

ADMINISTRATIVE PANEL DECISION

Telfar LLC. v. Kenyatta James

Case No. D2023-2301

1. The Parties

Complainant is Telfar LLC., United States of America (the “United States”), represented by Marq Vision Inc., Republic of Korea.

Respondent is Kenyatta James, United States.

2. The Domain Names and Registrar

The disputed domain names <buytelfarbagsonline.com>, <cheaptelfarbags.com>, <shoppingbagtelfar.com>, and <telfarshop.com> (the “Dispute Domain Names”) are registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 26, 2023. On May 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On May 26, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on June 1, 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 Respondent of the Complaint, and the proceedings commenced on June 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 25, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on July 3, 2023.

The Center appointed Richard W. Page as the sole panelist in this matter on July 10, 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

Complainant designs, manufactures, and sells handbags, apparel, and accessories under and in association with the registered trademark TELFAR (the “TELFAR Mark”) in the United States and worldwide. Complainant actively promotes the TELFAR Mark through its official website at “www.telfar.net”. Complainant registered the TELFAR Mark in the United States as early as August 13, 2019, and subsequently registered the TELFAR Mark in many additional jurisdictions around the world. Complainant has also been using the TELFAR Mark worldwide in association with the sale of handbags, apparel, and accessories from as early as 2005. Additionally, Complainant registered in the United States the trademark TELFAR EST. 2005, NYC, which was first used in commerce in 2014, and registered in 2021.

The Disputed Domain Names were registered on June 22, 2022, and all of them resolve to websites purporting to be selling TELFAR products, reproducing not only the TELFAR Mark but also the TELFAR EST. 2005, NYC trademark.

5. Parties’ Contentions

A. Complainant

Complainant contends that the Disputed Domain Names are confusingly similar to the TELFAR Mark and to Complainant’s domain name <telfar.net>, pursuant to paragraph 4(a)(i) of the Policy. Complainant further contends that the Disputed Domain Names identically reproduce the TELFAR Mark in its entirety, which is famous and highly distinctive since it has no practical meaning. The addition of the terms “shop”, “bags”, “shopping” or “cheap”, and the generic Top-Level Domain (“gTLD”) “.com”, does not diminish the confusing similarity to the TELFAR Mark.

Complainant asserts that Respondent has no rights or legitimate interests in the Disputed Domain Names pursuant to paragraph 4(a)(ii) of the Policy, because Complainant has never licensed or otherwise authorized Respondent to use the TELFAR Mark or to register any domain name that includes the TELFAR Mark. There is no relationship between Complainant and Respondent. Respondent is not known by the Disputed Domain Names. Respondent has no prior rights or legitimate interests justifying the use of the TELFAR Mark, and is not making a legitimate, noncommercial or fair use of the Disputed Domain Names or using the Disputed Domain Names in connection with a *bona fide* offering of goods or services.

Complainant further asserts that Respondent uses the Disputed Domain Names without Complainant’s authorization to sell counterfeit TELFAR products in association with the TELFAR Mark. Complainant has superior rights to the name “Telfar”.

Complainant alleges that the Disputed Domain Names have been registered and used in bad faith pursuant to paragraph 4(a)(iii) of the Policy. Complainant further alleges that the Disputed Domain Names have been used to sell counterfeit TELFAR products. Complainant further alleges that, given the famous and distinctive nature of the TELFAR Mark, and the unauthorized copying of much of Complainant’s website by Respondent, it is certain that Respondent had actual notice of Complainant’s rights in the TELFAR Mark at the time the Disputed Domain Names were registered. These acts of impersonating the TELFAR website preclude Respondent from asserting any rights or legitimate interests in the Disputed Domain Names.

Complainant further alleges that the Disputed Domain Names have been registered for the purpose of attracting Internet users to Respondent’s website by creating a likelihood of confusion, or at least an impression of association between the TELFAR Mark and the Disputed Domain Names in an effort to sell counterfeit TELFAR products.

Complainant further alleges that the Disputed Domain Names are assumed to be owned by the same entity for the following reasons: (1) the disputed websites have the same email addresses for their contacts; (2) the layout and the design of the websites are almost identical; (3) the WHOIS database shows the Disputed Domain Names and their websites have the same registrant information (addresses, phone numbers); (4) the “About Us” pages of the Disputed Domain Names’ websites have nearly identical explanations; and (5) the domain name <buytelfarbagsonline.com> leads to the domain and the website <telfarshop.com>. In addition, the Disputed Domain Names all resolve to a single website <telfarshop.com> which further supports the fact that Respondent is using the Disputed Domain Names in bad faith.

On April 28, 2023, the Disputed Domain Names and the infringing activities were reported in detail to the relevant Registrar and Host provider. Despite the reports made, the Registrar has failed to respond or to comply with Complainant’s request to either transfer the Disputed Domain Names to Complainant or to cancel them entirely.

Complainant further alleges that the Disputed Domain Names also prevent Complainant from utilizing the Disputed Domain Names, which adversely affects Complainant’s business. The Disputed Domain Names were registered in order to harm Complainant’s commercial activity.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.”

Even though Respondent has failed to file a Response or to contest Complainant’s assertions, the Panel will review the evidence proffered by Complainant to verify that the essential elements of the claims are met. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following:

- i) that the Disputed Domain Names registered by Respondent are identical or confusingly similar to the TELFAR Mark in which Complainant has rights; and,
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and,
- iii) that the Disputed Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

Section 1.2.1 of the [WIPO Overview 3.0](#) states that registration of a trademark is *prima facie* evidence of Complainant having enforceable rights in the TELFAR Mark.

Complainant has contended that it has registered the TELFAR Mark. Respondent has not contested this assertion. Therefore, the Panel finds that, for purposes of this proceeding, Complainant has enforceable rights in the TELFAR Mark.

Complainant contends that the Disputed Domain Names are identical and confusingly similar to the TELFAR Mark, pursuant to paragraph 4(a)(i) of the Policy.

Section 1.7 of the [WIPO Overview 3.0](#) states that inclusion of the entire trademark in a domain name will be considered confusingly similar. Section 1.8 of the [WIPO Overview 3.0](#) instructs that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) does not prevent a finding of confusing similarity. Section 1.11.1 of the [WIPO Overview 3.0](#) instructs that gTLDs such as “.com” may be disregarded for purposes of assessing confusing similarity.

Complainant further contends that the Disputed Domain Names reproduce the TELFAR Mark in its entirety. The addition of “shop”, “bags”, “shopping”, “buy”, “online”, or “cheap”, and the gTLD “.com”, do not prevent a finding of confusing similarity to the TELFAR Mark.

Based on this showing, the Panel finds that Complainant has met the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant asserts that Respondent has no rights or legitimate interest in the Disputed Domain Names pursuant to paragraph 4(a)(ii) of the Policy.

Section 2.1 of the [WIPO Overview 3.0](#) states that once Complainant makes a *prima facie* case in respect of the lack of rights or legitimate interests of Respondent, Respondent carries the burden of demonstrating its rights or legitimate interests in the Disputed Domain Names. Where Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Names:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Disputed Domain Names a name corresponding to the Disputed Domain Names in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Disputed Domain Names, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Disputed Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the TELFAR Mark.

Complainant asserts that it has never licensed or otherwise authorized Respondent to use the TELFAR Mark or to register any domain name that includes the TELFAR Mark. There is no relationship between Complainant and Respondent. Respondent is not known by the Disputed Domain Names. Respondent has no prior rights or legitimate interests justifying use of the TELFAR Mark and is not making a legitimate, noncommercial or fair use of the Disputed Domain Names or using the Disputed Domain Names in connection with a *bona fide* offering of goods or services.

Complainant further asserts that Respondent uses the Disputed Domain Names without Complainant's authorization.

The Panel finds that Complainant has made a *prima facie* case that Respondent lacks rights or legitimate interests in the Disputed Domain Names. Respondent has not contested these assertions.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Complainant alleges that Respondent registered and is using the Disputed Domain Names in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of the Disputed Domain Names:

- (i) circumstances indicating that you [Respondent] have registered or you have acquired the Disputed Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Names' registrations to Complainant who is the owner of the TELFAR Mark or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Names; or
- (ii) you [Respondent] have registered the Disputed Domain Names in order to prevent the owner of the TELFAR Mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you [Respondent] have registered the Disputed Domain Names primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Disputed Domain Names, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the TELFAR Mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product on your website or location.

The four criteria set forth in paragraph 4(b) of the Policy are nonexclusive. See, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In addition to these criteria, other factors alone or in combination can support a finding of bad faith. Such additional factors include, without limitation: activity such as fraud (Section 3.4 of the [WIPO Overview 3.0](#)); and actual or constructive knowledge (Section 3.2.2 of the [WIPO Overview 3.0](#)).

Complainant claims Respondent is selling counterfeit products, and Respondent has not denied it. The Panel notes the Disputed Domain Names resolve to websites purporting to be selling TELFAR products, reproducing not only the TELFAR Mark but also the TELFAR EST. 2005, NYC trademark. The Panel further notes that the websites at the Disputed Domain Names reproduce a similar look and feel to Complainant's official website while purporting to be selling the TELFAR products at a price substantively lower to Complainant's original products.

The Panel finds that Complainant has met the requirements of paragraph 4(b)(iv) of the Policy and shown the additional elements of fraud and actual/constructive knowledge. Irrespective of whether the products offered on Respondent's websites are in fact counterfeit or not, the reproduction of Complainant's trademarks on Respondent's website, noting the composition of the Disputed Domain Names, affirms the Panel's finding that Respondent likely registered the Disputed Domain Names to attract Internet users to its website for commercial gain.

Therefore, Complainant has satisfied the elements of 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 names <buytelfarbagsonline.com>, <cheaptelfarbags.com>, <shoppingbagtelfar.com>, and <telfarshop.com> be transferred to Complainant.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: July 17, 2023