

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. Client Care, Web
Commerce Communications Limited
Case No. D2023-1768

1. The Parties

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

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

2. The Domain Name and Registrar

The disputed domain name <tedbakershoesuk.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 20, 2023. On April 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 24, 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 26, 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 26, 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 May 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 25, 2023.

The Center appointed Beatrice Onica Jarka as the sole panelist in this matter on June 12, 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 owner of the world-famous TED BAKER brand, as it is currently, and for many years has been, one of the world's leading manufacturers of apparel, accessories, footwear, homeware, and beauty, and has advertised, marketed, promoted, distributed and sold such worldwide under its well-known and famous TED BAKER trademark.

The TED BAKER brand is supported by a vast portfolio of intellectual property rights, including a global portfolio of more than 500 trademarks covering a wide variety of goods and services and a large portfolio of copyrights for images used in association with the advertising, marketing and sale of TED BAKER-branded products globally (collectively, the "Complainant's IP Rights").

More particularly, the Complainant's trademark portfolio includes but is not limited to, the following in the United Kingdom:

- TED BAKER- Reg. No. UK00003250250, registered on December 29, 2017, Classes 3, 4, 8, 9, 11, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 28, 35, 41, 43, 44. See Annex 4.1.
- TED BAKER- Reg. No. UK00002320837, registered on August 15, 2003, Classes 3, 9, 14, 18, 20, 21, 24, 25. Annex 4.2.
- TED BAKER- Reg. No. UK00911370467, registered on April 12, 2013, Class 18. See Annex 4.3.
- TED BAKER- Reg. No. UK00905210661, registered on April 25, 2007, Class 35. See Annex 4.4.
- TED BAKER- Reg. No. UK00910245827, registered on January 11, 2012, Classes 3, 9, 14, 18, 25. Annex 4.5.

The Complainant began using its TED BAKER trademark over 35 years ago and spends millions of dollars marketing its goods and services globally, using the TED BAKER trademark, and has undertaken extensive efforts to protect its name and enforce such trademarks. The Complainant exerts careful control over use of the TED BAKER trademarks and imposes strict quality control measures over goods and services offered in connection with the trademarks. The Complainant further protects its brand, and the TED BAKER trademarks by diligently pursuing infringers.

The disputed domain name was registered August 12, 2022 and resolves to a website purportedly offering the Complainant's unauthorized and/or counterfeit goods.

5. Parties' Contentions

A. Complainant

The Complainant contends under the first element of the Policy (Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1)) the following:

- The Complainant is the owner of the world-famous TED BAKER trademark.

- The disputed domain name consists of the usual “www.” prefix, the Complainant’s trademark TED BAKER, the descriptive term “shoes”, followed by the geographic abbreviation “UK”, and the generic Top Level Domain “.com”.
- The relevant trademark is recognizable within the disputed domain name, the addition of other terms creating no distinctiveness.

The Complainant contends under the second element of the Policy (Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2)) the following:

- The Respondent has no rights or legitimate interests in respect of the domain name.
- The Respondent has not been licensed, contracted, or otherwise permitted by the Complainant in any way to use the TED BAKER trademark or to apply for any domain names incorporating the TED BAKER trademark, nor has the Complainant acquiesced in any way to such use or application of the TED BAKER trademark by the Respondent.
- There is no evidence that the Respondent is using or plans to use the TED BAKER trademark or the disputed domain names incorporating the TED BAKER trademark for a *bona fide* offering of goods or services that doesn’t infringe the Complainant’s IP rights.
- On the contrary, the Respondent has been actively using the TED BAKER trademarks in the domain name and on the physical website to promote its website for illegitimate commercial gains, more specifically, by operating a fake TED BAKER website offering unauthorized and/or counterfeit TED BAKER goods.
- Such unauthorized use of the TED BAKER 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.
- The Respondent has not been commonly known by the domain name.
- The Respondent is not making a legitimate non-commercial or fair use of the domain name.

The Complainant contends under the third element of the Policy (Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3)) the following:

- The disputed domain name was registered and is being used in bad faith.
- The Respondent was well aware of the Complainant’s trademark at the time the Respondent registered the disputed domain name.
- The Complainant’s trademarks are well-known around the world.
- The Complainant relies on the extensive range of registered trademarks for “TED BAKER” to which references have already been made.
- The use of privacy shields or similar services which mask the Respondent’s identity are an indication of bad faith.
- The Respondent is trying to pass off the disputed domain name as the Complainant’s website to sell competing and unauthorized goods.

- The Respondent has no reason to use the mark in the disputed domain name other than to attract Internet users to its site for commercial gain, especially since the Complainant's official website is "www.tedbaker.com".
- Thus, the Respondent is intentionally trying to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement.
- It has been found by prior UDRP panels that such use of a domain name constitutes bad faith.

B. Respondent

Although properly summoned, the Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

This Panel finds that the Complainant is the holder of the TED BAKER trademark rights.

In regards of the identity/confusing similarity requirement of the first element related to the disputed domain name, this Panel finds that it incorporates the Complainant's distinguished TED BAKER trademark in full followed by the terms "shoes" and "uk", it considers the said requirement is therefore fulfilled.

It has been established by the UDRP practice (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")) that the 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, which is the case in these proceedings. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the [WIPO Overview 3.0](#)).

Consequently, this Panel finds the Complainant's TED BAKER trademark recognizable within the disputed domain name which leads to the conclusion that the disputed domain name is confusingly similar to the trademark and the first element under of paragraph 4(a) of the Policy is accordingly established.

B. Rights or Legitimate Interests

According to UDRP practice, in relation to the second element of the Policy, the Complainant has to show that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that *prima facie* showing, the burden of production shifts to the Respondent, according to the section 2.1 of the [WIPO Overview 3.0](#).

In these proceedings, this Panel finds that the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and such showing has not been rebutted by the Respondent, as it did not reply to the Complainant's contentions.

In this case, the Panel considers within the unrebutted *prima facie* showing of the Complainant the following:

- The Respondent has not been licensed, contracted, or otherwise permitted by the Complainant in any way to use the TED BAKER trademark or to apply for any domain names incorporating the TED BAKER trademark, nor has the Complainant acquiesced in any way to such use or application of the TED BAKER trademark by the Respondent.

- There is no evidence that the Respondent is using or plans to use the TED BAKER trademark or the disputed domain name incorporating the TED BAKER trademark for a *bona fide* offering of goods or services that doesn't infringe the Complainant's IP rights, but on the contrary, the Respondent has been actively using the TED BAKER trademarks in the disputed domain name and on the physical website to promote its website for illegitimate commercial gains, more specifically, by operating a fake TED BAKER website offering unauthorized and/or possible counterfeit TED BAKER goods.
- The Respondent is not been commonly known by the disputed domain name.

Further, the Panel finds that the composition of the disputed domain name, including the Complainant's trademark in full, followed by the term "shoes" and the geographic abbreviation "uk", carries a risk of implied affiliation to the Complainant, particularly considering the content of the website to which the disputed domain name resolves.

Accordingly, this Panel finds that the second element under of paragraph 4(a) of the Policy is established.

C. Registered and Used in Bad Faith

The Complaint further submits several aspects in connection to the third element of the Policy which this Panel finds to be strong indication of bad faith registration and use of the disputed domain name.

Noting that the Complainant's TED BAKER trademark is distinctive and well known, it is likely that the Respondent was well aware of the Complainant's trademark at the time it registered the disputed domain name.

Considering also that the Respondent is trying to pass off the disputed domain name as the Complainant's website to sell competing and unauthorized goods, this Panel agrees with the Complainant that the Respondent has no reason to use the mark in the disputed domain name other than to attract Internet users to its site under the disputed domain name for commercial gain and is intentionally trying to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement.

Accordingly this Panel finds that the third element under of paragraph 4(a) of the Policy is 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, <tedbakershoesuk.com> be transferred to the Complainant.

/Dr. Beatrice Onica Jarka/

Dr. Beatrice Onica Jarka

Sole Panelist

Date: June 26, 2023