

ADMINISTRATIVE PANEL DECISION

EE Holding Group LLC v. Muhammad nawaz12, merchstore
Case No. D2024-0495

1. The Parties

The Complainant is EE Holding Group LLC, United States of America (“USA”), represented by The Sladkus Law Group, USA.

The Respondent is Muhammad nawaz12, merchstore, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <ericmanuelshop.site> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2024. On February 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 5, 2024, 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 the same day.

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 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 28, 2024.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on March 1, 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 limited liability company organized under the laws of Delaware, USA.

The Complainant owns all intellectual property, including all trademark rights, of fashion designer Eric Emanuel and is the current owner of his global trademark portfolio. Eric Emanuel is an independent sportswear designer who has built his business and its vibrant community from the ground up. He gained notoriety in the fashion industry by designing custom python basketball jerseys, which became popular with musical artists like Travis Scott, A\$AP Rocky, Future, and more. (Annex 4)

The Complainant only sells its goods online through its website at "www.ericmanuel.com", in-person at one of its two storefronts at 91 Greene St., New York, NY 10012 and 172 NE 40th St., Miami, FL 33137, and through other authorized retailers with whom Eric Emanuel has partnered.

The Complainant owns common law and registered trademark rights in ERIC EMANUEL ("Complainant's Marks"), including the following:

USA Trademark Registration No. 6.721.224 ERIC EMANUEL, registered on May 24, 2022, with first use in commerce on February 13, 2014, in Class 25;

International Trademark Registration No. 1762468 ERIC EMANUEL, registered on October 11, 2023, in Class 25.

The Complainant has used Complainant's Marks in commerce since 2014 in connection with apparel, footwear, accessories, and more.

The disputed domain name <ericmanuelshop.site> was registered on May 2, 2023 and resolves to a website which purportedly offers goods similar to those offered by the Complainant and alleged counterfeits thereof.

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 due to the Complainant's worldwide reputation and the popularity of the Complainant's brand, products bearing the Complainant's Marks are subject to frequent counterfeiting. Many third parties use Complainant's Marks without authorization, on or in connection with the advertising and sale of a variety of products. The sale of unauthorized products bearing counterfeit and/or infringing copies of the Complainant's Marks poses a real threat to the Complainant's brand, the sustainability of the Complainant's business, and to the individuals and companies who unwittingly purchase them. Similarly, the Complainant has encountered numerous instances of cybersquatting by third parties who register domain names using the Complainant's Marks. These cybersquatting domain names generally resolve to websites purporting to sell goods bearing counterfeit copies of the Complainant's Marks, and are made to look like authorized retail websites. The third parties who use the Complainant's well-known Marks as domain names, including the Respondent in this case, divert sales and Internet traffic away from the Complainant's

official website and authentic goods and instead drive Internet traffic towards websites purporting to sell counterfeit products, eroding the marketplace for legitimate goods, and hampering the Complainant's business.

Finally, the Complainant requests the Panel to order the transfer of the disputed domain name to the Complainant.

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.

Although the addition of the descriptive term "shop" may bear on assessment of the second and third elements, the Panel finds the addition of such 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 generic Top-Level Domain, here ".site", is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark ERIC EMANUEL in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

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.

Also, where a domain name consists of a trademark plus an additional term, UDRP panels have held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner, as the case here (disputed domain name bearing Complainant's Marks in their entirety with the additional term "shop"). [WIPO Overview 3.0](#), section 2.5.1.

Panels have held that the use of a domain name for illegal activity, such as passing off and/or the sale of counterfeit products here claimed, 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) 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.

The Panel is satisfied that the Respondent must have been aware of the Complainant's Marks mentioned in Section 4 above (Factual Background) when it registered the disputed domain name on May 2, 2023. By that time, the Complainant had registered and long ago used the trademark.

By registering the disputed domain name that includes the Complainant's trademark ERIC EMANUEL in its entirety the Respondent was targeting the Complainant and its business. The addition of the term "shop" only contributes to confuse Internet users and leads them to think that the relevant website belongs to or is endorsed by the Complainant with the intention to capitalize on the fame of the Complainant's trademark for its own benefit.

The fact that there is a clear absence of rights or legitimate interests coupled with no explanation for the Respondent's choice of the disputed domain name, the nature of the disputed domain name, the imitation of the Complainant's website to offer unauthorized goods which compete with those offered by the Complainant even if not counterfeits are indicative of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). The Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

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 <ericemanuelshop.site> be transferred to the Complainant.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

Date: March 14, 2024