

ADMINISTRATIVE PANEL DECISION

World Market Management Services, LLC v. Aleksandr Butenko
Case No. D2023-2377

1. The Parties

Complainant is World Market Management Services, LLC, United States of America (“United States”), represented by Bryan Cave Leighton Paisner LLP, United States.

Respondent is Aleksandr Butenko, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <worldmarket24.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 1, 2023. On June 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 2, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on June 5, 2023, 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 5, 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 Respondent of the Complaint, and the proceedings commenced on June 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 5, 2023. Respondent sent email communications to the Center on June 5, June 6, and June 15, 2023, respectively, wishing to explore settlement options, however, Complainant did not request suspension for it.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on July 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

Complainant is a company organized under the laws of the United States that is active in the retail business, selling a wide array of home furnishings, décor, and food products through physical retail stores as well as online.

Complainant has provided evidence that it is the registered owner of various trademarks relating to its company name and brand WORLD MARKET, including, but not limited, to the following:

- word mark WORLD MARKET, United States Patent and Trademark Office (USPTO), registration number: 2418723, registration date: January 9, 2001, status: active;
- word-/device mark WORLD MARKET, European Union Intellectual Property Office (EUIPO), registration number: 001682590, registration date: July 27, 2001, status: active.

Moreover, Complainant has evidenced to own since 1998 the domain name <worldmarket.com> which resolves to Complainant's main website at "www.worldmarket.com", used to operate Complainant's online retail store.

Respondent, according to the disclosed Whois information for the disputed domain name, is a resident of Ukraine who registered the disputed domain name on November 23, 2022. By the time of the rendering of this Decision, the disputed domain name resolves to a website at "www.worldmarket24.com", notifying Internet users that the Internet shop thereunder was currently unavailable. Complainant, however, has demonstrated that at some point before the filing of the Complaint, Respondent let the disputed domain name resolve to an online retail store at "www.worldmarket24.com", which prominently displayed Complainant's WORLD MARKET trademark and offered thereunder a variety of third-party products for online sale, at least some of which were obviously counterfeit, defective or otherwise non-working products, with no possibility to return those products due to e.g., false contact information provided by Respondent on the website under the disputed domain name.

On May 9, 2023, Complainant sent a cease-and-desist letter to Respondent to which it immediately replied on May 10, 2023, by offering to transfer the disputed domain name for an amount of USD 100,000.

Complainant requests that the disputed domain name be transferred to Complainant.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends that its roots in the retail business go back to the late 1950s and that its operations have grown significantly ever since to nowadays include 242 physical WORLD MARKET retail stores throughout the United States besides Complainant's online WORLD MARKET retail store at "www.worldmarket.com", with the WORLD MARKET trademark meanwhile enjoying reputation and goodwill due to substantial financial and other investments by Complainant and its affiliates.

Besides, Complainant submits that the disputed domain name is confusingly similar to Complainant's WORLD MARKET trademark, as it incorporates the latter in its entirety and merely adds the non-distinctive number "24". Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Respondent is not in any way associated with Complainant and has not been licensed or otherwise authorized by Complainant to use its WORLD MARKET trademark or the disputed domain name, (2) Complainant's WORLD MARKET trademark is extremely well-known and has been in use for over three decades before Respondent registered the disputed domain name, and (3)

Respondent was using the disputed domain name for illegal activity, including at minimum the sale of counterfeit goods, as evidenced by respective customer complaints as well as the submission of e.g., a fraudulent return address and shipping labels.

Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) given Complainant's long and continuous use of its WORLD MARKET trademark, Respondent cannot credibly deny knowledge of Complainant and its trademark when it registered the disputed domain name, (2) Respondent used the disputed domain name for a shame business to sell counterfeit products at lower prices to unsuspecting customers, using a false address for product returns to avoid refunding those customers when they realized they were scammed, and only taking down this website once Respondent's true identity was disclosed, and (3) Respondent attempted to sell the disputed domain name to Complainant for an absurd amount at about 10,000 times its registration price.

B. Respondent

Respondent did not file a formal Response in reply to Complainant's contentions, but took down the website under the disputed domain name upon notification of the Complaint and stated in its email communication to the Center of June 5, June 6, and June 15, 2023, that the disputed domain name was deleted and should be taken by Complainant, further, that Respondent did not own the disputed domain name.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that 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

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

Based on the available record, the Panel finds Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of Complainant's WORLD MARKET trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to this trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of another term (here the number "24") may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and Complainant's WORLD MARKET trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Panel considers that the record of this case reflects that:

before any notice to Respondent of the dispute, Respondent did not use, nor has it made demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.

Respondent (as an individual, business, or other organization) has not been commonly known by the disputed domain name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.

Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.

The record contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name.

Panels have held that the use of a domain name for illegal activity (e.g., here the sale of counterfeit, defective or otherwise non-working products, with no possibility to return those products due to e.g., false contact information provided by Respondent on the website under the disputed domain name) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel considers that the record of this case reflects that:

Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant or to a competitor of the Complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name. Paragraph 4(b)(i) of the Policy, and [WIPO Overview 3.0](#), section 3.1.1.

Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

Panels have held that the use of a domain name for illegal activity (e.g., here the sale of counterfeit, defective or otherwise non-working products, with no possibility to return those products due to e.g., false contact information provided by Respondent on the website under the disputed domain name) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

In this context, the Panel has well noticed Respondent's allegation of June 5, 2023, that it did not own the disputed domain name, but also recognized that Respondent came back to Complainant on May 10, 2023, with the offer to sell the disputed domain name at the price of USD 100,000, without any indication as to Respondent's ownership in the disputed domain name whatsoever, which is why the Panel qualifies Respondent's correspondence of June 5, 2023, merely as a protective claim, thereby also taking into account that Respondent provided false contact information when running the website under the disputed domain name, obviously in order to hide its true identity.

Based on the available record, the Panel finds the third element of the Policy has been 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, <worldmarket24.com>, be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: July 26, 2023