

ADMINISTRATIVE PANEL DECISION

Church and Co (Footwear) Limited v. yuansheng li
Case No. D2023-4070

1. The Parties

The Complainant is Church and Co (Footwear) Limited, United Kingdom, represented by Studio Barbero, Italy.

The Respondent is yuansheng li, China.

2. The Domain Name and Registrar

The disputed domain name <churchfootwearuk.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 28, 2023. On September 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 29, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center 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 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 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 9, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on November 29, 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 manufacturer of luxury footwear. It was founded in 1873 by Thomas Church in Northampton, England. In 1999, the company was bought by the Italian luxury fashion house PRADA. The Complainant sells its products in luxury stores around the world and through its official website at the domain name <church-footwear.com>, registered on April 18, 1996.

The Complainant is the owner of a number of trademark registrations for the signs “CHURCH” and “CHURCH’S” (together, the “CHURCH’S trademark”), including the following:

- the International trademark CHURCH’S with registration No. 829355, registered on May 26, 2004 for goods in International Classes 18, 25 and 35, designating a number of jurisdictions including China, where the Respondent appears to be located; and
- the European Union trademark CHURCH with registration No. 010775765, registered on September 5, 2012 for goods in International Classes 3, 9, 14, 16, 18, 25, 34 and 35.

The disputed domain name was registered on August 24, 2023. It directs to a website that prominently displays the Complainant’s CHURCH’S trademark and offers for sale footwear and other leather goods marked with the same trademark.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to its CHURCH’S trademark, because it incorporates the whole of the trademark with the addition of the non-distinctive elements “footwear” and “uk”, the latter of which may be interpreted as the country code for the United Kingdom. The Complainant notes that the addition to the CHURCH’S trademark of a geographical term and of a dictionary word related to the Complainant’s core business - the manufacturing and sale of shoes, is not a distinguishing feature, but may increase the confusion, since users may believe that the disputed domain name is used by the Complainant or by an entity affiliated to it in connection with its official web portal.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has not been authorized by the Complainant to use the CHURCH’S trademark or to register and use the disputed domain name, and is not an authorized reseller of the Complainant. The Complainant adds that the Respondent is not commonly known by a name corresponding to the disputed domain name and does not own any trademark registrations of the sign “Church”.

The Complainant points out that there is no evidence that before notice of the dispute the Respondent has used the disputed domain name in connection with a *bona fide* offering of goods or services or has made a legitimate noncommercial or fair use of it. Rather, the Respondent has used the disputed domain name to attract users to a website displaying the Complainant’s CHURCH’S trademark, where purported products of the Complainant are advertised and offered for sale at discounted prices, and which contains no disclaimer for the lack of affiliation between the website at the disputed domain name and the Complainant. According to the Complainant, the Respondent uses the disputed domain name in an attempt to confuse and mislead Internet users into believing that the website at the disputed domain name is operated by the Complainant or with its consent. The Complainant points out that the Respondent is using the disputed domain name to advertise and offer for sale *prima facie* counterfeit products, in view of the very low prices at which they are offered for sale. According to the Complainant, the lack of information about the entity operating the website at the disputed domain name supports the conclusion that the Respondent might have engaged in the sale of counterfeit goods and has indicated inaccurate and incomplete contact details to avoid being identified

and prosecuted for its illegal conduct. In the Complainant's view, such behavior demonstrates that the Respondent did not intend to use the disputed domain name in connection with any legitimate purpose, and its conduct cannot be considered as a *bona fide* offering of goods or services or as a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain. Rather, the Respondent attempts to gain from the sale of the products advertised on the website by free-riding the well-known CHURCH'S trademark of the Complainant and causing confusion amongst users as to the source or affiliation of its website and of the products offered for sale on it.

The Complainant further highlights that, irrespective of the nature of the products offered for sale on the website at the disputed domain name, no fair use could be invoked by the Respondent, since it attempts to impersonate the Complainant by indicating the name Church & Co Ltd in the copyright notice of the website at the disputed domain name.

The Complainant points out that the composition of the disputed domain name, combining the Complainant's CHURCH'S trademark with a descriptive term related to the Complainant's business and the geographical indicator "uk" - referring to the Complainant's country – the United Kingdom, carries a high risk of implied affiliation with the Complainant, especially considering that the Complainant operates its website at the very similar domain name <church-footwear.com>. The Complainant adds that the Respondent did not reply to its cease-and-desist letter of September 8, 2023.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It states that the registration of the CHURCH'S trademark predates the registration of the disputed domain name by several years, and adds that the CHURCH'S trademark has been extensively used since the 1870s in connection with the Complainant's products worldwide, including in the Respondent's country, and has been widely publicized globally and constantly featured throughout the Internet. According to the Complainant, the Respondent could not have possibly ignored the existence of the Complainant's CHURCH'S trademark when it registered the disputed domain name, with which it is confusingly similar. Indeed, the fact that purported Complainant's products are offered for sale and that the Complainant's CHURCH'S trademark is published on the website at the disputed domain name indicates that the Respondent is fully aware of the Complainant and its trademark.

The Complainant maintains that the use of the disputed domain name in connection with a commercial website, displaying the CHURCH'S trademark and offering for sale *prima facie* counterfeit goods branded with same trademark indicates that the Respondent's purpose in registering and using the disputed domain name was to intentionally attempt to attract Internet users seeking the Complainant's branded products to the website at the disputed domain name for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website at the disputed domain name and of the goods offered there.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the CHURCH'S trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the CHURCH'S trademark is recognizable within the disputed domain name, because it contains the distinctive element "church" of this trademark (and the entirety of the CHURCH trademark). Accordingly, the disputed domain name is confusingly similar to the CHURCH'S trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "footwear" and "uk") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the CHURCH'S trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel therefore finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity, (here, claimed sale of counterfeit goods and impersonation of the Complainant) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The evidence in this case shows that the website at the disputed domain name prominently displays the CHURCH'S trademark and logo with the exact same appearance as on the Complainant's website. The Respondent's website also has the same header as the Complainant's website ("Handmade English shoes for Men and Women") and the same copyright notice ("2023 Church & Co Ltd."). The "About Us" section of the Respondent's website states: "THE CHURCH'S STORY Our history, one that spans centuries, paints a meaningful portrait of a brand that fully appreciates the value of tradition and how it can keep us grounded while propelling us forward." There is no disclaimer for the lack of relationship with the Complainant and no information about the entity actually offering for sale the footwear and other products offered on the Respondent's website, and its Privacy Policy, Shipping Policy, Return Policy and Terms of Service contain unfinished sentences with blank spaces where the context requires the insertion of names and contact details about the provider of the goods. The prices indicated for these products are quite modest in comparison with the prices indicated on the official website of the Complainant, and the Complainant has submitted a price comparison of three random offerings on the Respondent's website, which shows that each of them is more than 15 times cheaper than the respective original product of the Complainant that looks exactly the same. One would not reasonably expect such price differences if the products offered by the Respondent were genuine goods manufactured by the Complainant.

Taking all the above into account, the Panel concludes that it is more likely that the Respondent has engaged in an illegitimate conduct where it attempts to impersonate the Complainant and to sell counterfeit goods by misleading Internet users that they are being offered genuine products of the Complainant. Such conduct cannot give rise to rights or legitimate interests in the disputed domain name.

Based on the available record, the Panel therefore finds that the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Further, Panels have held that the use of a domain name for illegal activity (here, claimed sale of counterfeit goods and impersonation of the Complainant) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

The Panel finds that the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

As discussed in the section on rights and legitimate interests, the evidence supports a conclusion that it is more likely than not that the Respondent has attempted to impersonate the Complainant in order to confuse and attract Internet users to its website, where to offer them counterfeit replicas of the Complainant's offerings at heavily discounted prices. Taking this into account, it appears likely that the Respondent's purpose in registering and using the disputed domain name was to intentionally attempt to attract Internet users seeking the Complainant's products to the website at the disputed domain name for commercial gain, by creating a likelihood of confusion with the Complainant's CHURCH'S trademark as to the source, sponsorship, affiliation, or endorsement of the website at the disputed domain name and of the goods offered on it.

Based on the available record, the Panel therefore finds that the Complainant has established the third element of the Policy.

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 <churchfootwearuk.com> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: December 8, 2023