

## **ADMINISTRATIVE PANEL DECISION**

### **No Ordinary Designer Label Limited t/a Ted Baker v. long peng cheng Case No. D2023-3081**

#### **1. The Parties**

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

The Respondent is long peng cheng, China.

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

The disputed domain name <tedbakeruk.com> (the “Domain Name”) is registered with DropCatch.com LLC (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2023. On July 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 19, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 July 20, 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 20, 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 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 18, 2023.

The Center appointed Gregor Vos as the sole panelist in this matter on August 23, 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 company active in the field of *inter alia* clothing, footwear, home, and beauty products and that sells and markets its products worldwide.

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

- i. United Kingdom Trade Mark Registration No. UK00003250250, registered on December 29, 2017;
- ii. United Kingdom Trade Mark Registration No. UK00002320837, registered on August 15, 2003.

The Domain Name was registered on July 13, 2022. Currently, the Domain Name does not resolve to an active website, but at the time of filing the Complaint, the Domain Name resolved to a webpage on which pornographic content was displayed.

#### **5. Parties’ Contentions**

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

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

Firstly, according to the Complainant, the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant states that the Domain Name incorporates the Trademarks in their entirety. The addition of the geographical term “uk” does not prevent a finding of confusing similarity.

Secondly, according to the Complainant, the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent is not commonly known by the Domain Name and is not authorized, licensed or otherwise permitted to use the Complainant’s Trademarks in any way. Also, the Respondent is not making legitimate noncommercial or fair use of the Domain Names. Further, the Respondent refers to the website to which the domain name <tedbakeralsus.com> resolves to show that the Domain Name is likely used to trick consumers into believing that the Complainant is in some way connected to the Respondent.

Finally, according to the Complainant, the Respondent has registered and is using the Domain Name in bad faith. According to the Complainant, the Respondent was aware or should have been aware of the well-known Trademarks when registering the Domain Name. The Domain Name was registered at least 60 years after the Complainant established trademark rights to the sign TED BAKER and the Respondent has concealed its identity with a privacy shield. In addition, the Respondent is using the Domain Name to offer pornographic content which qualifies as “ pornosquatting”.

##### **B. Respondent**

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

## 6. Discussion and Findings

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 Name is 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 Name; and
- iii. the Domain Name has been registered and is being used in bad faith.

Only if all three criteria have been met, the Panel is able to grant the remedy requested by the Complainant. The Panel will now consider each criterion individually.

### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the Domain Name is (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 Name with the Trademarks, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Trademarks and the Domain Name (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[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 Name. The addition of the element "uk" that refers to the United Kingdom, to the Domain Name does not prevent a finding of confusing similarity. The generic Top-Level Domain ".com" is viewed as a standard registration requirement and as such is disregarded under the confusing similarity test. 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 Name. 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 Panel notes that the contents of the website to which the domain name <tedbakersalesus.com> resolves have no relevance to the present proceedings. However, the Complainant has substantiated that

none of these circumstances of paragraph 4(c) of the Policy 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.

In addition, the Domain Name resolved to a webpage on which pornographic content is displayed which cannot be regarded as use in good faith (see *e.g. Prada S.A. v. Roberto Baggio*, WIPO Case No. [D2009-1187](#)). Furthermore, the composition of the Domain Name cannot constitute fair use if it, as in the present case, effectively impersonates or suggests sponsorship or endorsement by the trademark owner, without that being the case (section 2.5.1, [WIPO Overview 3.0](#)).

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 name has been registered and is 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 date of the Domain Name. Based on the record before it, and confirmed by earlier Panels, the Panel find 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, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the Domain Name without knowledge of the Complainant's activities and its Trademarks under which the Complainant is doing business.

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

Further, the Panel finds that this case constitutes a classic example of "porno-squatting" in which confusion with a trademark with a reputation is used to divert Internet users to a pornographic website for commercial purposes (see *e.g. Prada S.A. v. Roberto Baggio*, WIPO Case No. [D2009-1187](#)). Therefore, the Respondent is using the Domain Name in bad faith. Even if the current inactive page is 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 Name, 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 Name has been registered and is being used in bad faith and that the third element 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 Domain Name, <tedbakeruk.com> be transferred to the Complainant.

/Gregor Vos/

**Gregor Vos**

Sole Panelist

Date: September 6, 2023