

ADMINISTRATIVE PANEL DECISION

**Ben Sherman IP Holdings LP v. Domain Protection Services, Inc. /
Ghpiw Rvfwe
Case No. D2022-1936**

1. The Parties

The Complainant is Ben Sherman IP Holdings LP, United States of America (“United States”), represented by Tucker & Latifi, LLP, United States.

The Respondent is Domain Protection Services, Inc., United States / Ghpiw Rvfwe, China.

2. The Domain Name and Registrar

The disputed domain names <benshermansale.com> and <thebensherman.com> are 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 May 27, 2022, and initially concerned the <benshermansale.com> domain name. On May 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 31, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 1, 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 June 9, 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 June 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 4, 2022.

The Center appointed Fabrice Bircker as the sole panelist in this matter on July 13, 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.

On August 1, 2022, the Complainant requested that a second disputed domain name, namely <thebensherman.com>, be added in the procedure. On August 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the added disputed domain name. On September 8, 2022, the Registrar transmitted by email to the Center its verification response confirming that the second disputed domain name was registered in the name of the Respondent.

On September 12, 2022, the Panel issued a Procedural Order inviting the Respondent to submit a response to the amended Complaint by September 17, 2022, and extending the Decision due date until September 22, 2022.

On September 19, 2022, the Complainant sent an amended Complaint consolidating all his arguments in one writ.

The Respondent did not submit any response further to the Procedural Order.

4. Factual Background

The Complainant is the owner of BEN SHERMAN trademarks (such as those detailed in paragraph 6 below) protecting the clothing and fashion accessories brand, “Ben Sherman”, which was established in 1963.

The Complainant is also the holder of the <bensherman.com> domain name, which was registered on July 29, 1997, and which is used to resolve to a retailing website dedicated to the “Ben Sherman” brand.

Very little is known about the Respondent, except that it is apparently located in China, based on the information disclosed by the Registrar.

Both disputed domain names were registered on March 10, 2022, and are redirecting to websites that prominently display the BEN SHERMAN trademark, and that purport to offer for sale at discounted prices exclusively clothes bearing the BEN SHERMAN trademark.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain names, and its main arguments can be summarized as follows.

First, the Complainant requests the consolidation of both disputed domain names within the same procedure because they have been registered through the same registrar on the same date, because the related websites are visually identical and infringe the same BEN SHERMAN trademarks, and because the registrar verification has eventually revealed that they are both held by the Respondent.

Then, the Complainant contends in substance that the disputed domain names are confusingly similar to its BEN SHERMAN trademark because they incorporate said trademark in its entirety and the latter remain recognizable within them.

Besides, the Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain names because it has never authorized in any way the Respondent to register or to use the BEN SHERMAN trademark in any manner.

The Complainant also argues that the Respondent is not commonly known by the disputed domain names and that there can be no legitimate reason for the Respondent to use the disputed domain names because the latter are used in a way that infringes upon the BEN SHERMAN trademark, and which wrongfully leads the public to believe that the related websites are associated with or authorized by the Complainant.

At last, the Complainant contends that by using the disputed domain names to redirect toward websites offering for sale products seemingly identical to those protected by its trademark, the Respondent is intentionally attempting to attract for commercial gain, Internet users by creating a likelihood of confusion with its BEN SHERMAN trademark to falsely create the impression that the Respondent's websites and the goods offered for sale thereby are those of the Complainant or are somehow affiliated to the latter.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, for obtaining the transfer of the disputed domain names, the Complainant must establish each of the following three elements:

- (i) the disputed domain names are 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 disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

Besides, paragraph 15(a) of the Rules provides that “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Paragraphs 10(b) and 10(d) of the Rules also provide that “[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case” and that “[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence”.

Besides, the Respondent's failure to reply to the Complainant's contentions does not automatically result in a decision in favor of the Complainant, although the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

Taking the foregoing provisions into consideration the Panel finds as follows.

A. Request of consolidation of multiple domain names within the same procedure

The Complainant's request to add in the procedure the second disputed domain name, namely <thebensherman.com>, has been issued at a moment where the final Decision was not yet formatted, and contained convincing arguments as to the fact that both disputed domain names may be held by the Respondent.

Therefore, the Panel has accepted to consider this request.

Then the Registrar verification revealed that the second disputed domain name was indeed registered in the name of the Respondent, and through the Procedural Order, the Respondent been granted the possibility to submit a response.

As the second disputed domain name is obviously owned by the Responded and as the latter has been given a fair opportunity to defend his case further to the addition of this second disputed domain name within the procedure, the Panel accepts that the second disputed domain name be included in this procedure.

B. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first establish rights in a trademark or service mark and secondly establish that the disputed domain names are identical or confusingly similar to its trademark.

In the present case, to establish its rights the Complainant has communicated a schedule consisting of its trademarks portfolio, but without any supporting document such as official certificates of registration or extracts of intellectual property official databases.

This being said, it is well established that the general powers of a panel as articulated *inter alia* in paragraphs 10 and 12 of the Rules include, among others, the possibility to undertake limited factual researches into matters of public record if the panel considers such information useful to assessing the case merits and reaching a decision. These limited factual researches notably include accessing trademark registration databases (see for instance, [WIPO Overview 3.0](#), section 4.8).

Therefore, this Panel has performed such searches and its results thereof that the document provided by the Complainant reflects well its rights into the BEN SHERMAN trademark, as it is the owner of the following trademarks among many others:

- United States trademark registration No. 2104981 for BEN SHERMAN in class 25, with first use in 1969, filed on July 2, 1996, registered on October 14, 1997, and regularly renewed since then;
- European Union trademark registration No. 398354 for BEN SHERMAN, in class 25, filed on October 17, 1996, registered on December 10, 1998, and regularly renewed since then.

As a consequence, the Panel finds that the Complainant has trademark rights on BEN SHERMAN.

Turning to the comparison of the disputed domain names with the invoked trademark, there is no difficulty in finding that they are confusingly similar to the BEN SHERMAN trademark.

Indeed, both disputed domain names reproduce the Complainant's trademark, and it is of constant practice among the UDRP panels that:

- generic Top-Level Domains ("gTLDs") may be ignored for the purpose of assessing the confusing similarity, because they only play a technical function;
- the addition of other terms does not prevent a finding of confusing similarity under the first element when the Complainant's trademark remains clearly recognizable (see [WIPO Overview 3.0](#), section 1.8), what is the case here, precisely because the Complainant trademark is reproduced in its entirety.

Consequently, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy are satisfied.

C. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain names. Once such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain names. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy ([WIPO Overview 3.0](#), section 2.1; or for instance *Applied Materials, Inc. v. John Warren*, WIPO Case No. [D2020-0950](#)).

In the present case, the Complainant contends that it has not given its consent for the Respondent to use its BEN SHERMAN trademark in domain names registrations or in any other manner.

In addition, there is nothing in the record of the case likely to indicate that the Respondent may be commonly known by the disputed domain names.

Besides, the Respondent is using the disputed domain names to operate websites:

- purporting to offer for sale, at discounted prices, exclusively clothing under the Complainant's BEN SHERMAN trademark,
- ostentatiously displaying said trademark,
- reproducing the look and feel of the Complainant's website and even copying some of its graphic elements (such as its logo and its favicon).

This situation opens the question of whether the websites available through the disputed domain names are genuinely offering BEN SHERMAN products, or if the goods are counterfeits (what is the Complainant's belief) or even if they are fake shops.

Of course, if the products would be counterfeits or if the online stores would be fake, there would be a clear absence of rights or legitimate interests. Indeed, it is well established that "the use of a domain name for illegal activity (e.g., the sale of counterfeit goods [...], impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent" (see [WIPO Overview 3.0](#), section 2.13).

On the other side, one cannot exclude that the products sold on the websites available through the disputed domain names are genuine BEN SHERMAN goods.

In this respect, there is a consensus view (see [WIPO Overview 3.0](#), section 2.8) that a reseller using a domain name containing the complainant's trademark to undertake sales related to the complainant's goods makes a *bona fide* offering of goods and services and thus has a legitimate interest in the domain name if the following cumulative requirements are met:

- (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.

Here, the Panel notably finds that the Respondent's websites do not disclose their (lack of) relationship with the Complainant. Rather, the Respondent seeks to create an impression of association with the Complainant, by running websites that prominently display the BEN SHERMAN trademark, while looking close to the Complainant's official website.

In these conditions, even assuming that the Respondent would be offering for sale genuine BEN SHERMAN goods, it would not be in a position to claim any legitimate fair use of the disputed domain names.

Taken all the above into consideration, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names.

The Respondent has had the opportunity to rebut the Complainant's contentions but has not done so.

Consequently, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain names, and accordingly that the second element in paragraph 4(a) of the Policy is satisfied.

D. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and is using the disputed domain names in bad faith.

In the present case, the Panel finds that:

- the disputed domain names are confusingly similar with the Complainant's BEN SHERMAN trademark which i) predates them by several dozens of years, ii) is intrinsically distinctive and iii) is globally protected,
- the Respondent has proceeded with the registration of two domain names, both reproducing the Complainant's trademark, and these registrations occurred the very same day,
- the disputed domain names are being used to resolve to websites that give a strong impression of being operated or authorized by the Complainant, whereas it is not the case, and purporting to sell BEN SHERMAN branded products of the same nature than those protected by the Complainant's trademark,
- the Respondent, while invited to defend his case, has remained silent in this procedure.

It necessarily results from the above findings that the Respondent registered the disputed domain names being fully aware of the Complainant's rights, and that he is intentionally using the disputed domain names for commercial gain by creating a likelihood of confusion with the Complainant's BEN SHERMAN trademark as to the source, sponsorship, affiliation, or endorsement of his websites and of the products offered for sale therein, in the meaning of paragraph 4(b)(iv) of the Policy.

As a conclusion of the above, the Panel finds that the disputed domain names were registered and have been used in bad faith, within the meaning of paragraph 4(a)(iii) 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 names, <benshermansale.com> and <thebensherman.com>, be transferred to the Complainant.

/Fabrice Bircker/

Fabrice Bircker

Sole Panelist

Date: September 22, 2022