

ADMINISTRATIVE PANEL DECISION

BB IPCO LLC (as successor-in-interest to Brooks Brothers, Inc.) v. Giller Hunter
Case No. D2023-0297

1. The Parties

The Complainant is BB IPCO LLC (as successor-in-interest to Brooks Brothers, Inc.), United States of America (“US”) represented by Authentic Brands Group, US.

The Respondent is Giller Hunter, China.

2. The Domain Name and Registrar

The disputed domain name <brooksbrotherscloth.store> 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 January 23, 2023. On January 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 26, 2023, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 30, 2023, 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 amendment to the Complaint on January 30, 2023 and on February 7, 2023.

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 February 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 1, 2023.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on March 16, 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 is the successor-in-interest to Brooks Brothers, Inc., which started out in 1818 as a traditional men's clothier in the US and later expanded to a global fashion, beauty, and accessories brand sold in many countries.

The Complainant owns several trademark registrations for BROOKS BROTHERS, including the following:

- US Trademark Registration No. 667458, BROOKS BROTHERS, registered on September 23, 1958, in class 39;
- US Trademark Registration No. 1839876, BROOKS BROTHERS, registered on June 14, 1994, in class 9;
- US Trademark Registration No. 1835798, BROOKS BROTHERS, registered on May 10, 1994, in class 42;
- US Trademark Registration No. 3029206, BROOKS BROTHERS, registered on December 13, 2005, in classes 3, 8, 9, 14, 16, 18, 20, 21, 24, 25, 27, 28, and 35;
- US Trademark Registration No. 4023020, BROOKS BROTHERS, registered on September 6, 2011, in classes 3 and 4;
- US Trademark Registration No. 3029064, BROOKS BROTHERS logo, registered on December 13, 2005, in classes 25 and 35.

The disputed domain name <brooksbrotherscloth.store> was registered on November 11, 2022, and resolved to a website that offers clothing for men, women, and children.

5. Parties' Contentions

A. Complainant

The Complainant is the owner of the famous and luxurious BROOKS BROTHERS brand that was founded in 1818, having started out as a traditional men's clothier in the US and subsequently expanded to a global fashion, beauty and accessories brand sold in various countries as well as on the Complainant's official website "www.brooksbrothers.com".

The Complainant owns a global portfolio of over 1900 trademark filings covering a variety of goods and services and a vast portfolio of copyright images used in association with the marketing and sale of the BROOKS BROTHERS products globally.

The Complainant claims that the disputed domain name is confusingly similar with the trademark BROOKS BROTHERS in which the Complainant has rights, and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, the Respondent has not been licensed, contracted, or otherwise permitted by the Complainant in any way to use the BROOKS BROTHERS trademark in any way, nor has the Complainant acquiesced in any way to such use or application by the Respondent.

There is no evidence that “Brooks Brothers Cloth” is the name of the Respondent’s corporate entity, nor is there any evidence of fair use.

The Respondent used a privacy shield to mask its identity, which makes it difficult for the Complainant to contact the Respondent and amicably settle the dispute.

The Respondent has been actively using the BROOKS BROTHERS trademark in the disputed domain name and on the physical website to promote its website for illegitimate commercial gains. Such unauthorized use of the BROOKS BROTHERS trademarks is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities, while in fact, no such relationship exists.

More egregiously, the Respondent is trying to pass off the disputed domain name as the Complainant’s website to sell competing and unauthorized goods.

Finally, the Complainant requests the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with 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 name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainant’s BROOKS BROTHERS trademarks.

The disputed domain name incorporates the Complainant’s trademark BROOKS BROTHERS in its entirety with the addition of the term “cloth”, which certainly does not prevent a finding of confusing similarity. Section 1.8 of [WIPO Overview 3.0](#) provides that when the relevant trademark is recognizable within the disputed domain name –as it occurs in this case- the addition of a term would not prevent a finding of confusing similarity under the first element.

The “.store” generic Top-Level Domain (“gTLD”) is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark BROOKS BROTHERS in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it of the dispute, the respondent’s 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once 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 deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

Likewise, and as further discussed under section 6.C of this decision, it does not seem that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name, but rather that it intends to use the disputed domain name for the purpose of deriving unfair monetary advantage by confusing Internet users and leading them to believe that the site to which the disputed domain name relates is an official site of the Complainant.

As established in section 2.5 of [WIPO Overview 3.0](#): “Fundamentally, a respondent’s use of a domain name will not be considered ‘fair’ if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry.” Here, the nature of the disputed domain name carries a high risk of implied affiliation.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent must have been aware of the Complainant's trademark BROOKS BROTHERS mentioned in section 4 above (Factual Background) when it registered the disputed domain name on November 11, 2022. By that time, the Complainant had long ago registered and intensely used the well-known trademark BROOKS BROTHERS.

By registering the disputed domain name, the Respondent was targeting the Complainant and its business by incorporating the Complainant's trademark BROOKS BROTHERS in its entirety and adding the descriptive word "cloth", which only contributes to increase confusion with the intention to confuse Internet users and capitalize on the fame of the Complainant's trademark for its own benefit.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name, the nature of the disputed domain name, the passing-off of the Complainant, and the use of the disputed domain name to resolve to a website offering unauthorized goods which compete with those offered by the Complainant, are indicative of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). The Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

For the above reasons, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

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 <brooksbrotherscloth.store> be transferred to the Complainant.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

Date: March 30, 2023