

## **ADMINISTRATIVE PANEL DECISION**

**BEXLEY SAS v. jean Decroix**

**Case No. D2024-2960**

### **1. The Parties**

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

The Respondent is jean Decroix, France.

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

The disputed domain name <bexley-sale.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 July 22, 2024. On July 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 23, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 24, 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 July 26, 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 August 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 29, 2024.

The Center appointed Fabrice Bircker as the sole panelist in this matter on September 6, 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, BEXLEY SAS, is a French company founded in Lyon in 1985. It was originally specialized in the sale of shoes for men and has now diversified its activities to clothing for men.

The Complainant's products are sold in a network of 35 stores. They are mainly located in France, but the Complainant is also active in Luxembourg, Belgium and Spain.

In addition, the Complainant also operates an online store that generates 35 % of its turnover.

The Complainant's activities are notably protected through the following trademarks:



, French trademark No. 1330125, filed on November 5, 1985, registered on April 18, 1986, duly renewed since then, and designating goods of classes 18 and 25,

BEXLEY, International trademark No. 656086 registered on June 19, 1996, duly renewed since then, covering in particular Benelux and Spain, and designating goods of classes 18 and 25.

The Complainant's online presence is notably provided by the <bexley.com> domain name, which was registered on November 26, 1997, and which redirects to its official merchant website.

The disputed domain name, <bexley-sale.shop>, was registered on June 12, 2024.

When typed in a computer browser<sup>1</sup>, the disputed domain name resolves to a page displaying the following message: "b\*\*\*r The website is under maintenance".

However, on a smartphone browser the disputed domain name directs to a website mimicking the Complainant's online store as it notably:

- reproduces the Complainant's BEXLEY trademark and the corresponding logo,
- pretends offering for sale at discounted prices shoes and clothes bearing the BEXLEY trademark.

Very little is known about the Respondent, except that he is apparently located in France, based on the information disclosed by the Registrar.

Before introducing the Complaint, the Complainant sent a notification requesting the Registrar to block the disputed domain name, but in vain.

#### 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 confusingly similar to its BEXLEY trademark, because it reproduces the latter, and the added elements do not prevent it from being recognizable.

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<sup>1</sup> The Panel observes that this scenario may be comparable to instances where Internet users might have access to various website content. For instance, entering only the domain name might lead to an inactive page, whereas including "www." before the domain name could lead to an active page.

Besides, the Complainant argues that the Respondent has no rights or legitimate interests in respect with the disputed domain name, in substance because:

- the Respondent has no connection with the Complainant as he is not an authorized dealer, distributor or licensee of the Complainant, and he is not authorized to use the BEXLEY trademark,
- the BEXLEY trademark is highly distinctive and has been extensively used for almost 50 years by the Complainant in relation to men's shoes, clothing, accessories and leatherworking,
- the first 40 results of a Google search on "bexley sale" and on "bexley" exclusively refer to the Complainant's goods,
- the Respondent does not have prior rights on the word "bexley" and is not commonly known under this denomination.

Then, the Complainant contends that the disputed domain name has been registered and is being used in bad faith, notably because:

- the BEXLEY trademark is well-known in many countries in relation to the commercialization of men's shoes and apparel,
- the composition of the disputed domain name in as far it associates the Complainant's trademark with the element "sale" in the <.shop> generic Top-Level Domain ("gTLD") conducts the Internet users to believe that it redirects to a website offering discounted BEXLEY branded products,
- a mere Google search on the denomination "bexley" reveals the Complainant's trademark,
- the Respondent is being using a privacy protection service,
- the disputed domain name resolves to a website mimicking the Complainant's official website and pretending offering for sale at discounted price shoes and clothes bearing the BEXLEY trademark,
- the goods ordered on the website to which the disputed domain name resolves, are never delivered.

## **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to paragraph 4(a) of the Policy, in order to obtain a transfer of the disputed domain name, the Complainant must establish each of the following three elements:

- i. the disputed domain name 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 disputed domain name; and
- iii. the disputed domain name has been registered and is being used in bad faith.

Besides, paragraph 15(a) of the Rules provides that "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraphs 10(b) and 10(d) of the Rules also provide that "[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case" and that "[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence".

Besides, the Respondent's failure to reply to the Complainant's contentions does not automatically result in a decision in favor of the Complainant, although the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))), section 4.3).

Taking the foregoing provisions into consideration the Panel finds as follows:

### **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.

Based on the available record (Annex 6 of the Complaint), the Panel finds the Complainant has established registered trademark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3.

The entirety of the trademark 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.

Indeed, although the addition of other terms (here, "sale" 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 trademark for the purposes of the Policy because the BEXLEY trademark remains recognizable within said disputed domain name. [WIPO Overview 3.0](#), section 1.8.

Regarding the ".shop" gTLD in the disputed domain name, it is well established that a gTLD does not generally affect the assessment of a domain name for the purpose of determining identity or confusingly similarity. [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.

Indeed, the Complainant contends that it has not given its consent to the Respondent to use its BEXLEY trademark in a domain name registration or in any other manner.

In addition, there is nothing in the record of the case likely to indicate that the Respondent may be commonly known by the disputed domain name.

Besides, the Respondent is using the disputed domain name to operate a website:

- purporting to offer for sale, at discounted prices, shoes and fashion articles under the Complainant's BEXLEY trademark;
- ostentatiously displaying the Complainant's BEXLEY trademark, including under its stylized form;
- reproducing the look and feel of the Complainant's website.

This situation opens the question of whether the website available through the disputed domain name is genuinely offering BEXLEY products, or if the goods are counterfeits, or if it is a fake shop.

Of course, if the products would be counterfeits or if the online stores would be fake, there would be a clear absence of rights or legitimate interests. Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, 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.

On the other side, one cannot exclude that the products sold on the website available through the disputed domain name would be genuine BEXLEY goods.

In this respect, there is a consensus view that a reseller using a domain name containing a complainant's trademark to undertake sales related to a complainant's goods may constitute a bona fide offering of goods and services and thus has a legitimate interest in the domain name if the following cumulative requirements are met (see [WIPO Overview 3.0](#), section 2.8):

- 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.

Here, the Panel notably finds that the Respondent's website does not accurately and prominently disclose its (lack of) relationship with the Complainant. Rather, the Respondent seeks to create an impression of association with the Complainant, by running a website that prominently and repeatedly displays the Complainant's trademark.

In these conditions, even assuming that the Respondent would be offering for sale genuine BEXLEY goods, it would not be in a position to claim any rights or legitimate interests in the disputed domain name.

Based on the available record, 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 finds that the Respondent registered the disputed domain name being fully aware of the Complainant's rights, and that it is intentionally using said disputed domain name for commercial gain by creating a likelihood of confusion with the Complainant's BEXLEY trademark as to the source, sponsorship, affiliation, or endorsement of its websites and of the products offered for sale thereon, in the meaning of paragraph 4(b)(iv) of the Policy.

Indeed:

- the disputed domain name is confusingly similar with the Complainant's BEXLEY trademark which predates it by almost 40 years and is intrinsically distinctive and well-known (*BEXLEY SAS v. Lu Ni La*, WIPO Case No. [D2024-2457](#));
- when typed in a browser for smartphone<sup>2</sup>, the disputed domain name resolves to a site that gives a strong impression of being operated or authorized by the Complainant by using the Complainant's trademark, whereas this is not the case, and that purports to sell fashion articles under the BEXLEY trademark;
- the Respondent, while invited to defend his case, has remained silent in this procedure.

Besides, the fact that on a computer browser the disputed domain name resolves to a page indicating that the related website is in maintenance, does not change the analysis.

Indeed, 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 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. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes i) the distinctiveness and the reputation of the Complainant's trademark, ii) the composition of the disputed domain name in as far it can be perceived by the Internet users as directing to a merchant website for the Complainant's trademark, iii) the fact that the site to which the disputed domain name resolves when accessed on a smartphone, mimics the Complainant's merchant website, iv) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (vi) the use by the Respondent of a privacy service to conceal his 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.

The Panel finds 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 <bexley-sale.shop> be transferred to the Complainant.

*/Fabrice Bircker/*

**Fabrice Bircker**

Sole Panelist

Date: September 15, 2024

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<sup>2</sup> This claim supported by evidence appears in the body of the complaint, and it is well established that the general powers of a panel as articulated inter alia in paragraphs 10 and 12 of the Rules include, among others, the possibility to undertake limited factual research into matters of public record if the panel considers such information useful to assessing the case merits and reaching a decision. These limited factual researches notably include visiting the website linked to the disputed domain name (see for instance, [WIPO Overview 3.0](#), section 4.8)