

## **ADMINISTRATIVE PANEL DECISION**

EE Holding Group LLC v. Mudassar Malik, newtech  
Case No. D2024-2213

### **1. The Parties**

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

The Respondent is Mudassar Malik, newtech, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <officialericshorts.com> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 29, 2024. On May 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 30, 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, Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 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 amendment to the Complaint on June 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 the Respondent of the Complaint, and the proceedings commenced on June 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2024.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on July 16, 2024. The Panel submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7. On September 17, 2024, the Center informed the Parties that it had become necessary for the previously appointed panelist to step down and appointed Lynda M. Braun as the sole panelist in this matter. 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, United States. 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. The Complainant sells its authentic goods online exclusively through its own website, in-person at one of its two storefronts in the United States, and through other authorized brick and mortar retailers with whom Eric Emanuel has partnered.

The Complainant owns the following trademarks: ERIC EMANUEL, United States Trademark Registration No. 6,721,224, registered on May 24, 2022, with a first date of use in commerce of February 13, 2014, in international class 25; and EE (design mark, with two superimposed “Es”), United States Trademark Registration No. 7,310,338, registered on February 20, 2024, with a first use in commerce of February 13, 2014, in international class 25. The Complainant also owns the registered trademark ERIC EMANUEL in various jurisdictions worldwide, i.e., International Trademark Registration No. 1762468, dated October 11, 2023, in international class 25 (designating thirteen countries under the Madrid Protocol).

The aforementioned trademarks will hereinafter collectively be referred to as the “ERIC EMANUEL Mark”.

The Complainant owns the domain name <ericemanuel.com>, which resolves to its official website at “www.ericemanuel.com”, where the Complainant exclusively sells its authentic goods online.

The Complainant has used the ERIC EMANUEL Mark in commerce since 2014 in connection with apparel, footwear, accessories, and more and as a result of the Complainant’s extensive use of its marks for approximately a decade, consumers have come to recognize the ERIC EMANUEL Mark as indicating products emanating from the Complainant. Unfortunately, however, due to the Complainant’s worldwide reputation and the popularity of its brand, its products are subject to frequent counterfeiting.

The Disputed Domain Name was registered on November 15, 2023, and resolved to a fraudulent website designed to mimic the Complainant’s official website.<sup>1</sup> The website directed Internet users to a retail shopping website where articles of clothing identified as ERIC EMANUEL products and bearing the Complainant’s stylized EE logo were offered for sale. Screenshots of the Respondent’s website were submitted by the Complainant as an Annex to the Complaint.

#### **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:

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<sup>1</sup>As of the writing of the Decision, however, the Disputed Domain Name resolves to a landing page that states, “This account has been suspended.”

- the Disputed Domain Name is confusingly similar to the Complainant's trademark because the Disputed Domain Name contains the dominant part of the ERIC EMANUEL Mark, preceded by the term "official", followed by the term "shorts" (a product for which the Complainant is well known), and then followed by the generic Top-Level Domain ("gTLD") ".com", and thus does not prevent a finding of confusing similarity;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, among other things, the Complainant has not authorized the Respondent to register a domain name containing the ERIC EMANUEL Mark, or portion thereof, the Respondent was not making a bona fide offering of goods or services through the Disputed Domain Name, and the Respondent has never been commonly known by the ERIC EMANUEL Mark or any similar name; and
- the Disputed Domain Name was registered and is being used in bad faith because, among other things, the Respondent used the Disputed Domain Name to feature counterfeit goods on its resolving website for the purpose of deceiving unsuspecting consumers.

The Complainant seeks the transfer of the Disputed Domain Name in accordance with paragraph 4(i) of the Policy.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name was registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the ERIC EMANUEL Mark as explained below.

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

It is uncontroverted that the Complainant has established rights in the ERIC EMANUEL Mark based on its years of use as well as its registered trademarks for the ERIC EMANUEL Mark for clothing in the United States and other jurisdictions. The consensus view of panels is that "registration of a mark is prima facie evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the ERIC EMANUEL Mark.

The Disputed Domain Name consists of the first half of the Complainant's registered ERIC EMANUEL trademark preceded by the term "official", followed by the term "shorts", and then followed by the gTLD ".com". The test for confusing similarity involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Here, the former half of the ERIC EMANUEL mark is recognizable within the Disputed Domain Name. As stated in section 1.7 of the [WIPO Overview 3.0](#), "[i]n specific limited instances, while not a replacement as such for the typical side-by-side comparison, where a panel would benefit from affirmation as to confusing similarity with the complainant's mark, the broader case context such as website content trading off the complainant's reputation, [...], may support a finding of confusing similarity". Considering the evidence demonstrating that the Disputed Domain Name previously resolved to a website impersonating the Complainant in an alleged offering for sale of the Complainant's trademarked goods, it appears prima facie that the Respondent sought to target the Complainant's trademark through the Disputed Domain Name. [WIPO Overview 3.0](#), section 1.15.

As stated in section 1.8 of [WIPO Overview 3.0](#), "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". Thus, the addition of the terms "official" and "shorts" to the Complainant's ERIC EMANUEL Mark in the Disputed Domain Name does not prevent a finding of confusing similarity. See e.g., *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Finally, the addition of a gTLD such as ".com" in a domain name is a technical requirement. As such, it is well established that a gTLD may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's ERIC EMANUEL Mark.

Based on the available record, the Panel finds that 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 that 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.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a prima facie case. The Respondent has not submitted any arguments or evidence to rebut the Complainant's prima facie case. Furthermore, the Complainant has not authorized, licensed, or otherwise permitted the Respondent to use its ERIC EMANUEL Mark. Nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods or services. See Policy, paragraph 4(c).

Since the Disputed Domain Name directed to a website mimicking the Complainant's website, the Respondent's use of the Disputed Domain Name does not demonstrate rights or legitimate interests and does not constitute a protected noncommercial or fair use of the Disputed Domain Name.

When Internet users arrived at the Disputed Domain Name, they were directed to a website where the Respondent impersonated the Complainant and offered purportedly counterfeit products to customers, which products competed with those offered by the Complainant on its website. The Respondent was not making a legitimate noncommercial or fair use of the Disputed Domain Name, but rather was using the Disputed Domain Name for commercial gain with the intent to mislead the Complainant's customers into believing that they had arrived at the Complainant's website.

The use of the Disputed Domain Name to impersonate the Complainant and its website to offer competing or counterfeit goods does not confer rights or legitimate interests on the Respondent. See [WIPO Overview 3.0](#), section 2.13.1 ("Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods [...] impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.").

In sum, the Panel finds that the Complainant has established an un rebutted prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Based on the available record, the Panel finds that 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 finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith registration and use of the Disputed Domain Name pursuant to paragraph 4(a)(iii) of the Policy.

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.

Panels have held that the use of a domain name for illegal activity, as here, the offering of identical or similar, competing services [...] 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 due to the Respondent's impersonation of the Complainant to offer counterfeit goods to unwitting customers.

Further, the use of a domain name to intentionally attempt to attract Internet users to a respondent's website or online location by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of the registrant's website or online location for commercial gain demonstrates registration and use in bad faith. Here, the Respondent's registration and use of the Disputed Domain Name indicates that such registration and use had been done for the specific purpose of trading upon and targeting the name and reputation of the Complainant. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Moreover, the Panel concludes that the Respondent's registration of the Disputed Domain Name was an attempt to disrupt the Complainant's business. See *Banco Bradesco S.A. v. Fernando Camacho Bohm*, WIPO Case No. [D2010-1552](#). The Respondent's use of the Disputed Domain Name was also likely to confuse Internet users into incorrectly believing that the Respondent was authorized by or affiliated with the Complainant.

Finally, the Respondent attempted to pass off as the Complainant by creating a similar website offering allegedly counterfeit products (regardless of their genuine nature, competing products), demonstrating bad faith. Therefore, it strains credulity to believe that the Respondent had not known of the Complainant or its ERIC EMANUEL Mark when registering the Disputed Domain Name. See *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. [D2001-0763](#) (“a finding of bad faith may be made where the respondent “knew or should have known” of the registration and/or use of the trademark prior to registering the domain name”). In addition, how could the Respondent not be aware of the Complainant and its branded clothing when the Respondent featured goods bearing the ERIC EMANUEL Mark on its website? Rather, the Panel notes that the composition of the Disputed Domain Name (i.e., the addition of “shorts” that is descriptive of certain goods offered by the Complainant and “official” indicating a genuine or authorized relationship), together with the use of the Disputed Domain Name, affirms the Respondent’s intention to take unfair advantage of the likelihood of confusion between the Disputed Domain Name and the Complainant as to the origin or affiliation of the website at the Disputed Domain Name. In sum, the Panel finds that the Respondent had the Complainant’s ERIC EMANUEL Mark in mind when registering the Disputed Domain Name.

Based on the available record, the Panel finds that the third element of the Policy has been established

## 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 <officialericshorts.com> be transferred to the Complainant.

*/Lynda M. Braun/*

**Lynda M. Braun**

Sole Panelist

Date: September 19, 2024