

ADMINISTRATIVE PANEL DECISION

BEXLEY SAS v. Yongjie Weng

Case No. D2024-2562

1. The Parties

The Complainant is BEXLEY SAS, France, represented by Cabinet Regimbeau, France.

The Respondent is Yongjie Weng, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <bexley-outlet.shop> is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 24, 2024. On June 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 25, 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 (name not provided) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 25, 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 June 27, 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 June 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 18, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 19, 2024.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on July 29, 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 French shoes, clothing, and accessories brand founded in 1985. Its products are exclusively sold online and in its 35 physical stores in France, Belgium, Luxembourg, and Spain. The Complainant is the owner of registered trademarks in the mark BEXLEY, amongst which:

French Trademark No. 96606235 for BEXLEY, registered on June 28, 1996, in International Classes 18 and 25;

International Trademark No. 656086 for BEXLEY, registered on June 19, 1996, in International Classes 18 and 25; and

United States Trademark No. 3132674 for BEXLEY, registered on August 22, 2006, in International Class 25.

The Complainant also owns numerous domain names incorporating the mark BEXLEY, such as <bexley.fr> and <bexley.com> which are both used for its official website. The official website provides information about the Complainant's brand and products and an online store where the Complainant's branded goods are advertised and offered for sale.

The disputed domain name was registered on May 20, 2024, well after the Complainant secured rights in the mark BEXLEY and is currently owned by an individual based in the United States. According to a screen shot submitted by the Complainant dated June 20, 2024, the disputed domain previously resolved to a website with a similar design as the Complainant's official website, featuring the Complainant's BEXLEY trademarks and offering for sale purported BEXLEY products. As of the date of this decision, the disputed domain name currently no longer resolves to this website but instead resolves to a web page showing "b***r" and "The website is under maintenance".

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.

With respect to the first element, the Complainant claims that it has rights in the mark BEXLEY and that the disputed domain name is confusingly similar to this mark. The Complainant points out that the disputed domain name incorporates the BEXLEY mark in its entirety and argues that the disputed domain name differs from the Complainant's trademarks by the mere addition of the descriptive word "outlet", which is generally used to refer to a website or part of it dedicated to discounted products. The Complainant furthermore claims that the use of the website which the disputed domain name resolves to for an online shop selling BEXLEY branded goods further increases the confusing similarity since customers would infer that any website hosted under the disputed domain name is an official website belonging to the Complainant and used in the specific area of discounted sales. Moreover, the Complainant notes that the ".shop" extension is irrelevant when examining the identity or similarity between the contested domain name and the Complainant's prior rights since prior UDRP Panels have consistently found that the generic Top-Level Domain ("gTLD"), here the ".shop", is a standard registration requirement and shall thus be disregarded in the assessment of confusing similarity.

Regarding the second element, the Complainant claims that the Respondent lacks a right or legitimate interest in the disputed domain name. The Complainant contends that the Respondent has in fact no connection with the Complainant in any way. The Complainant confirms the Respondent is not an authorized dealer, distributor or licensee of the Complainant, nor has it been permitted by the latter to make any use of its prior rights. The Complainant also mentions that other UDRP Panels have previously held that

in those circumstances, no actual or contemplated bona fide or legitimate use of the domain name could reasonably be claimed or indeed inferred. Moreover, the Complainant states that searches through the European Union and French trademark registers have disclosed no other registration for BEXLEY other than those owned by the Complainant and that the Respondent therefore does not have prior rights in BEXLEY. The Complainant also point out that the Respondent is not commonly known under the name BEXLEY, whether as an individual or as an organization.

As to the assessment of the Respondent's bad faith at the time of registration, the Complainant points out that it has consistently been developing and extending its activity for the past 40 years, so that its BEXLEY trademarks are currently well known in many countries in relation to the commercialization of men's shoes and apparel. It follows, the Complainant notes, that by registering a domain name combining the Complainant's trademark with the word "outlet", the Respondent voluntarily tries to create confusion in the mind of consumers, letting them believe that they can buy discounted goods on this website. Indeed, the Complainant contends, the Respondent's choice for the gTLD ".shop" reinforces this finding, as it is likely to mislead Internet users into thinking that the website linked to the disputed domain name consists in a web-shop for the Complainant's products.

In addition, the Complainant claims that a simple search on the Internet of "BEXLEY" at the time of registration of the disputed domain name would have alerted the Respondent of the Complainant's presence, reputation and prior rights over this name. Furthermore, it points out that the Respondent's actual knowledge of the Complainant's prior rights is indicated by the fact that the denomination "BEXLEY" has been entirely reproduced in first position within the disputed domain name as well as the contents of the website that the disputed domain name previously resolved to, which they claim looks like the "special deal" and "clearance" sections of its official website. Moreover, the Complainant notes that the Respondent used a privacy protection service and that the use of such service shows that the Respondent specifically tried to block or intentionally delay the disclosure of its identity or coordinates, which is an additional indication that the registration was carried out in bad faith.

As to bad faith use, the Complainant contends that the disputed domain name resolves to a website that is a near exact copy of the Complainant's official websites; it copies the Complainant's official website's content, photographs and layout. The Complainant adds that this website appears to sell discounted BEXLEY goods that are not, in fact, on sale on the official website and, once they have been ordered, are never received by customers. The Complainant concludes that this is proof that the Respondent was aware of the Complainant and, by using the disputed domain name in this way, that the Respondent intentionally attempts to pass itself off as the Complainant and to attract Internet users to its website for its own commercial benefit.

B. Respondent

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

6. Discussion and Findings

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["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 Panel finds that the Complainant has clearly evidenced that it owns registered trademark rights to BEXLEY.

The entirety of the mark BEXLEY 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 the term “outlet” and a hyphen “-”, 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.

Finally, as for the applicable generic Top-Level domain (“gTLD”) “.shop”, the Panel holds that this can be disregarded under the first element confusing similarity test. [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.

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 Panel finds that the Respondent has not made a legitimate noncommercial or fair use of the disputed domain name. There is a high risk of implied affiliation here since the disputed domain name incorporates the Complainant’s BEXLEY trademark in its entirety and only adds a descriptive term to it (“outlet”). This composition cannot constitute fair use as the disputed domain name suggests sponsorship or endorsement by the Complainant. The addition of “outlet” implies that this is an outlet shop belonging to or at least supported by the Complainant. The fact that the disputed domain name previously resolved to a website using, without the Complainant’s permission, the Complainant’s branding and trademarks and offering BEXLEY branded products, further supports this.

The Complainant also claims that the Respondent used the website that the disputed domain name previously resolved to for illegal activity, namely to “sell discounted BEXLEY goods that are not, in fact, on sale on the official website and, once they have been ordered, are never received by customers.” However, the Panel notes that there is no evidence on file to support this statement. In line with decisions of prior Panels, this Panel is not prepared to accept merely conclusory or wholly unsupported allegations of illegal activity, even when the Respondent is in default, and will therefore disregard this statement.

Finally, the Complainant confirmed that the Respondent is not affiliated with the Complainant in any way nor has the Complainant licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant’s trademarks. The Panel has taken note of the Complainant’s confirmation in this regard and has not seen any evidence that would suggest the contrary. In the absence of any license or

permission from the Complainant to use its trademarks, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

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 intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's marks (paragraph 4(b)(iv) of the Policy). As set out in further detail above, the disputed domain name is confusingly similar to the Complainant's BEXLEY trademark since it incorporates this trademark in its entirety and only adds a descriptive term to it ("outlet"). In addition, the disputed domain name previously resolved to a website using the Complainant's branding and trademarks. These circumstances, in combination with the Respondent's clear absence of rights or legitimate interests in the disputed domain name, are strong indicators of 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 believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain name included the Complainant's BEXLEY trademark. As demonstrated by the Complainant, such trademarks were registered many years before the registration of the disputed domain name in several countries including the United States, the country of residence of the Respondent according to the WhoIs records. Furthermore, the disputed domain name incorporates the Complainant's BEXLEY trademark in its entirety and only adds a descriptive term to it ("outlet"). This descriptive term in the disputed domain name as well as the used gTLD ".shop" refer to a shop where discounted goods are sold, therefore implying that the disputed domain name leads to an outlet shop belonging to or at least supported by the Complainant. Moreover, the disputed domain name previously resolved to a website using, without the Complainant's permission, the Complainant's branding and trademarks. This indicates that the Respondent had the Complainant and its trademarks in mind when registering the disputed domain name. The Respondent's knowledge of the Complainant and its trademarks and therefore its registration in bad faith of the disputed domain name may accordingly be inferred from these circumstances. [WIPO Overview 3.0](#), section 3.2.2.

Furthermore, panels have found that the non-use of a domain name (including a parking page showing a message that "[t]he website is under maintenance") would not prevent a finding of bad faith use 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](#), sections 3.3 and 3.6. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's BEXLEY trademark, the composition of the disputed domain name (discussed above), as well as the use by the Respondent of a privacy service to conceal its identity. Accordingly, the Panel 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.

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 <bexley-outlet.shop> be transferred to the Complainant.

/Benoit van Asbroeck/

Benoit van Asbroeck

Sole Panelist

Date: August 12, 2024