

ADMINISTRATIVE PANEL DECISION

Ferm Living ApS v. Oldsa Oldsa
Case No. D2023-1635

1. The Parties

The Complainant is Ferm Living ApS, Denmark, represented by Aera A/S, Denmark.

The Respondent is Oldsa Oldsa, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <homefermliving.com> (“the Domain Name”) 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 14, 2023. On April 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 18, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 19, 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 amended Complaint on April 20, 2023.

The Center verified that the Complaint together with the amended 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 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 16, 2023.

The Center appointed Jon Lang as the sole panelist in this matter on May 23, 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 Danish company based in Copenhagen which has specialized in the manufacture and sale of furnishings and interior designs since its foundation in 2006. Products produced and distributed by the Complainant are sold worldwide in more than 75 countries. It owns the trademarks FERM LIVING (word mark) and FERM LIVING (device mark), together the “FERM LIVING trademark” or “Complainant’s trademark”, which are registered in more than 40 countries. Examples include Danish Trademark Registration no. VR 2007 00835 for FERM LIVING (word mark) with a Registration Date of March 27, 2007, and Danish Trademark Registration no. VR 2014 00497 for FERM LIVING (device mark) with a Registration Date of March 3, 2014.

The Complainant owns and maintains a website at the domain name <fermliving.com>.

The Domain Name was registered on September 2, 2022. It resolves to a website which displays the Complainant’s (device) trademark, designs, product names and pictures.

5. Parties’ Contentions

A. Complainant

The following is a summary of the main contentions of the Complainant.

The website to which the Domain Name resolves is being used to imitate the Complainant and attract customers in circumstances where the Respondent has no rights or legitimate interests in the Domain Name, the registration of which has been made in bad faith.

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Domain Name incorporates the entirety of the Complainant’s trademark and trade name FERM LIVING in combination with the term “home” and the generic top-level domain (“gTLD”) “.com”.

The addition of the suffix “home” does not impact the overall impression given by the dominant part of the Domain Name (*i.e.* FERM LIVING) and thus is not sufficient to overcome the confusing similarity to the Complainant’s FERM LIVING trademark which constitutes not only the dominant, but also the only distinctive element of the Domain Name.

Where a trademark is recognizable within a disputed domain name, the addition of other terms do not prevent a finding of confusing similarity.

Given the brand awareness of the FERM LIVING trademark worldwide, an Internet user would most probably assume a connection with, or endorsement from the Complainant and its business when landing on the website located at the Domain Name, particularly when the Complainant’s trademark is used (without permission) on that website.

Such an association between the website and the Complainant will undoubtedly be detrimental to the Complainant.

The gTLD “.com” should be excluded from any consideration of similarity given that it is a technical requirement of registration.

There is a clear phonetic, visual and conceptual similarity between the Domain Name and the Complainant's trademark.

The Respondent has no rights or legitimate interests in respect of the Domain Name.

The Complainant is not in any way affiliated with the Respondent or the Domain Name, and the Complainant has not permitted the use of its FERM LIVING trademark in any way.

There is no evidence to conclude that the Respondent owns any service marks or word marks that reflect the Domain Name and there is nothing to suggest that the Respondent is commonly known by the Domain Name.

The Complainant's trademark registrations predate the Respondent's registration of the Domain Name by several years.

Interior products and furniture are being marketed and sold at the Respondent's website which are being passed off as original products of the Complainant.

The Complainant's device mark is being used on the Respondent's website without consent.

The reason for the Respondent's registration of the Domain Name must be to profit from its sale and/or to use it for the purposes of intentionally attracting Internet users to the website to which it resolves by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website. The relevant public could be induced to assume that they are able to buy original FERM LIVING products from the Complainant on the Respondent's website, or be led to believe that the website is owned by or related to the Complainant. Such an association between the Respondent's website and the Complainant will undoubtedly be detrimental to the Complainant and the Complainant's trademark.

In addition, the Complainant is the proprietor of the domain name <fermliving.com> through which the Complainant is marketing and selling interior and furniture to its customers. The Respondent's use of the Domain Name will mislead existing and potential new customers to believe that the Respondent is acting as an authorized dealer of FERM LIVING products.

Mere registration of a domain name does not establish rights or legitimate interests in that name. There must be a fair or non-commercial use or *bona fide* offering of goods under the domain name to establish rights or legitimate interests. No such use exists here. The Respondent is using the Domain Name intending to make commercial gain by misleadingly diverting customers, or to tarnish the Complainant's trademark.

The Complainant has not licensed or otherwise permitted the Respondent to use its trademark, or to apply for any domain name incorporating the trademark.

The Domain Name was registered and is being used in bad faith

The Complainant's trademark rights were established several years prior to registration of the Domain Name which the Respondent is using to attract Internet users to its website.

It is likely that the intention of the Respondent is to profit from illegal exploitation of the goodwill and reputation of the Complainant's trademark.

It is apparent from the composition of the Domain Name that the Respondent must have known of the Complainant's trademark and its business. The Respondent could not have chosen or subsequently used the word "fermliving" in combination with the term "home", for any reason other than to trade-off of the goodwill and reputation of the Complainant's trademark, or otherwise to create the impression of a false association with, or sponsorship or endorsement of, the Complainant.

The registration of a domain name confusingly similar to a registered trademark by a person with no connection to the trademark in question amounts to "opportunistic bad faith".

There is no plausible reason for the Respondent's selection of a confusingly similar Domain Name in which the Respondent has no rights or legitimate interests, other than as a deliberate attempt to profit unfairly from confusion with the Complainant's trademark.

By using the Complainant's trademark (correctly spelt) and by directly or indirectly implying on the Respondent's website that it is an official shop, it is clear that the Respondent intended the Domain Name to be confused with the Complainant's trademark.

The Domain Name was registered with a deliberate intention to create an impression of association with the Complainant. Given the Respondent's lack of rights or legitimate interests in the Domain Name and its confusing similarity with the Complainant's trademark, any use of the Domain Name for marketing and sale of either counterfeit or identical products carries with it a risk of implied affiliation with the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires a complainant to prove that a respondent has registered a domain name which is: (i) identical or confusingly similar to a trademark or service mark in which a complainant has rights; and (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and (iii) that the domain name has been registered and is being used in bad faith. A complainant must prove each of these three elements to succeed.

A. Identical or Confusingly Similar

The Complainant clearly has rights in its FERM LIVING word and device trademarks.

Ignoring the gTLD ".com" (as the Panel may do for comparison purposes), the Domain Name comprises the Complainant's FERM LIVING trademark, preceded by the word "home".

As the FERM LIVING trademark and Domain Name are not identical, the issue of confusing similarity must be considered. Application of the confusing similarity test under the UDRP typically involves a comparison, on a visual or aural level, between the trademark and the disputed domain name. To satisfy the test, the trademark to which the domain name is said to be confusingly similar, would generally need to be recognizable as such

within the disputed domain name. The addition of common, dictionary, descriptive or negative terms are usually regarded as insufficient to prevent confusing similarity.

The FERM LIVING trademark is clearly recognizable within the Domain Name. The word that precedes it (“home”) does not prevent a finding that the Domain Name is confusingly similar to the Complainant’s FERM LIVING trademark. (See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.8).

The Panel finds that the Domain Name is confusingly similar to the FERM LIVING trademark for the purposes of the Policy and thus paragraph 4(a)(i) (of the Policy) has been established.

B. Rights or Legitimate Interests

By its allegations, the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name and, as such, the burden of production shifts to the Respondent to come forward with arguments or evidence demonstrating that it does in fact have such rights or legitimate interests. The Respondent has not done so and accordingly, the Panel is entitled to find, given the *prima facie* case made out by the Complainant, that the Respondent indeed lacks rights or legitimate interests in the Domain Name. Despite the lack of any answer to the Complaint however, the Panel is entitled to consider whether there would be anything inappropriate in such a finding.

Paragraph 4(c) of the Policy sets out a (non-exhaustive) list of circumstances which, if proved, will demonstrate that a respondent has rights to, or legitimate interests in a domain name. Thus, even if a respondent has not been licensed by or affiliated with a complainant (as is the case here), it might still be able to demonstrate rights or legitimate interests by reference to paragraph 4(c), or other factors. For instance, a respondent can show that it has been commonly known by the domain name or that it is making a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers.

The Respondent is not known by the Domain Name.

The Domain Name resolves to a website advertising for sale what purport to be “Ferm Living” products. The website does not appear to be “noncommercial” in nature. Even if it were, paragraph 4(c) contemplates “use” being without intent (for commercial gain) to misleadingly divert consumers. Given the inevitable impression of association with the Complainant however, it appears that this is precisely what the Domain Name is designed to do. In these circumstances, the Respondent would also likely fail in any attempt to demonstrate “fair use”.

A respondent can also show that before any notice of dispute, it was using or had made 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. It is unlikely that any offering by the Respondent using a Domain Name confusingly similar to the FERM LIVING trademark could be regarded as *bona fide*, particularly given that it resolves to what could be described as an imitation site displaying the Complainant’s FERM LIVING device mark, designs, product names and pictures, clearly suggesting, wrongly, that it is a website of, or affiliated in some way with, the Complainant.

The Domain Name was designed to create in the minds of Internet users a connection with the Complainant. In *Drexel University v. David Brouda*, WIPO Case No. [D2001-0067](#), the panel stated that “rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the Complainant”.

It is unlikely that the Respondent could have said anything to support an argument that it does have rights or legitimate interests in the Domain Name. The Panel is satisfied that the Respondent has no rights or legitimate interests in the Domain Name and accordingly, finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

One way a complainant may demonstrate bad faith registration and use of a domain name is to show that in using the domain name a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or of products or services on it (paragraph 4(b)(iv) of the Policy).

Given the nature of the website to which the Domain Name resolves, it is beyond doubt that the Respondent was aware of the Complainant's FERM LIVING trademark prior to its registration. The purpose behind registration of the Domain Name was clearly to attract Internet users to the Respondent's website using a domain name confusingly similar to the Complainant's FERM LIVING trademark. In other words, the circumstances envisaged by paragraph 4(b)(iv) of the Policy.

The Panel finds that, for the purposes of the Policy, there is evidence of both registration and use of the Domain Name in bad faith.

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 Domain Name <homefermliving.com> be transferred to the Complainant.

/Jon Lang/

Jon Lang

Sole Panelist

Date: June 6, 2023