

## **ADMINISTRATIVE PANEL DECISION**

GANT AB v. Tom Holt  
Case No. D2024-3963

### **1. The Parties**

The Complainant is GANT AB, Switzerland, represented by Adams & Adams Attorneys, South Africa.

The Respondent is Tom Holt, Spain.

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

The disputed domain name <gantsouthafrica.net> is registered with Paknic (Private) Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 27, 2024. On September 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 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 (Whois Agent Web Domains by Proxy) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 30, 2024, 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 September 30, 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 October 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 28, 2024.

The Center appointed Johan Sjöbeck as the sole panelist in this matter on October 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 has submitted evidence that it is the owner of the following trademark registrations:

GANT, South African trademark registration number 1983/06226 with registration date November 27, 1985. The trademark is registered in class 25 in respect of clothing, footwear and headgear.

GANT, South African trademark registration number 2002/03947 with registration date August 25, 2006. The trademark is registered in class 35 in respect of retail services.

The Respondent registered the disputed domain name <gantsouthafrica.net> on May 16, 2023. The disputed domain name resolves to a website that is an almost identical copy of the Complainant's official website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant was founded in 1949 by Bernard Gantmacher and has since grown to be a world-famous fashion brand. The Complainant currently operates in 70 markets with its products being available at over 4,000 retailers and exclusive stores all over the world. The Complainant is the proprietor of the well-known GANT trademark, which it has registered in various classes of goods and services across the globe, including South Africa. In addition to its trademark registrations, the Complainant claims common law rights in the trademark GANT.

The Complainant's GANT shirts defined the casual-yet-smart look and since its foundation in 1949, it has grown to be one of the world's most well-known sport fashion brands. The Complainant's GANT name and trademark has been, and is, extensively used by it on a day-to-day basis in relation to its products and activities. In the context of fashion and online clothing retail services, the GANT name and trademark is exclusively associated with the Complainant. The Complainant has made widespread use of its trademark. The Complainant has acquired a substantial goodwill and reputation in its name and trademark and it is, therefore, respectfully, submitted that this mark is well-known trademarks as envisaged by Article 6bis of the Paris Convention for the Protection of Industrial Property.

The Complainant's official website, located at "www.gant.com" is one of its primary portals for conducting business. A great majority of sales of its fashion and clothing items are sold online, through the Complainant's website. The Complainant has promoted its trademark extensively over the years. Its Facebook page has over 608,000 likes. It has over 499,000 followers on Instagram and over 80,000 followers on TikTok.

The disputed domain name, which wholly incorporates the Complainant's well-known GANT trademark, is identical to the Complainant's trademark save for the addition of the words "south africa". It is well established that the generic Top-Level Domain ".net" does not affect the disputed domain name for the purpose of determining whether it is identical or confusingly similar. The Complainant submits that its trademark is clearly recognizable within, and the only distinctive part of, the disputed domain name and that it is confusingly similar to the Complainant's registered and well-known trademark, in which it enjoys a reputation and goodwill acquired through use. The Complainant submits that the test under paragraph 4(a)(i) has been satisfied.

Not only is the Complainant's trademark wholly incorporated in the disputed domain name, but the disputed domain name is linked to an active website, on which the Complainant's trademark is used without authorization. It is to all intents and purposes a clone of the Complainant's website, and obviously being used in bad faith. In this regard, the Complainant points out that by virtue of its South African trademark registrations, it is entitled to prevent the use of a name or mark by any other person, which is confusingly or deceptively similar to its trademarks, in relation to the goods and/or services for which they are registered. This right extends to restrain the use by another person of such name or mark in relation to goods or services which are similar to the goods and/or services for which the marks are registered, if in such use there exists a likelihood of deception and/or confusion. Sections 34(1)(a) and 34(1)(b) of the South African Trade Marks Act 194 of 1993 apply in this regard.

Internet users are likely to assume that the website of the disputed domain name is the Complainant's South African website, aimed at the South African public, when this is not the case. The website, to which the disputed domain name resolves, purports to offer for sale a variety of clothing items and accessories under the Complainant's trademark. The website, however, has nothing to do with the Complainant and is not legitimate. It is clear that the disputed domain name, and the website to which it resolves, is being used in relation to the exact goods and services in respect of which the Complainant owns registered rights for its trademark. Not only does this conduct amount to trademark infringement, but it also amounts to passing-off in terms of the common law, as the Respondent is clearly seeking to take advantage of the reputation vesting in the Complainant's trademark. The Respondent is thus benefitting commercially, seemingly quite intentionally, from the goodwill and reputation of the Complainant.

The Complainant believes that the Respondent acquired the disputed domain name specifically to take unfair advantage of the reputation and goodwill in the Complainant's trademark. The clone website to which the disputed domain name resolves to is clearly seeking to exploit, unduly, without any entitlement, the Complainant's intellectual property, and presumably with the aim of misleading consumers in attempted phishing or fraudulent activities. Consumers will think that the website to which the disputed domain name resolves to is the Complainant's website, and order products (and pay for them), on that misunderstanding.

The Respondent has set out to attract, for commercial gain, internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website. The use and registration of this domain name will, therefore, certainly cause confusion and deception, and the Respondent has seemingly strained every nerve to copy the Complainant and cause consumer confusion.

The Complainant's registered trademark rights and common law rights pre-date the registration of the disputed domain name by years. There is no evidence that the Registrant has been or is commonly known by the name "GANT" or that it has acquired any trademark or service mark rights. The Complainant has not authorized the Respondent to use its GANT trademark. There is no relationship or association between the Complainant and the Respondent, whether by license or otherwise. The Respondent has no right to use the Complainant's trademark.

The disputed domain name resolves to a website on which the Complainant's trademark is being used, without authorization, in respect of the exact goods and services in respect of which the Complainant owns trademark registrations. Not only does this conduct constitute trademark infringement, but it seems that much of the content on the website appears to be identical, reproduced and/or adapted from the Complainant's official website, and this amounts to copyright infringement. It goes without saying that a clone website, particularly one that purports to sell goods to the public, is not legitimate.

The Respondent's intention in registering the disputed domain name is to take unfair advantage of the substantial reputation and goodwill in the Complainant's name and well-known trademark, and to direct internet traffic away from the Complainant's website, to its own. It is, therefore, submitted that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name. In fact, it seems that the Respondent registered the disputed domain name with

the intention of acquiring commercial gain, by linking it to a clone website and to misleadingly divert consumers from the Complainant's website to its own.

The Respondent was undoubtedly aware of the Complainant's rights in its trademark when the disputed domain name was registered. This is evident from the fact that the disputed domain name appears to be calculated to mimic the Complainant's official website. As mentioned, the disputed domain name is linked to a clone website which is being used to offer for sale a variety of clothing items and accessories which purport to be the Complainant's products. It clear that the clone website was created with the intention of creating a direct affiliation with the Complainant and its business. The Respondent is, therefore, not making legitimate non-commercial or fair use of the disputed domain name within the meaning of the Policy, by misleading consumers that it is somehow connected to or associated with the Complainant when this is not the case.

The Complainant has no knowledge of the goods being offered for sale on the clone website. Similarly, it has no control over the quality of the products and/or whether the goods are even original GANT products. The Complainant has no relationship or association with the Respondent and is concerned that the website may be aimed at phishing or similar activities and that the modus operandi of the Respondent and/or the persons behind this website may be to copy content from legitimate online retail stores, with the aim of making online sales to unsuspecting customers and then simply never delivering the products that have been ordered and paid for.

The Complainant's reputation could be damaged by means of unlawful competition or passing off, under the common law, by another party wrongly representing that it is, or is associated with, the Complainant. Members of the public may make online purchases, thinking that they are purchasing goods emanating from the Complainant, when they are not. There is a real likelihood of economic loss in the form of sales, as a result of internet traffic being directed away from the Complainant's website. Furthermore, the Complainant obviously does not wish to be wrongly associated with the clone website, being a website over which it has no control. There is a significant potential harm to the Complainant's reputation if consumers mistakenly associate the disputed domain name and clone website with the Complainant, and the goods and services being offered on the clone website are not of an acceptable quality, or indeed if they are paid for and never delivered, and this is wrongly attributed to the Complainant.

The Respondent has no rights or legitimate claim in respect of the disputed domain name or the Complainant's GANT trademark. The Respondent does not have any association with the Complainant. The Respondent has no connection with the Complainant's well-known trademark, and it is, therefore, submitted that it clearly acted in bad faith when registering the dipusted domain name. The fact that the disputed domain name resolves to a clone website also makes the bad faith obvious. Furthermore, the Respondent is preventing the Complainant from exercising its rights as the registration of the disputed domain name hinders the Complainant from registering or using the identical domain name. Hence, the Respondent's conduct amounts to an unfair disruption of the Complainant's business.

It is submitted that the use of the disputed domain name would lead internet users to believe that the disputed domain name is registered to, operated or authorized by, or otherwise connected to the Complainant. The disputed domain name creates the impression that the Repondent and the Complainant are somehow associated or connected due to the confusing similarity between the disputed domain name, and the Complainant's trademark.

The Respondent registered the disputed domain name to benefit from the extensive reputation the Complainant has established in its well-known trademark. This is clear evidence that the Respondent is currently using the disputed domain name strictly to capitalize from Internet users intending to visit the Complainant's website. The use of the disputed domain name is taking unfair advantage of, and is detrimental to, the distinctive character or repute of the Complainant's well-known trademark.

The Complainant accordingly submits that the disputed domain name has been registered and is being used in bad faith, as contemplated in paragraph 4(a)(iii) of the Uniform Dispute Resolution Policy.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) that 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 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 is, according to the submitted evidence, the owner of the registered trademark GANT. The disputed domain name incorporates the trademark in its entirety with the addition of the geographic term "southafrica". The addition of the geographic term does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's GANT trademark.

Having the above in mind, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark GANT and that the Complainant has proven the requirement under paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

The Complainant must show that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that the Respondent uses or has made preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services prior to the dispute;
- (ii) that the Respondent is commonly known by the disputed domain name, even if the Respondent has not acquired any trademark rights; or
- (iii) that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Complainant's trademark registrations for GANT predate the Respondent's registration of the disputed domain name. The Complainant has not licensed, approved or in any way consented to the Respondent's registration and use of its trademarks in the disputed domain name.

The Complainant maintains that the Respondent's website is a clone of the Complainant's official website. The evidence in the case demonstrates that the Respondent has attempted to create an impression of a website created by, belonging to, or endorsed by the Complainant. The Respondent's website, to which the

disputed domain name resolves, contains not only direct references to the Complainant but it also reproduces the Complainant's trademark and its official product images. On the Respondent's website, Internet users are offered to purchase a variety of clothing items and accessories that appear to be products of the Complainant.

Based on the submitted evidence, it is clear that the Respondent's website, to which the disputed domain name resolves, is an almost identical copy of the Complainant's official website. Given the above, the Respondent is not making a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Moreover, the Panel notes that the nature of the disputed domain name, incorporating the Complainant's trademark with a geographic term, carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

Although given the opportunity, the Respondent has not rebutted the Complainant's prima facie case. The Respondent has not submitted any Response or any evidence in this case to demonstrate that the Respondent is the owner of any trademark rights similar to the disputed domain name or that the Respondent is or has been commonly known by the disputed domain name.

By not submitting a response, the Respondent has failed to invoke any circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the disputed domain name. Thus, there is no evidence in the case that refutes the Complainant's submissions, and the Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

- (i) circumstances indicating the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name;
- (ii) circumstances indicating that the disputed domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding disputed domain name, provided there is a pattern of such conduct;
- (iii) circumstances indicating that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the disputed domain name has intentionally been used in an attempted to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location.

The Complainant has submitted evidence demonstrating that the Respondent is creating a false impression that not only the disputed domain name but also the website, to which the disputed domain name resolves, are provided by or endorsed by the Complainant. On the Respondent's website, the Complainant's trademark, content, and product images from the Complainant's official website are reproduced. In addition to copying the look and feel of the Complainant's official website, the Respondent offers products for sale that appear to be products of the Complainant.

By using the disputed domain name, which is confusingly similar to the Complainant's trademark, for a website where the Complainant's trademark and marketing material are reproduced, there is an increased risk of confusion as Internet users may more easily be confused or misled into believing that the disputed domain name and website belong to or are in some way associated with or endorsed by the Complainant. Considering that the Respondent is reproducing the Complainant's trademark and marketing material without permission on the website to which the disputed domain name resolves, the Panel finds, in the absence of contrary evidence, that the Respondent knew or should have known of the Complainant's trademark and business when registering and using the disputed domain name.

Thus, the evidence in the case before the Panel indicates that the disputed domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the websites or of a product or service on the website.

There is no evidence in the case that refutes the Complainant's submissions.

The Panel concludes that the Complainant has proved the requirements under paragraph 4(b) of the Policy and that the disputed domain name has been registered and is being used in bad faith.

## **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 <gantsouthafrica.net> shall be transferred to the Complainant.

*/Johan Sjöbeck/*

**Johan Sjöbeck**

Sole Panelist

Date: November 6, 2024