

ADMINISTRATIVE PANEL DECISION

Shishi AS v. Fenglan Jiang

Case No. D2023-5254

1. The Parties

The Complainant is Shishi AS, Estonia, represented by AAA Patendibüroo OÜ, aka AAA Legal Services, Estonia.

The Respondent is Fenglan Jiang, China.

2. The Domain Name and Registrar

The disputed domain name, <shishi-us.com>, is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 18, 2023. On December 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 22, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 30, 2024.

The Center appointed David Stone as the sole panelist in this matter on February 2, 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 Norwegian–Estonian business that was established in 1998 and which sells homeware and other interior decorations and provides decorating services for residential and business premises. It has sales offices in Estonia, Norway, and Lithuania and a subsidiary (SHISHI US, LLC) in the United States of America (the “US”), and its goods are stocked by independent retailers in numerous cities around the world.

The Complainant owns the following trade marks (the “Marks”).

- SHISHI: International registration number 839863 registered on August 4, 2004, in international classes 20, 21, 26, and 28, and designating jurisdictions including China, Norway and the US;
- SHISHI: European Union registration number 013061627 registered on December 2, 2014, in international classes 20, 21, 26, and 28;
- : European Union registration number 011101169 registered on January 23, 2013, in international classes 20, 21, 26, and 28; and
- SHISHI: US registration number 4985754 registered on June 28, 2016, in international classes 20, 21, 26, and 28.

As well as comprising the distinctive text of the Marks, the word SHISHI is the distinctive part of both the Complainant’s name and the name of its US subsidiary. Furthermore, the Complainant advertises its business on the website “www.shishi.ee” and operates two Instagram accounts, both of which have SHISHI in their account names. Both the Complainant’s website and one of the two Instagram accounts feature branding using the device mark SHISHI HOME OF BEAUTY, that is, European Union registration number 011101169, provided above.

The disputed domain name was registered on July 12, 2022. It resolves to a website that features branding using the word SHISHI set in a colour and font very similar to that used in SHISHI HOME OF BEAUTY. The website advertises for sale products that appear similar to those sold by the Complainant and which are described using the word SHISHI.

Before submitting the Complaint, the Complainant anonymously ordered from the Respondent’s website a decorative bauble similar to one of its own products, but received a pair of sunglasses rather than the ordered item.

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.

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to the Marks. In particular, the disputed domain name incorporates in their entirety the Marks comprising the word SHISHI and differs from them only in the addition of the term “us”. Prior panels have held that to establish identity or confusing similarity it suffices for a domain name wholly to incorporate a Complainant’s registered mark. The fact that the additional term “us” is used in the disputed domain name is irrelevant and does not preclude confusion. Given the name of the Complainant’s US subsidiary, SHISHI US, LLC, the term “us” in the disputed domain name can be perceived as a variation of the Complainant’s domain name <shishi.ee>, which is a clear indication of an intent to confuse Internet users. It is generally accepted that the Top-Level Domain, here “.com”, is irrelevant when assessing whether a domain name is identical or confusingly similar to a trade mark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has designed and is using its website to evoke the Complainant's website, by offering for sale products from the Complainant's product line and using the Marks to describe the goods and to create the look and feel of the Complainant's website. This is a strong indication that the Respondent seeks to create a false association with the Complainant. Prior panels have held that there cannot be a bona fide offering of goods or services where a respondent has deliberately designed a website in a way that gives Internet users the false impression that they have reached one of the complainant's official websites. In addition, the Respondent cannot assert that is making legitimate noncommercial or fair use of the domain name, without intent for commercial gain, and is ultimately offering third party products via the disputed domain name as evidenced by the Complainant's test purchase. Finally, the Respondent is not commonly known by the disputed domain name and has not been authorized by the Complainant to use the Marks.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. Given the reputation and popularity of the Marks, the Respondent must have had prior knowledge of them, and registered the disputed domain name with the intent of taking advantage of the Complainant's rights, reputation and goodwill. The Respondent is using the disputed domain name to attract Internet users for commercial gain, by creating a likelihood of confusion as to the source, sponsorship or endorsement of its website. Internet users visiting the Respondent's website will expect it to be affiliated with or endorsed by the Complainant because SHISHI is a dominant term in the address. Such users will then find the "look and feel" of the Complainant's website recreated on the Respondent's website through the use of the SHISHI logo and the advertisement of the Complainant's goods. Prior panels have held that replicating the look and feel of a complainant's website constitutes strong evidence of bad faith because it gives the false impression that the website is affiliated with or sponsored by the complainant. There is no plausible explanation for the Respondent's use of the domain name other than that it seeks to exploit the Complainant's goodwill and renown for financial gain.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets out the three requirements that the Complainant must prove in order to succeed:

- (i) that the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (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.

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 Marks comprising the word SHISHI 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.

Although the addition of another term, here “us”, may bear on assessment of the second and third elements, the Panel finds the addition of such a term does not prevent a finding of confusing similarity between the disputed domain name 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

(i) Paragraph 4I of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name) before any notice to the respondent of the dispute, the respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if the respondent has acquired no trade mark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the trade mark or service mark at issue.

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.

On the facts and contentions before the Panel, the Respondent is not commonly known by the disputed domain name, is not authorised to use the Marks, and cannot claim any rights or legitimate interests in them by virtue of prior registration.

The Complainant has supplied screenshots of the Respondent’s website. These show that the Respondent has been using the word SHISHI and a logo very similar in font and colour to the device mark SHISHI HOME OF BEAUTY to advertise homeware including Christmas baubles and other decorations. Comparison with the goods sold by the Complainant on its website at “www.shishi.ee” shows that some of the goods advertised by the Respondent appear very similar to the Complainant’s goods and are being advertised at higher prices. The Respondent has not contended that it is making bona fide use of its website to resell the Complainant’s genuine branded goods, and regardless, even if argued, the website displayed at the disputed domain name would not fall under the applicable safeguards of fair use envisioned under section 2.8 of the [WIPO Overview 3.0](#), considering the lack of disclaimer on the website as to its lack of relationship with the Complainant. Accordingly, it seems apparent to the Panel that the Respondent is using the disputed domain name to impersonate the Complainant and sell counterfeits or third party products, particularly in view of the Complainant’s test purchase whereby an allegedly counterfeit third party product was provided instead of the actual product (Complainant’s) ordered.

Panels have held that the use of a domain name for illegal activity, here the sale of counterfeit goods and/or impersonation, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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) sets out the non-exhaustive criteria for bad faith. Generally, for the purposes of the Policy, bad faith constitutes registration and use of a domain name in order to:

- (i) sell, rent or transfer the domain name to the trade mark owner (or a competitor thereof) for a profit;
- (ii) prevent the trade mark owner from registering its trade mark in a domain name, provided that the respondent is engaged in a pattern of such conduct;
- (iii) disrupt the business of a competitor; or
- (iv) divert Internet traffic for commercial gain.

As discussed in the previous section, in the present case the Panel finds that the Respondent is using a domain name confusingly similar to the Marks to impersonate the Complainant and profit from the resulting confusion. In the absence of an alternative explanation from the Respondent, the Panel concludes that the Respondent was aware of the Complainant and its business, and devised and registered the disputed domain name to create a false and misleading impression of association between the disputed domain name and the Complainant. The Respondent's objective was to divert Internet traffic for the Respondent's commercial gain. The registration of the disputed domain name was therefore in bad faith, and panels have held that the use of a domain name for illegal activity such as impersonation constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes 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 disputed domain name, <shishi-us.com>, be transferred to the Complainant.

/David Stone/

David Stone

Sole Panelist

Date: February 16, 2024