

## **ADMINISTRATIVE PANEL DECISION**

BA&SH v. Spitz Heffel

Case No. D2024-4091

### **1. The Parties**

The Complainant is BA&SH, France, represented by Cabinet Bouchara, France.

The Respondent is Spitz Heffel, United States of America (“U.S.”).

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

The disputed domain name <baandshshop.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 4, 2024. On October 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 8, 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 (Gname.com Pte. Ltd / Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 10, 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 October 11, 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 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 4, 2024.

The Center appointed Beatrice Onica Jarka as the sole panelist in this matter on November 7, 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 operates in the field of design, manufacture, and distribution of ready- to-wear goods for women as well as fashion accessories since 2003. The Complainant's goods and services are offered for sale all around the world.

The Complainant is the owner of several BA&SH trademarks duly registered and renewed to designate notably "bags, clothing, footwear", including:

- European Union trademark No. 005679758, registered on February 10, 2012 and renewed in classes 3, 14, 18, and 25;
- European Union trademark No. 17895989, registered on October 6, 2018 in classes 3, 9, 14, 18, 21, 25, and 35; and
- International registration BA&SH No. 1440828, registered on May 7, 2018 in classes 3, 9, 14, 18, 21, 25, and 35, notably designating China, United States of America, Switzerland, Monaco (Annex 11 to the Complaint)

According to the concerned Registrar's Whols database, the sole Respondent in this administrative proceeding is an individual from U.S..

The disputed domain name was registered on March 3, 2024 and resolves to a webpage purportedly selling the Complainant's products at discounted prices and reproducing the Complainant's logo.

#### **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 registration of a trademark confers to its owner a right of ownership on this trademark for the goods or services covered by the registration;
- the goods and services that are specifically claimed in this action are clothing, fashion accessories, and any other goods and services related to clothing and designated by Complainant's trademarks which falls within the scope of the Complainant's core business;
- the disputed domain name <baandshshop.com> was registered in 2024, more than fifteen years after the Complainant's earliest trademarks invoked herein, and is reproducing - in their entirety, in the same order and rank - all the letters of the BA&SH trademarks whose owner is the Complainant, and by replacing the sign "&" by the word "and";
- it is traditionally acknowledged that the term "and" and the ampersand & are essentially equivalent;
- the differences between the mark and the disputed domain name do not significantly distinguish the two;
- the only difference between the disputed domain name and the trademarks BA&SH is the addition of the English descriptive term "shop". Such added term is English dictionary term and can therefore not prevent a finding of confusing similarity;
- the term "shop" not only fails to distinguish the disputed domain name but even adds to the confusing similarity by leading users to believe that the Complainant or an authorized reseller operates them as it suggests a business relationship between the Respondent and the Complainant;
- the use of the disputed domain name in connection with a webpage purportedly selling the Complainant's products and reproducing the Complainant's logos affirms a finding of confusing similarity between the disputed domain name and the Complainant's trademarks;

- the generic Top-Level Domain (“gTLD”) suffix, in this case “.com”, shall be disregarded as a standard registration requirement when assessing the similarity between a trademark and a domain name;
- the trademarks BA&SH are readily recognizable and distinctive as incorporated in their entirety into the disputed domain name;
- the Respondent has no legitimate interest in appropriating the disputed domain name since he does not own any rights to the trademarks that it reproduces, which belong exclusively to the Complainant;
- the Respondent did not, at any time, request and a fortiori obtain any authorization, on any ground whatsoever, to reproduce and imitate the Complainant’s trademarks within a domain name;
- the Respondent has no right to use the trademarks of the Complainant in the course of a commercial activity, especially to designate goods that are identical to those of the Complainant, notably ready to wear products;
- there is no relationship whatsoever between the Parties as the Respondent is not related in any way to the Complainant’s business even if the Respondent intends to suggest the opposite in order to capitalize on the Complainant’s investments and notoriety, notably by prominently displaying the Complainant’s official BA&SH logo;
- the disputed domain name <baandshshop.com> incorporates the Complainant’s trademarks and is presumably used as e-commerce website selling ready to wear products and/or in a phishing scheme, which indicates the Respondent’s intention to divert consumers to the disputed domain name for commercial gain, by taking unfair advantage of the goodwill and reputation of the Complainant’s trademarks for BA&SH;
- the Respondent could not have ignored the Complainant’s trademarks at the time it registered the disputed domain name since the Complainant trademarks are “widely known as identifying the Complainant’s activities” and that the Complainant had already been highly active throughout the world for many years;
- the Complainant is thus notably the owner of the domain name <ba-sh.com> since 2004, which is used as its main website “www.ba-sh.com”, where consumers can purchase original ready-to-wear products under the Complainant trademarks and have them delivered worldwide;
- the Complainant is notoriously known on social networks under the pseudonym bashparis where it is “followed” by more than 1,100,000 people. The Respondent could not have ignored it;
- the Complainant’s trademarks have a meaning of their own which cannot be invented since they take up the initials of their founders, Mrs. Barbara Boccara and Mrs. Sharon Krief, jointly united under the term BA&SH (The Respondent could not have been mistaken or invented this term when registering the disputed domain name in order to offer ready-to-wear products for sale, which is exactly the activity of the Complainant, especially on a website displaying the Complainant’s official logo;
- the registration of the disputed domain name was performed with particular bad faith, since the Respondent could not possibly have been unaware of the Complainant’s activities and the Complainant’s trademarks;
- on the contrary, the Respondent is free riding on the worldwide reputation of the Complainant and the Complainant’s trademarks in order to attract Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s trademarks for commercial gain, and therefore falls within the example given in the Policy’s paragraph 4(b)(iv).
- the Respondent’s website, strictly reproduces, without any authorization, the Complainant’s trademarks on all its pages, and from the landing page highly suggesting that the Complainant is affiliated with or, sponsors, the Respondent’s website;
- such use of the disputed domain name shows that the Respondent has intentionally attempted to attract Internet users to an on-line location by creating likelihood of confusion with the Complainant’s trademarks;
- more specifically, the Respondent is using the Complainant’s trademarks and associating the same with goods (i.e, clothing) that are infringing BA&SH’s copyrights and design rights, since infringing clothing goods are offered for sale on the website;
- the addition the Complainant’s well-known trademarks with the descriptive term “shop” referring directly to its activities, especially for a website having a commercial activity identical to that of the Complainant, establish the Respondent’s knowledge of the Complainant’s rights, so that the disputed domain name was registered in bad faith;
- the use of a website to offer for sale the same kind of products as the Complainant’s, under Complainant’s trademarks and without the Complainant’s authorization constitutes bad faith use of the

disputed domain name, creating a likelihood of confusion which is an example of bad faith not only during the registration process of the disputed domain name but also in the use of disputed domain name;

- in particular, such use of the Complainant's trademarks further show that the Respondent is attempting to mislead Internet users into believing that the disputed domain name is associated with the Complainant, when it is not;
- by registering the disputed domain name, the Respondent could not have ignored that it was reproducing, in an identical manner, the Complainant's trademarks BA&SH, since the website related with the disputed domain name, unlawfully offers for sale ready to wear products referring to the Complainant's trademarks.

## **B. Respondent**

Although the Respondent was procedurally summoned, it 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 entirety of the Complainant's mark is reproduced within the disputed domain name, in the same order and rank - all the letters of the BA&SH trademarks whose owner is the Complainant, and by replacing the sign "&" by the word "and", when the term "and" and the ampersand & are essentially equivalent.

The only difference between the disputed domain name and the trademarks BA&SH is the addition of the English descriptive term "shop". Such added term is an English dictionary term and cannot prevent a finding of confusing similarity ([WIPO Overview 3.0](#), section 1.8.)

Accordingly, the disputed domain name is confusingly similar with the BA&SH trademarks whose owner is the Complainant and 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, as it has identified conduct which amounts to lack of rights or legitimate interests, here claimed the use of the disputed domain name <baandshshop.com> incorporating the Complainant's trademarks as e-commerce website selling ready to wear products, which indicates the Respondent's intention to divert consumers to the disputed domain name for commercial gain, by taking unfair advantage of the goodwill and reputation of the Complainant's trademarks for BA&SH.

Panels have held that the use of a domain name for illegitimate activity here, claimed impersonation/passing off can never confer rights or legitimate interests on a respondent ([WIPO Overview 3.0](#), section 2.13.1.)

Accordingly, 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:

- could not have ignored the Complainant's trademarks at the time it registered the disputed domain name since the Complainant trademarks are "widely known as identifying the Complainant's activities" and that the Complainant had already been highly active throughout the world for many years;
- is free riding on the worldwide reputation of the Complainant and the Complainant's trademarks in order to attract Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademarks for commercial gain, and therefore falls within the example given in the Policy's paragraph 4(b)(iv).
- reproduces, without any authorization, the Complainant's trademarks on the web pages, and suggests that the Complainant is affiliated with or, sponsors, the Respondent's website;
- has intentionally attempted to attract Internet users to an on-line location by creating likelihood of confusion with the Complainant's trademarks;
- is using the Complainant's trademarks and associating the same with goods (i.e, clothing) that are infringing BA&SH's copyrights and design rights, since infringing clothing goods are offered for sale on the website;
- has knowledge of the Complainant's rights, so that the disputed domain name was registered in bad faith;
- creates likelihood of confusion which is an example of bad faith not only during the registration process of the disputed domain name but also in the use of disputed domain name;
- is attempting to mislead Internet users into believing that the disputed domain name is associated with the Complainant, when it is not.

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 illegitimate activity here, claimed impersonation/passing off constitutes registration and use 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.

Accordingly, 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 <baandshshop.com> be transferred to the Complainant.

*/Dr. Beatrice Onica Jarka/*

**Dr. Beatrice Onica Jarka**

Sole Panelist

Date: November 20, 2024