

ADMINISTRATIVE PANEL DECISION

World First UK Limited v. tom, CCBN

Case No. D2024-1517

1. The Parties

The Complainant is World First UK Limited, United Kingdom ("UK"), represented by ELLALAN, China.

The Respondent is tom, CCBN, Australia.

2. The Domain Name and Registrar

The disputed domain name <worldfirst-shopping.com> is 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 April 10, 2024. On April 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 11, 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 (unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 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 amended Complaint on April 20, 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 the Respondent of the Complaint, and the proceedings commenced on April 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 13, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 14, 2024.

The Center appointed María Alejandra López García as the sole panelist in this matter on May 21, 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 an UK fintech company established in 2004 by Jonathan Quin and Nick Robinson. The Complainant provides foreign exchange collection and international payment services as well as additional value-added financial services.

Ant Group Co., Ltd. and its affiliates (hereinafter collectively referred to as “Ant Group”) is the owner of the leading payment and lifestyle platform “Alipay”, which was established in 2004 to create trust between online sellers and buyers. In 2019 the Complainant becomes a subsidiary of Ant Group Co., Ltd. and a part of the Ant Group. Since then, the Complainant has been expanding its business internationally, with 500+ employees based in London, Amsterdam, Singapore, Tokyo, Hangzhou, Shanghai, Shenzhen, Sydney, and Hong Kong, China, and have evolved into a global fintech company that connects business around the world with fast and affordable payments, access to international marketplaces, flexible currency risk management tools, working capital and more.

The Complainant asserts that it has won the prestigious Queen’s Award for Enterprise in International Trade, has transferred over USD 200 billion for more than 1,000,000 customers since 2004, and sends over one million payments per year. The Complainant looks to provide a one-stop digital payments and financial services platform for cross-border SMEs. The Complainant has global presence, including in Sydney, Hong Kong, China, Singapore, Netherlands, Japan, and the Republic of Korea.

The Complainant owns, among many others, the following trademark registrations:

- UK Trademark for WORLDFIRST (and design), Reg. No. UK00002454370, in International Class (“IC”) 36, filed on May 1, 2007, registered on September 28, 2007, and in force until May 1, 2027.
- UK Trademark for WORLDFIRST (and design), Reg. No. UK00002555667, in IC 36, filed on August 11, 2010, registered on February 11, 2011, and in force until August 11, 2030.
- International Trademark for WORLDFIRST (and design), Reg. No. 1398207, in ICs 9 and 36, registered on September 19, 2017, and in force until September 19, 2027.
- US Trademark for WORLDFIRST (word mark), Reg. No. 5870371, in ICs 9 and 36, filed on September 19, 2017, registered on October 1, 2019, and in force until April 1, 2026.
- Australian Trademark, for WORLDFIRST (word mark), Reg. No. 1922176, registered on September 19, 2017, and in force until September 19, 2027.

The disputed domain name was registered on September 6, 2023, and by the time of this Decision, it resolves to an inactive website with no content. However, according to the evidence provided by the Complainant, the aforesaid website previously resolved to a purported online shop.

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.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must satisfy each of the three following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights; and
- (ii) the 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.

To succeed, a complainant must meet all the three elements of the Policy, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.2. In the present case, no response or any communication has been submitted by the Respondent, which would not by itself mean that the Complainant is deemed to have prevailed, see [WIPO Overview 3.0](#), section 4.3. Therefore, this Panel shall analyze the evidence submitted by the Complainant and decide this dispute under the "balance of probabilities" or "preponderance of the evidence" standard, as set out in paragraph 14 and 15(a) of the Rules, and [WIPO Overview 3.0](#), section 4.2.

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 the trademark WORLDFIRST for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the Complainant's trademark WORLDFIRST is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainant's trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "-shopping", 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.

Regarding the design elements of the WORLDFIRST Complainant's Trademark, it is well established that such elements are incapable of representation in a domain name, therefore for the purposes of the first element analysis of the Policy, are disregarded when they do not effectively overtake the textual elements in prominence, as here. [WIPO Overview 3.0](#), section 1.10.

As for the applicable generic Top-Level Domain ("gTLD") ".com", it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark, as it is a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11.1.

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.

According to the submitted evidence, the Panel notes that the Complainant has never granted an authorization to the Respondent for the use of the trademark WORLDFIRST, including as a domain name; that the Respondent is not commonly known by the term “worldfirst-shopping.com”; that given the nature of the composition of the disputed domain name, the Respondent seeks to create an implied affiliation with the Complainant which doesn’t exist. [WIPO Overview 3.0](#), sections 2.5 and 2.5.1.

Therefore, 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 Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

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.

The Panel notes that the Complainant also offers access to international marketplaces, as Amazon, AliExpress, eBay, Shopify, Mercado Libre, and many others, which seems to explain the composition of the disputed domain name and the initial content of the website, i.e., online store, or potential marketplace. As the Complainant argued, the acquisition of the Complainant by Ant Group Co. Ltd. in 2019, garnered widespread global attention and media coverage, assertion that this Panel takes also into consideration. Additionally, the Panel notes that the Complainant’s business activity and Trademark are expanded across multiple jurisdictions.

In addition, and according with the consensus view, [WIPO Overview 3.0](#), section 3.1.4:

“(…) the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s mark: (i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent’s commercial benefit, even if unsuccessful, (iii) the lack of a respondent’s own rights to or legitimate interests in a domain name, (iv) redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer, (v) redirecting the domain name to the complainant’s (or a competitor’s) website, and (vi) absence of any conceivable good faith use.” (emphasis added).

Therefore, this Panel concludes that the disputed domain name was registered in bad faith.

At the time of filing the Complaint, the evidence reflects that the disputed domain name was used for a purported online shop. The use of the confusingly similar disputed domain name to mislead Internet users to a website offering commercial services is per se evidence of bad faith registration and use, vis-à-vis paragraph 4(b)(iv) of the Policy.

Given that by the time of this Decision, the disputed domain name resolves to an inactive website, the Panel will address its use, under the passive holding doctrine.

Accordingly, 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 name 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 worldwide reputation of the Complainant’s trademark, the composition of the disputed domain name, the absence of Respondent’s response, the lack of evidence of any good faith use, and finds that in the circumstances of this case the passive holding of the disputed domain name 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 name <worldfirst-shopping.com> be transferred to the Complainant.

/María Alejandra López García/

María Alejandra López García

Sole Panelist

Date: June 4, 2024