

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. Web Commerce Communications Limited, Client Care Case No. D2023-2671

1. The Parties

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

Respondent is Web Commerce Communications Limited, Client Care, Malaysia.

2. The Domain Name and Registrar

The disputed domain names <tedbakerstoresuk.com> and <tedbaker-usa.com> (the “Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private 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 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 25, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names, which differed from named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to Complainant on July 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 amendment to the Complaint on July 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 July 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 4, 2023.

The Center appointed Clive L. Elliott, K.C., as the sole panelist in this matter on August 11, 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

No Ordinary Designer Label Limited t/a Ted Baker (“Complainant”) is the owner of the well-known TED BAKER brand. Ted Baker is currently, and for many years has been, one of the world’s leading manufacturers of apparel, accessories, footwear, homeware and beauty products, and has advertised, marketed, promoted, distributed and sold such worldwide under its well-known TED BAKER trade mark (“Complainant’s Mark”).

The TED BAKER brand is supported by a portfolio of intellectual property rights, including a global portfolio of more than 500 trade marks covering a wide variety of goods and services and a large portfolio of copyrights for images used in association with the advertising, marketing and sale of TED BAKER-branded products globally.

More particularly, Complainant’s trade mark portfolio includes but is not limited to, the following in the United Kingdom and United States:

Mark	Jurisdiction	Registration No	Registration Date	Classes
TED BAKER	United Kingdom	UK00003250250	December 29, 2017	3, 4, 8, 9, 11, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 28, 35, 41, 43, 44
TED BAKER	United Kingdom	UK00002320837	August 15, 2003	3, 9, 14, 18, 20, 21, 24, 25
TED BAKER	United Kingdom	UK00911370467	April 12, 2013	18
TED BAKER	United Kingdom	UK00905210661	April 25, 2007	35
TED BAKER LONDON	United Kingdom	UK00910245827	January 11, 2012	3, 9, 14, 18, 25
TED BAKER	United States	2,644,551	October 29, 2002	25
TED BAKER	United States	2,672,649	January 7, 2003	9, 14, 18, 24

According to the publicly available Whois, the Domain Names were both registered on April 3, 2023 and resolve to websites purportedly offered for sale Complainant’s products at discounted prices.

5. Parties’ Contentions

A. Complainant

Complainant began using Complainant’s Mark over 35 years ago.

Complainant spends millions of dollars marketing its goods and services globally, using Complainant’s Mark, and has undertaken extensive efforts to protect its name and enforce such trade marks.

The Domain Names are confusingly similar to Complainant’s Mark in that the Domain Names contain Complainant’s Mark in its entirety followed by:

- (a) the descriptive term “stores” and the geographic abbreviation “uk”; in the case of the Domain Name <tedbakerstoresuk.com>; and
- (b) a dash followed by the geographic abbreviation “USA” in the case of the Domain Name <tedbaker-usa.com>.

It is important to note that where the relevant trade mark is recognizable within a domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

Complainant's Mark is well known around the world, and Complainant relies on the extensive range of registered trade marks for TED BAKER. A simple Google search would have disclosed Complainant's marks and business. This, Complainant contends is proof of bad faith at the time of registration.

In this case, Respondent registered the Domain Names at least 35 years after Complainant established registered trade mark rights in Complainant's Mark.

Complainant alleges that Respondent has been actively using the TED BAKER trade marks on a physical website to promote its website for illegitimate commercial gains, more specifically, by operating a fake TED BAKER website offering unauthorized and/or counterfeit TED BAKER goods. Accordingly, Complainant submits that Respondent is trying to pass off the Domain Names as Complainant's website to sell competing and unauthorized goods.

Finally, Complainant argues that Respondent has no reason to use the mark in the Domain Names other than to attract internet users to its site for commercial gain, especially since Complainant's official website is "www.tedbaker.com". Thus, Respondent is intentionally trying to create a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation, or endorsement. Such use of a domain name constitutes bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant has been trading under the TED BAKER brand since in or about 1988 and today Complainant is one of the world's leading manufacturers of apparel, accessories, footwear, and other related products. Complainant has also registered Complainant's Mark in a number of countries including the United Kingdom and the United States.

Complainant has therefore established it is the owner of Complainant's Mark.

The Domain Names reproduce Complainant's Mark, as both contain Complainant's trade mark TED BAKER in its entirety and the trade mark is clearly recognizable in the Domain Names. Added to the above are the words "stores", "uk", and "-usa" respectively. Therefore, the TED BAKER trade mark is reproduced in its entirety, albeit without a space between the two words. The addition of the words "stores", "uk", and "-usa" does not prevent a finding of confusing similarity. See section 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, Complainant's Mark is clearly recognizable in the Domain Names, notwithstanding the addition of the words "stores", "uk", and "-usa". See section 1.7 of [WIPO Overview 3.0](#).

The Domain Names are therefore confusingly similar to Complainant's Marks.

The first ground under the Policy is made out.

B. Rights or Legitimate Interests

Complainant argues that Respondent has no rights or legitimate interests in the Domain Names and is trying to pass off its goods as goods emanating from Complainant. More specifically, Complainant alleges that Respondent has been using the TED BAKER trade marks on a website offering unauthorized and/or counterfeit TED BAKER goods.

Such allegations call for a response from Respondent to refute such allegations and establish that it has some rights or legitimate interests to justify its registration and use of the Domain Names in this fashion. Given that Respondent has failed to respond, the Panel finds that Respondent has acted in a manner calculated to pass itself off as Complainant or as somehow associated with or authorised by Complainant.

Accordingly, the Panel finds that Respondent has not established relevant rights or legitimate interests pursuant to paragraph 4(c)(iii) of the Policy and that the Domain Names are inherently misleading. See section 2.5.1 of [WIPO Overview 3.0](#).

Complainant has established the second ground under the Policy.

C. Registered and Used in Bad Faith

Given the above and the reasons that follow, the Panel concludes that the Domain Names were registered and used in bad faith. The Panel does so on the following basis:

- (i) The fact that Complainant's Marks have been registered and used for some 35 years;
- (ii) Complainant's Mark is well known internationally;
- (iii) That Respondent is alleged to have used the Domain Names to sell counterfeit goods;
- (iv) Respondent's failure to put forward any plausible reason for registering and using the Domain Names in the way it has.

Furthermore, considering that Respondent appears to have used Complainant's Mark to purportedly sell Complainant's products in an attempt to pass off as Complainant affirms a knowledge of Complainant. The Panel therefore concludes that the Domain Names were registered and used for the purpose of taking advantage of Complainant's reputation in order to mislead Internet users and that such conduct amounts to bad faith under the Policy.

Accordingly, the Panel finds that the Domain Names were registered and used in bad faith.

Complainant has therefore established the third ground 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 Domain Names, <tedbakerstoresuk.com> and <tedbaker-usa.com>, be transferred to the Complainant.

/Clive L. Elliott, K.C./

Clive L. Elliott, K.C.

Sole Panelist

Date: August 28, 2003