

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. Web Commerce Communications Limited
Case No. D2023-1678

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 Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <tedbakeroutletusa.com> is 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 April 17, 2023. On April 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 19, 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 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 amendment to the Complaint on April 19, 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 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 Anna Carabelli as the sole panelist in this matter on May 26, 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, operates in the clothing retail industry, offering menswear, womenswear, and accessories.

The Complainant owns a global portfolio of trademark registration for TED BAKER, including:

- United States trademark registration No. 2644551, registered since October 29, 2002 and
- United States trademark registration No. 2672649, registered since January 7, 2003.

The Complainant also owns a large portfolio of copyrights for images used in connection with the advertising, marketing and sale of TED BAKER branded products globally.

The disputed domain name was registered on February 3, 2023. The evidence in the Complaint is that the disputed domain name redirects to an active website seemingly offering TED BAKER branded products. The Respondent's web site imitates the Complainant's official website and displays the Complainant's TED BAKER trademark.

5. Parties' Contentions

A. Complainant

The Complainant submits and contends that:

- The Complainant has been using its TED BAKER trademark for over 35 years and has built up substantial recognition in the TED BAKER brand among the public.
- The disputed domain name is identical or confusingly similar to the Complainant's TED BAKER trademark. In this regard, the Complainant notes that the disputed domain name entirely incorporates the TED BAKER mark, which is distinctive and well known internationally and firmly associated with the Complainant. The addition of the term "outlet" followed by the geographical abbreviation "usa" and the generic Top-Level Domain (gTLD) ".com", does not prevent a finding of confusing similarity.
- The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent (i) is not affiliated with the Complainant, (ii) has not been authorized or somehow given consent by the Complainant to register any domain name incorporating such trademark, (iii) in any event is not authorized or licensed to use the TED BAKER trademark, and (iv) is not commonly known by the disputed domain name.
- The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods and services and is not making a legitimate noncommercial or fair use of the disputed domain name. The Respondent has been actively using the disputed domain name to operate a fake TED BAKER website offering unauthorized and/or counterfeit TED BAKER goods.
- The disputed domain name was registered in bad faith. The Respondent was aware of and targeted the Complainant's trademark when registering the disputed domain name, which occurred at least 35 years after the Complainant's established registered trademark rights in the TED BAKER mark. The Respondent's use of a proxy service to mask its identity, is also indicative of bad faith.

- The disputed domain name is also used in bad faith to intentionally attract for commercial gain Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark and trying to pass off the disputed domain name as the Complainant's website to sell competing and unauthorized goods.

Based on the above, the Complainant requests 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

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

- (i) the disputed domain name is identical or confusingly similar to 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 has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark TED BAKER based on the evidence submitted in the Complaint.

The disputed domain name consists of the Complainant's trademark TED BAKER with addition of the term "outlet", followed by the geographical abbreviation "usa" and by the gTLD ".com".

The addition of the gTLD such as ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test (see section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Therefore, the relevant comparison to be made is with the second-level portion of the disputed domain name, *i.e.*, "tedbakeroutletusa". As highlighted in section 1.7 of the [WIPO Overview 3.0](#), the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. The disputed domain name entirely incorporates the Complainant's mark TED BAKER and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (*e.g.*, *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

Accordingly, the Panel finds that disputed domain name is confusingly similar to a mark in which the Complainant has rights. Therefore, the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice to it of the dispute, its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name, even if it has acquired no trademark or service mark rights;
- (iii) it is 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.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following: (a) the Complainant holds prior rights in the globally registered and well known TED BAKER mark, (b) the Respondent has not been authorized to use the Complainant's trademark in any way, and is not commonly known by the disputed domain name (c) the disputed domain names resolve to fake TED BAKER website offering unauthorized and/or counterfeit goods.

According to section 2.1 of the [WIPO Overview 3.0](#), 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.

Here the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy.

The Panel needs not come to a determination on the nature of the goods being offered on the Respondent's website, noting that the website at the disputed domain name contains the TED BAKER mark and mimics the Complainant's official website, and reflect no information concerning the websites' relationship (lack thereof) to the Complainant. See sections 2.8 and 2.13.2 of the [WIPO Overview 3.0](#). Further to the so-called "Oki Data test" enshrined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), even if the goods offered at the website to which the disputed domain name resolves were of a genuine nature, the disputed domain name cannot constitute fair use given its lack of disclaimers.

The Panel also finds that given that the disputed domain name is composed of the Complainant's distinctive trademark, along with the descriptive addition of "outlet" and the geographic abbreviation "usa". This composition of the disputed domain name carries a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use, particularly given the impersonating nature of the content that exacerbates said risk of implied affiliation.

The Panel concludes that the Respondent deliberately chose to include the Complainant's TED BAKER trademark in the disputed domain name, in order to achieve commercial gain by misleading third parties, and that such use cannot be considered as a legitimate noncommercial or fair use.

Based on the above, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and used in bad faith.

The TED BAKER trademark is distinctive and well known and the date of its first registration significantly precedes the date of registration of the disputed domain name. Moreover, given the use of the disputed domain name, the Panel concludes that the Respondent knew that the disputed domain name would be confusingly similar to the Complainant's trademark. The fact that the website at the disputed domain name features the Complainant's TED BAKER trademark and allegedly offers the Complainant's trademarked goods, indicates that the Respondent targeted the Complainant when registering the disputed domain name.

The above conduct constitutes opportunistic bad faith registration (see section 3.2.1 of the [WIPO Overview 3.0](#)), as well as bad faith use of the disputed domain name under the Policy. Indeed, the Respondent has used the disputed domain name to capitalize on the renown of the Complainant's TED BAKER mark.

By directing the disputed domain name to a commercial website allegedly offering the Complainant's goods, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its website (see section 3.1.3 of the [WIPO Overview 3.0](#)). Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith.

The Complainant points out that the Respondent used a privacy shield to mask its identity. Previous UDRP Panels have found that this may further supports a finding of bad faith, particularly where the respondent has registered a disputed domain name involving the complainant's well-known trademark (see *International Business Machines Corporation v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fudacion Comercio Electronico*, WIPO Case No. [D2021-0035](#); see also *Ustream TV, Inc. v. Vertical Axis, Inc.*, WIPO Case No. [D2008-0598](#); *Sermo Inc. v. CatalystMD, LLC*, WIPO Case No. [D2008-0647](#))

Based on the above, the Panel finds that the Complainant has established also 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, <tedbakeroutletusa.com> be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: June 9, 2023