

ADMINISTRATIVE PANEL DECISION

EE Holding Group LLC v. David Newman
Case No. D2024-0535

1. The Parties

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

Respondent is David Newman, United States.

2. The Domain Name and Registrar

The disputed domain name <ericmanuelshortshop.com> 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 6, 2024. On February 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 6, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on February 7, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on February 7, 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 Respondent of the Complaint, and the proceedings commenced on February 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on February 29, 2024.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on March 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

Complainant owns all intellectual property rights of fashion designer Eric Emanuel who is an independent sportswear designer. Complainant is advertising and selling its products online and through two of its own retail outlets, and through authorized retailers. Complainant's clothing products typically display a stylized EE logo. Complainant operates an online retailing website at the domain name <ericemanuel.com>. According to Complainant, it has used its ERIC EMANUEL trademark in commerce since 2014.

Complainant is owner of registration for the word trademark ERIC EMANUEL on the Principal Register of the United States Patent and Trademark Office (USPTO), registration number 6,721,224, registration dated May 24, 2022, in international class ("IC") 25, covering various items of clothing, including shirts and shorts. Complainant has applied for additional trademark registrations for the ERIC EMANUEL trademark and stylized EE trademark at the USPTO. Complainant has registered the word ERIC EMANUEL as an International trademark under the Madrid System, registration number 1762468, registration dated October 11, 2023, in IC 25, covering various items of clothing, designating thirteen countries under the Madrid Protocol.

According to the Registrar's verification, Respondent is the registrant of the disputed domain name. According to the Whois report, the disputed domain name was created on November 6, 2023. There is no indication on the record of this proceeding that any person other than Respondent has owned or controlled the disputed domain name since its initial date of registration.

Respondent has used the disputed domain name to direct Internet users to a retail shopping website where articles of clothing identified as ERIC EMANUEL products and bearing Complainant's stylized EE logo are purportedly offered for sale. According to Complainant, the products offered for sale on Respondent's website are unauthorized and counterfeit replications of Complainant's genuine products. In order to illustrate the scale of the difficulties it faces in the online retailing space, Complainant asserts that it has pursued four lawsuits in the United States District Court for the Northern District of Georgia "against nearly 600 unique defendants selling counterfeit goods online, resulting in the removal of more than 1,800 listings for counterfeit products across multiple e-commerce platforms and the disabling of approximately 50 websites and cybersquatting domains." There is no indication that these lawsuits specifically involved Respondent.

There is no indication on the record of this proceeding of any commercial or other relationship between Complainant and Respondent.

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 alleges that it owns rights in ERIC EMANUEL and related trademarks, and that the disputed domain name is confusingly similar to its ERIC EMANUEL trademark.

Complainant argues that Respondent lacks rights in the disputed domain name because: (1) Complainant has not in any manner authorized Respondent to use its trademark in the disputed domain name or

otherwise; (2) Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services; (3) Respondent has used the disputed domain name in connection with a “fraudulent website designed to mimic Complainant’s official website and deceive consumers”; (4) Respondent has not been commonly known by the disputed domain name and does not own trademark rights in the disputed domain name, and; (5) Respondent is not making legitimate noncommercial or fair use of the disputed domain name.

Complainant contends that Respondent registered and is using the disputed domain name in bad faith because: (1) mere registration of the disputed domain name confusingly similar to Complainant’s trademark creates a presumption of bad faith; (2) Respondent is using the disputed domain name in connection with a website selling counterfeit versions of Complainant’s products; (3) Respondent is intentionally attempting to attract for commercial gain Internet users to its website by creating a likelihood of confusion with Complainant’s trademark, and; (4) Complainant’s trademark is well known and Respondent concealed its identity.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical address provided in its record of registration. Courier delivery of the Written Notice to Respondent could not be completed because of an inaccurate physical address in Respondent’s record of registration. There is no indication of difficulty in transmission of email notification to Respondent. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark 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.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

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 other terms, here “shortshop”, 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 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

Paragraph 4(c) of the Policy provides a list of circumstances in which 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

Panels have held that the use of a domain name for illegal activity, here the alleged sale of counterfeit goods, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. The Panel notes that Respondent has failed to rebut Complainant’s allegation that Respondent is selling counterfeit products on its website. 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.

¹Respondent is using Complainant’s trademark to falsely create the impression that it is associated with Complainant. Even in the unlikely event that the goods offered by Respondent were acquired by it from a source with access to goods manufactured for Complainant and are offered without Complainant’s authorization, Respondent’s offers and sales nevertheless do not establish rights or legitimate interests in the disputed domain name because Respondent is using Complainant’s trademark to falsely create the impression that it is associated with Complainant. See [WIPO Overview 3.0](#), section 2.8.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that Respondent was manifestly aware of Complainant and its trademarks when it registered and used the disputed domain name in that it uses Complainant's trademarks on its website in connection with the sale of allegedly counterfeit versions of Complainant's products.

Panels have held that the use of a domain name for illegal activity, here the alleged sale of counterfeit goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. The Panel notes that Respondent has failed to rebut Complainant's allegation that Respondent is selling counterfeit products on its website. Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds 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 <ericmanuelshortshop.com> be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: March 29, 2024