

## **ADMINISTRATIVE PANEL DECISION**

Internet Services Australia 1 Pty Ltd v. Qhyue Puyehf

Case No. D2023-1481

### **1. The Parties**

The Complainant is Internet Services Australia 1 Pty Ltd, Australia, represented by Bird & Bird LLP, Australia.

The Respondent is Qhyue Puyehf, Hong Kong, China.

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

The disputed domain name <aeresale.com> is registered with Name.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 5, 2023. On April 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 6, 2023, 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, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 11, 2023, 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 April 18, 2023.

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 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 12, 2023.

The Center appointed Kateryna Oliynyk as the sole panelist in this matter on May 22, 2023. 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 been incorporated in 2011, and provides online retail, shopping and related services in Australia and New Zealand.

In addition to selling a range of products from international brands, the Complainant also sells its own clothing, shoes and accessories under its own private label brands, including the AERE trademark.

The Complainant has registered the AERE trademark and AERE-formative trademarks in many jurisdictions. For example, the Complainant owns the following registrations:

The Complainant relies in particular on the following AERE trademark registrations and applications in support of its action:

- New Zealand Trademark ("NZTM") Registration no. 1154239 for AERE in classes 14, 18, and 25 registered on January 27, 2021;
- NZTM registration no. 1169609 for AERE in classes 3, 4, 16, 20, 21, 24, 27, and 35, registered on July 29, 2021;
- NZTM registration no. 1169611 for AERE HOME in classes 3, 4, 16, 20, 21, 24, 27, and 35, registered on November 2, 2021;
- Australian Trade Mark ("AUTM") application no. 2105434 for AERE in classes 14, 18, and 25, with a priority date of July 22, 2020;
- AUTM application no. 2151914 for AERE in classes 3, 4, 16, 20, 21, 24, 27, and 35, January 28, 2021; and
- AUTM application no. 2151915 for AERE HOME in classes 3, 4, 16, 20, 21, 24, 27, and 35, with a priority date of January 28, 2021.

The disputed domain name was created on March 18, 2022, and resolves to a website purportedly selling the Complainant's products without the Complainant's authorization.

Prior to the filing of the Complaint, the Complainant had already filed a complaint under the Policy against the Respondent in connection with the domain name <shopaere.com>. Pursuant to that complaint, the disputed domain name was ordered by a previous UDRP panel to be transferred to the Complainant. See *Internet Services Australia 1 Pty Ltd v Qhyue Puyehf*, WIPO Case No. [D2022-4024](#).

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

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

###### **Identical or Confusingly Similar**

The Complainant alleges that the disputed domain name is confusingly similar to the AERE trademark which it contains in its entirety with the addition of the generic term "sale". The addition of the word "sale" after the AERE trademark is descriptive and does not detract from the identical or confusing similarity between the disputed domain name and the Complainant's AERE trademark.

#### No rights or legitimate Interests

The Complainant submits that the word “aere” is a coined or invented word that does not have an ordinary English meaning. Therefore, the word “aere” is not a descriptive word and does not describe any fashion or lifestyle products or services.

The Complainant claims that it has not licensed or authorized the Respondent to register or use the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks.

The Complainant submits that the disputed domain name was created long after the Complainant adopted and began using, supplying and offering for sale, goods and services (including shopping services) under the AERE trademark and after the Complainant’s reputation in the AERE trademark was established.

The Complainant contends that the disputed domain name resolves to the website with the look and feel of the Complainant’s official web shop and pretending to offer for sale original products under the AERE trademark.

#### Registered and used in bad faith

The Complainant contends that the disputed domain name has been registered and is being used in bad faith.

The Complainant claims that, by using the disputed domain name, the Respondent is intentionally attempting to attract for commercial gain Internet users to the Respondent’s website under the disputed domain name by creating a likelihood of confusion with the AERE trademark to falsely create the impression that the Respondent’s website and the goods and services being offered on the Respondent’s website under the disputed domain name are actually those of the Complainant or somehow affiliated with the AERE branded goods of the Complainant.

The Complainant further contends that the Respondent has been already engaged in the pattern of conduct of registration of the trademark-abusive domain name, directed at the Complainant.

#### **B. Respondent**

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

#### **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Considering that the Respondent did not reply to the Complainant’s contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel “shall draw such inferences therefrom as it considers appropriate”.

Paragraph 4(a) of the Policy directs that 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 respect of 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**

Under the first element, the Complainant must establish that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

According to section 1.1.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the term "trademark or service mark" as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of [WIPO Overview 3.0](#). The Complainant submitted evidence that the AERE trademark enjoys protection under national trademark registrations. Thus, the Panel finds that the Complainant's rights in the AERE trademark have been established pursuant to the first element of the Policy.

The disputed domain name consists of the Complainant's AERE trademark followed by the term "sale" followed by the generic Top-Level Domain ("gTLD") ".com".

According to section 1.8 of the [WIPO Overview 3.0](#), where 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 may however bear on assessment of the second and third elements.

Under section 1.7 of the [WIPO Overview 3.0](#), while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the gTLD, see section 1.11.1 of the [WIPO Overview 3.0](#).

It is the view of the Panel that it is readily apparent that the Complainant's AERE trademark remains recognizable in the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the AERE trademark in which the Complainant has rights.

The first element of paragraph 4(a) of the Policy is therefore satisfied.

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

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Based on the Complainant's contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its AERE trademark.

The Complainant further contends that the Respondent is not commonly known by the disputed domain name and has not made any *bona fide* use – neither commercial nor non-commercial, of the same.

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The evidence provided by the Complainant shows that the disputed domain name resolves to an active website seemingly impersonating the Complainant by featuring the Complainant's trademark, logo, and copyrighted images of the Complainant's trademarked goods. While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant and similarly, the lack of any accurate and prominent disclosure of the registrant's relationship with the Complainant on the website at the disputed domain name, renders any fair use safe harbor inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#). See also *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); *Pangaea Laboratories Ltd, Pacific Direct Intertrading Pty Ltd v. Astrix Pty Ltd*, WIPO Case No. [DAU2015-0013](#), "Oki Data is an exception to a general rule. The general rule is that it is generally not permissible to register a domain name that is the same as another's trade mark rights, knowing of those trade mark rights, to seek traffic to a commercial website. Oki Data is a narrow exception to this rule for legitimate resellers, distributors and dealers. Oki Data is also subject to any agreement between the parties."

Irrespective of the disputed domain name satisfying the so-called Oki Data test, the nature of the disputed domain name in relation to the Complainant's trademark carries a risk of implied affiliation, especially when considering the impersonating nature of the content exhibited at the disputed domain name, and as such cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain name. In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or a product or service on [respondent's] website or location".

The Respondent clearly knew of the Complainant's business and trademark as the disputed domain name resolves to a website offering products carrying the Complainant's trademark. The nature of the disputed domain name suggests affiliation with the Complainant as it incorporates the Complainant's trademark in full. The use of the term "sale" reinforces the impression of affiliation with the Complainant given the nature of the Complainant's products.

The Panel draws the inference that the disputed domain name featuring the Complainant's AERE trademark and the term "sale" is likely to attract visitors looking for the AERE products. Thus, on arriving at the Respondent's website those visitors or a sufficiently significant proportion of them are likely to believe that they have arrived at a website of or authorized by the Complainant. This impersonation of the Complainant will have been deliberate. The Respondent was clearly concerned to ensure that the visitors with whom they conducted business should think that they were dealing with the Complainant or an entity authorized by the Complainant, when they were not.

In the Panel's view, the use of the disputed domain name for such activity, clearly with a view to commercial gain, amounts to paradigm bad faith registration and use for the purposes of the Policy, paragraph 4(b)(iv).

Accordingly, the Panel finds 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, <aeresale.com>, be transferred to the Complainant.

*/Kateryna Oliinyk/*

**Kateryna Oliinyk**

Sole Panelist

Date: June 22, 2023