraph 4(a)(iii) of the Policy.

6. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy, the Panel orders that the disputed domain name <nbafootwear.com> be transferred to the Complainant.

A handwritten signature in black ink, consisting of a series of connected strokes that form the name 'Nathalie Dreyfus'.

Nathalie Dreyfus
Panelist

Dated: May 27, 2014