

ADMINISTRATIVE PANEL DECISION

Robinson Webster (Holdings) Limited v. Dbfq Rbggf and HeMengyu Case No. D2023-2023

1. The Parties

The Complainant is Robinson Webster (Holdings) Limited, United Kingdom, represented by Day Pitney LLP, United States of America (“United States”).

The Respondents are Dbfq Rbggf, Hong Kong, China, and HeMengyu, China.

2. The Domain Names and Registrars

The disputed domain name <jigsawsale.com> is registered with Name.com, Inc. (the “First Registrar”). The disputed domain name <fashionjigsaw.com> is registered with OwnRegistrar, Inc. (the “Second Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 5, 2023. On May 8, 2023, the Center transmitted by email to the First Registrar a request for registrar verification in connection with the disputed domain name <jigsawsale.com>. On May 9, 2023, the First Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain name <jigsawsale.com> 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 the first amended Complaint on the same date.

The Center verified that the Complaint together with the first 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 Dbfq Rbggf of the Complaint, and the proceedings commenced on May 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 12, 2023. The Respondent 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 July 7, 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.

On July 13, the Complainant informed the Center that the disputed domain name <jigsawsale.com> was redirecting to the disputed domain name <fashionjigsaw.com> and requested that this second disputed domain name be added to the Complaint. On July 14, 2023, the Complainant filed a second amended Complaint in which it added the disputed domain name <fashionjigsaw.com>. On July 17, 2023, the Center transmitted by email to the Second Registrar a request for registrar verification in connection with the additional disputed domain name. On July 18, 2023, the Second Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the additional disputed domain name which differed from the named Respondent (Own Registrar, Inc.) and contact information in the second amended Complaint. The Second Registrar disclosed the Respondent HeMengyu as the registrant of the disputed domain name <fashionjigsaw.com>. The Complainant filed a third amended Complaint on July 18, 2023.

On July 21, 2023, the Panel issued Procedural Order No. 1 in which it invited the Respondent for the disputed domain name <fashionjigsaw.com> to make any submissions regarding the Complainant's request for consolidation, and to file a Response in respect of the additional disputed domain name as it may deem appropriate. The Respondent did not undertake any of these actions.

4. Factual Background

The Complainant is a fashion-clothing retailer based in United Kingdom with store and concession partners across United Kingdom, Ireland, the Kingdom of Netherlands, and Australia as well as world-wide online sales of "JIGSAW" branded products.

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

- United States Trademark Registration JIGSAW No. 2992736, registered on September 6, 2005;
- United States Trademark Registration JIGSAW No. 2718338, registered on May 27, 2003;
- European Union Trade Mark Registration JIGSAW No. 000642553, registered on March 17, 1999;
and
- China Trademark Registration JIGSAW No. 14250071, registered on August 14, 2015.

The Complainant is also owner of domain names including the JIGSAW trademark, such as the domain name <jigsaw-online.com>.

The disputed domain name <jigsawsale.com> was registered on July 15, 2022, and the disputed domain name <fashionjigsaw.com> was registered on July 11, 2023. At the time of the decision and when the amended Complaint was filed, the disputed domain name <jigsawsale.com> redirected to the disputed domain name <fashionjigsaw.com>, resulting in a website displaying the JIGSAW trademark and content from the Complainant's website as well as offering clothing. Prior to such redirection, the website under the disputed domain name <jigsawsale.com> included nearly identical content.

5. Parties' Contentions

A. Complainant

On the first element of the Policy, the Complainant claims that the disputed domain names are confusingly

similar to the JIGSAW trademark. The disputed domain names incorporate the JIGSAW trademark in its entirety. The added terms “sale” or “fashion” do nothing to distinguish or eliminate the confusing similarity, as the term “jigsaw” is the dominant portion of the disputed domain names.

On the second element of the Policy, the Complainant contends that the Respondents have no rights or legitimate interests in respect of the disputed domain names. The Complainant has prior rights in the JIGSAW trademark, which precede the Respondents’ registration of the disputed domain names by several decades. The Respondents are not affiliated with or authorized by the Complainant to use the JIGSAW trademark in connection with the sale of apparel and accessories. Therefore, the Respondents’ offer to sell potentially counterfeit products bearing the JIGSAW trademark, using photographs owned by and taken from the Complainant, while claiming ownership of all “website design, text, logos, graphics, icons and images, and the selection that appear on this website” will inevitably lead consumers arriving at the disputed domain names to believe that the websites at the disputed domain names are affiliated or endorsed by the Complainant or that they belong to the Complainant. Such use of a third party mark to confuse and misdirect consumers into believing that the websites may be affiliated or endorsed by the Complainant or that they belong to the Complainant cannot be considered a *bona fide* offering of goods or services. Upon information and belief, the Respondents do not own any trademark or service mark rights in the name “JIGSAW” and is not been commonly known by the disputed domain names. The Respondents’ registration and use of the disputed domain names cannot be considered “fair use” as it falsely suggests affiliation with the Complainant and the Complainant’s JIGSAW trademark. In addition, the composition of the disputed domain names alone can create a risk of implied affiliation with the Complainant.

On the third element of the Policy, the Complainant asserts that the Respondents registered and used the disputed domain names in bad faith. The Respondents registered the disputed domain names decades after the Complainant established its trademark rights and did so with the bad faith intention of profiting off the Complainant’s reputation and goodwill. The Respondents’ actions are clearly calculated to capitalize on the reputation of the Complainant’s trademark by diverting Internet users seeking “JIGSAW” branded products to the Respondents’ websites for financial gain by holding itself out to be the Complainant or an official website of the Complainant, selling apparel and accessories under the JIGSAW trademark, which appears both in the disputed domain names and prominently on the websites to which the disputed domain names resolve, in an identical stylization to the JIGSAW stylized mark and posting photographs owned by and taken from the Complainant to advertise the Complainant’s products for sale, without any indication of the Respondents’ relationship to the Complainant. These factors clearly demonstrate bad faith by the Respondents. The Respondents’ failure to respond to the Complainant’s demand letter is further evidence of bad faith. Additionally, the Respondents’ actions in redirecting the disputed domain name <jigsawsale.com> after the initiation proceeding is also clear evidence of bad faith on the part of the Respondents and intent to frustrate the instant proceedings. Finally, the Respondents’ lack of any contact information at the websites to which the disputed domain names resolve, other than “jigsawsale@[...].com”, which does not appear to be a legitimate operational email address displays an intent to conceal the Respondents’ identity from the Complainant.

B. Respondents

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

6. Discussion and Findings

6.1 Consolidation of Respondents

The Panel has considered the possible consolidation of the Complaint for multiple Respondents. According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.11.2, “[w]here 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. Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s)."

The Panel notes *inter alia* the following features of the disputed domain names for the consolidation of the Respondents:

- the disputed domain name <jigsawsale.com> redirects to the disputed domain name <fashionjigsaw.com>;
- the redirection of the disputed domain name <jigsawsale.com> followed the notification of the Complaint to the Respondent Dbfg Rbggf;
- the content displayed on the website under the disputed domain name <fashionjigsaw.com> is nearly identical to that previously displayed on the website under the disputed domain name <jigsawsale.com> as well as both websites contain(ed) the same contact information; and

both of the disputed domain names contain the JIGSAW trademark in its entirety in combination with a descriptive term.

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 Respondents 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 [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 registered as the owner of several trademarks for JIGSAW. Suitable evidence was submitted. Consequently, the Panel finds that the Complainant has proven that it has rights in the JIGSAW trademark.

The disputed domain names contain the JIGSAW trademark entirely with the addition of the term “sale” or “fashion” as well as the generic Top-Level Domain “.com”. Section 1.8 of [WIPO Overview 3.0](#) states: “[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.” Further, section 1.11.1 of [WIPO Overview 3.0](#) states: “[t]he 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 discounted in the Panel’s consideration of confusing similarity.

The Panel finds that the JIGSAW trademark within the disputed domain names is recognizable, so that the terms “sale” and “fashion” 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 [WIPO Overview 3.0](#) states, “[w]here 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 JIGSAW trademark, the Respondent is not commonly known by the disputed domain names, and the Respondent has not used the disputed domain names for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Further, the Respondent has not attempted to justify why the disputed domain names were registered.

In addition, the Complainant suspects that the Respondent sells counterfeit products but omits to state arguments and provide evidence showing why the products sold by the Respondent are counterfeits. While some circumstantial evidence, such as the significant, unusual discount prices, tends to suggest the Respondent is offering counterfeit products, the Panel needs not come to a final determination on this matter. In any event, the Panel finds that the composition of the disputed domain names, adding the terms “sale” or “fashion” to the JIGSAW trademark, coupled with the use of the disputed domain name <jigsawsale.com> redirecting to <fashionjigsaw.com> resulting in a website displaying the JIGSAW trademark and content from the Complainant’s website as well as offering clothing, 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. That the

Respondent is not using the disputed domain names for any legitimate noncommercial or fair use, nor in connection with a *bona fide* offering of goods or services, is also confirmed by the fact that the websites accessible under the disputed domain names includes or included the wrong and misleading information that the content, such as text or images, available there is the exclusively property of the Respondent, whereas part of it is content from the Complainant's website.

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 the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that the Complainant demonstrates that the Respondent registered and is using the disputed domain names in bad faith. Section 3.1 of [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: "[n]oting 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 JIGSAW trademark at the time of registration of the disputed domain names. The incorporation of the JIGSAW trademark within the disputed domain names as well as the fact that the disputed domain names redirects or redirected to a website, under which the JIGSAW trademark and content from the Complainant's website is displayed and further clothing is offered, demonstrates the Respondent's actual awareness of and intent to target the Complainant. Moreover, the Respondent's actions in redirecting the disputed domain name <jigsawsale.com> after the initiation of the UDRP proceeding are also indicative of frustrating or interfering with the proceeding and thus of the Respondent's bad faith. 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 for commercial gain 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, <jigsawsale.com> and <fashionjigsaw.com>, be transferred to the Complainant.

/Christian Gassauer-Fleissner/
Christian Gassauer-Fleissner

Sole Panelist

Date: August 4, 2023