



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK-1400605
<b>Complainant:</b>	NBA Properties, Inc.,
<b>Respondent:</b>	Domain Administrator/Fundacion Private Whois
<b>Disputed Domain Name:</b>	<nbashoes.com>

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**1. The Parties and Contested Domain Name**

The Complainant is NBA Properties, Inc., of Olympic Tower Bldg., 645 Fifth Avenue New York, NEW YORK 10022, United States of America.

The authorized representative of the Complainant is Beijing Jieding IP Agency Co of 1601 Central Tower, 8 GuanghuaDongli, Jianguomenwai Avenue, Beijing 100020, China.

The Respondent is Domain Administrator/Fundacion Private Whois of nbashoes.com, Aptds. 0850-00056, Panama, Zona 15, Panama.

The domain name at issue is <nbashoes.com>. The domain name is registered with Internet.bs.Corp of 98 Hampshire Street, Nassau N-4892, Bahamas.

**2. Procedural History**

On April 23, 2014 the Complaint was filed with the Asian Domain Name Dispute Resolution Centre ("the Centre"). The Centre received the appropriate case filing fee by bank transfer on April 23, 2014.

On April 24, April 29, May 8 and May 16, 2014, the Centre transmitted by email to Internet.bs.Corp a request for registrar verification in connection with the registrant of the disputed domain name. On May 19, 2014, Internet.bs.Corp transmitted by email its verification response that the registrant of the disputed domain name is Domain Administrator/Fundacion Private Whois and that its email address is 5363a106spslylmy@udrp.privatewhois.net. On May 19, 2014 the Complainant advised the Centre that a copy of the Complaint, including all annexes, together with the transmittal coversheet, was sent to the respondent on 23 April 2014. The Centre 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 ADNDRC Supplemental Rules for Uniform

Domain Name Dispute Resolution Policy (the "Supplemental Rules"). Also on May 19, 2014, the Centre served the Complainant by forwarding to it, by email addressed to "5363a106spslylmy@udrp.privatewhois.net"; "5363a106johif8yt@udrp.privatewhois.net"; and "postmaster@nbashoes.com" the Written Notice herein together with the Complaint and the annexures thereto. The Written Notice stated that the date of commencement of the proceedings was May 19, 2014 and that the due date by which the Respondent was required to file its Response was June 8, 2014.

No Response was filed by the due date or at all and on June 9, 2014 the Centre notified the parties of that fact.

On June 27, 2014, the Centre appointed The Honourable Neil Anthony Brown QC as Panelist in the administrative proceeding. 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 Centre to ensure compliance with the Rule 7.

The Panel finds that the Asian Domain Name Dispute Resolution Centre has performed its obligations under Rule 2(a) of the Rules "to employ reasonably available means calculated to achieve actual notice to Respondent". Accordingly, the Panel is able to issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the Asian Domain Name Dispute Resolution Centre Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from the Respondent.

### **3. Factual background**

The Complainant is a company incorporated pursuant to the laws of the United States of America and is a subsidiary of the prominent National Basketball Association ("NBA"), the pre-eminent men's professional basketball league in North America. It is the owner and/or exclusive licensor of trademarks and logos of the NBA which are used on goods including shoes sold on behalf of the NBA. The NBA has a very popular website at [www.nba.com](http://www.nba.com) and uses social media widely.

The Respondent registered the disputed domain name on May 2, 2003. It now resolves to a parking page promoting products that are competitive with products supplied by the NBA. The Respondent has also concealed its true identity by using a privacy service.

### **Parties' Contentions**

#### **A. Complainant**

The Complainant's contentions are as follows:

1. The Complainant claims rights in its registered NBA trademark.
2. The disputed domain name is confusingly similar to the NBA trademark.
3. That is so because the domain name incorporates the NBA trademark and the word "shoes" which is a generic word describing one of the Complainant's products. Accordingly, internet users would assume that the domain name was a

domain name of the Complainant related to the Complainant and its business and used for the sale of its shoes.

4. The disputed domain name was registered by the Respondent on May 2, 2003.
5. The Respondent has no rights or legitimate interests in the disputed domain name as the Respondent has been using it to sell competing goods in breach of the Policy.
6. The disputed domain name was registered and is being used in bad faith as the Respondent has been using the website to sell competing NBA goods and was aware of the Complainant's ownership of the NBA trademark before the domain name was registered.

**B. Respondent**

The Respondent failed to file a Response in this proceeding.

**5. Findings and Discussion of the Issues**

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 the 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 first question that arises is whether the Complainant has a trademark on which it can rely. The Complainant has adduced evidence that the Panel accepts to the effect that the Complainant has trademark rights on which it can rely with respect to the disputed domain name.

The Complainant claims registered trademark rights in a series of registered trademarks including: US trademark No.0864034 for NBA, registered with the United States Patent and Trademark Office on January 21, 1969 and Registration No. 1170761 for NBA registered on April 28, 1998 with the Chinese trademark authority, collectively referred to hereafter as "the NBA trademark."

Accordingly, the Complainant has proved that it has a trademark on which it may rely.

The second question that arises is whether the disputed domain name may be said to be identical or confusingly similar to the NBA trademark. The Panel finds that the disputed domain name is confusingly similar to the NBA trademark as, in making this comparison, the gTLD suffix ".com" is to be ignored and the objective internet user would naturally assume that a domain name incorporating a trademark and adding only the word "shoes", one of the products of the famous NBA and associated with its activities, is similar and confusingly so to the trademark.

The Complainant has therefore established the first of the three elements that it must establish.

## **B) Rights and Legitimate Interests**

It is now well established that the Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a) (ii) of the Policy and then the onus of proof shifts to the Respondent to show it does have rights or legitimate interests. There are many decisions to that effect, one of the most notable of which is *Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) where it was held that a complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the UDRP before the onus of proof shifts to the respondent to show that it does have rights or legitimate interests in the domain name).

Having regard to the evidentiary case presented on behalf of the Complainant, the Panel finds that the Complainant has made out a *prima facie* case that arises from the following considerations:

- (a) the Respondent has chosen to take the Complainant's prominent NBA trademark and to use it in its domain name making only the addition of the word "shoes" to the trademark;
- (b) the unchallenged evidence is that the Respondent had no authority to register the domain name and to use it as it has done, namely to sell goods that are in competition with the goods of the NBA and in circumstances where it must be assumed that this was being done for financial gain;
- (c) the Respondent has engaged in these activities without the consent or approval of the Complainant.

These matters go to make out the *prima facie* case against the Respondent and, the onus of proof having been reversed, it is then up to the Respondent to rebut that case.

As the Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has thus made out the second of the three elements that it must establish.

## **C) Bad Faith**

It is clear that to establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith.

That case may be made out if there are facts coming within the provisions of paragraph 4(b) of the Policy. That paragraph sets out a series of circumstances that are to be taken as evidence of the registration and use of a domain name in bad faith, namely:

"... (i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or

to a competitor of Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

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

(iii) 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, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location."

However, those criteria are not exclusive and Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression and frequently do so.

Having regard to those principles, the Panel finds that the disputed domain name was registered and used in bad faith. That is so for the following reasons.

The Respondent registered the disputed domain name in bad faith because it must have known at all times that it had no right to register it because of the existence of the famous NBA and its equally famous trademark.

The Respondent used the domain name in bad faith by using it to sell goods, namely shoes, that compete with NBA goods. The Respondent did this at a time when it must have known that he had no rights to the domain name at all. It is no exaggeration to say that the Respondent has acted dishonestly and had no right to obtain and use the domain name in the way it has done or in any other way and has not attempted in a Response to explain its actions.

These facts bring the case squarely within the provisions of paragraphs 4(b) (iii) and 4(b) (iv) of the Policy.

Moreover, the fact that the Respondent has hidden its true identity behind a privacy service puts it beyond doubt that the Respondent has acted in bad faith both in registering and using the disputed domain name.

Having regard to the totality of the evidence, the Panel finds that, in view of Respondent's acquisition of the disputed domain name and using it in the manner described, the Respondent registered and used the disputed domain name in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the three elements that it must establish.

## 6. Decision

Having established all three elements required under the Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name, <**nbashoes.com**> be TRANSFERRED to the Complainant.

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The Honourable Neil Anthony Brown QC

Dated: June 27, 2014