

ADMINISTRATIVE PANEL DECISION

Cutting Edge Ventures Limited, Naked Wolfe Footwear Pty. Ltd. v. Client Care, Web Commerce Communications Limited
Case No. D2024-0384

1. The Parties

The Complainants are Cutting Edge Ventures Limited, Seychelles, and Naked Wolfe Footwear Pty. Ltd., Australia, represented by Landmark B.V., Netherlands (Kingdom of the).

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

2. The Domain Names and Registrar

The disputed domain names <nakedwolfemx.com>, <nakedwolfesmexlco.com>, <nakedwolfesusa.com>, <nakedwolfeuk.com>, and <nakedwolfe-usa.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 January 29, 2024. On January 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 30, 2024, 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 (Not Available From Registry) and contact information in the Complaint. The Center sent an email communication to the Complainants on January 30, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on February 1, 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 February 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 23, 2024.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on February 28, 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 Complainants belong to the same group of family-owned companies, and offer luxury fashion footwear, accessories and clothing products for both men and women. The Complainants operate their main website at “www.nakedwolfe.com”, where the Complainants offer for sale various of their fashion products.

The Complainants own several trademark registrations for NAKED WOLFE, among which:

- European Union Trademark Registration No. 015170351 for NAKED WOLFE, registered on April 27, 2017, in the name of the Complainant Cutting Edge Ventures Limited;
- United States of America Trademark Registration No. 5503628 for NAKED WOLFE, registered on June 26, 2018, in the name of the Complainant Cutting Edge Ventures Limited;
- Canada Trademark Registration No. TMA1002649 for NAKED WOLFE, registered on August 13, 2018, in the name of the Complainant Cutting Edge Ventures Limited;
- United Kingdom Trademark Registration No. UK00915170351 for NAKED WOLFE, registered on April 27, 2017, in the name of the Complainant Cutting Edge Ventures Limited;
- International trademark registration No. 1338046 for NAKED WOLFE, registered on December 19, 2016, in the name of the Complainant Naked Wolfe Footwear Pty. Ltd.

These trademarks were all registered before the registration dates of the disputed domain names, which were registered by the Respondent on the following dates: <nakedwolfeuk.com>, registered on June 1, 2023; <nakedwolfesusa.com>, registered on October 21, 2023; <nakedwolfe-usa.com>, registered on November 28, 2023; <nakedwolfesmexlco.com>, registered on August 25, 2023; and <nakedwolfemx.com>, registered on December 8, 2023.

According to the Complainants’ evidence, the disputed domain names (namely <nakedwolfemx.com>, <nakedwolfesmexlco.com>, and <nakedwolfe-usa.com>) resolved to websites which prominently used the Complainants’ registered trademarks and offered content that were unauthorized productions of the Complainants’ original photographs, thereby imitating the Complainants’ official website’s look and feel and purportedly promoting the Complainants’ products. The other disputed domain names (namely <nakedwolfesusa.com> and <nakedwolfeuk.com>) did not connect to active websites.

5. Parties’ Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainants contend that they are the owner of a number of registered trademarks consisting of NAKED WOLFE (in various combinations) and that these trademarks are distinctive and reputable. The Complainants assert that the disputed domain names are confusingly similar to the abovementioned trademarks since they incorporate such trademarks and merely combine them with geographical terms such as “usa”, “uk”, “mexlco”, or “mx”. The Complainants also argue that the disputed domain names directing to active websites displayed websites impersonating the Complainants and were used for the sole purpose to infringe use of the Complainants’ trademark and logo NAKED WOLFE, as well as copyright-protected materials for scamming clients of the Complainants. The Complainants allege that in these circumstances

the Respondent has no rights or legitimate interests in the disputed domain names, which were registered and are used in bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Preliminary Issue: Consolidation of the Complainants

The Complaint was filed in the name of multiple Complainants and the Complainants therefore request consolidation in this regard. Concerning consolidation, the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states in section 4.11.1: "In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation."

The Panel has carefully reviewed all elements of this case, giving particular weight to the following elements: the Complainants are part of the same group of family-owned companies and both own trademark registrations for NAKED WOLFE and therefore have a common grievance of trademark-abusive domain name registration and use against the Respondent. As such, the Panel concludes that both Complainants are the target of common conduct by the Respondent, and both have common grievances regarding the use of the NAKED WOLFE trademarks in the disputed domain names by the Respondent.

The Panel accepts that permitting the consolidation would be fair and equitable to all Parties involved and would safeguard procedural efficiency. The Panel also notes that the Respondent did not object to the request for consolidation. The Panel therefore grants the request for consolidation of the Complainants and shall hereafter refer to the Complainants jointly as "the Complainant".

6.2 Substantive Issues

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 names, [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 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, respectively "usa", "susa", "uk", "smexlco" or "mx", 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 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.

Moreover, upon review of the facts and evidence, the Panel notes that the Respondent has not provided any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services. Instead, upon review of the facts and the evidence submitted in this proceeding, the Panel notes that those of the disputed domain names directing to active websites, showed a clear intent on the part of the Respondent to misleadingly pass them off as the Complainant’s websites for commercial gain by selling unauthorized products branded with the Complainant’s trademarks. Moreover, the Respondent’s websites did not display any accurate and prominent disclaimer regarding the absence of relationship between the Complainant and the Respondent. Therefore, it is clear to the Panel from the foregoing elements that the Respondent is not a good faith provider of goods or services under the disputed domain names, see also *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Given the abovementioned elements, the Panel concludes that the Respondent’s use does not constitute a bona fide offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain names.

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

Furthermore, the Panel notes that according to the Complainant’s evidence, some of the disputed domain names direct to inactive webpages. In this regard, the Panel finds that holding domain names passively, without making any use of them, also does not confer any rights or legitimate interests in the disputed domain names on the Respondent in the circumstances of this proceeding (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#); and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

Finally, the Panel also finds that the nature of most of the disputed domain names, being confusingly similar to the Complainant’s trademarks and consisting of additional geographical abbreviations, such as “usa”, “uk”, or “mx”, carries a risk of implied affiliation as it effectively impersonates the Complainant and its products or suggests sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Given the intensive use and distinctiveness of the Complainant's prior registered trademarks, the Panel finds that the subsequent registration of the disputed domain names, which are confusingly similar to such marks, clearly and consciously targeted the Complainant's prior registered trademarks. The Panel therefore deducts from the Respondent's efforts to consciously target the Complainant's prior trademarks that the Respondent knew of the existence of the Complainant's trademarks at the time of registering the disputed domain names. This finding is confirmed by the fact that those of the disputed domain names which were linked to active websites clearly used the Complainant's trademarks and purportedly offered for sale the Complainant's products, since this proves that the Respondent was fully aware of the Complainant's business and its prior trademarks. In the Panel's view, the foregoing elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain names in bad faith.

As to use of the disputed domain names in bad faith, the Complainant provides evidence that those of the disputed domain names which were linked to active websites showed a clear intent on the part of the Respondent to misleadingly pass it off as the Complainant's website for commercial gain by purportedly offering for sale the Complainant's products to Internet users without the presence of a disclaimer or any other circumstance indicating good faith. The Panel concludes from these facts that the Respondent was intentionally attracting Internet users for commercial gain to such websites, by creating consumer confusion between the websites associated with the disputed domain names and the Complainant's trademarks. This constitutes direct evidence of the Respondent's bad faith under paragraph 4(b)(iv) of the Policy. The Panel therefore finds that it has been demonstrated that the Respondent has used and is using the disputed domain names in bad faith.

Moreover, the Panel notes that according to the Complainant's evidence, some of the disputed domain names direct to inactive webpages. 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 non-use of the disputed domain names 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 distinctiveness and intensive use of the Complainant's trademarks, the composition of the disputed domain names, and the unlikelihood of any good faith use of the disputed domain names by the Respondent and finds that in the circumstances of this case the passive holding of some of the disputed domain names 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 disputed domain names <nakedwolfemx.com>, <nakedwolfesmexlco.com>, <nakedwolfesusa.com>, <nakedwolfeuk.com>, and <nakedwolfe-usa.com> be transferred to the Complainant Cutting Edge Ventures Limited.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: March 13, 2024