

## ADMINISTRATIVE PANEL DECISION

Saks.com LLC v. 刘瑞丰 (Liu Rui Feng)

Case No. D2023-3334

### 1. The Parties

The Complainant is Saks.com LLC, United States of America (“United States”), represented by Loeb & Loeb LLP, United States.

The Respondent is 刘瑞丰 (Liu Rui Feng), China.

### 2. The Domain Names and Registrar

The disputed domain names <saksfifthavenue.sale>, <saksfifthavenue.vip>, and <saksoff5th.shop> are all registered with DNSPod, Inc. (the “Registrar”).

### 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on August 2, 2023. On August 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 4, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names that differed from the named Respondents (Unknown Registrant and the Registrar) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 17, 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 in English on August 18, 2023.

On August 17, 2023, the Center informed the parties in Chinese and English that the language of the registration agreements for the disputed domain names is Chinese. On August 18, 2023, the Complainant requested that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on August 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 15, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on October 13, 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 group company of Saks & Company, LLC ("Saks & Co."), a luxury retail store chain. Saks & Co. opened the first Saks Fifth Avenue store in the early 1900s and it now has stores throughout the United States and elsewhere. The Complainant owns multiple trademark registrations in multiple jurisdictions, including the following Chinese trademark registrations:

- numbers 777990, 797841 and 803879, all for SAKS FIFTH AVENUE, registered on February 14, 1995, December 7, 1995, and December 28, 1995, respectively; and
- numbers 24020757 and 24020758, both for SAKS OFF 5TH, both registered on May 7, 2018.

The above trademark registrations are current. The Complainant has also registered the domain names <saksfifthavenue.com> (created on November 11, 1998) and <saksoff5th.com> (created on August 19, 2012) that it uses in connection with websites where it sells clothing, shoes, and accessories.

The Respondent is an individual based in China.

The disputed domain names were created on the following dates:

Disputed domain name	Creation date
<saksoff5th.shop>	March 29, 2023
<saksfifthavenue.vip>	April 3, 2023
<saksfifthavenue.sale>	April 20, 2023

According to cached webpages provided by the Complainant, in April 2023, the disputed domain name <saksoff5th.shop> resolved to a shopping website in English that prominently displayed the SAKS OFF 5TH mark and offered for sale a classic tote bag, while the disputed domain name <saksfifthavenue.vip> resolved to a shopping website in English that prominently displayed the SAKS FIFTH AVENUE mark. Both websites invited Internet users to enter personal details to create an account. The contact telephone on both websites was a Chinese mobile number. At the time of this Decision, both disputed domain names are passively held. The disputed domain name <saksfifthavenue.sale> does not resolve to an active website either, rather it is passively held.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names are identical to its SAKS FIFTH AVENUE and SAKS OFF 5TH marks.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not affiliated with the Complainant in any way. At no time has the Complainant licensed or otherwise endorsed, sponsored, or authorized the Respondent to use the Complainant's marks or to register domain names incorporating the Complainant's marks. The sole purpose of the Respondent's websites located at the disputed domain names is to confuse the average consumer into believing the websites are somehow connected or related to the authentic Saks Fifth Avenue website.

The disputed domain names were registered and are being used in bad faith. The disputed domain names are being used for dangerous, illegal or malicious purposes by using the Complainant's marks to lure unsuspecting customers to the disputed domain names.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Language of the Proceeding**

The language of the Registration Agreements for the disputed domain names is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint and amended Complaint were filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including that the disputed domain names are formed by English words; translation of the Complaint would create significant expense for the Complainant and delay the proceeding; some of the website content associated with the disputed domain names was in English and the Respondent has registered other domain names in English so that it is fair to assume that the Respondent is proficient in English.

The Respondent did not make any submission with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1.

The Panel notes that two of the disputed domain names have resolved to websites in English, from which it is reasonable to infer that the Respondent is familiar with that language. Moreover, despite having received an email regarding the language of the proceeding and the notification of the Complaint in both Chinese and English, the Respondent has not commented on the language of the proceeding or expressed any interest in otherwise participating in this proceeding. Therefore, the Panel considers that requiring the Complainant to translate the Complaint would create an undue burden and delay.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

### **6.2 Substantive Issues**

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements with respect to each disputed domain name:

- (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.

The burden of proof of each element is borne by the Complainant. The Respondent's failure to respond to the Complainant's contentions does not by itself mean that the Complainant is deemed to have prevailed. See [WIPO Overview 3.0](#), section 4.3.

#### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of trademark SAKS FIFTH AVENUE or SAKS OFF 5TH is reproduced within each of the disputed domain names. Accordingly, each of the disputed domain names is identical to one of these marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

#### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise. Furthermore, the Panel notes the composition of the disputed domain names carries a high risk of implied affiliation with the Complainant ([WIPO Overview 3.0](#), section 2.5.1).

Based on the available record, the Panel finds the second element of the Policy has been established.

#### **C. Registered and Used in Bad Faith**

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

“(iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] web site or location or of a product or service on [the respondent’s] web site or location.”

In the present case, the Panel notes that the Respondent registered the disputed domain names in 2023, years after the registration of the Complainant’s SAKS FIFTH AVENUE and SAKS OFF 5TH marks, including in China, where the Respondent is based. The disputed domain names wholly incorporate either the SAKS FIFTH AVENUE mark or the SAKS OFF 5TH mark with no additional element besides a generic Top-Level Domain, which is a standard requirement of domain name registration. The marks are not common phrases and have no apparent meaning other than as a reference to the Complainant’s stores and products. The websites associated with two of the disputed domain names also prominently displayed the Complainant’s marks. The Respondent provides no explanation for his choice to register the disputed domain names. In view of these circumstances, the Panel finds that the Respondent had the Complainant’s marks in mind when he registered the disputed domain names.

The disputed domain names <saksfifthavenue.vip> and <saksoff5th.shop> have been used in connection with shopping websites. This is the same type of service (*i.e.*, retail) in connection with which the Complainant uses its marks. At the time of this Decision, the disputed domain names do not resolve to any active website. The Panel finds that these disputed domain names were used in an intentional attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s SAKS FIFTH AVENUE mark or SAKS OFF 5TH mark within the terms of paragraph 4(b)(iv) of the Policy.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain name <saksfifthavenue.sale> does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark; (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use; (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the record, the Panel notes the distinctiveness or reputation of the Complainant’s SAKS FIFTH AVENUE trademark, the composition of the disputed domain name <saksfifthavenue.sale>, which is identical to that mark and identical to the disputed domain name <saksfifthavenue.vip> that the Respondent registered around the same time and subsequently used in bad faith. The Panel finds that in the circumstances of this case the passive holding of the disputed domain name <saksfifthavenue.sale> does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

## 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 <saksfifthavenue.sale>, <saksfifthavenue.vip>, and <saksoff5th.shop> be transferred to the Complainant.

*/Matthew Kennedy/*

**Matthew Kennedy**

Sole Panelist

Date: October 27, 2023