

ADMINISTRATIVE PANEL DECISION

BB IPCO LLC v. Xueli You

Case No. D2022-1187

1. The Parties

Complainant is BB IPCO LLC, United States of America (“United States”), represented by Authentic Brands Group LLC, United States.

Respondent is Xueli You, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 5, 2022. On April 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 9, 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 Complainant on April 11, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on April 12, 2022.

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 Respondent of the Complaint, and the proceedings commenced on April 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 18, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 19, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on June 3, 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

Per the Complaint, Complainant is the owner of the BROOKS BROTHERS brand. Since the brand was founded in 1818, having started out as a traditional men's clothier in the United States, it has expanded to a global fashion, beauty and accessories brand sold in various countries as well as on Complainant's official website at "www.brooksbrothers.com". Complainant spends millions of dollars marketing its goods and services globally, using the BROOKS BROTHERS trademarks. Complainant imposes strict quality control measures over goods and services offered in connection with the trademarks.

Complainant is the owner of numerous BROOKS BROTHERS trademarks worldwide, including the United States Registration No. 667458 for BROOKS BROTHERS (word), filed on April 30, 1957 and registered on September 23, 1958 for goods in International Classes 10, 25, and 26.

The Domain Name was registered on March 4, 2022, and leads to a website which per Complainant is selling counterfeit BROOKS BROTHERS goods and mimicking the website of Complainant, in an attempt to pass it off as an official website of Complainant.

Complainant sent cease-and-desist letters to Respondent on March 8, 2022, March 14, 2022, and March 22, 2022 to which Respondent did not reply.

5. Parties' Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for the transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

(ii) 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

Complainant has demonstrated rights through registration and use of the BROOKS BROTHERS mark.

The Panel finds that the Domain Name is confusingly similar to the BROOKS BROTHERS trademark of Complainant.

The Domain Name incorporates the said trademark of Complainant in its entirety. This is sufficient to establish confusing similarity (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.7).

The word “outlet” which is added in the Domain Name does not alter the above ([WIPO Overview 3.0](#), section 1.8).

The generic Top-Level Domain (“gTLD”) “.online” is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are generally required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#)).

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are 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.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted a response to Complainant’s contentions and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per the Complaint, Respondent was not authorized to register the Domain Name.

Respondent did not demonstrate prior to the notice of the dispute any use of the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrates, the Domain Name leads to a website mimicking that of Complainant and suggesting falsely that it is that of Complainant or of an affiliated entity or of an official dealer of Complainant.

Per the Complaint, Respondent is not an affiliated entity or an authorized distributor or reseller of Complainant and no agreement, express or otherwise, exists allowing Respondent to use Complainant’s trademarks on the website at the Domain Name or in the Domain Name itself. The website at the Domain Name extensively reproduces, without authorization by Complainant, Complainant’s trademarks and official Complainant product images. Such use, noting in particular the failure of Respondent to disclose the lack of relationship with Complainant on the website at the Domain Name, would not constitute a fair use ([WIPO Overview 3.0](#), section 2.8).

Lastly, per the Complaint, the website is used for the offering of counterfeit products.

The use of a domain name for illegal activity (e.g., the sale of counterfeit goods or passing off) can never confer rights or legitimate interests on a respondent (*Prada S.A. v. Domains For Life*, WIPO Case No. [D2004-1019](#); [WIPO Overview 3.0](#), section 2.13.1).

Furthermore, the nature of the Domain Name effectively impersonates or suggests sponsorship or endorsement by Complainant and so cannot constitute a fair use ([WIPO Overview 3.0](#), section 2.5.1).

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in bad faith:

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or

(ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Domain Name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. As per the Complaint, Complainant’s BROOKS BROTHERS trademark is widely known. Because the BROOKS BROTHERS mark had been widely used and registered at the time of the Domain Name registration by Respondent, the Panel finds it more likely than not that Respondent had Complainant’s mark in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

As regards bad faith use of the Domain Name, Complainant has demonstrated that the Domain Name leads to a website, which prominently displays Complainant’s registered BROOKS BROTHERS trademark and publicity images, thereby giving the false impression that it is operated by Complainant or a company affiliated with Complainant or an authorized dealer of Complainant. The Domain Name operates by intentionally creating a likelihood of confusion with Complainant’s trademark and business as to the source, sponsorship, affiliation, or endorsement of the website to which it leads. This is indicative of bad faith registration and use (*Oculus VR, LLC v. Sean Lin*, WIPO Case No. [DCO2016-0034](#); [WIPO Overview 3.0](#), section 3.1.4). Furthermore, per the Complaint, counterfeit versions of Complainant’s goods are offered for sale on the website (*Bayerische Motoren Werke AG v. Domains by Proxy, LLC / Alfred Kolinz, bmwupdate*, WIPO Case No. [D2017-2450](#), *Bayerische Motoren Werke (BMW) v. Balog Sebastian*, WIPO Case No. [D2017-1407](#)).

The Panel considers the following factors: (i) the reputation of Complainant's mark, (ii) the failure of Respondent to submit a response, (iii) the fact that the website it leads to displays Complainant's trademark and product images, selling per the Complaint counterfeit goods, (iii) the fact that Respondent did not reply to the cease and desist letters of Complainant, and (iv) the Domain Name leads to a website which gave the false impression that it was operated by Complainant or an official retailer of Complainant while selling per the Complaint counterfeit goods.

Under these circumstances and on this record, the Panel finds that Respondent has registered and is using the Domain Name in bad faith.

Complainant has established Policy paragraph 4(a)(iii).

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 <brooksbrothersoutlet.online> be transferred to Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: June 17, 2022