

ADMINISTRATIVE PANEL DECISION

Saks.com LLC v. Xiaohong Peng
Case No. D2022-4758

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 Xiaohong Peng, China.

2. The Domain Name and Registrar

The disputed domain name <saksfifths.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 December 12, 2022. On December 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 14, 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 sent an email communication to the Complainant on December 15, 2022, providing further registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on December 15, 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 the Respondent of the Complaint, and the proceedings commenced on December 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 10, 2023.

The Center appointed Dr. Clive N.A. Trotman as the sole panelist in this matter on January 17, 2023. 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 has traded in luxury goods for nearly 100 years. The Complainant's first store, in New York City, was named Saks Fifth Avenue. Presently the Complainant has 42 Saks Fifth Avenue stores and 66 Saks Fifth Avenue Off 5th stores.

The Complainant has provided a list running to some 11 pages of its trademarks for variously SAKS FIFTH AVENUE, SAKS FIFTH AVENUE OFF 5TH, SAKS OFF 5TH, SAKS, and other trademarks incorporating SAKS, registered in 61 countries or jurisdictions, of which 55 trademarks are registered in the People's Republic of China, being the stated domicile of the Respondent.

The Panel has selected the following trademarks as being representative for the purposes of the present proceeding:

SAKS FIFTH AVENUE, United States Registration Number 1180632, registered December 1, 1981, in class 42;

SAKS FIFTH AVENUE, United States Registration Number 620917, registered February 7, 1956, in class 25;

SAKS OFF 5TH, United States Registration Number 5875299, registered October 1, 2019, in class 35;

SAKS, United States Registration Number 5647775, registered January 8, 2019, in classes 35 and 44;

SAKS FIFTH AVENUE OFF 5TH, European Union Trade Mark Number 14023791, registered February 16, 2016, in classes 16, 18, 25, and 35.

The Complainant also conducts business online through the domain names <saksfifthavenue.com> and <saksoff5th.com>.

Nothing of significance is known about the Respondent except for the contact details provided in order to register the disputed domain name on August 20, 2022. The disputed domain name has previously resolved to a multi-page website (the "Respondent's website") bearing the Complainant's trademarks and offering for sale an extensive range of clothing, jewellery, and other items. More recently the disputed domain name has not resolved to an active website.

5. Parties' Contentions

A. Complainant

The Complainant's extensive submissions are summarised below.

The Complainant contends that it has rights in various trademarks comprising or incorporating the word SAKS, including those listed in section 4 above.

The Complainant says the disputed domain name is nearly identical to the Complainant's trademarks and is also confusingly similar to the Complainant's domain names. The disputed domain name incorporates the Complainant's trademarks and in circumstances where this is so, a disputed domain name should generally be considered to be confusingly similar to the relevant trademarks.

The Complainant further contends that the Respondent has no rights or legitimate interest in the disputed domain name, which is being used commercially to trade on the Complainant's goodwill by deception.

The Complainant says it has found no evidence the Respondent has been commonly known as "Saks", "Saks Fifth", or "Saks Fifth Avenue", or by any variation upon these, or has ever held a related trademark. The Respondent has not been licensed to use the Complainant's trademarks and is not known to have sought permission ever to do so.

The Complainant says the disputed domain name is not in any legitimate noncommercial or fair use. The disputed domain name resolves to what the Complainant says appears to be a retail website that identically clones content of the Complainant's website. The Respondent therefore must have been aware of the Complainant's trademarks. Furthermore the Respondent, by accepting customers' credit card information, has been doing so under the false pretence that the customers are dealing with the Complainant.

The Complainant contends that the disputed domain name has been registered and is being used in bad faith. The use of the disputed domain name is to present a website similar to the Complainant's legitimate website, whereby the Respondent offers for sale for commercial gain counterfeit copies of products sold by the Complainant. The Respondent's website displays the Complainant's trademark in scripted logo form. The Respondent uses the website of the disputed domain name to collect credit card and email address information from customers.

The Complainant says its trademarks are distinctive and of long standing duration such that the Respondent cannot reasonably have been unaware of them and that in any case a simple Internet search would have found the Complainant.

The Complainant has cited and quoted from a number of previous decisions under the Policy that it considers relevant to its position.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Respondent is required to submit to a mandatory administrative proceeding in the event that the Complainant asserts to the applicable dispute-resolution provider, in compliance with the Rules, that:

"(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith".

The Complainant has made the relevant assertions as required by the Policy. The dispute is properly within the scope of the Policy and the Panel has jurisdiction to decide the dispute.

A. Identical or Confusingly Similar

The Panel has examined the trademark registration evidence produced by the Complainant in respect of the trademarks SAKS FIFTH AVENUE, SAKS FIFTH AVENUE OFF 5TH, SAKS OFF 5TH, and SAKS.

The disputed domain name is <saksfifths.com>, which may be read as the words “saks” and “fifths”. Insofar as the disputed domain name clearly incorporates the trademark SAKS, which standing alone is a registered trademark of the Complainant and is the leading and distinctive word in the numerous other trademarks owned by the Complainant including SAKS FIFTH AVENUE, SAKS FIFTH AVENUE OFF 5TH, and SAKS OFF 5TH, the disputed domain name is found to be confusingly similar to the Complainant’s trademarks. Moreover, the word “fifth” is an essential component of those of the Complainant trademarks that incorporate the word. The Respondent’s adaptation of “fifth” to “fifths” is found to be of no consequence and does not prevent a finding of confusing similarity.

The Panel finds for the Complainant under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has asserted a *prima facie* case to the effect that the Respondent is not a licensee of the Complainant, is not authorised to use the Complainant’s trademarks, and has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy provides for the Respondent to rebut the Complainant’s *prima facie* case under paragraph 4(a)(ii) of the Policy and to establish rights or legitimate interests in a disputed domain name by demonstrating, without limitation:

- “(i) before any notice to you 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 (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 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”.

Evidence produced by the Complainant shows the disputed domain name to have resolved to a website partly copied from the Complainant’s trading website and offering for sale goods that the Complainant states are similar to its own and are counterfeit. On the evidence, the Respondent’s use of the disputed domain name for an offering of goods is found not to be *bona fide* or to be a legitimate fair or noncommercial use because the Respondent has misrepresented itself as the Complainant and has traded on the goodwill of the Complainant. There is no evidence the Respondent has been commonly known by the disputed domain name.

The Respondent has not accepted the opportunity to assert any rights or legitimate interests in the disputed domain name with reference to paragraphs 4(c)(i), (ii), or (iii) of the Policy or otherwise.

The Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name and finds for the Complainant under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant is required to prove under paragraph 4(a)(iii) of the Policy that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy lists four alternative circumstances, without limitation, that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

- “(i) circumstances indicating that you 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 web site 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 Panel has examined the Complainant's evidence in the form of screen captures of the Respondent's website showing the content on November 23, 2022 and December 8, 2022. For comparison the Complainant has produced copies of its own website "www.saksfifthavenue.com" as it appeared on December 1, 2022 and December 8, 2022. The Respondent's website is strikingly similar to the Complainant's website, for example in heading some of the pages with the words "Saks Fifth Avenue" in an exact copy of the characteristically florid script-style font depicted in the Complainant's trademark, United States Registration Number 620917, registered in 1956, as listed in section 4 above. The many pages of the Respondent's website display numerous articles of apparel for sale, particularly women's clothes, shoes, and some jewellery, as does the Complainant's website. The Complainant in evidence has highlighted certain screen capture illustrations of clothing and jewellery from the Respondent's website, side by side with illustrations from the Complainant's own website, from which latter they are found inescapably to have been copied. Items on the Respondent's website are priced, and under the heading "OUR SHOP" are provided the facilities "My account", "Checkout", "Cart", and "Payment Method", making clear that the Respondent's website is in commercial use.

The Panel finds on the evidence and on the balance of probabilities that the disputed domain name has been used intentionally to attract or to attempt to attract Internet users by confusion with the Complainant's trademarks for commercial gain, constituting use in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. There is no evidence the disputed domain name has been used for any other purpose since its relatively recent registration on August 20, 2022, and the Panel further finds on the balance of probabilities that the disputed domain name was registered in bad faith for the purpose for which it has been used. Accordingly registration and use of the disputed domain name in bad faith are found in the terms 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 name <saksfifths.com> be transferred to the Complainant.

/Dr. Clive N.A. Trotman/

Dr. Clive N.A. Trotman

Sole Panelist

Date: January 31, 2023