

ADMINISTRATIVE PANEL DECISION

ABG-Nine West, LLC v. wubing bing

Case No. D2023-1623

1. The Parties

The Complainant is ABG-Nine West, LLC, United States of America ("United States"), represented by Authentic Brands Group, United States.

The Respondent is wubing bing, China.

2. The Domain Name and Registrar

The disputed domain name <ninediscount.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 April 13, 2023. On April 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 18, 2023, 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 April 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 11, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on May 19, 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 a fashion, footwear and accessories company created in 1978. It is the owner of the United States trademark NINE WEST with registration No. 1775652, registered on June 8, 1993, for goods and services in International Classes 18, 25, and 42 (the “NINE WEST trademark”). The Complainant is also the owner of the United States trademark NINE & CO. with registration No. 2760248, registered on September 2, 2003 for goods in International Class 18 (the “NINE & CO. trademark”).

The Complainant is also the owner of the domain name <ninewest.com>, which resolves to its official website.

The disputed domain name was registered on July 21, 2022. It resolves to an online shop that displays the NINE WEST trademark and offers for sale products bearing the same trademark at what appear to be discounted prices, with international shipping. The title of the website is “Nine West | Women Shoes & Handbags for Women | Buy Online ...” The website does not indicate the name of the provider of the goods offered on it, but lists a contact address in Nashville, Tennessee, United States. The Terms and Conditions of the website declare “We own and retain all proprietary rights to the Site, the Content, and all associated Intellectual Property rights.”

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to its NINE WEST trademark, because it incorporates the distinctive element “nine” of this trademark, followed by the descriptive term “discount”.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is not commonly known by the disputed domain name and has not been permitted by the Complainant to use the NINE WEST trademark or to register any domain name incorporating this trademark. The Complainant adds that the Respondent is not using the disputed domain name for a *bona fide* offering of goods or services or making a legitimate noncommercial or fair use of the disputed domain name. Rather, the Respondent is actively using the NINE WEST trademark for illegitimate commercial gains by operating a fake Nine West website offering counterfeit Nine West goods. According to the Complainant, such unauthorized use of the NINE WEST trademark is likely to trick consumers into erroneously believing that the Respondent is somehow affiliated with the Complainant or the latter is endorsing the commercial activities of the Respondent while in fact no such relationship exists.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It states that the NINE WEST trademark is well known around the world and the Respondent was well aware of it when it registered the disputed domain name in July 2022 - 30 years after the Complainant registered the NINE WEST trademark. The Complainant points out that the Respondent is trying to pass its website off as the Complainant’s official website to sell competing and unauthorized goods. According to the Complainant, the Respondent has no reason to use the NINE WEST trademark in the disputed domain name other than to attract internet users to its website for commercial gain, by trying to create a likelihood of confusion with the NINE WEST trademark as to the source, sponsorship, affiliation, or endorsement of its website and the goods offered on it.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the NINE WEST and NINE & CO. trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the NINE WEST and NINE & CO. trademarks are recognizable within the disputed domain name, as it incorporates their distinctive "nine" element. While the addition of other terms (here, "discount") may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

As further noted in section 1.15 of the [WIPO Overview 3.0](#), the content of the website associated with the domain name is usually disregarded by panels when assessing confusing similarity under the first element. In some instances, panels have however taken note of the content of the website associated with a domain name to confirm confusing similarity whereby it appears *prima facie* that the respondent seeks to target a trademark through the disputed domain name. The Panel accepts this being the case here, as the website at the disputed domain name features the NINE WEST trademark and offers goods bearing the same trademark, and the Respondent does not provide any plausible explanation about its use of the disputed domain name. As further discussed below in this decision, the Panel's conclusion is that the Respondent seeks to target the Complainant through the disputed domain name and the associated website.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Panel considers that the record of this case reflects that:

Before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.

The Respondent (as an individual, business, or other organization) has not been commonly known by the disputed domain name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.

The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.

The record contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name.

The Complainant has submitted evidence that the disputed domain name resolves to a website that features the NINE WEST trademark and offers for sale goods bearing the same trademark. The website however does not indicate the provider of the goods and does not disclose its lack of relationship with the Complainant, which makes it appear as an official online location for the sale of the Complainant's NINE WEST offerings. The Respondent does not allege that the goods offered for sale on its website are original products of the Complainant, and there is nothing in the case file to contradict the Complainant's allegation that these are counterfeit goods. In view of this, the evidence in the case does not support a conclusion that the Respondent's conduct complies with the requirements of the "Oki Data test" (see section 2.8.1 of the [WIPO Overview 3.0](#)), *i.e.*, that the Respondent must actually be offering the Complainant's NINE WEST goods and must be using its website to sell only such goods, and that the Respondent's website must accurately and prominently disclose the Respondent's relationship with the Complainant. Therefore, there is no basis for a finding that the Respondent is making a *bona fide* offering of goods and thus has a legitimate interest in the disputed domain name.

Panels have held that the use of a domain name for illegal activity (*e.g.*, the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

To the extent that there is no allegation or evidence to disprove the Complainant's statement that the goods offered by the Respondent on its website are counterfeit, the Panel accepts as more likely than not that this is indeed the case. The use by the Respondent of the disputed domain name for such illegal activity can never confer on it rights or legitimate interests in the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but 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.

The Panel considers that the record of this case reflects that:

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Respondent has registered the disputed domain name 30 years after the registration of the NINE WEST trademark and it is confusingly similar to this trademark. The disputed domain name is being used for a website that features the NINE WEST trademark and offers for sale goods that are marked with this trademark, which confirms the Respondent's knowledge of the trademark and its targeting by the Respondent. The Respondent's website does not disclose its lack of relationship with the Complainant; rather, it contains a copyright statement that the Respondent is the copyright owner of the content of the website, and an overall misleading impression that the website is an official online source for the Complainant's Nine West goods. There is nothing in the case file to contradict the Complainant's statement that the Respondent's website offers counterfeit goods, which is an illegal activity. All this taken together leads the Panel to the conclusion that the disputed domain name has been registered and is being used in bad faith.

Therefore, based on the available record, the Panel finds the third element of the Policy has been established.

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

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: June 2, 2023