

ADMINISTRATIVE PANEL DECISION

Daniel Wellington AB v. Web Commerce Communications Limited, Client Care

Case No. D2023-4015

1. The Parties

The Complainant is Daniel Wellington AB, Sweden, represented by SILKA AB, Sweden.

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

2. The Domain Names and Registrar

The disputed domain names <danielwellingtonargentina.com>, <danielwellingtonaustralia.com>, <danielwellington-belgie.com>, <danielwellingtonbelgie.com>, <danielwellingtoncanada.com>, <danielwellingtonchile.com>, <danielwellingtondanmark.com>, <danielwellingtonecuador.com>, <danielwellingtonespana.com>, <danielwellingtonfrance.com>, <danielwellingtongreece.com>, <danielwellingtonhrvatska.com>, <danielwellingtonhungary.com>, <danielwellingtonindia.com>, <danielwellingtonireland.com>, <danielwellingtonitalia.com>, <danielwellingtonjapan.com>, <danielwellingtonksa.com>, <danielwellingtonlondon.com>, <danielwellingtonmalaysia.com>, <danielwellingtonmexico.com>, <danielwellington-nederland.com>, <danielwellingtonnederland.com>, <danielwellingtonnorge.com>, <danielwellingtonoutlet.com>, <danielwellingtonperu.com>, <danielwellingtonphilippines.com>, <danielwellingtonportugal.com>, <danielwellingtonromania.com>, <danielwellingtonschweiz.com>, <danielwellingtonslovenia.com>, <danielwellingtonsuomi.com>, <danielwellington-thailand.com>, <danielwellington-turkiye.com>, <danielwellingtonturkiye.com>, <danielwellingtonuae.com>, <danielwellington-uk.com>, and <daniel-wellingtonusa.com> (the “Domain Names”) are 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 September 25, 2023. On September 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On September 28, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (Not Disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 28, 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 the same day.

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 October 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 1, 2023.

The Center appointed Olga Zalomiy as the sole panelist in this matter on November 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 Swedish fashion company established in 2011, specializing in the design and production of watches, jewelry, and accessories. The Complainant owns various internationally registered trademarks featuring the DANIEL WELLINGTON formative. For example, the Complainant owns the following DANIEL WELLINGTON trademark registrations in Malaysia, where the Respondent is located:

- Malaysia trademark registration No. 2013013212, registered on September 20, 2013;
- Malaysia trademark registration No. 2013013211, registered on September 20, 2013; and
- Malaysia trademark registration No. 2013013210, registered on September 20, 2013.

On May 25, 2023, the Respondent registered the following Domain Names:

<daniel-wellingtonusa.com>, <danielwellington-uk.com>, <danielwellingtonargentina.com>, <danielwellingtonaustralia.com>, <danielwellingtonbelgie.com>, <danielwellingtoncanada.com>, <danielwellingtonchile.com>, <danielwellingtondanmark.com>, <danielwellingtonecuador.com>, <danielwellingtonespana.com>, <danielwellingtonfrance.com>, <danielwellingtongreece.com>, <danielwellingtonhrvatska.com>, <danielwellingtonhungary.com>, <danielwellingtonindia.com>, <danielwellingtonireland.com>, <danielwellingtonitalia.com>, <danielwellingtonjapan.com>, <danielwellingtonksa.com>, <danielwellingtonlondon.com>, <danielwellingtonmalaysia.com>, <danielwellingtonmexico.com>, <danielwellingtonnederland.com>, <danielwellingtonnorvege.com>, <danielwellingtonoutlet.com>, <danielwellingtonperu.com>, <danielwellingtonphilippines.com>, <danielwellingtonportugal.com>, <danielwellingtonromania.com>, <danielwellingtonschweiz.com>, <danielwellingtonslovenia.com>, <danielwellingtonsuomi.com>, <danielwellingtonturkiye.com>, and <danielwellingtonuae.com>.

On July 25, 2023, the Respondent registered the Domain Names <danielwellington-belgie.com>, and <danielwellington-nederland.com>. On July 30, the Respondent registered the Domain Name <danielwellington-turkiye.com>. Finally, the Respondent registered the Domain Name <danielwellington-thailand.com> on August 10, 2023.

The Domain Names used to direct to online stores offering for sale products under the Complainant's DANIEL WELLINGTON trademark. The websites under the Domain Names displayed the Complainant's trademarks, as well as photographs and purportedly offered for sale the DANIEL WELLINGTON branded products at discounted prices. At some point before the Complaint was filed, the following Domain Names became inactive: <danielwellington-belgie.com>, <danielwellington-nederland.com>, <danielwellington-uk.com>, <danielwellingtonaustralia.com>, <danielwellingtonbelgie.com>,

<danielwellingtondanmark.com>, <danielwellingtonespana.com>, <danielwellingtonfrance.com>, <danielwellingtonitalia.com>, <danielwellingtonmexico.com> <danielwellingtonnederland.com> <danielwellingtonnorge.com> <danielwellingtonoutlet.com>, <danielwellingtonportugal.com>, <danielwellingtonsuomi.com>, and <danielwellingtonuae.com> (the “Inactive Domain Names”). The remaining Domain Names still direct to online stores offering for sale purported DANIEL WELLINGTON watches.

5. Parties’ Contentions

A. Complainant

The Complainant’s contentions can be summarized as follows:

The Complainant asserts that the Domain Names include the entirety of the Complainant’s DANIEL WELLINGTON mark, along with elements such as hyphens, country names, country codes, generic terms, and the generic Top-Level Domain (“gTLD”) “.com.” Despite these variations, the Complainant argues that the recognizable presence of the DANIEL WELLINGTON mark within the Domain Names makes them confusingly similar. The addition of other terms, whether descriptive, geographical, pejorative, or otherwise, is considered inconsequential to the finding of confusing similarity under the first element. The inclusion of the gTLD “.com” does not affect the determination of similarities between the Complainant’s DANIEL WELLINGTON mark and the Domain Names.

The Complainant asserts that the Respondent lacks rights or legitimate interests in the Domain Names for the following reasons: 1) the Complainant has not granted authorization to the Respondent for the use of its DANIEL WELLINGTON mark in any capacity or context, 2) the Respondent is not affiliated with the Complainant, and 3) the Respondent is not commonly known by the Domain Names. The Respondent’s use of the Domain Names does not constitute legitimate noncommercial or fair use, as the websites they resolve to closely mimics the Complainant’s trademark, display copyrighted images without authorization, lack disclaimers of any association with the Complainant, and offer DANIEL WELLINGTON-branded products at a significant discount. Although some of the Domain Names are currently inactive, the Complainant argues that they previously hosted similar websites to the active ones.

The Complainant asserts that the Domain Names were registered and are being used in bad faith because the reproduction of the Complainant’s mark, that was registered many years prior to the Domain Names, suggests that the Respondent selected them with the Complainant’s mark and activities in mind. The registration of thirty-eight domain names containing the well-known trademark is, by itself, indicative of bad faith. Moreover, the inclusion of country names, country codes, and generic terms related to the Complainant’s goods and activities in the Domain Names, along with the fact that they resolve to websites displaying the Complainant’s brand and purportedly offering its goods for sale, further supports the inference that the Respondent registered the Domain Names with the intention of attracting Internet users for commercial gain by causing confusion with the Complainant’s mark.

The Respondent’s passive holding of the 16 inactive Domain Names does not prevent a finding of bad faith because of the well-known status of the Complainant’s DANIEL WELLINGTON mark, the unavailability of the Respondent’s identity, and the lack of plausible good faith use. The historical use of those Domain Names, where they resolved to websites displaying the Complainant’s mark and offering its goods for sale without disclosing any lack of affiliation with the Complainant, reinforces the argument of intentional confusion for commercial gain.

The sale of purported DANIEL WELLINGTON-branded products with a substantial discount indicates the Respondent’s illegal activity.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to each the Domain Names:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (paragraph 4(a)(i)); and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must prove that the Domain Names are identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

The submitted evidence shows that the Complainant owns multiple trademark registrations for the DANIEL WELLINGTON trademark. Pursuant to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), this satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.

"Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element." Section 1.8, [WIPO Overview 3.0](#). It is well-established that the applicable gTLD should be disregarded under the confusing similarity test as a standard registration requirement. Section 1.11.1, [WIPO Overview 3.0](#).

The Domain Names consist of the DANIEL WELLINGTON trademark along with hyphens, country names, country codes, dictionary terms, and the gTLD ".com". Since the Complainant's DANIEL WELLINGTON trademark is clearly recognizable within the Domain Names, the inclusion of hyphens, country names, country codes, or dictionary terms does not prevent the finding of confusing similarity. Consequently, the Domain Names are confusingly similar to the Complainant's DANIEL WELLINGTON trademark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy outlines specific circumstances in which the Respondent is required to establish their rights or legitimate interests in a disputed domain name, which include:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the 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 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

While the primary burden of proof in UDRP proceedings lies with the complainant, it is acknowledged that asserting that a respondent lacks rights or legitimate interests in a domain name can be challenging, as it often necessitates the provision of negative evidence, which is usually within the respondent's knowledge or control. Consequently, when a complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of producing relevant evidence shifts to the respondent, requiring them to demonstrate their rights or legitimate interests in the domain name. In cases where the respondent fails to produce such evidence, the complainant is considered to have satisfied the second element of the UDRP. [WIPO Overview 3.0](#), Section 2.1.

In this case, there is no evidence to support that the Respondent has been commonly known by the Domain Name. The Domain Names are registered under the name of Web Commerce Communications Limited, Client Care. It is undisputed that the Respondent lacks any trademark registrations for the Domain Names. The Complainant asserts, and the Respondent does not contest, that the Complainant has not granted the Respondent any license or permission to use the DANIEL WELLINGTON trademark in the Domain Names or for any other purpose.

The Respondent is not making a legitimate noncommercial or fair use of the Domain Names. Initially, the Respondent used each of the Domain Names to direct to websites with an online store selling purported DANIEL WELLINGTON branded products at a significant discount, which likely indicates that the products are counterfeit. It is well-established that the use of a domain name for illegal activity does not confer rights or legitimate interests on its owner.

Even if the DANIEL WELLINGTON branded products sold on the websites at the Domain Names are genuine, previous UDRP panels have recognized that resellers or distributors using domain names containing the complainant's trademark to undertake sales of the complainant's goods may be making a *bona fide* offering of goods and thus have a right or legitimate interest in such domain names in some situations. Outlined in the *Okidata* case¹, the following cumulative requirements must be satisfied for the respondent to make a *bona fide* offering of goods and services:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to corner the market in domain names that reflect the trademark.

The Panel finds the Respondent has failed to meet the *Okidata* test outlined above. The websites at the Domain Names displayed the Complainant's trademarks, the Complainant's copyrighted images and offered for sale purported DANIEL WELLINGTON products. No specific information as to lack of affiliation between the Complainant and the Respondent was provided, let alone accurately and prominently disclaimed on the websites under the Domain Names. Instead, the following statements were displayed in the bottom part of some of the websites: "Copyright © 2023 danielwellington-turkiye Powered By danielwellington-turkiye.com", "Copyright © 2023 danielwellingtonusa Powered By daniel-wellingtonusa.com" or "Copyright © 2023 danielwellingtonireland Powered By danielwellingtonireland.com", all of which related to the Complainant, its trademarks and its watches. Such a statements coupled with the absence of a disclaimer created an impression of an affiliation between the Complainant and the Respondent.

At some point, the Complainant disabled the websites and are Inactive Domain Names. However, the current non-use of the Inactive Domain Names does not confer any rights or legitimate interests for the Respondent because webpages under the title "[t]he page is not working" do not show use or preparations to use the Inactive Domain Names in connection with a *bona fide* offering of goods or services. Nor is the

¹ *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Respondent making a legitimate noncommercial or fair use of the Domain Names. Here, the Respondent failed to file a response, provided incorrect contact information and has been engaged in a pattern of trademark abusive domain name registrations.

Consequently, the Panel determines that the Complainant has successfully established a *prima facie* case, and the burden of presenting evidence demonstrating rights or legitimate interests in the Domain Name has shifted to the Respondent.² As the Respondent has failed to provide any rebuttal evidence, the Complainant is deemed to have met the second element of the UDRP.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(a)(iii) of the Policy, the Complainant must prove that the Domain Names were registered and are being used in bad faith.

The registration of the Domain Names by the Respondent can be deemed as in bad faith for several reasons. Firstly, the Respondent registered these Domain Names a minimum of eight years after the Complainant had already registered its trademarks. Considering the Complainant's significant global online presence, it is evident that they have established a substantial footprint on the Internet. Therefore, a basic Internet search would have easily revealed the Complainant's existence to the Respondent. Additionally, the composition of the Domain Names strongly suggests that the Respondent had knowledge of the Complainant's trademark. This inference is further supported by the Respondent's use of the Complainant's copyrighted images and trademarks associated with the Domain Names. Consequently, it is reasonable to conclude that the Respondent either had actual knowledge of the Complainant's trademark or, at the very least, displayed a willful disregard for its existence – a behavior that many panels have previously recognized as indicative of bad faith.

The UDRP establishes that, for purposes of paragraph 4(a)(iii) of the Policy, "bad faith" registration and use of a domain name can be established by a showing of circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to source, sponsorship, affiliation or endorsement of the respondent's website or location, or of a product or service on the respondent's website or location. See Policy, paragraph 4(b)(iv).

Prior UDRP panels have found "the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: [...] (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name, [...] (vi) absence of any conceivable good faith use."³

Here, the websites at the Domain Names were designed to look like websites of an official or authorized reseller of the Complainant's products. The Respondent's websites prominently displayed the Complainant's DANIEL WELLINGTON trademark. Thus, it is likely that the Respondent registered the Domain Names with full knowledge of the Complainant and its trademark rights. Such registration is in bad faith.

The active websites of the Domain Names were likely used to offer for sale the counterfeits of the Complainant's goods. The websites that displayed the Complainant's copyrighted images and texts contained no information about its real owner.

Therefore, the Respondent is using the Domain Names to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's websites or other online locations, by creating a likelihood of confusion with the Complainant's marks as to source, sponsorship, affiliation or endorsement of the

² Section 2.1, [WIPO Overview 3.0](#).

³ Section 3.1.4, [WIPO Overview 3.0](#)

Respondent's websites or locations, or of a product or service on the Respondent's websites. Such use is in bad faith.

Previous UDRP panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the present record, the Panel finds the current non-use of the Inactive Domain Name does not prevent a finding of bad faith in the circumstances of this proceeding. [WIPO Overview 3.0](#), Section 3.3. Having reviewed the present record, the Panel notes the distinctiveness of the Complainant's trademark, the failure to submit a response, the composition of the Domain Names, thus finding that in the circumstances of this case the passive holding of the Domain Names does not prevent finding of bad faith under the Policy.

Finally, establishing bad faith registration and use of a domain name involves demonstrating circumstances wherein the respondent registered the domain with the intent to hinder the trademark or service mark owner from acquiring a corresponding domain. This is especially applicable if the respondent has consistently exhibited such behavior, as outlined in the UDRP, paragraph 4(b)(ii). Previous UDRP panels have already identified the Respondent's consistent pattern of registering domain names to impede trademark owners. In the current case, the Respondent's parallel actions concerning the Complainant's DANIEL WELLINGTON trademark validate the assertion of bad faith registration and use as per paragraph 4(b)(ii).

The Panel finds that the Complainant has satisfied the third element of the UDRP.

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 Domain Name, <danielwellingtonargentina.com>, <danielwellingtonaustralia.com>, <danielwellingtonbelgie.com>, <danielwellingtonbelgie.com>, <danielwellingtoncanada.com>, <danielwellingtonchile.com>, <danielwellingtondanmark.com>, <danielwellingtonecuador.com>, <danielwellingtonespana.com>, <danielwellingtonfrance.com>, <danielwellingtongreece.com>, <danielwellingtonhrvatska.com>, <danielwellingtonhungary.com>, <danielwellingtonindia.com>, <danielwellingtonireland.com>, <danielwellingtonitalia.com>, <danielwellingtonjapan.com>, <danielwellingtonksa.com>, <danielwellingtonlondon.com>, <danielwellingtonmalaysia.com>, <danielwellingtonmexico.com>, <danielwellingtonnederland.com>, <danielwellingtonnederland.com>, <danielwellingtonnorge.com>, <danielwellingtonoutlet.com>, <danielwellingtonperu.com>, <danielwellingtonphilippines.com>, <danielwellingtonportugal.com>, <danielwellingtonromania.com>, <danielwellingtonschweiz.com>, <danielwellingtonslovenia.com>, <danielwellingtonsuomi.com>, <danielwellington-thailand.com>, <danielwellington-turkiye.com>, <danielwellingtonturkiye.com>, <danielwellingtonuae.com>, <danielwellington-uk.com>, and <daniel-wellingtonusa.com>, be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: November 15, 2023