

ADMINISTRATIVE PANEL DECISION

SPG IP Holdings, LLC v. 深圳葛里法科技有限公司 (shen zhen ge li fa ke ji you xian gong si)
Case No. D2024-3480

1. The Parties

The Complainant is SPG IP Holdings, LLC, United States of America, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is 深圳葛里法科技有限公司 (shen zhen ge li fa ke ji you xian gong si), China.

2. The Domain Name and Registrar

The disputed domain name <simonpremiumoutlets.shop> is registered with Alibaba Cloud Computing Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on August 27, 2024. On August 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 28, 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 (N/A) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 28, 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 in English on August 29, 2024.

On August 28, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On August 29, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in Chinese and English of the Complaint, and the proceedings commenced on September 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 30, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 10, 2024.

The Center appointed Douglas Clark as the sole panelist in this matter on October 15, 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 wholly owned subsidiary of Simon Property Group, L.P. ("SPG"), an American real estate investment trust that invests in shopping malls, outlet centers, and community/lifestyle centers. SPG became a public company in 1993 after being founded by brothers Melvin and Herbert Simon in the 1960s. Through acquisitions and partnerships with several organizations, the SPG has grown and expanded into various markets and territories.

The Complainant is the owner of trademark registrations across various jurisdictions, including:

Trademark	Jurisdiction	Registration Number	Registration Date	International Class
	International	1273274	July 23, 2014	9, 16, 35, 36, 37
SIMON PREMIUM OUTLETS	European Union	015721723	June 5, 2017	35, 36, 37
SIMON PREMIUM OUTLETS	United Kingdom	UK00915721723	June 5, 2017	35, 36, 37
SIMON PREMIUM OUTLETS	Singapore	40201621338Q	December 7, 2017	35, 36, 37
SIMON PREMIUM OUTLETS	China	28053095	November 14, 2018	35, 36, 37

SPG further utilizes the "Simon Premium Outlets" term as part of its brand logo, featured extensively on SPG's websites and as part of the promotion of Simon Premium Outlets brand.

The Complainant uses its primary domain names <premiumoutlets.com> and <simonpremiumoutlets.com> to promote its businesses.

The Respondent is based in China. The Respondent registered the disputed domain name <simonpremiumoutlets.shop> on July 25, 2024. Prior to the Complainant's request to take down the website, the disputed domain name resolved to a page that attempted to copy the Complainant's official website through the use of the Complainant's SIMON PREMIUM OUTLETS trademark and imitating the look and feel of the Complainant's official websites and offered products for sale in English.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name to the Complainant and 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:

- a) The disputed domain name is identical or confusingly similar to the Complainant's trademark or service mark in which the Complainant has rights.
- b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- c) The disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requests that the language of the proceeding be English for several reasons, including:

- a) The Complainant is unable to communicate in Chinese and translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter;
- b) Such additional delay, considering the obviously abusive nature of the disputed domain name and its website, poses continuing risk to the Complainant and unsuspecting consumers seeking the Complainant or its products;
- c) The disputed domain name is comprised of Latin characters;
- d) The website found at the Disputed Domain Name hosts content that is entirely in English;
- e) The term Simon Premium Outlets, which is the entire composition of the disputed domain name, does not carry any specific meaning in the Chinese language;
- f) The Complainant submits that the Respondent's domain name portfolio is further evidence to substantiate that the Respondent understands the English language. The Complainant submits the Respondent's domain name portfolio is wholly comprised of English dictionary terms as domain names, such as: <bestshoeshop.cn>, <halloweenshop.cn>, <runningshoese.cn>, <shoesbestdealer.cn>, and <shoesclearance.cn>;
- g) It would unduly burden the Complainant to have to arrange and pay for translation where the Respondent has demonstrated behavior that disrupts the Complainant's business and has already required the Complainant to devote significant time and resources to addressing this instance of abuse.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, and in particular that the website under the disputed domain name is wholly in English, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues: Three Elements

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

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 mark SIMON PREMIUM OUTLETS for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The only other difference between the disputed domain name and the Complainant's trademark is the addition of the generic Top-Level Domain ("gTLD") ".shop" to the disputed domain name. The gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.

Accordingly, 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 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.

First, the Complainant's registration for the trademark SIMON PREMIUM OUTLETS constitutes prima facie evidence of the Complainant's rights to these trademarks. The Respondent is not sponsored, affiliated to, licensed nor authorized to use the Complainant's trademarks in any manner, including the disputed domain name.

Second, apart from the reference to the disputed domain name, the Respondent is not commonly known by the disputed domain name, which suggests a lack of rights and legitimate interests in the disputed domain name.

Third, the Respondent's registration on July 25, 2024, came significantly after the Complainant's registration of its trademarks. Prior to the Respondent's registration, the Complainant's trademarks had enjoyed high degree of fame and reputation which the Respondent was not authorized to use.

In any event, as the Respondent has failed to 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 Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

In the premises, 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.

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.

As stated above, the Panel notes that the disputed domain name was registered at least a decade after the Complainant's registration of the trademark SIMON PREMIUM OUTLETS and the Complainant had been providing services under this trademark well before the registration of the disputed domain name. The Respondent's registration of the disputed domain name and the contents on the website which the disputed domain name directs bearing resemblance to the Complainant's trademarks and official websites, indicating the Respondent's knowledge of and familiarity with the Complainant's brand and business. As such, the Respondent's use of these trademarks in the disputed domain name cannot be a coincidence.

It is clear that by creating the confusion as to the source, sponsorship, affiliation or endorsement with the Complainant's trademarks, the Respondent is attempting to attract, for commercial gain, potential customers to make purchases on the website to which the disputed domain name directs. Such use of the disputed domain name falls into the bad faith under paragraph 4(b)(iv) of the Policy.

For the above reasons, 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 <simonpremiumoutlets.shop> be transferred to the Complainant.

/Douglas Clark/

Douglas Clark

Sole Panelist

Date: October 29, 2024