

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. Kuefer Christin,
Beich Claudia
Case No. D2023-2878

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 Respondents are Kuefer Christin, Germany, and Beich Claudia, Germany.

2. The Domain Names and Registrar

The disputed domain names <tedbakercanadaoutlet.com> and <tedbakerwarszawa.com> (the “Domain Names”) are registered with Domain Best Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 6, 2023. On July 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On July 14, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 14, 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 July 20, 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 Respondents of the Complaint, and the proceedings commenced on July 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 13, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on August 14, 2023.

The Center appointed Gregor Vos as the sole panelist in this matter on August 15, 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 a manufacturer of apparel, accessories, footwear, homeware, and beauty products and began using the sign TED BAKER over 35 years ago.

The Complainant is the owner of *inter alia* the following trademark registrations for the sign TED BAKER (hereinafter jointly referred to as the "Trademarks").

- i. European Union Trade Mark registration No. 005210661, registered on April 25, 2007;
- ii. European Union Trade Mark registration No. 004267191, registered on April 16, 2007.

It is undisputed that the Complainant is the holder of the domain name <tedbaker.com>.

The Domain Name <tedbakercanadaoutlet.com> was registered on February 9, 2023, and the Domain Name <tedbakerwarszawa.com> was registered on February 20, 2023. At the time of filing of the Complaint, the Domain Names resolved to websites that appeared to mimic the Complainant's website and on which the Trademarks were depicted. The Domain Names currently do not resolve to active webpages.

5. Parties' Contentions

A. Complainant

Preliminarily, according to the Complainant, the Domain Names are under common control of one entity. Therefore, the different domain name disputes should be consolidated in these proceedings.

With the Complaint, the Complainant further seeks that the Domain Names be transferred to the Complainant. The Complaint is based on the following factual and legal grounds: the Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights, the Respondents have no rights or legitimate interests in respect of the Domain Names, and the Domain Names were registered and are being used in bad faith.

Firstly, according to the Complainant, the Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant states that the Domain Names contain the Trademarks in their entirety. The addition of the terms "canada" and "outlet", and "warszawa" respectively does not prevent a finding of confusing similarity.

Secondly, according to the Complainant, the Respondents have no rights or legitimate interests in respect of the Domain Names. To support this the Complainant argues that the Respondents have not been licensed, contracted, or otherwise permitted in any way to use the Complainant's Trademarks or to apply for any domain names incorporating the Complainant's Trademarks, nor has the Complainant acquiesced in any way to such use or application of the Complainant's Trademarks by the Respondents. Furthermore, the Complainant argues that there is no evidence of any *bona fide* use of the Trademarks or Domain Names incorporating the Complainant's Trademarks, and that the Respondents are not making a legitimate noncommercial or fair use of the Domain Names. Also, the Complainant argues that the Respondents are not commonly known by the Domain Names. Finally, the Respondents have actively used the Complainant's Trademarks in the Domain Names and on the websites to which they resolved for illegitimate commercial gains.

Finally, according to the Complainant, the Respondents have registered and are using the Domain Names in bad faith. According to the Complainant, the Respondents were well aware of the Complainant's Trademarks at the time the Respondents registered the Domain Names. Also, the gap of several years between registration of the Complainant's Trademarks and the Respondents' registration of the Domain Names would indicate bad faith registration. Further, the use of a privacy shield to mask the Respondents identities, would also indicate bad faith. Finally, the Complainant argues that the Respondents are trying to pass off the websites to which the Domain Names resolved to as the Complainant's website to sell competing and unauthorized goods, thus intentionally trying to create a likelihood of confusion with the Complainant's Trademarks.

B. Respondents

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

6. Discussion and Findings

6.1 Preliminary Procedural Issue: Consolidation of Multiple Domain Names and the Respondents

The Panel will first deal with the question of whether the different domain name disputes should be consolidated in a single proceeding.

The consolidation of multiple domain name disputes under paragraph 3(c) or 10(e) of the Rules may be appropriate where the particular circumstances of a case indicate that common control is being exercised over the disputed domain names or the websites to which the domain names resolve and the panel, having regard to all of the relevant circumstances, determines that consolidation would be procedurally efficient and fair and equitable to all parties.

Indicia of common control have been found based on commonalities in registrant information, such as shared administrative or technical contacts and shared postal or email addresses, as well as other circumstances in the record indicating that the respondents are related or that a sufficient unity of interests otherwise exists that they may be essentially treated as a single domain name holder for purposes of paragraph 3(c) of the Rules (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2; *Speedo Holdings B. V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#)).

In the present case, the Panel finds that the consolidation of the domain name disputes is justified for the following reasons. Both Domain Names are registered with same Registrar and are hosted on the same name servers. Also, both Domain Names were registered in February 2023 and share the same IP location. Further, both Domain Names resolved to websites on which similar content is displayed. The Panel also notes that the email addresses provided by the Respondents to the Registrar show similarities, as they were created with the same Chinese email service provider and are seemingly composed of random letters and numbers that do not relate to or reflect the Respondents' names, which themselves may be fake given the courier's inability to deliver the Center's communication to the contact details provided by the Registrar. Finally, the Respondents have not objected to consolidation of the domain name disputes.

Therefore, the Panel finds, having regard to all circumstances, that the Domain Names are under common control and that it is procedurally efficient and fair and equitable to all parties when the domain names disputes are consolidated. Unless explicitly mentioned otherwise, the Respondents will further jointly be referred to as the "Respondent".

6.2 Substantive Issues

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules,

the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual presentations.

For the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

- i. the Domain Names are identical or confusingly similar to a trademark or a service mark in which the Complainant has rights; and
- ii. the Respondent has no rights or legitimate interests in respect of the Domain Names; and
- iii. the Domain Names have been registered and are being used in bad faith

Only if all three elements have been fulfilled, the Panel is able to grant the remedy requested by the Complainant. The Panel will deal with each of the requirements in turn.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the Domain Names are (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

With respect to having rights pursuant to paragraph 4(a)(i) of the Policy, it is noted that the Complainant is registered as the owner of the Trademarks. Consequently, the Panel finds that the Complainant has proven that it has rights in the Trademarks.

With regard to the assessment of identity or confusing similarity of the Domain Names with the Trademarks, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Trademarks and the Domain Names (see section 1.7 of the [WIPO Overview 3.0](#)). In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark (see section 1.7 of the [WIPO Overview 3.0](#)).

In the present case, the Trademarks are incorporated in their entirety in the Domain Names. The addition of the terms "canada", "warszawa", and "outlet" does not prevent a finding of confusing similarity.

Consequently, the Panel finds that the requirement under paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Domain Names. The *onus* of proving this requirement, like each element, falls on the Complainant. Given the difficulty in proving a negative, however, it is usually sufficient for a complainant to make out a *prima facie* case that a respondent lacks rights or legitimate interests. If a complainant does establish a *prima facie* case, the burden of production shifts to the respondent (see, e.g. [WIPO Overview 3.0](#), section 2.1; *Sanofi v. Cimpress Schweiz GmbH*, WIPO Case No. [D2017-0522](#)).

Paragraph 4(c) of the Policy lists three non-limitative examples of instances in which a respondent may establish rights or legitimate interests in a disputed domain name.

The Complainant has substantiated that none of these circumstances apply in this case. By defaulting, the Respondent has failed to rebut the *prima facie* case established by the Complainant. Furthermore, based on the record before it, the Panel does not see an indication that any of the circumstances of paragraph 4(c) of the Policy is present.

The composition and content of the Domain Names carries a false impression that the websites are operated by the Complainant or somehow related to the Complainant, which cannot confer rights or legitimate interests on the Respondent. While limited rights have been recognized for resellers under the so-called “Oki-Data test” enshrined in [WIPO Overview 3.0](#), section 2.8, the Domain Names do not fall within the applicable fair use safeguard in view of the fact that neither website provides information on the relationship (or lack thereof) with the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name. Paragraph 4(a)(ii) is thereby fulfilled.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, a complainant must show that the disputed domain names have been registered and are being used in bad faith. Paragraph 4(b) of the Policy lists four non-limitative circumstances which may be considered as evidence of registration and use in bad faith of a domain name.

In the present case, the Trademarks are registered by the Complainant and have been used for many years. The Complainant’s rights to the Trademarks predate the registration dates of the Domain Names. Based on the record before it, and confirmed by earlier Panels, the Panel finds that the Trademarks enjoy a reputation (see e.g. *No Ordinary Designer Label Limited t/a Ted Baker v. Web Commerce*, WIPO Case No. [D2023-1678](#)). In light of this reputation and the fact that the Domain Names resolved to websites that appear to mimic the Complainant’s website, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the Domain Names without knowledge of the Complainant’s activities and its Trademarks under which the Complainant is doing business.

With regard to use of the Domain Names in bad faith, the Panel finds that the use of the Trademarks in the Domain Names and on the website to which these resolved signals an intention on the part of the Respondent to confuse Internet users into thinking that the Domain Names are connected to the Complainant ([WIPO Overview 3.0](#), section 3.2.1).

Even if the current inactive pages are taken into account, it is generally accepted by UDRP panels that the non-use of a domain name does not prevent a finding of bad faith (section 3.3 of the [WIPO Overview 3.0](#)). In light of the reputation of the Trademarks, the lack of any rights or legitimate interests in the Domain Name by the Respondent, and in the absence of any conceivable good faith use of the Domain Names, the Panel finds from the present circumstances that the Respondent has intentionally sought to take unfair advantage of or otherwise abuse the Trademarks.

Therefore, the Panel finds that the Domain Names have been registered and are being used in bad faith and that the third element of paragraph 4(a)(iii) of the Policy is fulfilled.

8. 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, <tedbakercanadaoutlet.com> and <tedbakerwarszawa.com>, be transferred to the Complainant.

/Gregor Vos/

Gregor Vos

Sole Panelist

Date: August 30, 2023