

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. Client Care, Web
Commerce Communications Limited
Case No. D2023-2711

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 Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <tedbakerfactoryoutlet.com> and <tedbakerlondonstore.com> 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 23, 2023. On June 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 27, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 3, 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 amendment to the Complaint on July 5, 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 the Respondent of the Complaint, and the proceedings commenced on July 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 2, 2023.

The Center appointed Andrew F. Christie as the sole panelist in this matter on August 9, 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 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 products worldwide under its TED BAKER trademark.

The Complainant has a global portfolio of more than 500 trademarks 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. The Complainant's TED BAKER trademark registrations include United Kingdom Trademark Registration No. 2320837 (registered as of January 15, 2003), and United States Trademark Registration No. 2644551 (registered on October 29, 2002), both for the word trademark TED BAKER.

The disputed domain names were registered on May 8, 2023. The Complainant has provided screenshots, taken on June 14, 2023, of the websites resolving from the disputed domain names, both of which display the TED BAKER trademark and purportedly offer TED BAKER clothing and shoes for sale at discount prices. At the time of this decision, the disputed domain names resolve to websites that appear very similar to those shown in the Complainant's screenshots.

5. Parties' Contentions

A. Complainant

The Complainant made the following contentions to establish that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights. The disputed domain names consist of the Complainant's TED BAKER trademark followed by the descriptive term "factoryoutlet", in the case of the first disputed domain name, and by the geographic identifier "London" and descriptive term "store", in the case of the second disputed domain name, and in each case end in the generic Top-Level Domain ("gTLD") ".com". The Complainant's trademark is recognizable within the disputed domain names, and the addition of other terms, whether descriptive, geographical, pejorative, meaningless, or otherwise, do not prevent a finding of confusing similarity under the first element.

The Complainant made the following contentions to establish that the Respondent has no rights or legitimate interests in respect of the disputed domain names. 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 names incorporating the TED BAKER trademark, and the Complainant has not acquiesced in any way to such use or application of the TED BAKER trademark by the Respondent. There is no evidence that the Respondent is using, or plans to use, the TED BAKER trademark or the disputed domain names incorporating the TED BAKER trademark, for a *bona fide* offering of goods or services that doesn't infringe the Complainant's intellectual property rights in the TED BAKER trademark. The Respondent has been actively using the TED BAKER trademark in the disputed domain names, and on the websites resolving from them, to operate a fake TED BAKER website offering unauthorized and/or counterfeit TED BAKER goods. Such unauthorized use of the TED BAKER trademark 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. The Respondent has not been commonly known by the disputed domain names.

The Complainant made the following contentions to establish that the disputed domain names were registered and are being used in bad faith. The Respondent was well aware of the Complainant's trademark at the time the Respondent registered the disputed domain names, as the Complainant's trademarks are well-known around the world, and a simple Google search would have disclosed the Complainant's trademarks and business. The Respondent registered the disputed domain names at least 35 years after the Complainant established registered trademark rights in the TED BAKER trademark. The Respondent used a privacy shield to mask its identity, which makes it difficult for the Complainant to contact the Respondent and amicably settle the dispute, and is an indication of bad faith. The Respondent is trying to pass off the website to which the disputed domain names resolve as the Complainant's website, to sell competing and unauthorized goods. The Respondent is intentionally trying to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of it.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Once the gTLD ".com" is ignored (which is appropriate in this case), the disputed domain names consist of the whole of the Complainant's registered word trademark TED BAKER, with the addition of either the descriptive term "factoryoutlet" or the descriptive term "londonstore". The Complainant's trademark is clearly recognizable within the disputed domain names. The addition of the descriptive terms does not avoid a finding of confusing similarity of the disputed domain names with the Complainant's trademark.

Accordingly, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent is not a licensee of the Complainant, is not otherwise affiliated with the Complainant, and has not been authorized by the Complainant to use its TED BAKER trademark. The Respondent has not provided any evidence that it has been commonly known by, or has made a *bona fide* use of, the disputed domain names, or that it has, for any other reason, rights or legitimate interests in the disputed domain names. The evidence provided by the Complainant shows that the disputed domain names have been used to resolve to websites displaying the Complainant's TED BAKER trademark, and purportedly offering for sale the Complainant's goods.

Given the confusing similarity of the disputed domain names to the Complainant's word trademark, the absence of any relationship between the Respondent and the Complainant, and the risk of implied false affiliation with the Complainant, the Respondent's use of the disputed domain names is neither a *bona fide* use nor a legitimate noncommercial or fair use.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, and the Respondent has not rebutted this. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

The disputed domain names were registered many years after the Complainant registered its TED BAKER trademark. It is inconceivable that the Respondent registered the disputed domain names ignorant of the existence of the Complainant's trademark, given that the disputed domain names consist of the Complainant's word trademark with the addition of descriptive terms relating to a source for purchasing

products, and that the Respondent used the disputed domain names to resolve to websites displaying the Complainant's word trademark and purporting to sell the Complainant's products. Given the Respondent's lack of rights or legitimate interests in the disputed domain names and the confusing similarity of the disputed domain names to the Complainant's trademark, any use of the disputed domain names by the Respondent almost certainly implies an affiliation with the Complainant that does not exist. The Respondent's registration of the disputed domain names in these circumstances is a bad faith registration. Furthermore, the evidence on the record provided by the Complainant indicates that the Respondent has used the disputed domain names in an attempt to attract, almost certainly for commercial gain, Internet users to a website by creating confusion in the minds of the public as to an association between the website and the Complainant. The Respondent's use of the disputed domain names in this manner is a bad faith use.

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, <tedbakerfactoryoutlet.com> and <tedbakerlondonstore.com>, be transferred to the Complainant.

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: August 20, 2023