

## ADMINISTRATIVE PANEL DECISION

BCBG IP Holdings LP v. 林靖 (Jing Lin)

Case No. D2024-1043

### 1. The Parties

The Complainant is BCBG IP Holdings LP, United States of America (“United States”), represented by ESCA Legal, United States.

The Respondent is 林靖 (Jing Lin), China.

### 2. The Domain Name and Registrar

The disputed domain name <bcbgmaxazriaoutletstore.com> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

### 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 8, 2024. On March 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 12, 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 (Registrant of “bcbgmaxazriaoutletstore.com”) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 15, 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 in English on the same day.

On March 15, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On the same day, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 March 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 16, 2024.

The Center appointed Jonathan Agmon as the sole panelist in this matter on April 19, 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 company in the women's clothing industry. Founded in 1989, in Los Angeles, United States, it operates its two brands, BCBG and BCBGMAXAZRIA, which have become globally recognized brands, headlining New York Fashion Week several times. The Complainant's apparel, handbags, luggage and other goods are sold in numerous high-street retail stores, dressing famous celebrities.

The Complainant owns various trademarks for BCBG and BCBGMAXAZRIA, including the following:

- United States trademark No. 1939918 for BCBG, registered on December 5, 1995;
- United States trademark No. 2229364 for BCBG, registered on March 2, 1999;
- United States trademark No. 2581591 for BCBG, registered on June 18, 2002;
- United States trademark No. 2229365 for BCBG MAX AZRIA, registered on March 2, 1999;
- United States trademark No. 2362512 for BCBG MAX AZRIA, registered on June 27, 2000;
- United States trademark No. 6066028 for BCBGMAXAZRIA, registered on May 26, 2020;
- International trademark No. 1756845 for BCBG, registered on August 24, 2023; and
- International trademark No. 1563082 for BCBGMAXAZRIA, registered on October 27, 2020.

The Complainant operates its webpage at <bcbg.com>. It also has an active social media presence, with over 100,000 followers collectively on Instagram, Facebook, and X.

The disputed domain name was registered on January 15, 2024. It resolves to a webpage displaying the Complainant's BCBGMAXAZRIA trademark, that offers products bearing the Complainant's BCBGMAXAZRIA trademark for sale.

#### **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 well-known and globally recognised BCBG and BCBGMAXAZRIA trademarks in which the Complainant has rights. The Respondent is attempting to confuse and/or mislead consumers attempting to visit the Complainant's website. The

disputed domain name contains the entirety of the Complainant's BCBGMAXAZRIA trademark with the addition of the terms "outlet", "store", and the generic Top Level Domain ("gTLD") ".com". The addition of the gTLD is an attempt by the Respondent to deceive consumers into believing that the disputed domain name has commercial relations to the Complainant. The Respondent is also cybersquatting on the disputed domain name, preventing the Complainant from utilizing it.

- The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not approved, licensed, or affiliated by the Complainant. The Complainant has not authorized the Respondent to use its BCBG and BCBGMAXAZRIA trademarks in any way, including registering the disputed domain name. The Respondent is clearly impersonating the Complainant and to confuse the public as to the source of the counterfeit goods offered for sale on the Respondent's website, and therefore is not using the disputed domain name for any bona fide offering of goods or services.

- The disputed domain name was registered and is being used in bad faith. The Complainant's BCBG and BCBGMAXAZRIA trademarks are globally recognized and protected. It is inconceivable that the Respondent did not have actual notice of the Complainant's BCBG and BCBGMAXAZRIA trademarks, and it is more likely than not that the Respondent had the Complainant's marks in mind when registering the disputed domain name. The disputed domain name also resolves to a webpage that prominently displays the Complainant's trademarks and offers counterfeit products for sale. The Respondent is also attempting to hide his registered contact information, and is utilizing a proxy server, which are indicators of bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that:

- the disputed domain name resolves to a webpage that contains information only in the English language;
- the dispute domain name and the gTLD are in the English language;
- the disputed domain name consists of the added English terms "outlet", "store", and the gTLD ".com", added to the Complainant's BCBGMAXAZRIA trademark;
- the sales conducted on the Respondent's website are in the English language and the currency is the United States Dollar, which indicates that the Respondent is attempting to target Internet users residing in the United States, where English is the predominant spoken language;
- the Complainant is unable to communicate in the Chinese language, and requiring the Complaint to be translated into Chinese would unfairly disadvantage the Complainant, delaying the proceedings. This would cause the Complainant to suffer an unfair financial burden to translate the Complaint into Chinese.

The Respondent did not make any submissions with respect to the language of the proceeding despite being duly notified by the Center in both Chinese and English of the language of the proceeding and of the commencement of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

### **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 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 terms, here, "outlet" and "store" 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 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.

The Respondent is not commonly known by the disputed domain name. The Respondent is not affiliated with the Complainant. He was also not authorized or licensed by the Complainant to use the BCBG and/or

BCBGMAXAZRIA trademarks in any way, including registering the disputed domain name. The disputed domain name resolves to a website displaying the Complainant's BCBGMAXAZRIA trademark and is offering for sale at a steep discount, goods bearing, or sold under the Complainant's BCBGMAXAZRIA trademark. The Respondent is also advertising a 365-day return policy on goods sold. This is strong evidence that the goods sold on the Respondent's website are counterfeit goods.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: sale of counterfeit goods, 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.

In the present case, the Panel notes that the Respondent registered the disputed domain name long after the Complainant registered its BCBG and/or BCBGMAXAZRIA trademarks. Given the reputation and goodwill of the Complainant's trademarks, it is highly unlikely that the Respondent did not know of the Complainant and its trademarks prior to the registration of the disputed domain name. The fact that the disputed domain name resolves to a website designed to resemble and pass off as the Complainant's own website, and selling counterfeit goods at a steep discount, is strong evidence of bad faith, and is a typical case of cybersquatting. This is exacerbated by the fact that the chosen suffix, "outletstore", has the connotation that the goods sold on the Respondent's website are legitimately sold at a high discount. There is therefore an increased risk of confusion between the disputed domain name and the Complainant's own website.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: sale of counterfeit goods, 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 also draws an adverse inference from the Respondent's failure to file any Response, to rebut the Complainant's assertions, and that he registered an incomplete address with the Registrar.

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 <bcbgmaxazriaoutletstore.com> be transferred to the Complainant.

*/Jonathan Agmon/*

**Jonathan Agmon**

Sole Panelist

Date: May 3, 2024