

ADMINISTRATIVE PANEL DECISION

Christopher Esber v. Hbdb Ybdw
Case No. D2023-1792

1. The Parties

The Complainant is Christopher Esber, Australia, represented by Yara Law, Australia.

The Respondent is Hbdb Ybdw, China.

2. The Domain Name and Registrar

The disputed domain name <christopheresbershop.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 21, 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 (Whois Agent, Domain Protection Services, Inc) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 25, 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 28, 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 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 19, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on May 25, 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 an Australian fashion designer who established his brand in 2010 in Sydney.

The Complainant's collections are sold in multiple high-end fashion houses throughout the world, including the European Union in locations such as London and Milan, and are also available for purchase in multiple United States of America cities, including New York. They can also be purchased from the Complainant's website at "www.christophersber.com.au" and from multiple third-party fashion websites as well as from traditional bricks and mortar outlets around the world.

The Complainant is the owner of several trademark registrations for CHRISTOPHER ESBER, including the following, as per trademark certificates submitted as annexes 7 to the Complaint:

- Australian trademark registration No.1354304 for CHRISTOPHER ESBER (word mark), filed on April 4, 2010, and registered on November 15, 2010, in class 25;
- International trademark registration No. 1582455 for CHRISTOPHER ESBER (word mark), registered on December 23, 2020, in classes 03, 04, 14, 18, 25, and 35;
- Hong Kong, China trademark registration No. 305638230 for CHRISTOPHER ESBER (word mark), registered on May 27, 2021, in classes 03, 04, 14, 18, 25, and 35.

The Complainant is also the owner of the domain name <christophersber.com.au>, which is used by the Complainant to promote and offer for sale his fashion products under the trademark CHRISTOPHER ESBER.

The disputed domain name <christophersbershop.com> was registered on June 30, 2022, and is pointed to a website publishing the Complainant's trademark and offering for sale purported Christopher Esber products at discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the trademark CHRISTOPHER ESBER in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the descriptive term "shop" and the generic Top-Level Domain (gTLD) ".com".

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent is in no way affiliated, associated or connected with the Complainant in any way nor has it ever been authorized by the Complainant to register or use the disputed domain name or seek the registration of any domain name incorporating his word mark or a domain name which is similar to his trademark.

The Complainant submits that the Respondent's use of a Whois privacy service clearly supports the conclusion that the Respondent has no rights or legitimate interests in the disputed domain name and that its use is simply for unlawful personal commercial gain, especially considering that the underlying registrant is not commonly known by the disputed domain name.

The Complainant further contends that there is no evidence that the Respondent used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial use, since the disputed domain name resolves to a website which infringes the Complainant's registered trademark rights.

Moreover, the Complainant highlights that the Respondent's website makes specific reference to clothing, jewelry, swimwear, footwear and apparel, all of which are goods sold by the Complainant under his trademark CHRISTOPHER ESBER.

The Complainant further submits that the Respondent's unauthorized use is clearly intended for commercial gain and that the Respondent does not possess and cannot fulfil customer orders unless it intends to deliberately mislead or confuse consumers by enticing them to purchase goods that they will either never receive or are counterfeit/fake inferior quality goods, thus clearly adversely impacting on the Complainant's legitimate business and severely tarnishing the Complainant's trademark and reputation.

The Complainant further emphasizes that, with respect to the Respondent's website and the "Oki Data test", the Respondent is allegedly offering the relevant goods under the Complainant's trademark without however accurately or prominently disclosing its (inexistent) relationship with the Complainant, giving the impression that the Respondent is somewhat associated, affiliated or connected with the Complainant, which it is not.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering his brand's goodwill and world renown, the Respondent deliberately attempted to attract Internet users to its website (or other online location) for commercial gain, by creating a likelihood of confusion with the Complainant's name and trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of the products offered therein.

The Complainant further underlines that, considering the surname "Esber" in combination with the first name "Christopher" is not common and most certainly distinctive and rare in the fashion and apparel industry (particularly, the high-end of this market/industry), the Respondent was undoubtedly acting in bad faith at the time of registering the disputed domain name since a simple online search, would have disclosed the Complainant and his products, available not only on his own website but also at multiple third-party retailers including The Iconic, Matches Fashion, MyTheresa, Desorde Boutique, Far Fetch, Net-A-Porter and Parlour X.

The Complainant concludes that the Respondent registered the disputed domain name with the Complainant's trademark in mind, deliberately aiming at disrupting the Complainant's business and at attracting Internet users to its own website for commercial gain by creating a likelihood of confusion with the Complainant's name and trademark.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "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." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has provided evidence of ownership of trademark registrations for CHRISTOPHER ESBER in several jurisdictions, as mentioned under Section 4 above.

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

The disputed domain name incorporates the trademark CHRISTOPHER ESBER in its entirety with the addition of the term "shop" and the gTLD suffix ".com", which the Panel finds does not prevent a finding of confusing similarity.

As found in a number of prior cases decided under the Policy, where a trademark is recognizable within a domain name, the addition of generic or descriptive terms does not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#).

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

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

"(i) before any notice to you of the dispute, your use of, or 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; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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."

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not submitting a Response, has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

Moreover, it has been repeatedly stated that when a respondent does not avail itself of its right to respond to a complaint, it can be assumed in appropriate circumstances that the respondent has no rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademark. Moreover, there is no element from which the Panel could infer a Respondent's right or legitimate interest over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

The Panel notes that the disputed domain name is pointed to a website displaying the Complainant's trademark and offering for sale purported Christopher Eesber products at discounted prices. Irrespectively

of the nature of the products offered by the Respondent, the Panel finds that the Respondent's use of the disputed domain name does not meet the cumulative requirements set forth in the Oki Data test for resellers using a domain name containing a complainant's trademark to be making a *bona fide* offering of goods and services. Specifically, the website does not accurately and prominently disclose the Respondent's (lack of) relationship with the trademark holder. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and section 2.8.1 of the [WIPO Overview 3.0](#). Moreover, the Panel finds that the disputed domain name is inherently misleading. See section 2.5.1 of the [WIPO Overview 3.0](#).

In view of the above-described use of the disputed domain name, the Panel finds that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

As to the bad faith at the time of the registration, the Panel notes that, in light of the prior registration and use of the Complainant's trademark CHRISTOPHER ESBER in connection with the Complainant's products, advertised and offered for sale also online via the Complainant's website at "www.christopheresber.com.au" and on many third-party platforms, the Respondent was or should have been aware of the Complainant's trademark. Indeed, a simple online search for "Christopher Esber" would have revealed the existence of the Complainant and its trademark.

Moreover, the fact that the disputed domain name has been pointed to a website featuring the Complainant's trademark and offering purported Christopher Esber products at discounted prices, clearly suggests that the Respondent was indeed well aware of the Complainant and its trademark.

The Panel also finds that, by pointing the inherently misleading disputed domain name to the website described above, promoting and offering for sale purported Christopher Esber products and failing to accurately and prominently disclose the relationship with the trademark owner, the Respondent has intentionally attempted to attract Internet users to his website for commercial gain, by causing a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of his website and the products promoted therein according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to 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, <christopheresbershop.com>, be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: June 9, 2023