

ADMINISTRATIVE PANEL DECISION

BA&SH v. Whois Agent, Domain Protection Services, Inc. / Yahui Mo, Kang Cao

Case No. D2022-0236

1. The Parties

Complainant is BA&SH, France, represented by Cabinet Bouchara, France.

Respondents are Whois Agent, Domain Protection Services, Inc., United States of America / Yahui Mo, China, Kang Cao, China.

2. The Domain Names and Registrar

The disputed domain names <bashsoldes.com> and <bashtienda.com> (the “Domain Names”) are registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 25, 2022. Also, on January 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. And on January 25, 2022, 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, and contact information in the Complaint. The Center sent an email communication to Complainant on January 26, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amended Complaint. Complainant filed an amended Complaint on January 27, 2022.

The Center verified that the Complaint together with the amended 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 Respondents of the Complaint, and the proceedings commenced on January 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 17, 2022. Respondents did not submit any response. Accordingly, the Center notified Respondents’ default on February 18, 2022.

The Center appointed Harrie R. Samaras as the sole panelist in this matter on February 28, 2022. 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.

In its Complaint, Complainant requests the Panel to find that the Domain Names are subject to common ownership or control and that this justifies consolidating the claims against Respondents in this proceeding to be fair and equitable to all parties and procedurally efficient. On January 27, 2022, the Center informed the parties “that there appears to be at least *prima facie* grounds sufficient to warrant accepting the Complaint for the Panel’s final determination of the consolidation request on appointment” and proceeded to the commencement and formal Complaint notification on that basis.

4. Factual Background

Complainant operates in the field of design, manufacture, and distribution of ready-to-wear goods for women as well as fashion accessories. Complainant owns multiple registrations for the “BA&SH” Mark (or the “Mark”) including: French Trademark Registration No. 3,444,110 (registered on August 1, 2006) and European Union Trademark Registration No. 5,679,758 (registered on February 10, 2012).

Complainant has brick-and-mortar stores in different parts of the world, a website at <ba-sh.com> from which consumers can purchase merchandise from anyplace in the world and Complainant will ship it to them, and Complainant is well known on social media networks under the pseudonym bashparis where it is “followed” by more than 852,000 people.

Respondents registered the Domain Name <bashsoldes.com> on November 19, 2021 and the Domain Name <bashtienda.com> on November 22, 2021. They both resolve to websites (the “Websites”) selling ready-to-wear clothes, shoes and accessories like those sold by Complainant on its website. On the Websites, the BA&SH Mark appears in the same font and size prominently on the top of each page, many of the photos are copies of those on Complainant’s website, the categories of merchandise on the Websites are the same or similar to the categories of merchandise on Claimant’s website (dresses, outerwear, pants, bags, accessories, shoes), and both the overall and specific arrangements of merchandise on the Websites are the same or similar to how Complainant has arranged its merchandise on its website.

5. Parties’ Contentions

A. Complainant

Complainant has exclusive rights to the Mark under the provisions of Articles L. 711-1 *et al.* of the French Intellectual Property Code and Article 9 of the EU Trademark Regulation 2017/1001, which allow it to oppose any infringement likely to be carried out by anyone, in good or bad faith, in any form and for any reason whatsoever. Under Article L. 713-1 of the French Intellectual Property Code and Article 9 of the EU Trademark Regulation 2017/1001, the registration of a trademark confers to its owner a right of ownership on this trademark for the goods or services covered by the registration.

The Domain Names reproduce in their entirety, in the same order and rank, all the letters of the Mark.

It is traditionally acknowledged that an ampersand “&” is not a valid character in a domain name and registrants, in registering a mark comprising an ampersand as a domain name will typically either omit it or spell it out as “and”. The omission of an ampersand or its conversion to the word “and” in a domain name should not normally result in a mark which is distinguishable from the original.

The only difference between the Domain Names and the BA&SH Mark is the addition of the Spanish descriptive term “tienda” (meaning “store” or “commerce” in Spanish) in <bashtienda.com>, and the French term “soldes” (meaning “sales” in French) in <bashsoldes.com>. Those added terms are Spanish and French dictionary terms and can therefore not prevent a finding of confusing similarity. Rather, they lead users to believe that Complainant or an authorized reseller operates them as it suggests a business relationship between Respondents and Complainant. And using the Domain Names in connection with webpages purportedly selling Complainant’s products and reproducing Complainant’s logo affirms a finding of confusing similarity.

Respondents have no rights or legitimate interests in the Domain Names because they do not own any rights to the Mark. Respondents did not obtain any authorization from Complainant to use the Mark in a domain name or to designate goods that are identical to those of Complainant. There is no relationship between the Parties insofar as Respondents are not related to Complainant’s business. The Domain Names incorporate the Mark and are used as e-commerce websites selling read-to-wear products which shows Respondents’ intention to divert consumers to the websites for commercial gain.

When the Domain Names were registered, the Mark was widely known as identifying Complainant’s activities and Complainant has owned since 2004 the domain name <ba-sh.com> for its main website where consumers can purchase original ready-to-wear products under the Mark and have them delivered worldwide. Moreover, Complainant is notoriously known on social networks under the pseudonym bashparis where it is “followed” by more than 852,000 people – Respondents could not have ignored it. The Mark has a meaning of its own which cannot be invented since they represent the initials of their founders, Mrs. Barbara Boccara and Mrs. Sharon Krief, jointly united under the term BA&SH.

As mentioned above, Respondents could not possibly have been unaware of Complainant and its Mark when registering the Domain Names. Respondents are free riding on the worldwide reputation of Complainant and the Mark to attract Internet users to the websites associated with the Domain Names by creating a likelihood of confusion with the Mark for commercial gain. Those websites reproduce, without any authorization, the Mark on all of their pages and from the landing page suggest an affiliation or sponsorship with Complainant. And Respondents are using the Mark and associating it with the same goods.

Adding to the Mark the term “soldes” referring to one of the promotional periods of Complainant’s business, or “tienda” referring directly to its activities, especially for websites having a commercial activity identical to that of Complainant, establish Respondent’s knowledge of Complainant’s rights. And use of a website to offer for sale the same kind of products as Complainant’s, under Complainant’s Mark and without Complainant’s authorization constitutes bad faith use. Such use shows that Respondents are attempting to mislead Internet users into believing that the Domain Names are associated with Complainant, when they are not. This is also true for displaying the Mark in the website banner.

B. Respondents

Respondents did not reply to Complainant’s contentions.

6. Discussion and Findings

A. Consolidation of Proceedings

Paragraph 3(c) of the Rules provides that a complaint may relate to more than one domain name, provided that the same domain name holder registers the domain names. Paragraph 4(f) of the Policy provides that where there are multiple disputes between a complainant and respondent, either party may petition to consolidate the disputes before a single administrative panel. Under paragraph 10(e) of the Rules, it is for the panel to decide a request by a party to consolidate multiple domain name disputes in accordance with the Policy and Rules. In its Complaint, Complainant requests that the Panel consolidate the domain name disputes for the two Domain Names registered by Respondents.

To file a single complaint against multiple respondents, the complaint must meet the following criteria: (i) the domain names or corresponding websites are subject to common control, and (ii) it would be equitable and procedurally efficient to permit the consolidation. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.11.2.

The Panel finds that Complainant satisfies both parts of the above-mentioned test. With regard to part (1):

1. Both Domain Names are registered under DOMAIN PROTECTION SERVICES, Inc., and the phone number, city and country of Respondents are the same.
2. Both Respondents have email addresses following the same formulation: “word + number + @163.com” and they are hosted by the same email provider Guangzhou NetEase Computer System Co., Ltd (163.com): duprongaae16136@163.com and bopgutaoy3327@163.com.
3. Both Domain Names are registered with NAME.COM, INC.
4. Both Domain Names share identical NS records listed at parent services and retrieved from local name servers.
5. The Domain Name <bashsoldes.com> was registered only 3 days before the registration of the Domain Name <bashtienda.com>, both Domain Names have a similar structure: trademark + additional term + “.com”, and Respondents are using both Domain Names in the same way, as e-commerce websites in competition with Complainant purportedly selling Complainant’s products, reproducing its photos and displaying the Mark.

Regarding the second part of the test, Complainant submits that it would be unfair to require it to file separate complaints against Respondents because it is clear that both Domain Names are connected and under the same control, citing to WIPO Case No. [D2019-0082](#), *Facebook Inc. v. Toriqul Islam / Bright IT, Toriqul Islam (the “First Respondent”), Foyes Babu (the “Second Respondent”), Shafiqul Islam / Stream365, Safiqul Islam (the “Third Respondent”), Feroj Ahammed, It House (the “Fourth Respondent”)*. The Panel agrees.

For the aforementioned reasons, Complainant’s consolidation request is granted.

B. Identical or Confusingly Similar

Complainant has rights in the BA&SH Mark by way of the aforementioned trademark registrations.

The Domain Names identically reproduce Complainant’s BA&SH Mark in its entirety, adding the Spanish dictionary term “tienda” (<bashtienda.com>) and the French dictionary term “soldes” (<bashsoldes.com>). Further, Respondents have removed the ampersand “&” from the Mark. It is sufficient to establish identity or confusing similarity for purposes of the Policy where a domain name wholly incorporates a complainant’s registered mark. See, e.g., *Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#). The Domain Names differ from the Marks merely because of the addition of dictionary terms and the elimination of the “&”. These additions and elimination do not prevent a finding of confusing similarity. *BA&SH v. Domain Administrator, See PrivacyGuardian.org / Name Redacted*, WIPO Case No. [D2019-1616](#); *BA&SH v. Yan Wei*, WIPO Case No. [D2019-2578](#) (noting the fact that the ampersand symbol “&” cannot be used when registering a domain name, thus registrants usually either omit the ampersand, as was the case with the disputed domain names, or replace it by “and”). Lastly, including a generic Top-Level Domain, such as “.com,” in the Domain Names does nothing to prevent a finding of confusing similarity. *Champagne Lanson v. Development Services/MailPlanet.com, Inc.*, WIPO Case No. [D2006-0006](#).

The Panel therefore holds that Complainant has established the first element of paragraph 4(a) of the Policy.

C. Rights or Legitimate Interests

Complainant asserts that Respondents have no legitimate interests in the Domain Names because: (1) they have not obtained permission from Complainant to use the Mark for any purpose including in the Domain Names; (2) Respondents have no rights to use the Mark in commerce to designate goods that are identical to those of Complainant, notably ready-to-wear products; (3) there is no relationship between Complainant and Respondents even if Respondents intend to suggest the opposite; and (4) Respondents are capitalizing on Complainant's reputation by using Domain Names that incorporate the Mark and prominently displaying the BA&SH Mark on e-commerce websites selling ready-to-wear products in competition to Complainant thus, diverting consumers to the websites for commercial gain.

Where, as here, Complainant has raised a *prima facie* presumption of Respondents' lack of any rights or legitimate interests in the Domain Names, and Respondents have failed to rebut that presumption, the Panel is satisfied that Complainant has carried its burden of proving that Respondents have no rights or legitimate interests in the Domain Names within the meaning of paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Respondent registered and has been using two Domain Names that are confusingly similar to the BA&SH Mark. When Respondents registered the Domain Names only three days apart in November 2021, Complainant had been using the Mark for at least 15 years. Given Complainant's widespread (on the Internet and brick-and-mortar stores) and established use of the Mark worldwide, the Panel finds it is highly unlikely Respondents were unaware of the Mark when it registered the Domain Names. Respondents' bad faith registration is also evidenced by the facts that: (1) Respondents have not shown that they have any rights or legitimate interests in the Domain Names particularly insofar as the Mark was coined based on the first names of Complainant's founders; (2) Respondents registered Domain Names that are exactly the same as Complainant's registered BA&SH Mark adding dictionary terms in different languages ("soldes" meaning sale in French and "tienda" meaning shop in Spanish) that are commonly used on commercial websites; (3) Respondents are using confusingly similar Domain Names on two similar websites that are selling goods that compete with those sold by Complainant; (4) as described above, the Websites are uncannily similar to Complainant's website. On the uncontroverted evidence, the Panel finds that Respondents registered the Domain Names in bad faith.

The Panel further finds that by using the Domain Names as described above to sell merchandise that competes with the merchandise that Complainant sells, Respondents have intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's Mark as to the source, sponsorship, affiliation or endorsement of such site or the products or services advertised on such site, within the meaning of paragraph 4(b)(iv) of the Policy. *Advance Magazine Publishers Inc. v. Red Wagon Films*, WIPO Case No. [D2006-0893](#).

The Panel therefore holds that Complainant has established element (iii) above.

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 Names, <bashsoldes.com>, and <bashtienda.com>, be transferred to Complainant.

/Samaras, Harrie R./

Samaras, Harrie R.

Sole Panelist

Date: March 14, 2022