

ADMINISTRATIVE PANEL DECISION

MZ Wallace, Inc. v. Client Care, Web Commerce Communications Limited
Case No. D2023-5005

1. The Parties

The Complainant is MZ Wallace, Inc., United States of America (the “United States”), represented by Vedder Price P. C., United States.

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

2. The Domain Name and Registrar

The disputed domain name <mzwallacefactoryoutlet.com> is 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 November 30, 2023. On December 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 4, 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 (Not Available from Registry) and contact information in the Complaint. The Center sent an email communication to the Complainant December 7, 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 December 7, 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 December 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 10, 2024.

The Center appointed Alistair Payne as the sole panelist in this matter on January 24, 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 a retailer of bags and decorative items such as handbags, tote bags, satchels, travel bags, wallets, purses, and tassels throughout the United States. The Complainant was established in 2000 and since at least April 2000 has been conducting business under the MZ WALLACE trade marks and has continuously used the MZ WALLACE trade marks to identify its goods and services in the United States related to its bags. The Complainant owns numerous trade mark registrations in the United States and elsewhere for its MZ WALLACE trade mark, including United States Registration number 5550328 registered on August 28, 2018, and also Malaysian trade mark registration TM2019008449 registered on May 20, 2020.

The disputed domain name was registered on October 12, 2023. It fully incorporates Complainant's MZ WALLACE trade mark and resolves to a website that uses the Complainant's mark and appears to be authorised by the Complainant.

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 name.

The Complainant submits that it owns registered trade mark rights for its MZ WALLACE trade mark as noted above and that the disputed domain name wholly contains its trade mark and is therefore confusingly similar to it. It submits that the addition of the term "factory outlet" in the disputed domain name, which is descriptive of the Complainant's business, does not prevent a finding of confusing similarity.

The Complainant submits that the Respondent's use of a confusingly similar mark to the Complainant's MZ WALLACE trade mark is unauthorised and that the Respondent's use of the disputed domain name cannot be considered to be in connection with a *bona fide* offering of goods and services as the webpage at the disputed domain name continues to describe the Respondent's services as if the site is associated with the Complainant. This is perpetuated, says the Complainant, by the Respondent describing itself as "Mz Wallace New York" and "mzwallacefactoryoutlet.com" throughout the entirety of its website, the Respondent directly copying the Complainant's images of its products, using images that are identical to the Complainant's, and direct copying of Complainant's product names and descriptions. As a consequence, says the Complainant, the Respondent has no rights or legitimate interests in the disputed domain name.

As far as bad faith is concerned the Complainant submits that the Respondent deliberately selected and registered, on October 12, 2023, the disputed domain name which fully incorporates the Complainant's MZ WALLACE trade mark as the dominant element in order to falsely suggest to the public that the Respondent is somehow associated with the Complainant, when this is not the case. The Complainant says that by virtue of its choice of the disputed domain name and the contents of the website to which it resolves, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the disputed domain name by creating a likelihood of confusion with the Complainant's MZ WALLACE trade mark. It says that the Respondent is intentionally attempting to create confusion among Internet users to attract attention to the disputed domain name for commercial gain in terms of paragraph 4(b)(iv) of the Policy.

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.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

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 disputed 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 disputed domain name such as those enumerated in the Policy or otherwise.

The Complainant has submitted that the Respondent's use of a confusingly similar mark to the Complainant's MZ WALLACE trade mark is unauthorised and that the Respondent's use of the disputed domain name cannot be considered to be in connection with a bona fide offering of goods and services as the webpage at the disputed domain name continues to describe the Respondent's services as if the site is associated with the Complainant. The Panel notes that the Respondent describes itself as "Mz Wallace New York" and "mzwallacefactoryoutlet.com" throughout the entirety of its website at the disputed domain name, as submitted by the Complainant the Respondent appears to have directly copied the Complainant's images of its products and has directly copied the Complainant's product names and descriptions. The Panel finds that this conduct is not bona fide and is not consistent with the Respondent having rights or legitimate interests in the disputed domain name. Rather, such conduct illustrates the Respondent's intent to impersonate the Complainant via both the composition and use of the disputed domain name, which can never confer rights or legitimate interests upon a respondent. [WIPO Overview 3.0](#), section 2.13.

Accordingly, 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.

In the present case, the Panel notes that the Respondent registered the disputed domain name in October 2023, some years after the Complainant's registration of its trade mark rights as set out under Part 4 above. The Complainant's MZ WALLACE trade mark is highly distinctive for hand bags and other baggage products and appears to enjoy protection as a registered trade mark in a number of jurisdictions including in Malaysia where the Respondent is reportedly based. The disputed domain name resolves to a website that masquerades as if it is the Complainant' website or is authorised by the Complainant when this is not the case. It features the Complainant's trade mark, images of its products and uses its product names. The Panel therefore finds that it is most likely that the Respondent was well aware of the Complainant's trade mark and business when it registered the disputed domain name.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

In this case the Respondent has used the disputed domain name to intentionally attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's MZ WALLACE trade mark and diverting Internet users to a website which masquerades as if it belongs to or is authorised by the Complainant when this is not the case. The website to which the disputed domain name resolves features representations of the Complainant's mark, products and product names without the Complainant's authorisation and appears to offer products at heavily discounted prices. The Respondent has failed to respond to the Complaint or to otherwise explain itself. The Panel finds that the Respondent's conduct amounts to conduct in terms of paragraph 4(b)(iv) of the Policy which is evidence of registration and use of the disputed domain in bad faith.

The Panel therefore 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 disputed domain name <mzwallacefactoryoutlet.com> be transferred to the Complainant.

/Alistair Payne/
Alistair Payne
Sole Panelist
Date: February 8, 2024