

ADMINISTRATIVE PANEL DECISION

Saks.com LLC v. Domain Administrator, See PrivacyGuardian.org / He YouYou

Case No. D2022-0308

1. The Parties

The Complainant is Saks.com LLC, United States of America (“United States”), represented by Loeb & Loeb, LLP, United States.

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States / He YouYou, China.

2. The Domain Name and Registrar

The disputed domain name <saksfifthavenue.com> (“Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 28, 2022. On January 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 31, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 9, 2022 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 amended Complaint on February 14, 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 the Respondent of the Complaint, and the proceedings commenced on February 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 8, 2022.

The Center appointed Willem J. H. Leppink as the sole panelist in this matter on March 17, 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.

4. Factual Background

The Complainant is a group company of Saks & Company, LLC (“Saks & Co.”), an American retail store chain, headquartered in New York, selling luxury goods. Saks & Co. opened its first store in the early 1900s, the Saks Fifth Avenue, in New York. Currently there are 42 Saks Fifth Avenue stores and 66 Saks Fifth Avenue Off 5th stores operating in both the United States and multiple other countries. In 2019, the company made a revenue of almost USD 5 billion.

The Complainant is the owner of several trademark registrations comprising the word elements SAKS FIFTH AVENUE, including, but not limited to the Chinese trademark, SAKS FIFTH AVENUE (word mark), with registration no. 803879 and with a registration date of December 28, 1995 (the “Trademark”). Moreover, the Complainant has multiple trademark rights comprising “SAKS” and “SAKS FIFTH AVENUE OF 5TH”. The Complainant is also owner of the domain name <saksfifthavenue.com>.

The Domain Name was registered on November 29, 2021. The Domain Names resolved to a website (the “Website”), on which the Respondent purports to be marketing and promoting products from the company Walmart.

5. Parties' Contentions

A. Complainant

The Complainant contends the following:

The Domain Name is identical or confusingly similar to the Trademark. More specifically, the Domain Name incorporates the Trademark in its entirety and only adds the letter “x” at the end of the Domain Name. Moreover, the Domain Name mimics the Complainant’s existing domain name and deliberately introduces a mistyping. The mistyping and/or misreading of the Complainant’s Trademark and/or domain name causes confusion amongst the customers regarding the affiliation with or ownership by the Complainant.

The Respondent has no rights or legitimate interest in regard to the Domain Name. The Respondent is not known as “Saks”, “Saks Fifth Avenue”, or any variation thereof. Additionally, the Respondent has not secured a license to use the Trademark. Nor has the Respondent any other authorization and, to the knowledge of the Complainant, never requested such permission to use the Trademark. There is also no legitimate noncommercial or fair use of the Domain Name. The email address mentioned on the Website seems to be involved with phishing and/or scamming.

Moreover, the Domain Name has been registered and used in bad faith. The Respondent registered the Domain Name with prior knowledge of the Trademark. The Respondent has also used a privacy service to register the Domain Name. Moreover, the Respondent is intentionally using the Domain Name to attract Internet users to the Website by creating a likelihood of confusion. The likelihood of confusion derives from the false impression of an association with the Complainant. In doing so, the Respondent diverts not only the clientele but also the goodwill that corresponds with the Complainant for the sole purpose of commercial gain. Additionally, as mentioned under the second element as well, the Website is used for fraudulent activities such as phishing and trademark infringements.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; 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

The Complainant has sufficiently proven to have rights in the Trademark. Moreover, the Complainant has proven to have rights in many countries worldwide including, but not limited to, the United States, Canada, Europe Union, and China.

The Domain Name consists of the Trademark in its entirety, and only adds the letter "x" at the end. Therefore, the Trademark is clearly recognizable in the Domain Name. The addition of the letter "x" at the end of the Domain Name does not prevent a finding that this Domain Name is confusingly similar to the Trademark.

Accordingly, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant in its Complaint and as set out above has established a *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name.

The Panel could not find any evidence by referring to the types of evidence set forth in paragraph 4(c) of the Policy from which the Panel might conclude that the Respondent has rights or legitimate interests in the Domain Name, such as:

- (i) use or preparation to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services prior to notice of the dispute; or
- (ii) being commonly known by the Domain Name (as an individual, business or other organization) even if the Respondent has not acquired any trademark or service mark rights; or
- (iii) making 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.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the Domain Name. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the Domain Name, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

The Complainant has asserted that the Respondent is not affiliated with the Complainant in any way. Moreover, there is no evidence that "saksfifthavenue" is the Respondent's name or that the Respondent is commonly known under this name. There is also no evidence that the Respondent is, or has ever been, a

licensee of the Complainant or that the Respondent has ever asked, or has ever been permitted in any way by the Complainant to register or use the Trademark, or has applied for or used any Domain Name incorporating the Trademark.

The purported offering for sale of certain Walmart products on the Website cannot be considered as use of the Domain Name in connection with a *bona fide* offering of goods and services, in particular given the use appears intended to compete with or capitalize on the reputation and goodwill of the Trademark or otherwise mislead Internet users. Moreover, the Complainant contends an email address provided on the Website appears to be linked to posting fake reviews online and scamming.

The Respondent has also not put forward any evidence that would support the claim that the use of the Domain Name would relate to a legitimate noncommercial or fair use.

Certainly lacking a substantive Response, the Panel thus finds that the Respondent's use cannot be considered to be in good faith, which could result in a legitimate interest, seeing that the Respondent has not put forward any evidence that would indicate that the Respondent was licensed or authorized by the Complainant to use the Trademark.

The Panel therefore finds that the second element has been satisfied.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent has registered and used the Domain Name in bad faith and refers to its considerations under section 6.B. above.

In light of the evidence filed by the Complainant, the Panel finds that the Trademark and the Complainant's activities are well known throughout the world. The Complainant is the owner of numerous trademarks which were used and registered decades before the Domain Name was registered. The Complainant made a revenue of nearly USD 5 billion in 2019. Accordingly, in the Panel's view, the Respondent must have been aware of the existence of the Complainant's activities and rights at the time the Respondent registered the Domain Name. In this regard, the Panel also notes a simple Internet search would lead the Respondent to the Complainant's website. Lastly, the Respondent opted to register the Domain Name through a privacy service, which in this case serves as another indication of registration in bad faith (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 3.6).

Therefore, the Panel finds that there is no plausible explanation as to why the Respondent registered the Domain Name other than that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Website, by creating a likelihood of confusion with the Trademark, as to the source, sponsorship, affiliation, or endorsement of the Respondent. In doing so, the Respondent makes it unclear for Internet users whether the Website is operated by the Complainant or not. Thus, by creating the likelihood of confusion, the Respondent intended to trade off the goodwill and reputation of the Complainant.

Furthermore, the Complainant contends the Respondent seems to carry out fraudulent activities on the Website, as the email address used on the Website has been associated with other scamming websites.

In addition, the Panel takes into consideration that the Respondent has been hiding behind a privacy shield.

Finally, although the lack of a formal response by the Respondent as such cannot by itself lead to the conclusion that there is registration and use in bad faith, the cumulative circumstances as outlined in the Decision are sufficient for the Panel to find that the use of the Domain Name by the Respondent is in bad faith.

Accordingly, the Panel finds that the Domain Name has been registered and is being used in bad faith and as such the third element is satisfied.

7. Decision

For the foregoing reasons, in accordance with Paragraph 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <saksfifthavenue.com> be transferred to the Complainant.

/Willem J. H. Leppink/
Willem J. H. Leppink
Sole Panelist
Date: March 25, 2022