

ADMINISTRATIVE PANEL DECISION

Parke-Bell Ltd., Inc. v. Domain Admin, Hush Whois Protection Ltd.
Case No. D2022-3722

1. The Parties

The Complainant is Parke-Bell Ltd., Inc., United States of America (“United States”), represented by Brann & Isaacson, United States.

The Respondent is Domain Admin, Hush Whois Protection Ltd., Seychelles.

2. The Domain Name and Registrar

The disputed domain name <touchofclassfurnitureoutlet.com> (the “Disputed Domain Name”) is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 5, 2022. On October 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 7, 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 (Owner, c/o whoisproxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 7, 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 October 11, 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 October 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 8, 2022.

The Center appointed Mariya Koval as the sole panelist in this matter on November 14, 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 an Indiana corporation and a well-known retailer of furniture, as well as premium quality home decor and furnishings under its Trademark TOUCH OF CLASS (the "TOUCH OF CLASS" Trademark). The Complainant has used its TOUCH OF CLASS Trademark continuously in commerce since 1978 in connection with a wide variety of goods and services, including retail, mail order and online services featuring home decor and furnishing products. The Complainant has an annual distribution exceeding 9,000,000 catalogs, and sales of more than USD 48 million.

The Complainant is the owner, among others, of the United States Trademark Registration No. 2697085, registered on March 18, 2003, in respect of services in class 35.

The Complainant operates the domain name <touchofclass.com> (registered on June 8, 1996), reflecting its TOUCH OF CLASS Trademark for sale and promotion of its goods.

The Disputed Domain Name was registered on October 3, 2012. As at the date of this decision, the Disputed Domain Name resolves to a parking webpage displaying commercial links related to furniture, including those related to the Complainant's competitors trademarks, targeting directly Complainant's field of activity. Moreover, the webpage contains indication that the Disputed Domain Name is up for sale.

5. Parties' Contentions

A. Complainant

The Complainant asserts that it has used the TOUCH OF CLASS Trademark continuously in commerce since 1978, in connection with a wide variety of goods and services. The Disputed Domain Name is confusingly similar to the Complainant's TOUCH OF CLASS Trademark in which it has established rights. The Disputed Domain Name incorporates the TOUCH OF CLASS Trademark in its entirety, except that the Respondent eliminated the spaces between the words comprising the Trademark and added the generic words "furniture outlet."

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant has never authorized the use of its TOUCH OF CLASS Trademark, much less the registration of the Disputed Domain Name. It has no connection to an organization identifying itself as "Hush Whois Protection Ltd." hiding behind a proxy shield, and based in the Seychelles.

The Respondent has no rights in the TOUCH OF CLASS Trademark, and the Complainant's use of the TOUCH OF CLASS Trademark in commerce predates the Respondent's infringing usage of the Complainant's Trademark by many decades. The Respondent is using the Trademark in the Disputed Domain Name solely to divert traffic to and through its website; that is not a legitimate interest. It is also noteworthy that the Disputed Domain Name is up for sale. When visiting the website, one of the predominant features is a link in the top right corner offering visitors the option to "buy this domain."

The Complainant further claims that the Respondent both registered and is using the Disputed Domain Name in bad faith. The Respondent's use of the Complainant's TOUCH OF CLASS Trademark is a straightforward attempt at using the Trademark's fame and goodwill to increase their own profits and advertising revenue, by attracting more consumers to the Disputed Domain Name, which is nothing more

than a collection of links to other furniture vendors. Such strategy is not employed in good faith; rather, case law informs that this is a clear example of bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has properly asserted its rights in the TOUCH OF CLASS Trademark due to the long use.

The Disputed Domain Name completely reproduces the Complainant's TOUCH OF CLASS Trademark in combination with the dictionary words "furniture" and "outlet", and the generic Top-Level Domain ("gTLD") ".com". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. In this case, the addition of the terms "furniture" and "outlet" to the TOUCH OF CLASS Trademark does nothing to prevent a finding of confusing similarity.

Also, in accordance with [WIPO Overview 3.0](#), section 1.11, the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Pursuant to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's TOUCH OF CLASS Trademark pursuant to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has used its TOUCH OF CLASS Trademark for more than 30 years in commerce and its domain name <touchofclass.com> since 1996, which is long before the Respondent registered the Disputed Domain Name in 2012.

The Complainant contends that it has not authorized the Respondent to use its TOUCH OF CLASS Trademark or to apply for any domain name incorporating the Trademark.

In accordance with section 2.1 of the [WIPO Overview 3.0](#) while the overall burden of proof in UDRP proceedings is on the Complainant, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If such *prima facie* case is made, the burden of production

shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is generally deemed to have satisfied the second element.

Taking into account the facts and arguments set out above, the Panel finds that the Complainant has made a *prima facie* case. The Respondent registered the Disputed Domain Name more than eight years after the TOUCH OF CLASS Trademark and the Complainant's official domain name <touchofclass.com> had been registered. There is no evidence that the Respondent owns any TOUCH OF CLASS Trademarks, nor that it is commonly known by the Disputed Domain Name. Therefore, the Respondent has failed to come forward with any evidence to rebut such *prima facie* case.

The Disputed Domain name resolves to a parked page containing PPC links relating to goods that directly compete with the goods the Complainant sells under its TOUCH OF CLASS Trademark. Displaying links with messages regarding selling products highly similar to those being sold under the Complainant's Trademark through the Disputed Domain Name, which, in its turn, incorporates the Complainant's TOUCH OF CLASS Trademark in its entirety, clearly shows that the Respondent is attempting to capitalize on the goodwill and reputation of the Complainant's Trademark and not for any *bona fide* offering of goods and services or noncommercial or fair use. In accordance with section 2.9 of the [WIPO Overview 3.0](#) applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users.

Moreover, in accordance with the [WIPO Overview 3.0](#), section 2.5.1, where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. Therefore, the addition of the terms "furniture" and "outlet", which directly refer to the Complainant's business, carries a risk of implied affiliation of the Disputed Domain Name with the Complainant's Trademark. This is further evidence that the Respondent was very well aware of the Complainant's TOUCH OF CLASS Trademark and business at the time of registration of the Disputed Domain Name. Moreover, it is obvious that the Respondent registered the Disputed Domain Name for the only purpose of creating an impression that the Disputed Domain Name is connected with the Complainant and its TOUCH OF CLASS Trademark.

The Respondent did not respond to the Complaint and did not participate in this proceeding, accordingly, the Respondent has failed to present any evidence to support any rights or legitimate interests in the Disputed Domain Name.

In light of the above, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name. Therefore, the Panel finds that the second element of the UDRP has been met by the Complainant.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy indicates some circumstances, 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:

(i) circumstances indicating that you [respondent] have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Complainant has used its TOUCH OF CLASS Trademark since 1978 and its domain name <touchofclass.com> - since 1996. Thus, first use of the TOUCH OF CLASS Trademark by the Complainant was more than 30 years before the Respondent registered the Disputed Domain Name. Moreover, it is most unlikely that the Respondent could have registered the Disputed Domain Name, which incorporates the TOUCH OF CLASS Trademark in its entirety with terms related to the Complainant's business, accidentally. In view of this, the Panel is of opinion that the Respondent was likely well aware of the Complainant's Trademark when he registered the Disputed Domain Name in 2012.

Also, incorporation of the Complainant's TOUCH OF CLASS Trademark in its entirety in the Disputed Domain Name creates a strong likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name.

The website operated by the Respondent under the Disputed Domain Name comprises a series of "click through" links to the Complainant's competitors websites. The Respondent is clearly using the Disputed Domain Name to intentionally attract Internet users and consumers looking for the Complainant, by creating a likelihood of confusion with Complainant, all for commercial gain. The Panel infers that some visitors, once at the Respondent's website will follow the provided links and "click through" to other sites which offer products or services unrelated to the Complainant and where all websites offer products or services which compete with those of the Complainant. Moreover, the website under the Disputed Domain Name is offered for sale (at the price of USD 1,999) that is obviously in excess of the Respondents out-of-pocket costs directly related to the Disputed Domain Name¹. Such use of the Disputed Domain Name cannot be considered as use in good faith.

According to section 3.1.4 of the [WIPO Overview 3.0](#) UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is of opinion that it is clear that the Respondent, having registered and used the Disputed Domain Name, which is confusingly similar to the Complainant's Trademark, primarily intended to disrupt the Complainant's business. In view of the absence of any evidence to the contrary and that the Respondent did not file any statement, the Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith.

The Panel also concludes that addition of the dictionary terms "furniture" and "outlet" to the TOUCH OF CLASS Trademark does not change an impression of strong association of the Disputed Domain Name with the Complainant's Trademark, but on the contrary, taking into consideration that the Complainant has a longstanding history of conducting retail furniture business, even strengthens such association. Previous UDRP panels have concluded that in appropriate circumstances, bad faith is established where the Complainant's trademark has been well-known or in wide use at the time of registering a domain name, see, e.g., *Chanel, Inc. v. EstcoEnterprises Ltd., Estco Technology Group*, WIPO Case No. [D2000-0413](#).

Finally, the Respondent, not participating in these proceedings, has failed to indicate any facts and/or evidence, which would show the good faith registration and use of the Disputed Domain Name.

¹ As part of the general powers of the Panel, as articulated, inter alia, in paragraph 10 of the Rules, the Panel has further corroborated the use of the Disputed Domain Name.

In view of the foregoing, the Panel finds that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant and accordingly, the Disputed Domain Name has been registered and is being used in bad faith.

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, <touchofclassfurnitureoutlet.com>, be transferred to the Complainant.

/Mariya Koval/

Mariya Koval

Sole Panelist

Date: November 28, 2022