

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. erner markus Case No. D2023-2667

1. The Parties

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

The Respondent is erner markus, Germany.

2. The Domain Name and Registrar

The disputed domain name <tedbakeroutletaustralia.com> is registered with Domain Best Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2023. On June 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 23, 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 June 28, 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 June 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 July 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 24, 2023.

The Center appointed Mihaela Maravela as the sole panelist in this matter on August 1, 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

According to information in the Complaint, the Complainant is one of the world's leading manufacturers of apparel, accessories, footwear, homeware and beauty, and has advertised, marketed, promoted, distributed and sold such goods worldwide under its TED BAKER trademark. The Complainant has registered various trademarks consisting of or including TED BAKER, such as the European Union Trade Mark No. 005210661 registered on April 25, 2007 for TED BAKER (word trademark).

The disputed domain name was registered on February 13, 2023 and it resolves to an active website which prominently displays the Complainant's registered TED BAKER trademark. It also appears to use similar product images, layouts and functions to those used by the Complainant on its website.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is identical or confusingly similar to the Complainant's registered trademarks TED BAKER, as the disputed domain name consists of the usual "www." prefix, the Complainant's trademark TED BAKER (not case sensitive), followed by the descriptive term "outlet" (not case sensitive), the geographic identifier "Australia", and the generic suffix ".com".

As regards the second element, the Complainant argues that 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 name 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. Moreover, the Complainant contends that the Respondent has been 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.

With respect to the third element, the Complainant argues that the Respondent was well aware of the Complainant's trademark at the time the Respondent registered the disputed domain name as the Complainant's trademarks are well-known around the world, and the disputed domain name was registered at least 35 years after the Complainant established registered trademark rights in the TED BAKER trademark. Further, the Complainant shows that the Respondent is selling competing and unauthorized goods. 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.

B. Respondent

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

6. Discussion and Findings

No response has been received from the Respondent in this case. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules. The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the

particular facts and circumstances of the case. See section 4.2, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (iii) the disputed domain name has been registered and is being used in bad faith.

Under 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”.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, the Complainant must prove that it has rights to a trademark, and that the disputed domain name is identical or confusingly similar to that trademark. This first element under the Policy functions primarily as a standing requirement. [WIPO Overview 3.0](#), section 1.7.

The Complainant has provided evidence of its rights in the TED BAKER trademark by providing evidence of its trademark registrations.

As regards the second limb of the first element, the test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name. It is well established that the generic Top-Level Domain (“gTLD”) may be ignored when assessing the confusing similarity between the disputed domain name and the Complainant’s trademarks as they are viewed as a standard registration requirement. See section 1.11.1 of the [WIPO Overview 3.0](#).

The trademark TED BAKER is reproduced in its entirety in the disputed domain name. The addition of the words “outlet”, and “australia” does not prevent a finding of confusing similarity with the Complainant’s trademark TED BAKER, which is recognizable in the disputed domain name. The fact that a domain name wholly incorporates a complainant’s trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such trademarks. The addition of an additional term (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

This Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademarks and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests in the disputed domain name.

As established by previous UDRP panels, it is sufficient for the complainant to make a *prima facie* case demonstrating that the respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the respondent (see section 2.1 of the [WIPO Overview 3.0](#)). In the present case, the Complainant has proved it holds rights over the trademark TED BAKER, and claims that the Respondent has no legitimate reason to acquire the disputed domain name.

From the evidence put forward by the Complainant, the website to which the disputed domain name resolves mimics the Complainant’s official website and is used for selling products under the Complainant’s TED BAKER trademark. The Complainant contends that it has never licensed or otherwise permitted the

Respondent to use the trademark TED BAKER. The website at the disputed domain name displays no disclaimer as to the lack of any relationship with the Complainant. Irrespective of whether the goods offered for sale are genuine or not, the Respondent's use of the disputed domain name in the above circumstances is not in connection with a *bona fide* offering of goods or services as contemplated by the first circumstance of paragraph 4(c) of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), section 2.8 of the [WIPO Overview 3.0](#).

Also, there is no evidence that the Respondent is commonly known by the disputed domain name in the meaning of the second circumstance of paragraph 4(c) of the Policy. Moreover, the use of the disputed domain name is not a legitimate noncommercial or fair use as contemplated by the third circumstance of paragraph 4(c) of the Policy.

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel considers that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because it did not respond to the Complainant's contentions.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The disputed domain name was registered many years after the Complainant had obtained registration of its TED BAKER trademarks. The disputed domain name incorporates the Complainant's trademark and the words "outlet" and "australia" in additions to the gTLD ".com". The website at the disputed domain name includes the Complainant's trademark and imitates the Complainant's official website. Under these circumstances, the Panel considers that the Respondent has registered the disputed domain name with knowledge of the Complainant and its trademark and that it targeted that trademark.

As regards the use of the disputed domain name, paragraph 4(b)(iv) of the Policy has direct bearing to the present case:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to his website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the said website location or of a product or service on that website location.

The conduct of the Respondent falls under the above provisions. The disputed domain name is confusingly similar to the TED BAKER trademark of the Complainant and is inherently misleading. The website to which the disputed domain name resolves, directs users to a website similar to the official website of the Complainant. Also, products purporting to be under TED BAKER trademark are apparently sold and no disclaimer is included regarding the lack of a relationship between the Respondent and the Complainant. The Internet users will likely be confused as to the source of the products sold on such website.

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary. Consequently, the Panel concludes that the condition of paragraph 4(a)(iii) of the Policy is fulfilled.

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 <tedbakeroutletaustralia.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: August 11, 2023