

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. 陈晓梅 (Chen Xiao Mei)
Case No. D2022-0902

1. The Parties

The Complainant is No Ordinary Designer Label Limited t/a Ted Baker, United Kingdom, represented by Stobbs IP Ltd, United Kingdom.

The Respondent is 陈晓梅 (Chen Xiao Mei), China.

2. The Domain Name and Registrar

The disputed domain name <tedbakeroutlets.com> (the “Disputed Domain Name”) is registered with Xin Net Technology Corp. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 15, 2022. On March 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 21, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on March 21, 2022, 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 March 21, 2022.

On March 21, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On March 21, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 English and Chinese of the Complaint, and the proceedings commenced on March 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 19, 2022.

The Center appointed Peter J. Dernbach as the sole panelist in this matter on April 28, 2022. 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 No Ordinary Designer Label Limited t/a Ted Baker, a British company founded in 1998, which operates in the clothing retail industry, offering menswear, womenswear, and accessories. The Complainant has stores and outlets in Europe, United States of America ("United States"), Canada, Australia, Asia, South Africa, and the Middle East.

The Complainant is the owner of the TED BAKER trademarks including:

The United States trademark TED BAKER, registration number 2672649, registered since January 7, 2003; and

European Union trademark TED BAKER, Trade Mark number 015022064, registered since August 29, 2016.

The Complainant's main e-commerce website can be found at "www.tedbaker.com".

The Disputed Domain Name <tedbakeroutlets.com> was registered on December 3, 2017. The Disputed Domain Name resolves to a live website, which features the Complainant's TED BAKER branding and offers for sale TED BAKER branded stock. The website to which the Disputed Domain Name resolves also facilitates payment processing facilities and requires the registration of a customer account at the point of purchase. The Respondent is offering goods for sale on the website to which the Disputed Domain Name resolves at significantly discounted prices, which has not been authorised by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant requests the Panel appointed in this administrative proceeding that the Disputed Domain Name be transferred to the Complainant.

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has registered trademarks for the brand name TED BAKER. The Complainant has built up substantial recognition in the TED BAKER brand among the public. The Disputed Domain Name wholly incorporates the term "ted baker" with the addition of the term of "outlets". The additional word reinforces an association with the Complainant who is known for operating in fashion and has products sold in designer outlets. The addition of the Top-Level Domain ("TLD") ".com" is merely a technical requirement for domain name registration.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Disputed Domain Name was created on December 3, 2017. By that time, the Complainant already had extensive rights worldwide in the TED BAKER trademarks.

Although the Respondent has not created an exact replica of the Complainant's website, the Disputed Domain Name is set-up with the intention of creating a connection with the Complainant's website, because the website to which the Disputed Domain Name resolves has the same overall impression to that of the Complainant's website due to the inclusion of the Complainant's trademarks and logo.

Further, the Respondent has not been commonly known by the Disputed Domain Name. The Complainant submits that to the best of its knowledge, the Respondent has never legitimately been known by the name TED BAKER at any point in time. Merely registering the Disputed Domain Name is not sufficient to establish rights or legitimate interests.

The Disputed Domain Name has been set-up to resolve to a website with the aim of deceiving the Complainant's customers. The Respondent's use of the Disputed Domain Name is not in connection with a *bona fide* offering of goods or services.

Based on the above, the Complainant submitted that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names without intent of or commercial gain to misleadingly divert consumers. There is no believable or realistic reason for registration or use of the Disputed Domain Name other than to take advantage of the Complainant's rights.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

The Complainant's TED BAKER trademarks significantly predate the registration of the Disputed Domain Name.

The Respondent is using the Disputed Domain Name, which reproduces the Complainant's trademark in its entirety, in order to attract the Complainant's customers to the Respondent's own e-commerce store. The Respondent is offering goods for sale on its website at significantly discounted prices, which has not been authorised by the Complainant.

Even if the goods are merely offered for re-sale purposes, the Disputed Domain Name will fail the re-seller test as stated in section 2.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and confirmed in the case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), by failing to accurately disclose its relationship with the Complainant (the non-existence of the relationship).

The Respondent is intending to draw unsuspecting Internet users to the website at the Disputed Domain Name, for its own commercial gain and, which in turn, is likely to cause detriment to the Complainant.

Based on the above, the Complainant submitted that the Disputed Domain Name was registered and used in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1 Language of the Proceeding

Paragraph 11(a) of the Rules provides that “[u]nless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”.

Paragraph 10(b) of the Rules provides 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 Paragraph 10(c) of the Rules provides that “[t]he Panel shall ensure that the administrative proceeding takes place with due expedition [...]”.

The Registration Agreement is in Chinese. The Complainant requested that the language of the proceeding be English.

The Panel notes that the Respondent conducted its business at the website to which the Disputed Domain Name resolved in English. The website to which the Disputed Domain Name resolved accepted payment in USD, AUD, CAD, and GBP.

The Panel is satisfied that the Respondent has sufficient familiarity with English that the Respondent should be able to understand the language of the Complaint and has chosen not to respond. Moreover, the Respondent was given an opportunity to comment on the language of the proceeding and failed to do so.

Therefore, it will not be prejudicial to the Respondent in its abilities to articulate its arguments in English in the proceeding, whereas requiring the Complainant to translate the Complaint into Chinese would cause unnecessary delay to the proceeding. *Dolce & Gabbana S.r.l. v. Zhang Yali*, WIPO Case No. [D2013-1101](#).

In order to ensure fairness to the Parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes, the Panel determines under paragraph 11(a) of the Rules that English shall be the language of the proceeding and the Decision will be rendered in English.

6.2 Substantive Issues

In this UDRP proceeding, the Complainant must prove, by evidence, each of the following UDRP 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.

A. Identical or Confusingly Similar

The Complainant has established that it is the owner of the TED BAKER trademarks.

The Disputed Domain Name is a combination of the Complainant’s TED BAKER trademark, the term “outlets”, and the TLD “.com”. The Disputed Domain Name incorporates the TED BAKER trademark in its entirety. The term “outlets” does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant’s TED BAKER trademark. Moreover, the addition of the TLD “.com” does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant’s TED BAKER trademarks.

For the above reasons, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's TED BAKER trademarks, and the condition of paragraph 4(a)(i) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, the Disputed Domain Name, for the purposes of paragraph 4(a)(ii) of the Policy:

“(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable 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; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [Disputed Domain Name], even if [the Respondent has] acquired no trademark or service mark rights; or

(iii) [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 or service mark at issue.”

Pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy, the Complainant is required to first establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The burden of production would then shift to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Disputed Domain Name.

The Complainant has established that it is the owner of the TED BAKER trademarks, and that the Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks, nor has it permitted the Respondent to apply for or use any domain name incorporating the TED BAKER trademark. Furthermore, the record shows that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name, because the website to which the Disputed Domain Name resolved was used for the unauthorized sale of goods similar to the Complainant's goods. Such use is not a legitimate noncommercial or fair use.

As stated in section 2.8 of the [WIPO Overview 3.0](#), resellers or distributors using a domain name containing a complainant's trademark to undertake sales related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the “*Ok! Data* test”, the following cumulative requirements will be applied in the specific conditions:

(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.

In the circumstances of this case, the Respondent is not making a *bona fide* offering of goods or services. In particular, the Panel notes that the Respondent's website does not disclose the lack of relationship with the Complainant, but rather appears deliberately intended to impersonate the Complainant. Moreover, the nature of the Disputed Domain Name carries a risk of implied affiliation (see section 2.5.1 of [WIPO Overview 3.0](#)).

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The burden of production thus shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Disputed Domain Name. The Respondent did not submit any evidence or allegation to show that it has rights or legitimate interests in the Disputed Domain Name.

Having considered the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The relevant part of paragraph 4(b) of the Policy explicitly states that “the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: [...] (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The Complainant operates and owns a well-known fashion brand. The TED BAKER trademarks were registered by the Complainant long before the registration of the Disputed Domain Name. The Respondent knew or should have known the TED BAKER trademarks when registering the Disputed Domain Name. A quick search of the term “ted baker” at the time the Disputed Domain Name was registered would have revealed to the Respondent the existence of the Complainant’s TED BAKER trademarks, but it appears that the Respondent failed to do so. Having considered the above, the Panel finds that the Disputed Domain Name has been registered in bad faith.

The Respondent was using the Disputed Domain Name to direct Internet users to the website that sells goods similar to the Complainant’s goods at a low price. The website prominently features the Complainant’s TED BAKER trademarks. The website offers no disclosure as to the absence of any relationship between the Complainant and the Respondent. It is evident that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant’s TED BAKER trademarks as to the source, sponsorship, or affiliation of the Respondent’s website. Having considered the above, the Panel finds that the Disputed Domain Name has been used in bad faith.

Having considered the above, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith, and thus the condition of paragraph 4(a)(iii) of the Policy has been fulfilled.

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 <tedbakeroutlets.com> be transferred to the Complainant.

/Peter J. Dernbach/

Peter J. Dernbach

Sole Panelist

Date: May 11, 2022