

ADMINISTRATIVE PANEL DECISION

Aktieselskabet af 21. November 2001 A/S. v. kuang Tian and Cunfeng Wang
Case No. D2023-1904

1. The Parties

The Complainant is Aktieselskabet af 21. November 2001 A/S., Denmark, internally represented.

The Respondents are kuang Tian, China; and Cunfeng Wang, China.

2. The Domain Names and Registrar

The disputed domain names <jackjonesbootmaker.com> and <jackjoneswear.com> are 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 27, 2023. On April 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 27, 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 May 10, 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 May 15, 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 Respondents of the Complaint, and the proceedings commenced on May 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 11, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondent’s default on June 16, 2023.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on June 21, 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 is part of the Bestseller Group, which is an international fashion company founded in Denmark in 1975. The Group has more than 15,000 employees around the world. Their products are available online, in the branded stores and in wholesale stores across Europe, the Middle East, North America, Latin America, Australia, India and China. The net turnover for the Bestseller Group in 2020/21 was approximately EUR 3.6 billion.

The Complainant is the owner of several trademarks for JACK & JONES ("JACK & JONES trademark"), including:

- International Trademark Registration JACK & JONES No. 967704, registered on June 18, 2008, for several jurisdictions, including Albania, Armenia, Georgia and Republic of Moldova;
- European Union Trademark Registration JACK & JONES No. 001107747, registered on June 14, 2000;
- Danish Trademark Registration JACK & JONES No. VR 1990 06569, registered on September 28, 1990; and
- United States of America Trademark Registration JACK & JONES No. 4336634, registered on May 21, 2013.

The Complainant is also the owner of numerous domain names including the JACK & JONES trademark, such as the domain name <jackjones.com>.

The Respondents registered the disputed domain name <jackjonesbootmaker.com> on October 18, 2022, and <jackjoneswear.com> on November 5, 2022 respectively. At the time of the decision and when the Complaint was filed, the disputed domain names resolve to similar websites which display the JACK & JONES trademark and purportedly offer among others clothing bearing the JACK & JONES trademark for sale.

5. Parties' Contentions

A. Complainant

The arguments put forward by the Complainant can be summarized as follows:

On the first element of the Policy, the Complainant claims that the disputed domain names are confusingly similar to the JACK & JONES trademark. The disputed domain names include the JACK & JONES trademark, or the variation "Jack Jones" hereof, with only the addition of the generic words "bootmaker" or "wear" as well as the generic Top-Level Domain ("gTLD") ".com". The JACK & JONES trademark remains distinguishable in the disputed domain names and the addition of the words "bootmaker" or "wear" do not prevent a finding of confusing similarity.

On the second element of the Policy, the Complainant contends that the Respondents have no rights or legitimate interests in the disputed domain names. The Respondents appear to operate two separate online-clothing shops through websites connected to the disputed domain names. The Respondents use the JACK & JONES trademark by appearing to sell clothing and accessories labelled with the JACK & JONES trademark. The Complainant has not licensed or otherwise permitted the Respondents to use the JACK & JONES trademark nor to register any domain names incorporating the JACK & JONES trademark. Further, there is no business relationship between the Complainant and the Respondents. The Respondents' use of the JACK & JONES trademark on clothing constitutes an infringement. Consequently, the disputed domain names are not being used in connection with a *bona fide* offering of goods.

On the third element of the Policy, the Complainant asserts that the Respondents have registered and used the disputed domain names in bad faith. The Complainant's trademarks predate the registration of the disputed domain names and is further a well-known trademark worldwide. The Respondents do not have the right to use a domain name which incorporates the JACK & JONES trademark. By using the JACK & JONES trademark, the Respondents are benefitting from the good will of the name and trademark established by the work done of the Complainant. Using the Complainant's name and trademarks the Respondents intentionally and in bad faith divert Internet traffic to their own sites for their own commercial gain, thereby potentially depriving the Complainant of visits by Internet users.

B. Respondents

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

6. Discussion and Findings

6.1 Procedural Issue: Consolidation of Multiple Respondents

The Panel has considered the possible consolidation of the Complaint for the disputed domain names. According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2, "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario".

The Panel notes the following features of the disputed domain names and arguments submitted by Complainant in favor of the consolidation of the disputed domain names:

- the nature of the language used on the websites associated with the disputed domain names and the overall setup and design are highly similar;
- the text displayed on the websites associated with the disputed domain names, e.g., "About us", "FAQ", "Returns & Exchanges", "Delivery", "Privacy Policy", "Terms and Conditions", "Payment Method" and "Shipping and Returns") are almost identical;
- the disputed domain names were registered with the same Registrar and their registration dates are only a few days different;
- the disputed domain names were registered using the same privacy service;
- the email addresses of the Respondents all use "huanmaill.com".

In view of the above, the Panel finds that it is more likely than not that the disputed domain names are subject to the common control, and consolidation of the multiple registrants is fair to the Parties. Further, the Respondents have not objected to the Complainant's request for consolidation. Therefore, the Panel grants the consolidation as requested by the Complainant, and will refer to these Respondents as the "Respondent".

6.2 Substantive Matters

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".

It has been a consensus view in previous UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of the "[WIPO Overview 3.0](#)").

The 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 disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Complainant, under the first requirement of paragraph 4(a)(i) of the Policy, needs to establish that the disputed domain names are identical or confusingly similar to a trademark or a service mark in which it has rights.

The Complainant is the owner of several registered trademarks containing JACK & JONES. Suitable evidence was submitted. Consequently, the Panel finds that the Complainant has proven that it has rights in the JACK & JONES trademark.

The disputed domain names contain the entirety of the JACK & JONES trademark (save for the ampersand sign) with the addition of the terms “bootmaker” or “wear” as well as the gTLD “.com”. Section 1.8 of the [WIPO Overview 3.0](#) states: “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(s) may however bear on assessment of the second and third elements.” Further, section 1.11.1 of the [WIPO Overview 3.0](#) states: “The applicable 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”. The gTLD “.com” will therefore be disregarded in the Panel’s consideration of confusing similarity.

The Panel finds that the relevant trademark JACK & JONES is recognizable within the disputed domain names and that the terms “bootmaker” or “wear” do not prevent a finding of confusing similarity.

For the reasons above, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The second element the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain names.

Regarding the second element of the Policy, section 2.1 of the [WIPO Overview 3.0](#) states, “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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element”. In this case, the Respondent did not reply to the Complainant’s contentions.

According to the Complaint, the Complainant has not authorized the Respondent to use the JACK & JONES trademark and the Respondent has not used the disputed domain names for a legitimate noncommercial or fair use, nor used them in connection with a *bona fide* offering of goods or services. Furthermore, there is no indication that the Respondent is commonly known under the disputed domain names and the Respondent has not attempted to justify why the disputed domain names were registered. Moreover, the Panel finds that the composition of the disputed domain names, adding the terms “bootmaker” or “wear” to the JACK &

JONES trademark, coupled with the use of the disputed domain names redirected to similar websites, under which the JACK & JONES trademarks are displayed and clothing among others bearing the JACK & JONES trademark are promoted, affirms the Respondent's intention of taking unfair advantage of the likelihood of confusion between the disputed domain names and the Complainant, as to the origin or affiliation of the websites at the disputed domain names.

Accordingly, the Panel finds that the Complainant has made a *prima facie* showing of the Respondent's lack of rights or legitimate interests in respect of the disputed domain names, which has not been rebutted by the Respondent. The Panel therefore finds that the Complainant has established the second element of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that the Complainant demonstrate that the Respondent registered and is using the disputed domain names in bad faith. Section 3.1 of the [WIPO Overview 3.0](#) states, "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark". Section 3.2.2 of the [WIPO Overview 3.0](#) reads: "Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

Considering the reputation and public presence of the Complainant, it is unlikely that the Respondent had no knowledge of the JACK & JONES trademark. The incorporation of the JACK & JONES trademark within the disputed domain names as well as the fact that the disputed domain names redirect to similar websites, under which the JACK & JONES trademarks are displayed and clothing among others bearing the JACK & JONES trademark are promoted, demonstrates the Respondent's actual awareness of the Complainant trademark, and its intent to target the Complainant. In light of the lack of any rights to or legitimate interests in the disputed domain names by the Respondent and in the absence of any conceivable good faith use, the Panel finds from the present circumstances that the Respondent has intentionally attempted to attract Internet users to its websites or affect the commercial activities of the Complainant by creating a likelihood of confusion with the Complainant's trademarks.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 names <jackjonesbootmaker.com> and <jackjoneswear.com> be transferred to the Complainant.

/Christian Gassauer-Fleissner/

Christian Gassauer-Fleissner

Sole Panelist

Date: July 5, 2023