

ADMINISTRATIVE PANEL DECISION

Nanu-Nana Joachim Hoepp GmbH & Co. KG v. Brenda Kelly
aka Kelly Brenda
Case No. D2024-1798

1. The Parties

The Complainant is Nanu-Nana Joachim Hoepp GmbH & Co. KG, Germany, represented by NORDEMANN DE, Germany.

The Respondent is Brenda Kelly aka Kelly Brenda, United States of America.

2. The Domain Name and Registrar

The disputed domain name <nanu-shop.com> is registered with Mat Bao Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 29, 2024. On April 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 3, 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 May 6, 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 May 8, 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 May 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 30, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 31, 2024.

The Center appointed Alan L. Limbury as the sole panelist in this matter on June 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

Founded in 1972, the Complainant, Nanu-Nana Joachim Hoepp GmbH & Co. KG, is a German limited liability company established under the laws of Germany and part of a group of companies operating brick-and mortar retail stores and a web shop at “www.nanu-nana.de”, offering articles in the fields of home & living, kitchen utensils, home accessories, decoration, presents/gifts, seasonal products and toys under the name NANU-NANA.

The Complainant is the owner inter alia of the following registered trademarks:

- NANU word mark (German Patent and Trade Mark Office, Reg. No. 39647710, registered on August 19, 1997 in Nice classes 3, 20);
- NANU-NANA word mark (European Union Reg. No. 006217814, registered on April 11, 2011 in Nice classes 16, 18, 20, 21, 24, 25, 28, and 35);
- NANA word mark (European Union Reg. No. 006218945, registered on April 19, 2011 in Nice classes 4, 6, 8, 11, 14, 16, 18, 20, 21, 24, 26, 28, 30, 34, and 35);
- NANU-NANA figurative mark (European Union Reg. No. 015434798, registered on December 30, 2016 in Nice class 35); and
-  figurative mark (European Union Reg. No. 015434822, registered on December 30, 2016 in Nice classes 4, 6, 8, 9, 11, 16, 18, 20, 21, 24, 25, and 35)(the “Elephant mark”).

The disputed domain name <nanu-shop.com> was registered on August 28, 2023. It resolves to a German language website prominently displaying the Complainant’s Elephant and NANU-NANA marks and purporting to offer for sale the Complainant’s products at discounted prices.

On April 18, 2024, the Complainant received an email from an Internet user who, on March 28, 2024, had placed an order for two books on the Respondent’s website, thinking it was the Complainant’s website, but had not received them.

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 <nanu-shop.com> is confusingly similar to the Complainant’s NANU mark and that the Respondent has no rights or legitimate interests in respect of the disputed domain name, which was registered and is being used in bad faith.

As to legitimacy, the Respondent has no trademark rights to the term NANU used in the disputed domain name; is not affiliated with the Complainant in any way; has not been authorized by the Complainant to register or use the disputed domain name nor to seek the registration of any domain name incorporating the Complainant’s trademarks; and is not commonly known by the disputed domain name. The Complainant has prior rights in the trademarks, which precede the Respondent’s registration of the disputed domain name

by years. To the Complainant's knowledge, the Respondent has never used, or made any preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. A reseller or distributor can be making a bona fide offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). The Respondent fails the *Oki Data* test because a thorough examination of the website accessible under the disputed domain name shows that there is no clear statement indicating that the Respondent is not the trademark owner and does not include any statement that clearly establishes the relationship between the Complainant and the Respondent. Consumers are misled by the disputed domain name and the content of the website to think that they are visiting a website of the Complainant. Consumers are then misled with the alleged possibility of obtaining products via a website that creates the false impression to be licensed, approved or operated by the Complainant. Such fraudulent use of the disputed domain name is contrary to a legitimate interest in the use of the domain name. The behavior of the Respondent constitutes imitation of trademarks, brand image and goodwill of the Complainant which serves to run a scam.

As to bad faith, the disputed domain name, which was registered in 2023, and the website operated under it is a pure imitation of the Complainant's website and business, as the identified combination of all of the Complainant's trademarks on the website cannot be a coincidence. The combination of the word "shop" with the Complainant's mark NANU in the disputed domain name shows that the Respondent had actual knowledge of the Complainant, its business, products and rights when registering the disputed domain name. The Respondent is using the disputed domain name in bad faith to operate the website which gives the impression that it is affiliated with or approved, licensed or operated by the Complainant, while offering for sale NANU products. The website includes copies of the Complainant's trademarks and reproduces images of the Complainant's products. Therefore, the Respondent intentionally attempts to create likelihood of confusion with the Complainant's trademarks and general brand image for commercial gain.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that a complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (i) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a Response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences as it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint. However, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), at section 4.3.

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 NANU 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 "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 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 circumstances set out in paragraph 4(c) of the Policy in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name are:

- (i) before any notice to the Respondent of the dispute, the use by the Respondent of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the Respondent (as an individual, business or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

[WIPO Overview 3.0](#), section 2.8.1 provides:

2.8.1 Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

Even assuming, contrary to the experience of a customer who thought the Respondent's website was that of the Complainant, that the Respondent is actually offering the goods at issue, there is no disclosure on the Respondent's website that the registrant has no relationship with the trademark holder. Accordingly, the Oki Data test is not satisfied.

Further, Panels have held that the use of a domain name for illegal activity claimed as applicable to this case: impersonation/passing off, or other types of fraud 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, including:

- (iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on its website or location.

In the present case, the Panel is satisfied that the Respondent was fully aware of Complainant's NANU mark when Respondent registered the <nanu-shop.com> domain name and that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with Complainant's marks as to the source of the Respondent's website and of the goods promoted on that website. This demonstrates registration and use in bad faith to attract users for commercial gain under paragraph 4(b)(iv) of the Policy.

Further, Panels have held that the use of a domain name for illegal activity claimed as applicable to this case: impersonation/passing off, or other types of fraud 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 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 <nanu-shop.com> be transferred to the Complainant.

/Alan L. Limbury/

Alan L. Limbury

Sole Panelist

Date: July 3, 2024