

ADMINISTRATIVE PANEL DECISION

Hurley Japan Co., Ltd v. Client Care, Web Commerce Communications Limited

Case No. D2023-3165

1. The Parties

The Complainant is Hurley Japan Co., Ltd, Japan, represented by IP Twins, France.

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

2. The Domain Names and Registrar

The disputed domain names <hurleyindonesia.com>, <hurleymalaysia.com>, and <hurleysingapore.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 July 24, 2023. On July 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 25, 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 (Unknown Respondent) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 25, 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 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 August 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 29, 2023.

The Center appointed Daniel Kraus as the sole panelist in this matter on September 12, 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 Hurley Japan Co., Ltd, part of the Hurley group of companies. Hurley was founded in 1979 and distributes clothes, swimwear, and accessories marketed towards surfing and swimming. Hurley products are distributed throughout North America, Europe, Australia, and Japan, through the Complainant.

The Complainant is a wholly-owned subsidiary of Hurley International, headquartered in Costa Mesa, California, United States of America ("USA"). Hurley sells its goods through its own website and the retail stores of other companies through its HURLEY Marks. Hurley promotes its HURLEY Marks through print, web, and television advertising as well as sports sponsorships.

The Complainant also distributes and markets HURLEY products in Japan, Republic of Korea, and the ASEAN region. To that effect, the Complainant is the owner of the following trademarks, registered well before the registration of the disputed domain names:

- Singaporean trademark HURLEY No. T9811765H, registered on September 20, 2001, duly renewed, and designating goods in international class 14;
- Malaysian trademark HURLEY No. 98013630, registered on June 3, 1998, duly renewed, and designating goods in international class18;
- Singaporean trademark HURLEY No. T9811766F, registered on October 4, 2001, duly renewed, and designating goods in international class 18;
- Malaysian trademark HURLEY No. 98013629, registered on November 26, 1998, duly renewed, and designating goods in international class18.

The disputed domain names were all created on December 2, 2022.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are highly similar to its earlier trademarks. The disputed domain names reproduce the earlier trademarks of the Complainant together with the geographical terms "Malaysia" and "Singapore" and "Indonesia". The Respondent has no rights or legitimate interests in respect of the domain names that are the subject of the Complaint. The Respondent has acquired no trademark in the name HURLEY which could have granted the Respondent rights in the disputed domain names. Furthermore, the Complainant has found no evidence that the Respondent is known by the disputed domain names. The Complainant has not authorized the use of its earlier trademarks or terms similar thereto in the disputed domain name.

The Complainant further puts forth that the Respondent has not, before the original filing of the Complaint, used or made preparations to use the disputed domain names in relation to a *bona fide* offering of goods or services. The disputed domain names <hurleymalaysia.com> and <hurleyindonesia.com> resolve to a website highly resembling the official website of the Complainant and reproducing its name and trademark. Since said website does not display any element as to clarify or disclaim the relationship between the Respondent and the Complainant, the Complainant submits that no rights or legitimate interests relating to

the Respondent in the disputed domain name can be found. Whether or not products are actually sold on the Respondent's website, and whether any such products are genuine or counterfeit, according to the Complainant, the website gives the false impression that it is owned, operated or endorsed by, or affiliated with, the Complainant. Accordingly, this use should not be considered to be a *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy. The disputed domain name <hurleysingapore.com> resolves to an error page. The Complainant states that a blank or error page is not a *bona fide* offering of goods or services under the Policy.

The disputed domain names are inherently likely to mislead Internet users, and there is no evidence that the Respondent has been making a legitimate non-commercial or fair use of the disputed domain names. The Complainant sees no plausible use of the domains that would be legitimate, fair, and non-commercial.

Finally, the Complainant contends that the Respondent has registered and is using the disputed domain names in bad faith. Firstly, the Complainant and its trademarks were so widely well-known, that to the Complainant, it is inconceivable that the Respondent ignored the Complainant or its earlier rights. The Respondent necessarily had the Complainant's name and trademark in mind when registering the domain name. The Respondent's choice of domain name cannot have been accidental and must have been influenced by the fame of the Complainant and its earlier trademarks. It is highly likely that the Respondent chose the domain names because of their similarity to a trademark in which the Complainant has rights and legitimate interest. This was most likely done in the hope and expectation that Internet users searching for the Complainant's services and products would instead come across the Respondent's domains. According to the Complainant, such use cannot be considered a good faith use. The Complainant's trademark registrations significantly predate the registration date of the disputed domain names. In this regard, knowledge of the Complainant's intellectual property rights, including trademarks, at the time of registration of the disputed domain name, proves bad faith registration. A quick trademark search would have revealed to the Respondent the existence of the Complainant and its trademarks. Respondent's failure to do so is a contributory factor to its bad faith. Further, the current use of the domain names may not be considered a good faith use. By simply maintaining the domain names, the Respondent is preventing the Complainant from reflecting its trademark in the corresponding domain name. The disputed domain names <hurleymalaysia.com> and <hurleyindonesia.com> resolve to a website highly resembling the official website of the Complainant, and reproducing its name and trademark. Since said websites do not display any element as to clarify or disclaim the relationship between the Respondent and the Complainant, the Complainant submits that such use of the disputed domain names must necessarily be regarded as bad faith use of the domain name under the Policy. It is clear that the Respondent is actively trying to benefit from the renown and fame of the Complainant and its brands to make commercial gain, by creating confusion in the mind of the Internet user of average attention. In addition, the domain name <hurleysingapore.com> resolves to an error page, and that does not prevent a finding of bad faith under the doctrine of passive holding.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

For the Panel, the Complainant has proven all three elements.

A. Identical or Confusingly Similar

By virtue of the trademark registrations provided, the Panel is satisfied that the Complainant has trademark rights in HURLEY.

The trademarks of the Complainant are recognizable in the disputed domain names. The addition of the generic Top-Level Domain (“gTLD”) and the geographic locations (*i.e.*, “Indonesia”, “Malaysia”, and “Singapore”), do not prevent a finding of confusing similarity to the trademark of the Complainant. The contested domain names reproduce the Complainant’s trademark. Therefore, the Complainant the disputed domain names are confusingly similar to the Complainant’s trademarks.

Besides, it is established case law (*e.g.*, *All Saints Retail Limited v. Tanja Lemann, Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-1403](#)) that the addition of a term to a trademark in a domain name does nothing to prevent confusing similarity arising from that domain name

It is further also already well established that the addition of a gTLD extension such as “.com” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark. As a result, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or
- (iii) the respondent is making a legitimate non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Based on the Respondents’ default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain names.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain names. Accordingly, the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests, shifting the burden of production onto the Respondent to present evidence of rights or legitimate interests. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.1.

The Respondent has not indicated any reason to justify why it has chosen the specific term “hurley” to compose the disputed domain names. The Panel notes that the present record provides no evidence to demonstrate the Respondent’s intent to use or to make preparations to use the domain names in connection with a *bona fide* offering of goods or services. On the contrary, the disputed domain names <hurleymalaysia.com> and <hurleyindonesia.com> resolve to a website highly resembling the official website of the Complainant and reproducing its name and trademark. Since said website does not display any element as to clarify or disclaim the relationship between the Respondent and the Complainant, no rights or legitimate interests relating to the Respondent in the disputed domain names can be found (see *Spigen Korea Co. Ltd., Spigen Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2016-0145](#)).

Whether or not products are actually sold on the Respondent's website, and whether any such products are genuine or counterfeit, the website gives the false impression that it is owned, operated or endorsed by, or affiliated with, the Complainant. Accordingly, this use should not be considered to be a *bona fide* offering of goods or services within the meaning of paragraph 41(i) of the Policy. As for the disputed domain name <hurleysingapore.com>, it resolves to an error page. In *Carrefour v. Andre Machado*, WIPO Case No. [DIO2020-0004](#), the Panel stated that a blank or error page is not a *bona fide* offering of goods or services under the Policy. This also applies in the present case. Moreover, given the composition of the disputed domain name, and in particular noting the use to which the other disputed domain names were put, it is clear that the Respondent sought to create a risk of implied affiliation to the Complainant when constructing the disputed domain name and such composition cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain names, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

The Complainant enjoys a long-lasting worldwide reputation, which has been established by the Complainant. The Respondent necessarily had the Complainant's name and trademark in mind when registering the disputed domain names. The Respondent's choice of domain names cannot have been accidental and must have been influenced by the fame of the Complainant and its earlier trademarks, particularly in light of the impersonating nature of the content found at the websites to which two of the disputed domain names resolved to.

According to the [WIPO Overview 3.0](#), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

It is highly likely that the Respondent chose the domain names because of their similarity to the Complainant's trademark. This was most likely done in the hope and expectation that Internet users searching for the Complainant's services and products would instead come across the Respondent's domains. Such use cannot be considered a good faith use.

Besides, the Complainant's trademark registrations significantly predate the registration date of the disputed domain names. In this regard, previous Panels have established that knowledge of the Complainant's intellectual property rights, including trademarks, at the time of registration of the disputed domain names, proves bad faith registration. A quick trademark search would have revealed to the Respondent the existence of the Complainant and its trademarks. Respondent's failure to do so is a contributory factor to its bad faith (see e.g., *Lancôme Parfums Et Beaute & Cie, L'oreal v. 10 Selling*, WIPO Case No. [D2008-0226](#)).

Therefore, at the very least, the Respondent knew or should have known that, when acquiring and using the domain names, it would do so in violation of the Complainant's earlier rights.

The use of the domain names by the Respondent may not be considered a good faith use. The disputed domain names <hurleymalaysia.com> and <hurleyindonesia.com> resolve to a website highly resembling the official websites of the Complainant, and reproducing its name and trademark. Since said website does not display any element as to clarify or disclaim the relationship between the Respondent and the Complainant, such use of the disputed domain names must be regarded as bad faith use of the domain name under the Policy. It is clear that the Respondent is actively trying to benefit from the renown and fame of the Complainant and its brands to make commercial gain, by creating confusion in the mind of the Internet user of average attention. In addition, the domain name <hurleysingapore.com> resolves to an error page. The non-use of a domain name (including a blank or "coming soon" page) does not prevent a finding of bad faith under the doctrine of passive holding (see *Carrefour v. Andre Machado*, WIPO Case No. [DIO2020-0004](#) cited above).

By registering several domain names reproducing the Complainant's trademark, the Respondent entered into a pattern of behaviour consisting of registering domain names confusingly similar to established trademarks and using the domains for commercial gain, which is an additional factor of bad faith under the Policy.

It is finally noteworthy that the Complainant's searches show that the Respondent is cited as respondent in a very large number of UDRP proceedings. See, among others, *All Saints Retail Limited v. Tanja Lemann, Client Care, Web Commerce Communications Limited, supra*.

All the above characterizes bad faith registration and use in the present case. Accordingly, the Panel finds that the disputed domain names were registered and being used in bad faith, and the Complainant has also satisfied the third element of 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 disputed domain names, <hurleyindonesia.com>, <hurleymalaysia.com>, and <hurleysingapore.com> be transferred to the Complainant.

/Daniel Kraus/

Daniel Kraus

Sole Panelist

Date: September 26, 2023