

## **ADMINISTRATIVE PANEL DECISION**

Gempler's Inc. v. Wei Jun Wu (吴伟军)

Case No. D2023-2501

### **1. The Parties**

The Complainant is Gempler's Inc., United States of America ("United States"), represented by Andrus Intellectual Property Law, LLP, United States.

The Respondent is Wei Jun Wu (吴伟军), China.

### **2. The Domain Name and Registrar**

The disputed domain name <gemplers.shop> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the "Registrar").

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on June 8, 2023. On June 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 12, 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 (GEMPLERS.SHOP) and contact information in the Complaint. The Center sent an email communication to the Complainant in English and Chinese on June 16, 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 in English on June 20, 2023.

On June 16, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On June 20, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on June 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 14, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on August 2, 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 specializes in outfitting outdoor work crews by providing and selling durable workwear, tools, safety gear, and supplies from a variety of brands. The Complainant states that it has used the GEMPLER'S and GEMPLERS marks in connection with the sales of the above products since at least August of 1984. The Complainant also has a strong online presence, and mainly promotes its products at the website linked to its official domain name <gemplers.com>, registered since October 13, 1996.

The Complainant provides evidence that it owns a portfolio of trademark registrations for GEMPLER'S (word marks). Examples of such registrations include United States trademark registration number 1680275 for the GEMPLER'S word mark, registered on March 24, 1992; and United States trademark registration number 4252539 for the GEMPLER'S word mark, registered on December 4, 2012. The relevant registered trademarks adduced by the Complainant were successfully registered prior to the date of registration of the disputed domain name by the Respondent, which is January 23, 2023.

The Complainant submits evidence that the disputed domain name directed Internet users to an active website, which was operated as an e-commerce website selling and offering a variety of products (such as noise cancelling headphones and lens gear) by reference to its GEMPLER'S trademark. However, on the date of this decision, the Panel notes that the disputed domain name directs to an inactive webpage.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant essentially contends that the disputed domain name is confusingly similar to its trademarks for GEMPLER'S, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

The Complainant particularly claims that its trademarks are well-regarded in its sector and provides printouts of its official website and trademark registrations. Moreover, the Complainant provides evidence that the disputed domain name was linked to an active website, operating as an e-commerce website. In this context, the Complainant essentially claims that the Respondent is using this website as a website using its GEMPLER'S trademarks to sell products, thereby intentionally attracting Internet users for commercial gain to its website by creating consumer confusion between such website and the Complainant's trademarks. The Complainant also argues that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, that the Respondent also has no other rights or interests in the disputed domain name and that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant. The Complainant essentially contends that such use made of the disputed domain name by the Respondent does not confer any rights or legitimate interests in respect of the disputed domain name and constitutes registration and use in bad faith.

The Complainant requests the transfer of the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Preliminary issue: Language of the Proceeding**

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

According to the Registrar's verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainant filed its Complaint and its amended Complaint in English, and requests that English be the language of the proceeding. The Panel notes that the Respondent did not comment on the language of the proceeding and did not submit any arguments on the merits of this proceeding.

In considering this request, the Panel has carefully reviewed all elements of this case, and deems the following elements particularly relevant: the Complainant's request that the language of the proceeding be English; the lack of comment on the language of the proceeding and the lack of response on the merits of this proceeding by the Respondent (the Panel notes that the Respondent was invited by the Center in Chinese and in English and in a timely manner to present his/her comments and response in either Chinese or English, but chose not to do so); the fact that the disputed domain name is written in Latin letters and not in Chinese characters and the fact that the website linked to the disputed domain name was exclusively in English and not in Chinese; and, finally, the fact that Chinese as the language of the proceeding could lead to unwarranted delays and additional costs for the Complainant. In view of all these elements, the Panel grants the Complainant's request, and decides that the language of this proceeding shall be English.

### **6.2. Discussion and Findings on the Merits**

The Policy requires the Complainant to prove three elements:

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

Based on the evidence and arguments submitted, the Panel's findings are as follows:

#### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant has provided sufficient evidence that it has valid rights in its marks for GEMPLER'S, based on its prior trademark registrations.

Further, as to whether the disputed domain name is identical or confusingly similar with the Complainant's GEMPLER'S marks, the Panel finds that the disputed domain name consists of only the Complainant's GEMPLER'S marks. The Panel considers that the generic Top-Level Domain ("gTLD"), which is ".shop" in this case, is viewed as a standard registration requirement, and may as such be disregarded by the Panel (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1). Accordingly, based on the above elements, the Panel finds that the disputed domain name is identical to the Complainant's GEMPLER'S marks. The Panel therefore decides that the Complainant has satisfied the requirements of the first element under the Policy.

## B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel accepts that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee or distributor of the Complainant, is not a good faith provider of goods or services under the disputed domain name and is not making legitimate noncommercial use or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, no evidence or arguments have been submitted by the Respondent in reply.

Further, reviewing the facts and the evidence submitted in this proceeding, the Panel notes that the disputed domain name directed to a website which showed a clear intent on the part of the Respondent to obtain unlawful commercial gain from misleading Internet users. The Respondent did this by prominently using the Complainant's GEMPLER'S trademark in the banner of the disputed domain name with the goal to offer a variety of products, thereby misleading consumers into believing that the Respondent was licensed by, or otherwise affiliated with the Complainant or its GEMPLER'S trademarks. Moreover, such website did not accurately and prominently disclose the lack of relationship between the Respondent and the Complainant. It is clear to the Panel from the foregoing elements that the Respondent was not acting as a good faith provider of goods or services under the disputed domain name (see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)) and that there are also no other circumstances conferring any rights or legitimate interests in the disputed domain name on the Respondent. Furthermore, the Panel notes that on the date of this decision, the disputed domain name directs to an inactive webpage. In this regard, the Panel finds that holding a domain name passively, without making any use of it, also does not confer any rights or legitimate interests in the disputed domain name on the Respondent (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#) and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

Moreover, the Panel agrees with the Complainant that the nature of the disputed domain name (being identical to the Complainant's prior trademarks) carries a high risk of implied affiliation and cannot constitute fair use, as it effectively impersonates the Complainant and its products or suggests sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

On the basis of the foregoing elements, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

## C. Registered and Used in Bad Faith

Given the intensive use and longstanding registration of the Complainant's registered trademark, which precede the registration date of the disputed domain name by several decades, the Panel finds that the subsequent registration of the disputed domain name consciously targeted the Complainant's prior registered trademarks for GEMPLER'S. The Panel deducts from these efforts to consciously target the Complainant's prior registered trademarks and the use of the Complainant's trademarks on the website which was associated with the disputed domain name that the Respondent knew of the existence of the Complainant's trademarks at the time of registering the disputed domain name. The Panel also considers the disputed domain name to be so closely linked and so obviously connected to the Complainant and its trademarks that the Respondent's registration of this disputed domain name points toward the Respondent's bad faith. In the Panel's view, these elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name directed to an active website selling and offering a variety of products (such as noise cancelling headphones and lens gear) by reference to its GEMPLER'S trademark, which was prominently

visible in the website banner, without the authorization of the Complainant. The Panel concludes from these facts that the Respondent intentionally attracted Internet users for commercial gain to the website associated with the disputed domain name, by creating consumer confusion between the website associated with the disputed domain name and the Complainant's trademarks, which is direct evidence of the Respondent's bad faith under paragraph 4(b)(iv) of the Policy. However, on the date of this decision, the disputed domain name links to an inactive website. In this regard, the [WIPO Overview 3.0](#), section 3.3 provides: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding." The Panel has reviewed all elements of this case, and attributes particular relevance to the following elements: the fact that the disputed domain name is identical to the Complainant's trademark, the distinctiveness and intensive prior use made of the Complainant's trademark and the unlikelihood of any good faith use to which the disputed domain name might be put by the Respondent. In these circumstances, the Panel considers that the passive holding of the disputed domain name constitutes use of the disputed domain name in bad faith. The Panel therefore finds that it has been demonstrated that the Respondent has used, and is using the disputed domain name in bad faith.

Finally, the Respondent has failed to provide any response or evidence to establish its good faith or absence of bad faith. The Panel therefore finds that the Complainant has satisfied the requirements of the third requirement under 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 <gemplers.shop> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: August 16, 2023