

ADMINISTRATIVE PANEL DECISION

Shoe Zone Retail Limited v. Web Commerce Communications Limited Case No. D2023-5015

1. The Parties

The Complainant is Shoe Zone Retail Limited, United Kingdom, represented by Freeths LLP, United Kingdom.

The Respondent is Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <shoezoneoutlet.com> and <shoezone-uk.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 December 1, 2023. On December 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 5, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registration Private) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 19, 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 amendment to the Complaint on January 11, 2024.

The Center verified that the Complaint together with the amendment to the 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 January 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 31, 2024. On February 9, 2024, the Center notified the Parties that it would proceed to panel appointment.

The Center appointed Alissia Shchichka as the sole panelist in this matter on February 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 a footwear retailer and operates over 320 physical stores across the United Kingdom ("UK"). The company reported an annual turnover of GBP 165 million in 2023.

The Complainant has evidenced to be the registered owner of numerous trademark registrations, including, but not limited, to the following:

- the UK trademark registration (series) No. UK00002302794, registered on February 14, 2003, for the word marks SHOE ZONE and SHOEZONE, in classes 25 and 35;
- the UK trademark registration No. UK00800921601, registered on April 28, 2008, for the word mark SHOE ZONE, in class 25;

The Complainant is also the owner of the domain name <shoezone.com>, registered on November 25, 1998.

The Complainant's trademarks and domain name were registered before the disputed domain names, both of which were registered on October 24, 2023. The disputed domain names currently display inactive webpages. However, based on the evidence provided by the Complainant, the disputed domain names previously redirected to identical e-commerce websites that impersonated the Complainant and advertised similar products.

The Respondent, according to the disclosed Whois information for the disputed domain names, is located in Malaysia.

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 emphasizes that the Complainant's reputation is globally recognized, and established over numerous years in relation to footwear and related services.

According to the Complainant, the disputed domain names are confusingly similar to the Complainant's trademarks SHOE ZONE and SHOEZONE as they incorporate the entire trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names since (1) the Complainant's rights predate the Respondent's registration of the disputed domain names; and (2) the Complainant has never licensed, or otherwise permitted the Respondent to apply to register the disputed domain names.

Finally, the Complainant asserts that the Respondent was aware of and deliberately targeted the Complainant's previously registered trademarks with the intention of causing confusion between the disputed domain names and the Complainant's trademarks, seeking financial gain by exploiting the Complainant's trademark reputation. This confusion has led consumers to make purchases on the disputed domain names, under the mistaken belief that they are affiliated with the Complainant, thereby causing reputational and

commercial damage to the Complainant's business. Such use cannot be considered a bona fide offering of goods or services.

Therefore, the Complainant alleges that the registration and use of the disputed domain names was, and currently is, in bad faith, contrary to the Policy and Rules.

The Complainant requests that the disputed domain names be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

The Respondent's default in the case at hand does not automatically result in a decision in favor of the Complainant, however, paragraph 5(f) of the Rules provides that if the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from the Respondent's failure to submit a response as it considers appropriate.

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 Panel finds the mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, "outlet" and "uk", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark 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 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 names.

The Complainant has confirmed that the Respondent is not affiliated with the Complainant, or otherwise authorized or licensed to use the SHOE ZONE and SHOEZONE trademarks or to seek registration of any domain name incorporating the trademarks. The Respondent is also not known to be associated with the SHOE ZONE and SHOEZONE trademarks, and there is no evidence showing that the Respondent has been commonly known by the disputed domain names. [WIPO Overview 3.0](#), section 2.3.

Based on the available record, the Panel finds that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. [WIPO Overview 3.0](#), section 2.4.

Currently, the disputed domain names merely resolve to inactive pages. Previously, as demonstrated by the Complainant on record, the disputed domain names redirected to webpages that impersonated the Complainant and advertised shoes from various brands. Additionally, the Respondent has failed to disclose the non-existing relationship with the Complainant. Consequently, the Respondent has not met at least two criteria outlined in the Oki Data test, which establishes nominative (fair) use by resellers. [WIPO Overview 3.0](#), section 2.8.

Finally, the Panel also notes that the composition of the disputed domain names, carries a risk of implied affiliation or suggests sponsorship and/or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Complainant has provided evidence supporting its prima facie claim that the Respondent lacks any rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

Therefore, the Panel concludes that the Respondent does not have any rights or legitimate interests in the disputed domain names and the Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

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 Complainant’s SHOE ZONE and SHOEZONE trademarks

substantially predate the Respondent's registration of the disputed domain names. The Complainant has established a solid reputation, particularly in the UK, where it maintains a widespread network of physical stores. Furthermore, the inclusion of the abbreviation "uk" (for United Kingdom) in one of the disputed domain names indicates that the Respondent knew or should have known about the Complainant's trademarks at the time of registering the disputed domain names. [WIPO Overview 3.0](#), section 3.2.2.

Moreover, the Respondent's knowledge of the Complainant and its trademarks can be readily inferred from the Respondent's use of the Complainant's mark and logo on the disputed domain names, which previously resolved to webpages impersonating the Complainant and promoting products sold by the Complainant.

In the Panel's view, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its websites. Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Upon reviewing the available evidence, the Panel concludes that the current non-use of the disputed domain names does not preclude a finding of bad faith, as established in the landmark UDRP decision *Te/stra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Based on the available record, 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 disputed domain names <shoezoneoutlet.com> and <shoezone-uk.com> be transferred to the Complainant.

/Alissia Shchichka/

Alissia Shchichka

Sole Panelist

Date: February 26, 2024