

ADMINISTRATIVE PANEL DECISION

C. & J. Clark International Ltd v. Not disclosed
Case No. D2023-4732

1. The Parties

The Complainant is C. & J. Clark International Ltd, United Kingdom, represented by SafeNames Ltd., United Kingdom.

The Respondent is Not disclosed, China.

2. The Domain Name and Registrar

The disputed domain name <usclarks.shop> (the “Domain Name”) is registered with TLD Registrar Solutions Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 14, 2023. On November 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 16, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 16, 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 November 17, 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 November 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 20, 2023.

The Center appointed Gregor Vos as the sole panelist in this matter on January 15, 2024. 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 international shoe manufacturer and retailer that was founded in 1825.

The Complainant is the owner of *inter alia* the following trademark registrations (the “Trademarks”):

- European Union Trade Mark registration No. 000167940 for the wordmark CLARKS, registered on July 16, 1998;
- United States Trademark registration No. 691307 for the wordmark CLARKS, registered on January 12, 1960.

The Domain Name was registered on June 19, 2023, and used to resolve to website mimicking the Complainant’s website and offering for sale the Complainant’s products at discounted prices. Currently, the Domain Name does not resolve to an active webpage.

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 Domain Name.

Notably, the Complainant first contends that the Domain Name is confusingly similar to its Trademarks, since it incorporates the Trademarks in their entirety with the mere addition of the geographical indication ‘us’ that refers to the United States and the generic Top-Level Domain (“gTLD”) “.shop” that is generally disregarded under the first element.

Second, the Complainant states that the Respondent has no rights or legitimate interests in the Domain Name. The Respondent has never received authorization from the Complainant to use the Trademarks in the Domain Name and is not commonly known by the Domain Name. Also, the Respondent is not making a legitimate noncommercial or fair use of the Domain Name.

Finally, according to the Complainant, the Respondent was undoubtedly aware of the Trademarks when registering the Domain Name and the current passive holding of the Domain Name does not preclude a finding of use of the Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

First, 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.

Second, the entirety of the Trademarks is reproduced within the Domain Name. Accordingly, the Domain Name is confusingly similar to the Trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of another term here, “us”, may bear on assessment of the second and third elements, the Panel finds the addition of this term does not prevent a finding of confusing similarity between the Domain Name and the Trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 the Domain Name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy or otherwise.

Furthermore, the construction of the Domain Name and the prior impersonating nature of the website at the Domain Name demonstrate the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the Domain Name and the Complainant as to the origin or affiliation of the website at the Domain Name. The current non-use of the Domain Name cannot be considered a *bona fide* offering of goods and services.

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.

First, the Panel notes that the Trademarks were 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. In light of the reputation of the Trademarks, 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. The reputation of the Trademarks of the Complainant has been confirmed by earlier UDRP panels (see e.g., *C & J Clark International Limited v. Karen Brand*, WIPO Case No. [DCO2015-0035](#) and *C. & J. Clark International Ltd v. Drescher Karin; Schulze*

Stefanie; Hoffmann Florian; Name Redacted; Henrik Tess; Wulf Susanne; Fischer Thorsten; Baier Johanna; benjamin vogt; Baer Barbara; Stephanie Werfel; David Bader; Web Commerce Communications Limited, Client Care; Whoisprotection.cc, Domain Admin; Torsten GRUNEWALD; Gabriele ACKERMAN; Uwe Achen; Steffen Schuster; Sven Eisenhauer; Eric Koehler; Lea Muench; Christina Kuster; ming dian; Manuela Ziegler; matilda allen; Paul Fried; Nataliia Kuripko; Andreas Kirsch; David Boehm; Markus Schroder; Felix Fuhrmann; Daniel Beyer; Johanna Barth; Katja Kirsch; Sara Moench; Brigitte Kuester; Yvonne Grunewald; Annett Roth; Uta Weiss; Dennis Bohm; Katrin Winkel; Sophie Adler; Mike Schweizer; Jens Jager; Torsten Kuhn; Jens Keller; Eric Kuster; Juliane Fassbinder; Sabrina Furst; Monika Kaufmann; Mike Klug; Andrea Moench; Simone Luft; Kerstin Eichelberger; Doreen Koch; Marcel Ebersbach; Dieter Hahn; Alexander Schneider; Michelle Baier; Florian Weber; Lena Duerr; Mike Braun; Kevin Eisenhauer; Maria Schaefer; Anna Frey; Maik Wulf, WIPO Case No. [D2022-0817](#)).

Second, the Complainant provided evidence that the Domain Name previously resolved to a website impersonating the Complainant and offering for sale the Complainant's products at discounted prices. The Panel finds that the Respondent used the Domain Name to intentionally attract, for commercial gain, Internet users to their website by creating a likelihood of confusion with Complainant's Trademarks as to the source, sponsorship, affiliation, or endorsement of that Respondent's website which the Panel finds constitutes bad faith registration and use under paragraph 4(b)(iv) of the Policy.

Third, 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 available record, the Panel finds the current non-use of the Domain Name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the reputation of the Complainant's Trademarks, and the composition of the Domain Name in which merely the geographical indication "us" and the gTLD ".shop" are added to the Trademarks, and finds that in the circumstances of this case the passive holding of the Domain Name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established 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 Domain Name <usclarks.shop> be transferred to the Complainant.

/Gregor Vos/

Gregor Vos

Sole Panelist

Date: January 29, 2024