

ADMINISTRATIVE PANEL DECISION

Simon Property Group, L.P. v. gao da
Case No. D2023-3403

1. The Parties

The Complainant is Simon Property Group, L.P., United States of America (“United States”), represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is gao da, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <simonshop.vip> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on August 9, 2023. On August 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 10, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 10, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center sent another email communication to all Parties in Chinese and English regarding the language of the proceeding. The Complainant filed an amended Complaint in English on August 14, 2023 which included the request 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 Chinese and English of the Complaint, and the proceedings commenced on August 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 12, 2023.

The Center appointed Rachel Tan as the sole panelist in this matter on September 22, 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 an American real estate investment trust that invests in shopping malls, outlet centers, and community/lifestyle centers. It has been listed on the New York stock exchange since 1993. The Complainant maintains the presence and has been providing information about its SIMON brand and services from its primary website “www.simon.com” since 1997. According to “similarweb.com”, the Complainant’s website at “www.simon.com” received an average of 4 million visits per month during the period ranging January to March 2023.

The Complainant is the owner of marks consisting of the element “simon”, including United States Trade Mark Registration No. 2969024 for SIMON, registered on July 19, 2005, in class 35 and United States Trade Mark Registration No. 5375533 for [∞]SIMON, registered on January 9, 2018, in classes 9, 35, 36, 37, and 41.

The Complainant is also the registrant of several domain names incorporating the SIMON mark, for example <simon.com>, <shopsimon.app>, <shopsimon.com> and <shopsimons.net>.

The Respondent is gao da, Hong Kong, China.

The disputed domain name was registered on June 6, 2023. At the date of this Decision, the disputed domain name does not resolve to any active website. At the time of filing of the Complaint, the disputed domain name resolved to a website in English. This website allegedly displayed the Complainant’s SIMON logo mark, offered goods within the same sector as that offered by the Complainant and used information and videos taken from the Complainant’s official website.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it is the owner of the SIMON mark. It is a standard practice not to consider the Top-Level Domain (“TLD”) “.vip” when comparing the disputed domain name to the Complainant’s marks. In the present case, the “.vip” TLD is even likely to heighten confusion in the minds of Internet users as the Complainant offers a “VIP Shopper Club” under the SIMON mark. Further, the fact that the descriptive term “shop” in the disputed domain name is closely linked and associated with the Complainant’s brand and mark only serves to underscore and increase the confusing similarity between the disputed domain name and the Complainant’s mark.

The Complainant further alleges that the Respondent is not sponsored by or affiliated with the Complainant in any way. The Respondent registered the disputed domain name significantly after the Complainant’s registration of its SIMON mark and domain names. The Respondent is not making a *bona fide* offering of goods or services or legitimate noncommercial or fair use of the disputed domain name. In particular, the Respondent uses the disputed domain name to host a third-party website that offers goods within the same sector as that offered by the Complainant, while prominently displaying the Complainant’s SIMON logo mark at the masthead of the website. The Respondent’s inclusion of the Complainant’s logo on the disputed domain name’s website is a direct effort to take advantage of the fame and goodwill that the Complainant has built in its brand.

The Complainant finally asserts that by registering a domain name that is confusingly similar to the Complainant's SIMON mark, the Respondent has demonstrated knowledge of and familiarity with the Complainant's brand and business. The Respondent's use of the Complainant's logo prominently featured on the resolved website further evinces the likelihood the Respondent has chosen to register the disputed domain name to target the Complainant and not for any arbitrary reason. Moreover, the "About Us" and "Contact Us" pages of the resolved website feature information that an individual who is not aware of the Complainant would not simply be privy to, including copyrighted videos and a quote credited to the CEO of the Complainant, information in the footer of the website stating that they are "Shop PO, LLC", (which is a joint venture between the Complainant and Rue Gilt Groupe), and the address of Rue Gilt Groupe is also featured on the resolved website. This demonstrates that the Respondent is clearly attempting to appear legitimate in their intention to targeting the Complainant and using the fame of the Complainant's marks to improperly increase traffic to the resolved website for the Respondent's own commercial gain in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

Initially, the Panel must address the language of the proceeding. Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement unless otherwise agreed by the parties, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The panel may choose to write a decision in either language, or request translation of either party's submissions.

In this case, the Registrar has confirmed to the Center that the language of the Registration Agreement as used by the registrant for the disputed domain name is Chinese. However, the Complainant has requested that English be adopted as the language of the proceeding for the reasons summarised below:

- (a) the Complainant is unable to communicate in Chinese and translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter;
- (b) such additional delay, considering the obviously abusive nature of the disputed domain name and its resolved website poses continuing risk to the Complainant and unsuspecting consumers seeking the Complainant or its products; and
- (c) the disputed domain name is comprised of Latin characters. The terms "simon" and "shop" do not carry any specific meaning in the Chinese language. Further, the resolved website features various phrases and fully formed sentences in English which suggests that the Respondent is at the very least competent in English.

It is established practice to take paragraphs 10(b) and 10(c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

The Panel having considered the circumstances finds that English shall be the language of this proceeding. The reasons are set out below:

- (a) the Complainant is based in the United States. Requiring the Complainant to translate the Complaint in Chinese would lead to delay and cause the Complainant to incur translation expenses;

(b) the Respondent's choice of English terms for the disputed domain name and resolved website indicate that the Respondent is familiar with the English language;

(c) even if the Respondent does not possess a sufficient command of English to understand the Complaint, there were ample opportunities for the Respondent to raise an objection. The Center notified the Parties in English and Chinese of the language of the proceeding, the Complainant requested English to be the language of the proceeding, but the Respondent did not protest against this request;

(d) the Respondent has failed to participate in the proceeding even though the Center sent the notification of the Complaint in English and Chinese, and indicated that the Response may be submitted in Chinese or English; and

(e) the Complaint has been submitted in English. No foreseeable procedural benefit may be served by requiring Chinese to be used. On the other hand, the proceeding may proceed expeditiously in English.

Accordingly, the Panel determines that the language of the proceeding shall be English, and will proceed with issuing this Decision in English.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has adduced evidence to demonstrate its established rights in the SIMON mark.

The Panel notes that the SIMON mark is wholly encompassed within the disputed domain name. The SIMON mark is instantly recognizable in the disputed domain name. In cases where a domain name incorporates the entirety of a trade mark, 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 for purposes of UDRP standing. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

Further, it is accepted by previous UDRP panels that the addition to the complainant's trade mark of other words or terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity between the domain name and the complainant's trade mark under the first element of the Policy. See section 1.8 of the [WIPO Overview 3.0](#). As such, the Panel finds the additional term "shop" does not preclude a finding of confusing similarity between the SIMON mark and the disputed domain name.

Lastly, it is permissible for the Panel to disregard the TLD in the disputed domain name, *i.e.*, ".vip". It is accepted by UDRP panels that the practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to "new g[eneric] TLDs") and the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment to the first element. See sections 1.11.1 and 1.11.2 of the [WIPO Overview 3.0](#).

Accordingly, the Complainant has satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

In circumstances where the Complainant possesses rights to the SIMON mark, whereas the Respondent seems to have no trade mark rights, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the burden of production shifts to the Respondent to show that he or she has rights or legitimate interests in the disputed domain name. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not provided evidence of a legitimate noncommercial or fair use of the disputed domain name or reasons to justify his or her choice of the term “simon” in the disputed domain name. There is no indication to show that the Respondent is commonly known by the disputed domain name or otherwise has rights or legitimate interests in it. Moreover, the Complainant has not granted the Respondent any license or authorization to use the Complainant’s marks or register the disputed domain name.

The Panel notes that the disputed domain name previously resolved to a website in English noticeably displayed the Complainant’s SIMON logo mark. This website allegedly offered goods within the same sector as that offered by the Complainant and used information and videos taken from the Complainant’s official website. This website did not accurately and prominently disclose a lack of a relationship between the Complainant and the Respondent. Therefore, the facts do not support a claim of a *bona fide* offering of goods or services under the “Oki Data test”. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, the Complainant has satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant’s SIMON mark was registered well before the registration of the disputed domain name. Through use and advertising, the Complainant’s SIMON mark is known throughout the world, including in China. Search results using the related terms “simon” and “shop” on the Internet search engines direct Internet users to the Complainant and its service, which indicates that an exclusive connection between the SIMON mark and the Complainant has been established. As such, the Respondent should have known of the Complainant’s SIMON mark when registering the disputed domain name. This fact has been reinforced by the Respondent’s use of the SIMON logo mark on the website at the disputed domain name.

The Panel notes that the disputed domain name previously resolved to a website displayed the Complainant’s SIMON logo mark. The resolved website allegedly offered goods within the same sector as that offered by the Complainant and used information and videos taken from the Complainant’s official website. The lack of a disclaimer that the Respondent is not affiliated with the Complainant is noticeably absent. The Panel is satisfied that the Respondent intends to take advantage of the reputation of the Complainant’s trade marks to attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s marks as to source, sponsorship, affiliation, or endorsement of the website. This demonstrates bad faith registration and use of the disputed domain name, as provided in paragraph 4(b)(iv) of the Policy.

The Panel notes that the disputed domain name currently does not resolve to any active website. The current inactive use of the disputed domain name in this case would not prevent a finding of bad faith under the doctrine of passive holding. In its determination, the Panel considers the degree of reputation of the Complainant’s SIMON mark, the Respondent’s failure to respond in the face of the Complainant’s allegations of bad faith, as well as the implausibility of any good faith use that the disputed domain name may be put. See section 3.3 of the [WIPO Overview 3.0](#).

Given all the circumstances of the case, the Panel finds that the Respondent must have known of the Complainant before registering the disputed domain name, and considering the Respondent’s lack of rights or legitimate interests, and by registering and using the disputed domain name as discussed above as well as continuing to hold the disputed domain name, the Panel is led to conclude that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied the third element under paragraph 4(a) 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 name, <simonshop.vip>, be transferred to the Complainant.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: October 6, 2023