

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. Client Care, Web
Commerce Communications Limited
Case No. D2023-1182

1. The Parties

The Complainant is No Ordinary Designer Label Limited t/a Ted Baker, United States of America (“United States”), represented by Authentic Brands Group, United States.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <tedbaker-chile.com>, <tedbakeritalianegozi.com>, <tedbakernzsale.com>, <tedbakeronlineromania.com>, <tedbakeroutletsuomi.com>, <tedbakerpolskasklep.com>, <tedbakerportugalonline.com>, <tedbakersaleaustralia.com>, <tedbakersaleireland.com>, <tedbakersalesouthafrica.com>, <tedbakersaleus.com>, <tedbakersingaporesale.com>, and <tedbakerstoreschweiz.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 16, 2023. On March 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 17, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 17, 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 March 17, 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 March 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 18, 2023.

The Center appointed Petra Pecar as the sole panelist in this matter on April 28, 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, No Ordinary Designer Label Limited trading as Ted Baker, holds the globally renowned TED BAKER brand. As a leading manufacturer of apparel, accessories, footwear, homeware, and beauty products for many years, the Complainant has effectively advertised, marketed, promoted, distributed, and sold items under its well-established and esteemed trademark. The brand is supported by an extensive assortment of intellectual property rights, including a global portfolio of over 500 trademarks that cover a broad variety of goods and services. Furthermore, the Complainant maintains a substantial collection of copyrights for images employed in the advertising, marketing, and sales of TED BAKER-branded products worldwide.

The Complainant asserts ownership over an assortment of trademarks for the brand TED BAKER, which encompass various registrations in different jurisdictions, including:

- Australian Trademark TED BAKER, Reg. No. 2269657, Class 25, registered on May 13, 2022;
- Chilean Trademark TED BAKER, Reg. No. 1162062, Class 25, registered on August 19, 2015;
- Chilean Trademark TED BAKER, Reg. No. 1122349, Class 35, registered on August 29, 2014;
- European Union Trademark TED BAKER, Reg. No. 005210661, Class 35, registered on April 25, 2007;
- European Union Trademark TED BAKER, Reg. No. 004267191, Class 25, registered on April 16, 2007;
- Finnish Trademark TED BAKER, Reg. No. 1404015, Class 24, registered October 12, 2017;
- New Zealand Trademark TED BAKER LONDON, Reg. No. 954648, Classes 3, 9, 14, 18, and 25, registered on January 4, 2013;
- International Trademark TED BAKER, Reg. No. 684563, Class 25, registered on December 1, 1997, designating Romania and Poland;
- International Trademark TED BAKER, Reg. No. 810735, Classes 3, 9, 14, and 18, registered on June 16, 2003, designating Romania;
- Singaporean Trademark TED BAKER, Reg. No. T0300247E, Class 25, registered on September 6, 2003;
- South African Trademark TED BAKER, Reg. No. 1997/10134, Class 25, registered on August 8, 2000;
- South African Trademark TED BAKER LONDON, Reg. No. 2012/05102, Class 25, registered on September 30, 2013;
- Swiss Trademark TED BAKER, Reg. No. 2P444313, Classes 9, 18, and 25, registered on July 28, 1997; and
- United States Trademark TED BAKER, Reg. No. 2644551, Class 25, registered on October 29, 2002.

The primary e-commerce website of the Complainant is "www.tedbaker.com". The disputed domain name <tedbaker-chile.com> was registered on December 27, 2022, the disputed domain names <tedbakersaleireland.com>, <tedbakersaleus.com>, <tedbakersingaporesale.com>, <tedbakersalesouthafrica.com>, <tedbakernzsale.com>, <tedbakersaleaustralia.com> were registered on the January 8, 2023, and the disputed domain names <tedbakeroutletsuomi.com>, <tedbakerstoreschweiz.com>, <tedbakerpolskasklep.com>, <tedbakerportugalonline.com>, <tedbakeritalianegozi.com>, <tedbakeronlineromania.com> were registered on January 9, 2023. The disputed domain names redirect to websites that display an "Access Denied" error while the disputed domain

name <tedbakersaleus.com> misleads consumers by imitating an authentic TED BAKER website and offering counterfeit products.

5. Parties' Contentions

A. Complainant

The Complainant, No Ordinary Designer Label Limited trading as Ted Baker, owns the world-famous TED BAKER brand and has been using the TED BAKER trademark for over 35 years. The disputed domain names consist of several elements combined with the Complainant's trademark TED BAKER. The disputed domains include the trademark TED BAKER, a descriptive term such as "online", "sale", "outlet", or "store", and a geographic identifier including "Romania", "Suomi" (Finland in Finnish), "Ireland", "US", "Singapore", "South Africa", "Schweiz" (Switzerland in German), "Polska sklep" (translates to "Poland Shop"), "Portugal", "italianegozi" (translates to "Italia Shops"), "Chile", "NZ" (abbreviation for New Zealand), and "Australia", followed by the generic suffix ".com".

The Complainant argues that the disputed domain names are registered with the same Registrar; registration occurred on or around January 8 and 9, 2023; Whois records show IP locations in Riga, Latvia; IP addresses begin with "172.67."; Hostingchecker.com lists Cloudflare, Inc. as the host; and 12 out of 13 websites display "Access Denied. Error 1020...", suggesting common control.

The Complainant asserts that the disputed domain names are identical or confusingly similar to the Complainant's registered trademarks, as the relevant trademark is recognizable within the disputed domain names. Therefore, the disputed domain names are deemed identical or confusingly similar to the Complainant's registered TED BAKER trademark. The disputed domain names combine the recognizable TED BAKER trademark with various descriptive terms and geographic identifiers, potentially causing confusion among consumers and negatively impacting the Complainant's brand and reputation.

The Complainant argues that the Respondent lacks rights and legitimate interests in the disputed domain names incorporating the TED BAKER trademark. The Complainant has neither granted the Respondent permission nor consent to use or register TED BAKER trademark. Although 12 out of the 13 disputed domain names connected with websites that display the "Access Denied" error, there is no evidence of fair use.

The Respondent's use of the TED BAKER trademark in the disputed domain name <tedbakersaleus.com> misleads consumers by imitating an authentic TED BAKER website and offering counterfeit products for illegitimate financial gains. This unauthorized use could lead to incorrect associations between the Complainant and Respondent, while no such relationship exists. Consequently, the Complainant asserts that there is no evidence of the Respondent's use or preparations to use the disputed domain names for any *bona fide* offering of goods or services, the Respondent is not commonly known by the disputed domain names, and the Respondent's use of the disputed domain names is neither legitimate noncommercial nor fair.

The Complainant asserts that the Respondent registered the disputed domain names on or around January 8 and 9, 2023, being well aware of the Complainant's widely recognized TED BAKER trademarks, which demonstrates bad faith registration, as there is a significant 60-year gap between the Complainant's TED BAKER trademark registration and the Respondent's disputed domain names registration.

Moreover, the Complainant highlights the Respondent's use of a privacy shield to hide its identity, which is an indication of bad faith. The Respondent's attempt to impersonate the Complainant's website for selling competing and unauthorized goods shows a deliberate effort to create confusion with the Complainant's trademark for commercial gain. Such use of a domain name has been deemed as bad faith by previous UDRP panels.

B. Respondent

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

6. Discussion and Findings

Even if the Respondent did not file a Response to the Complainant's contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

"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", as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (i) the disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (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 by the Respondent in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. A trademark registration provides a clear indication that the rights in the trademark belong to the complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.2.1).

The Complainant has presented substantial evidence regarding the global registrations of various TED BAKER trademarks. The Panel concludes that the Complainant has effectively proven its entitlement to the TED BAKER trademarks, supported by prior trademark registrations.

The inclusion of a complainant's trademark in a disputed domain name may establish confusing similarity under the Policy, even if accompanied by other terms. In the present case, the addition of the terms such as "online", "sale", "outlet", or "store", hyphen, and geographic identifiers like "Romania", "Suomi", "Ireland", "US", "Singapore", "South Africa", "Schweiz", "Polska sklep" (which means "Poland Shop"), "Portugal", "italianegozi" (which means "Italia Shops"), "Chile", "NZ", and "Australia", do not prevent a finding of confusing similarity. The inclusion of additional terms, regardless of their descriptive, geographical, pejorative, or meaningless nature, does not preclude a determination of confusing similarity, as set forth in section 1.8 of the [WIPO Overview 3.0](#).

Furthermore, it is well accepted practice by UDRP panels that a generic Top-Level Domain ("gTLD"), such as ".com", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11 of the [WIPO Overview 3.0](#)). For that reason, the Panel accepts not to take gTLD ".com" into account when assessing confusing similarity of the disputed domain name.

The Complainant's TED BAKER trademark is clearly recognizable within the disputed domain names and accordingly, the Panel finds that the Complainant has satisfied the first requirement that the disputed domain names are identical or confusingly similar to the Complainant's registered trademark, under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of 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 name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence to rebut that presumption. If the respondent fails to do so, a complainant is generally deemed to have satisfied the second element, as set out in paragraph 4(a)(ii) of the Policy (see also [WIPO Overview 3.0](#), section 2.1). The Respondent did not provide any proof of authorization to use the TED BAKER trademarks or to register domain names that incorporates the TED BAKER trademark.

Based on the allegations of the Complainant, it appears that the Respondent lacks any affiliation or association with the Complainant and has not been granted any authorization or license to register or use domain names that include the Complainant's TED BAKER trademark. Moreover, the Respondent has failed to provide a response to the Complaint, which precludes the Respondent from presenting any information or factors that could potentially justify prior rights or legitimate interests in the disputed domain names. Additionally, there is no indication of the Respondent engaging in any *bona fide* or noncommercial activities using the disputed domain name, thereby suggesting an absence of legitimate or genuine use.

The Panel finds that the nature of the disputed domain names, which consists of the Complainant's TED BAKER trademark and, the addition of terms related to the Complainant's activity such as "online", "sale", "outlet", or "store", hyphen, and geographic identifiers like "Romania", "Suomi", "Ireland", "US", "Singapore", "South Africa", "Schweiz", "Polska sklep", "Portugal", "italianegozi", "Chile", "NZ", and "Australia", strongly indicates the false affiliation with the Complainant and for that reason a fair use cannot be constituted when the disputed domain names effectively impersonates or suggests affiliation with the Complainant (see section 2.5.1 of the [WIPO Overview 3.0](#)).

Based on the above, the Panel finds that the second element of paragraph 4(a)(ii) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires a complainant to demonstrate that the respondent registered and is using the disputed domain name in bad faith. [WIPO Overview 3.0](#), section 3.1, states that "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark".

Paragraph 4(b) of the Policy stipulates that any of the following circumstances, *inter alia*, shall be considered as evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on its website or location.

Complainant's TED BAKER trademark is contained in its entirety in the disputed domain names. The fact that the disputed domain name comprises a combination of the Complainant's TED BAKER trademark and additional terms such as "online", "sale", "outlet", or "store", which is closely associated with the Complainant's activities, reflects that the Respondent is very familiar with the Complainant, its activity and its TED BAKER trademark. The addition of the geographic identifiers like "Romania", "Suomi", "Ireland", "US", "Singapore", "South Africa", "Schweiz", "Polska sklep", "Portugal", "italianegozi", "Chile", "NZ", and "Australia" indicate only the target territory.

With regard to the bad faith at the time of registration, the Panel notes that it is not likely that the Respondent was not aware of the Complainant and its TED BAKER mark since it was in use at least 35 years before the disputed domain names registration. On the contrary, the Panel finds that it is likely that the Respondent was aware of the Complainant, its rights and reputation in the TED BAKER trademark at the time the disputed domain names were registered. A quick Internet search would reveal the prior existence of TED BAKER trademark. The Panel finds that the Respondent included the trademark TED BAKER in combination with descriptive and geographic terms intentionally in order to mislead consumers and/or for commercial gain. Therefore, the Panel holds that the disputed domain names were registered in bad faith.

Most of the disputed domain names redirect to websites that present an "Access Denied" error, and the disputed domain name <tedbakersaleus.com> misleads customers by resembling a genuine TED BAKER site while offering counterfeit products. The Panel concludes that the non-use of the disputed domain names that redirect to error pages does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)). Further, the disputed domain name <tedbakersaleus.com>, which imitates the Complainant's legitimate website and sells counterfeit items, is using the disputed domain names with bad faith.

The use of a domain name to intentionally attempt to attract Internet users to a respondent's website or online location by creating a likelihood of confusion with a complainant's trademark as to the source, sponsorship, affiliation or endorsement of the respondent's website or online location for commercial gain demonstrates registration and use in bad faith.

As described under paragraph 4(b)(iv) of the Policy, the Respondent is therefore using the disputed domain names to intentionally attract, for commercial gain, Internet users to its web site by creating a likelihood of confusion with the Complainant's TED BAKER trademark.

The Respondent registered disputed domain names under hidden identity which is additional indication of bad faith.

The Respondent's registration of 13 domain names confusingly similar to the Complainant's distinctive trademark indicates a pattern of abusive registration.

Furthermore, the Complainant's TED BAKER trademark should be observed as a trademark that is sufficiently distinctive and that enjoys a certain level of reputation. The Respondent has failed to provide any response to the Complaint and has therefore failed to provide any justification for the registration and use of the disputed domain names. It seems rather unlikely that even if the disputed domain names, which redirect to error page, were put to actual use, such use would be in good faith. Based on the foregoing reasons, the Panel finds that the disputed domain names in the present case should be observed as use in bad faith.

The Panel concludes that the disputed domain names were registered and used in bad faith and that consequently, the Complainant has satisfied the requirement under 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, <tedbaker-chile.com>, <tedbakeritalianegozi.com>, <tedbakernzsale.com>, <tedbakeronlineromania.com>, <tedbakeroutletsuomi.com>, <tedbakerpolskasklep.com>, <tedbakerportugalonline.com>, <tedbakersaleaustralia.com>, <tedbakersaleireland.com>, <tedbakersalesouthafrica.com>, <tedbakersaleus.com>, <tedbakersingaporesale.com>, and <tedbakerstoreschweiz.com>, be transferred to the Complainant.

/Petra Pecar/

Petra Pecar

Sole Panelist

Date: May 12, 2023