

ADMINISTRATIVE PANEL DECISION

World Market Management Services, LLC v. Rupert Pearl, RupertPearl
Case No. D2024-0371

1. The Parties

Complainant is World Market Management Services, LLC, United States of America (“US”), represented by Bryan Cave Leighton Paisner LLP, US.

Respondent is Rupert Pearl, RupertPearl, US.

2. The Domain Name and Registrar

The disputed domain name <worldmarketonsale.com> is registered with Hello Internet Corp (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 26, 2024. On January 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 30, 2024, 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 (Unidentified Domain Name Registrant) and contact information in the Complaint. The Center sent an email communication to Complainant on January 30, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on January 30, 2024.

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 Respondent of the Complaint, and the proceedings commenced on February 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 25, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on February 27, 2024.

The Center appointed Phillip V. Marano as the sole panelist in this matter on March 6, 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

Complainant operates physical and online retail stores that sell a wide variety of home furnishings, décor, and food products, many of which are imported from around the world. Since 1998 Complainant has continually offered its goods through its official <worldmarket.com> domain name and website. Complainant owns numerous valid and subsisting registrations for the WORLD MARKET trademark in the US, including the trademark for WORLD MARKET (US Reg. No. 2,347,302), registered on May 2, 2000, with the earliest priority dating back to May 17, 1991, as well as a stylized trademark for WORLD MARKET (US Reg. No. 4,558,662), registered on July 1, 2014, with priority dating back to February 2008.

Respondent registered the disputed domain name on December 19, 2023. At the time this Complaint was filed, the disputed domain name resolved to website content that mirrors the trade dress of Complainant's official <worldmarket.com> website, purports to sell similar goods as Complainant, and features an identical version of Complainant's stylized WORLD MARKET trademark.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Complainant asserts ownership of the WORLD MARKET trademark and has adduced evidence of trademark registrations in the US, including the trademark for WORLD MARKET (US Reg. No. 2,347,302), registered on May 2, 2000, with the earliest priority dating back to May 17, 1991, as well as a stylized trademark for WORLD MARKET (US Reg. No. 4,558,662), registered on July 1, 2014, with priority dating back to February 2008. The disputed domain name is confusingly similar to Complainant's WORLD MARKET trademark, according to Complainant, because it incorporates Complainant's trademark in its entirety and "merely adds the non-distinctive, generic phrase 'on sale' to the end of the mark in an obvious attempt to trade off the goodwill of Complainant and its Marks and create confusion."

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: Respondent's use of the disputed domain name for illegal activity, specifically "impersonating or passing itself off as Complainant and making fraudulent sales or sales of counterfeit goods" as demonstrated by at least one consumer fraud complaint to Complainant; Respondent's false claim it is located in the US, when it is likely located in China; the lack of any association, authorization or license between Complainant and Respondent; the well-known nature of Complainant's WORLD MARKET trademarks; the lack of any evidence that Respondent is known by the name "World Market" or any variation thereof; and Respondent's use of the disputed domain name to intentionally target Complainant, Complainant's WORLD MARKET trademark and Complainant's retail store services.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: the well-known nature of Complainant's WORLD MARKET trademark; Respondent's use of the disputed domain name to impersonate Complainant and conduct a "sham business to defraud and steal from customers who it dupes into believing they are buying Complainant's authentic WORLD MARKET brand products, but delivers different products once paid"; Respondent's inclusion on its website header of Complainant's identical stylized WORLD MARKET trademark; Respondent's use a red and white "W" favicon just like Complainant; Respondent's fraudulent website claim to sell authentic WORLD MARKET brand Christmas products from Complainant; Respondent's use of fake contact information on its website, including a phone number with fourteen digits and misappropriation of a third party's residence as its business address; and Respondent's use of false domain name registration data in connection with the disputed domain name, which Complainant could not corroborate or correlate with Respondent through either TLO or idiCore database searches. In particular, Complainant has provided a customer fraud report it received regarding, "One customer [who] contacted Complainant after being duped

and defrauded by Respondent to notify Complainant of the imposter website. The customer thought they were buying an authentic World Market® nutcracker decoration for \$95.95, but instead Respondent shipped to them a costume ring directly from China. In addition to notifying Complainant, the customer stated they were planning to report Respondent's fraudulent activity to the U.S. Department of Justice's Internet Crime Complaint Center (IC3)."

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

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

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g. where a particular conclusion is prima facie obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

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 Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Ownership of a nationally or regionally registered trademark serves as prima facie evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the WORLD MARKET trademark has been registered in the US with priority dating back to May 17, 1991. Thus, the Panel finds that Complainant's rights in the WORLD MARKET trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's WORLD MARKET trademark. In this Complaint, the disputed domain name is confusingly similar to Complainant's WORLD MARKET trademark because, disregarding the ".com" generic Top-Level Domain ("gTLD"), the entirety of the trademark is contained within the disputed domain name. [WIPO Overview 3.0](#), section 1.7 ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name [...] [I]n cases where a domain name incorporates the entirety of a trademark, 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[...]"). In regard to gTLDs,

such as “.com” in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.1.

The combination with the phrase “on sale” does not prevent a finding of confusing similarity between Complainant’s WORLD MARKET trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.8 (Additional terms “whether descriptive, geographic, pejorative, meaningless, or otherwise” do not prevent a finding of confusing similarity under the first element”); see also *Dr. Martens Int’l Trading GmbH, et al. v. LinHua*, WIPO Case No. [D2012-0435](#) (<drmartenonsale.com> confusingly similar to DR. MARTENS trademark); and *Pandora Jewelry, LLC v. Lee*, WIPO Case No. [D2010-0582](#) (<pandoraonsale.com> confusingly similar to PANDORA). Indeed, the Panel concurs with Complainant that the additional phrase “on sale” does not prevent a finding of confusing similarity between Complainant’s WORLD MARKET trademark and the disputed domain name.

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1. It is evident that Respondent, identified by Whois data for the disputed domain name as “Rupert Pearl”, is not commonly known by the disputed domain name or Complainant’s WORLD MARKET trademark.

More importantly, UDRP panels have categorically held that use of a domain name for illegal activity—including the impersonation of the complainant and other types of fraud—can never confer rights or legitimate interests on a respondent. See e.g. *Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence*, WIPO Case No. [D2009-1017](#) (“Respondent has used the domain name to pretend that it is the Complainant and in particular to create false emails pretending that they are genuine emails coming from the Complainant and one of its senior executives”); see also *The Commissioners for HM Revenue and Customs v. Name Redacted*, WIPO Case No. [D2017-0501](#) (“In addition, the disputed domain names ... have had their web hosting suspended as a result of fraudulent activities. This is evidence of bad faith registration and use of the disputed domain names”). In its Complaint, Complainant has submitted persuasive, direct and uncontroverted evidence (including screen grab comparisons of Complainant and Respondent websites, as well as a customer fraud report regarding Respondent’s website) that Respondent operates a fraudulent website through the disputed domain name which impersonates Complainant in furtherance of Respondent’s illegal scheme to defraud consumers online.

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or

- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

Again, UDRP panels have categorically held that registration and use of a domain name for illegal activity — including impersonation, passing off, and other types of fraud — is manifestly considered evidence of bad faith within paragraph 4(b)(iv) of the Policy. See also *GEA Group Aktiengesellschaft v. J. D.*, WIPO Case No. [D2014-0357](#) (concluding that Respondent's use of the disputed domain name to disrupt the Complainant's business by using it to impersonate the Complainant for commercial gain was evidence of respondent's bad faith registration and use of the disputed domain); *KPPB LLP v. Czinczenheim*, WIPO Case No. [D2021-2947](#) (bad faith readily found from impersonating complainant in attempt to defraud and steal money from complainant's customers and steal money from them); *Gerber Tech. LLC v. WhoisGuard Protected, WhoisGuard, Inc. / Nazareth Barsoumian*, WIPO Case No. [DCO2020-0035](#) (evidence that respondent used domain to impersonate complainant and trick unsuspecting customers into making fraudulent payments establishes bad faith). To this end, Complainant has offered persuasive direct and uncontroverted evidence that Respondent operates a fraudulent website through the disputed domain name which impersonates Complainant in furtherance of Respondent's illegal scheme to defraud consumers online. As summarized above, this includes side-by-side comparisons of Complainant's and Respondent's websites (showing misappropriation and copying of Complainant's stylized WORLD MARKET trademark and favicon) as well as a customer fraud report concerning Respondent.

Finally, prior UDRP panel determinations agree, the use of false registration data in connection with a disputed domain name further supports a finding of bad faith registration and use. See *e.g. Action Instruments, Inc. v. Technology Associates*, WIPO Case No. [D2003-0024](#) (Providing false contact information violates paragraph 2 of the Policy, which requires a registrant to represent that the statements it "made in [its] Registration Agreement are complete and accurate". Maintaining that false contact information in the Whois records (which can easily be updated at any time) after registration constitutes bad faith use of the domain name because it prevents a putative complainant from identifying the registrant and investigating the legitimacy of the registration."); *Royal Bank of Scotland Group v. Stealth Commerce v. a.k.a. Telmex Management Services, Inc.*, WIPO Case No. [D2002-0155](#); and *Home Director, Inc. v. HomeDirector*, WIPO Case No. [D2000-0111](#). As summarized above, Complainant has offered persuasive circumstantial evidence that Respondent provides divergent yet equally false contact information on its website as well as its registration data for the disputed domain name.

In view of the foregoing, the Panel concludes that 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 <worldmarketonsale.com> be transferred to Complainant.

/Phillip V. Marano/
Phillip V. Marano
Sole Panelist
Date: April 2, 2024