

ADMINISTRATIVE PANEL DECISION

Internet Services Australia 1 Pty Ltd v. Ytreho Efrtgh

Case No. D2023-1512

1. The Parties

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

The Respondent is Ytreho Efrtgh, China.

2. The Domain Name and Registrar

The disputed domain name <dazieshop.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 6, 2023. On April 6, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 12, 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 17, 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 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 11, 2023.

The Center appointed Zoltán Takács 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

Founded in 2011 and based in Sidney, Australia, the Complainant operates The Iconic, an online marketplace that enables customers to buy fashion and sports products online.

In addition to selling a range of clothing, shoes, accessories and beauty products from international brands, the Complainant promotes and sells its own clothing, shoes, bags and accessories under its own private label brands, such as DAZIE.

The Complainant among others owns the Australian Trademark Registration No. 1895370 for the word mark DAZIE, registered since December 18, 2017, for clothing, footwear and headgear of class 25 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

The disputed domain name was registered on April 11, 2022, and resolves to a website that substantially copies content from the Complainant's official web pages related to the DAZIE brand (including its trademark, texts and product images) and purports to sell the Complainant's products.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name, which fully incorporates its DAZIE trademark, is confusingly similar to it because the addition of the term "shop" to the trademark in the disputed domain name is not sufficient to distinguish the disputed domain name from its trademark.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant contends that the Respondent's use of its trademark, texts and product images on the website under the disputed domain name shows the Respondent's awareness of its trademark at the time of registration of the disputed domain name, as well as the Respondent's intent to deceive consumers into believing that it is a website run or controlled by the Complainant.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a nationally or regionally registered trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced evidence of having registered rights in the DAZIE trademark and for the purpose of this proceeding the Panel establishes that the Australian Trademark Registration No. 1895370 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name". If the trademark is recognizable in the domain name, the domain name is normally considered confusingly similar to the mark for the purposes of UDRP standing.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the 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.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The disputed domain name incorporates the Complainant's trademark in its entirety and in view of the Panel the addition of the term "shop" to the Complainant's trademark does not prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain name.

The Panel finds that the disputed domain name is therefore confusingly similar to the Complainant's trademark and that the first ground of the Policy is established.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice of the dispute, its use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;

- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), while 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 often impossible 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 the relevant evidence demonstrating its rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant has submitted sufficient and uncontested evidence that it holds well-established rights in the DAZIE trademark and that it has never authorized the Respondent to use its trademark in a domain name or otherwise.

There is no evidence that the Respondent is commonly known by the disputed domain name. Likewise, there is no evidence that the Respondent has prior to any notice of this dispute used or made demonstrable preparations to use the disputed domain name in connection with a legitimate or *bona fide* offering of goods and services or it is making legitimate noncommercial or fair use of the disputed domain name.

As shown by the Complainant, the Respondent is using the disputed domain name to confuse Internet users presumably looking for the Complainant's DAZIE branded products through redirecting them to its own website, which is extensively displaying the Complainant's DAZIE trademark and related imagery and purportedly offers for sale the Complainant's products.

The Respondent has not only failed to respond and disclose its relationship (or lack of thereof) with the Complainant, but is actively impersonating the Complainant. UDRP panels have categorically held that use of a domain name for illegal activity, such as impersonation/passing off, can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- “(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (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’s DAZIE trademark is inherently distinctive for the corresponding goods and the Respondent has reproduced it in the disputed domain name. Furthermore, the Respondent is copying the Complainant’s texts and copyrighted materials at the website under the disputed domain name and purports to sell the Complainant’s DAZIE branded products. Thus, it is clear that the Respondent had actual knowledge of the Complainant’s business and its DAZIE trademark at the time of registration of the disputed domain name and the Panel cannot conceive any other reason for the Respondent’s decision to register the disputed domain name other than to target the Complainant’s business and its DAZIE trademark.

The Respondent is evidently using the disputed domain name to divert Internet traffic intended for the Complainant to its website in order to gain illegitimate profit through impersonation or false association and the Panel finds that the Respondent is intentionally attempting 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 the website at the disputed domain name within the meaning of paragraph 4(b)(iv) of the Policy.

For the reasons set out above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

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 <dazieshop.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: June 5, 2023