

ADMINISTRATIVE PANEL DECISION

Stussy, Inc. v. Julius Bergman

Case No. D2022-1153

1. The Parties

The Complainant is Stussy, Inc., United States of America (“United States”), represented by FindFakes, United States.

The Respondent is Julius Bergman, France.

2. The Domain Names and Registrar

The disputed domain names <stussysouthafrica.com> and <stussysouthafricas.com> are registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 2, 2022, with regards the disputed domain name <stussysouthafrica.com>. On April 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 5, 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 April 5, 2022, providing the registrant and contact information disclosed by the Registrar, and requesting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 8, 2022, in which the Complainant requested the addition of the disputed domain name <stussysouthafricas.com> to the Complaint. The Center transmitted by email to the Registrar a request for registrar verification in connection with the additional disputed domain name on April 11, 2022. On April 21, 2022, the Registrar transmitted by email to the Center its verification response confirming that the additional disputed domain name is registered by the Respondent.

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 April 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 13, 2022.

The Center appointed Tuukka Airaksinen as the sole panelist in this matter on May 17, 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 the owner of the trademark STUSSY, registered in many countries, such as in South Africa, under No. 1998/23484. The Complainant has used its trademark since at least 1986 for fashion and clothing goods and related apparel. The Complainant also owns the domain name <stussy.com>.

The disputed domain names were registered on September 17, 2021 (<stussysouthafrica.com>) and on March 17, 2022 (<stussysouthafricas.com>).

5. Parties' Contentions

A. Complainant

The disputed domain names are identical and confusingly similar to the Complainant's trademark STUSSY. As explained below, the Respondent's use and registration of the disputed domain names is confusingly similar to the Complainant's trademark.

The Respondent has no legitimate rights or legitimate interests in the disputed domain names. To the Complainant's best knowledge, the Respondent does not own trademark registrations for STUSSY anywhere in the world.

The Complainant has not licensed or approved the use of its trademark by the Respondent and the disputed domain names are used to allegedly sell the Complainant's goods and services, which does not constitute *bona fide* offering of goods or services or a legitimate noncommercial and fair use of the Complainant's trademark. The Complainant contends that it attempted a purchase via the website at the dispute domain name <stussysouthafrica.com> and despite the successful payment, no goods were ever shipped, illustrating that the Respondent is using the disputed domain names to defraud unsuspecting Internet users. Beginning April 4, 2022, the Complainant alleges that the disputed domain name <stussysouthafricas.com> began redirecting to the other disputed domain name.

The Respondent had knowledge of the Complainant's trademark when registering the disputed domain names. The disputed domain names are used to attract, for commercial gain, Internet users to the Respondent's website by creating likelihood of confusion with the Complainant's trademark.

B. Respondent

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

6. Discussion and Findings

In order to obtain the transfer of a domain name, a complainant must prove the three elements of paragraph 4(a) of the Policy, regardless of whether the respondent files a response to the complaint or not. The first element is that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. The second element a complainant must prove is that the respondent has no rights or legitimate interests in respect of the domain name. The third element a complainant must establish is that the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires that the Complainant establish that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. Consequently, the Complainant must prove that it has rights to a trademark, and that the disputed domain names are identical or confusingly similar to this trademark.

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), “[t]he applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test”.

Furthermore, “[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements”. See section 1.8 of the [WIPO Overview 3.0](#).

The disputed domain names are confusingly similar to the Complainant’s trademark, which is clearly recognizable in the disputed domain names. The addition of the terms “southafrica” and “southafricas” does not prevent the confusing similarity with the Complainant’s trademark.

This means that the disputed domain names are confusingly similar with the Complainant’s trademark and hence the first element of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests to the disputed domain names.

It is widely accepted among UDRP panels that once a complainant has made a *prima facie* case showing the absence of the respondent’s rights or legitimate interests in a disputed domain name, the burden of production shifts to the respondent to come forward with evidence of such rights or legitimate interests. If the respondent fails to do so, the complainant is deemed to have satisfied the second element of the Policy. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#), and section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has credibly submitted that the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register the disputed domain names, that the Respondent has no rights or legitimate interests in the disputed domain names, and that the Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain names and is not commonly known by the disputed domain names in accordance with paragraph 4(c)(ii) of the Policy.

Moreover, the Panel finds that the nature of the disputed domain names carries a risk of implied affiliation with the Complainant's trademark. See section 2.5.1 of the [WIPO Overview 3.0](#). Moreover, the disputed domain names are used for a website that impersonates the Complainant, offer no clarifying information as to its (lack of) relation to the Complainant, and purports to offer for sale the Complainant's trademarked goods. However, based on the Complainant's own experience, such goods are merely meant to lure unsuspecting Internet users into making purchases whereby the users are charged but do not receive said goods. Accordingly, the use of a domain name for illegal activity (e.g., fraud) can never confer rights or legitimate interests upon a respondent.

Accordingly, the Panel finds that the Complainant has made a *prima facie* case that has not been rebutted by the Respondent. Considering the Panel's findings below, the Panel finds that there are no other circumstances that provide the Respondent with any rights or legitimate interests in the disputed domain names. Therefore, the Panel finds that the second element of the Policy is fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant establish that the disputed domain names have been registered and are being used in bad faith. Paragraph 4(b) of the Policy provides 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:

“(i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business or competitor; or

(iv) by using the domain name, [the respondent has] intentionally 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 mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location.”

The disputed domain names are used to host a website that looks like an authorized website of the Complainant or its authorized representative. The website includes the Complainant's logo (trademark STUSSY in a highly stylized form) and its overall impression is that it looks like the Complainant's authorized website. Evidently, the Respondent was aware of the Complainant when it registered the disputed domain names and did so with the clear intent to target the Complainant.

The Complainant's agent made a test buy from the Respondent's website by paying for two different items, but no products were delivered, and no communication was received from the Respondent.

The disputed domain names have been used for a fraudulent website purporting to be affiliated with the Complainant, or to impersonate the Complainant as the Respondent has used the Complainant's trademark and logo at its website. The disputed domain names have therefore been used to attract, for commercial gain Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark.

Therefore, the Panel finds that the third element of the Policy is 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 names, <stussysouthafrica.com> and <stussysouthafricas.com>, be transferred to the Complainant.

/Tuukka Airaksinen/

Tuukka Airaksinen

Sole Panelist

Date: May 26, 2022