

ADMINISTRATIVE PANEL DECISION

BCBG IP Holdings LP v. Ying Du
Case No. D2022-4016

1. The Parties

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

The Respondent is Ying Du, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 26, 2022. On October 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 31, 2022, the Registrar transmitted by email to the Center its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 the Respondent of the Complaint, and the proceedings commenced on November 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 22, 2022.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on November 29, 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 the holder of the intellectual property rights in the BCBG and MAX AZRIA fashion brands founded in 1989 by Mr. Max Azria, an American fashion designer and CEO of BCBG Max Azria Group, a fashion house that encompassed more than 20 brands. The Complainant operates an online retail website under the domain name <cbcg.com>. The Complainant owns a portfolio of trademark registrations in over 114 countries, including the BCBG MAX AZRIA trademark, for various goods and services, such as handbags, clothing, footwear, fragrance, home goods, and online retail services. The Complainant's BCBG MAX AZRIA trademark registrations date back to as early as 1998 (US Trademark Registration No. 2160919 for BC BG MAX AZRIA covering goods of International Class 25, registration date May 26, 1998; US Trademark Registration No. 2162709 for BC BG MAX AZRIA covering goods of International Class 18, registration date June 2, 1998). The Complainant has registered BCBG MAX AZRIA as a trademark in classes 20, 24 and 25 in China. The class 25 registration dates to 1999 (Chinese Trademark Registration No. 1246718 for BCBG MAX AZRIA for goods in International Class 25, registration date February 14, 1999).

The disputed domain name <bcbgmaxazrias.com> was created on August 9, 2022, and resolves to a website with the look and feel of the Complainant's official web shop and pretending to offer for sale original products under the BCBG MAX AZRIA trademark.

5. Parties' Contentions

A. Complainant

Identical or Confusingly Similar

The Complainant alleges that the disputed domain name is confusingly similar to the BCBG MAX AZRIA trademark which it contains in its entirety with the addition of the letter "s". The inclusion of one additional letter in no way changes the meaning or significance of the mark and is clearly an intentional misspelling of the Complainant's trademark.

No rights or legitimate Interests

The Complainant submits that disputed domain name was registered many years after the first registrations of the Complainant's BCBG MAX AZRIA trademark.

The Complainant claims that it has not licensed or authorized the Respondent to register or use the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks.

The Complainant contends that the disputed domain name resolves to the website with the look and feel of the Complainant's official web shop and pretending to offer for sale original products under the BCBG MAX AZRIA trademark. The user interface of the website under the disputed domain name has been designed with the infringement of the Complainant's copyright as it reproduces images from the Complainant's advertisement campaigns, images from the Complainant's official online site and copies language from the Complainant's official online site. The Complainant alleges that the products sold are counterfeits.

Registered and used in bad faith

The Complainant claims that, by using the disputed domain name, the Respondent is intentionally attempting to attract for commercial gain Internet users to the Respondent's website under the disputed domain name by creating a likelihood of confusion with the BCBG MAX AZRIA trademark to falsely create the impression

that the Respondent's website and the goods and services being offered on the Respondent's website under the disputed domain name are actually those of the Complainant or somehow affiliated with the BCBG MAX AZRIA branded goods of the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[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."

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

According to section 1.1.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the term "trademark or service mark" as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of [WIPO Overview 3.0](#). The Complainant submitted evidence that the BCBG MAX AZRIA trademark enjoys protection under national trademark registrations. Thus, the Panel finds that the Complainant's rights in the BCBG MAX AZRIA trademark have been established pursuant to the first element of the Policy.

It is well established that domain names which consist of common, obvious or intentional misspellings of trademarks are considered to be confusingly similar for the purposes of the first element of the Policy. [WIPO Overview 3.0](#), section 1.9 ("Examples of such typos include (i) adjacent keyboard letters, (ii) substitution of similar-appearing characters ... (iii) the use of different letters that appear similar in different fonts, (iv) the use of non-Latin internationalized or accented characters, (v) the inversion of letters and numbers, or (vi) the addition or interspersion of other terms or numbers"). See *e.g. Edmunds.com, Inc. v. Digi Real Estate Foundation*, WIPO Case No. [D2006-1043](#) ("This is clearly a 'typosquatting' case where the disputed domain name is a slight misspelling of a registered trademark to divert Internet traffic. In fact, the [...] domain name comprises the Complainant's trademark [...] with a single misspelling of an element of the mark: a double consonant 'S' at the end").

The disputed domain name in this Complaint is a misspelling of the Complainant's BCBG MAX AZRIA trademark, merely adding an "s" at the end of the trademark, which is reflected in the disputed domain name in its entirety. Accordingly, the Panel finds that the Complainant's BCBG MAX AZRIA trademark is clearly recognizable within the disputed domain name and the disputed domain name clearly constitutes an attempt at typosquatting, by the Respondent.

Under section 1.7 of the [WIPO Overview 3.0](#), while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domain ("gTLD"), see section 1.11.1 of the [WIPO Overview 3.0](#).

It is the view of the Panel that it is readily apparent that the Complainant's trademark remains recognizable in the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the BCBG MAX AZRIA trademark in which the Complainant has rights.

The first element of paragraph 4(a) of the Policy is therefore satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Based on the Complainant's contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its BCBG MAX AZRIA trademark.

The Complainant further contends that the Respondent is not commonly known by the disputed domain name and has not made any *bona fide* use – neither commercial nor non-commercial, of the same.

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

The evidence provided by the Complainant shows that the disputed domain name resolves to an active website seemingly impersonating the Complainant by featuring the Complainant's trademark, logo, and copyrighted images of the Complainant's trademarked goods. While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant and similarly, the lack of any accurate and prominent disclosure of the registrant's relationship with the Complainant on the website at the disputed domain name, renders any fair use safe harbour inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#). See also *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); *Pangaea Laboratories Ltd, Pacific Direct Intertrading Pty Ltd v. Astrix Pty Ltd*, WIPO Case No. [DAU2015-0013](#), "Oki Data is an exception to a general rule. The general rule is that it is generally not permissible to register a domain name that is the same as another's trade mark rights, knowing of those trade mark rights, to seek traffic to a commercial website. Oki Data is a narrow

exception to this rule for legitimate resellers, distributors and dealers. Oki Data is also subject to any agreement between the parties.”

Irrespective of the disputed domain name satisfying the so-called Oki Data test, the nature of the disputed domain name in relation to the Complainant’s trademark carries a risk of implied affiliation, especially when considering the impersonating nature of the content exhibited at the disputed domain name, and as such cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain name. In the absence of any evidence rebutting the Complainant’s *prima facie* case indicating the Respondent’s lack of rights or legitimate interests in respect of the disputed domain name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy

C. Registered and Used in Bad Faith

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. See [WIPO Overview 3.0](#), section 3.1.3.

The Respondent clearly knew of the Complainant’s business and trademark as the disputed domain name resolves to a website with the look and feel of the Complainant’s official web shop and pretending to offer for sale original products under the BCBG MAX AZRIA trademark. The Complainants alleges that the products sold are counterfeit.

The disputed domain name resolves to a website, which purportedly offers products of the Complainant for sale. The Oki Data test requirements have not been met in this case, the Respondent lacks rights to or legitimate interests in the disputed domain name, and the disputed domain name has been registered and used to take commercial advantage due to its confusing similarity with the Complainant’s BCBG MAX AZRIA trademark. Such conduct falls squarely within the meaning of paragraph 4(b)(iv) of the Policy.

Therefore, the Complainant has established that the Respondent registered and is using the disputed domain name in bad faith, and accordingly, the Panel finds that the Complainant has satisfied 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 name <bcbgmaxazrias.com> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: December 13, 2022