

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. Allan Molina,
Muhammad Adaya
Case No. D2023-2731

1. The Parties

Complainant is No Ordinary Designer Label Limited t/a Ted Baker, United States of America, represented by Authentic Brands Group, United States of America.

Respondent is Allan Molina, Muhammad Adaya, United States of America.

2. The Domain Names and Registrar

The disputed domain names <tedbakersingapore.com> and <tedbaker-uk.com> are registered with Gransy, s.r.o. d/b/a subreg.cz (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 26, 2023. On June 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 28, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to Complainant on July 3, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 5, 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 Respondent of the Complaint, and the proceedings commenced on July 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 27, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on August 2, 2023.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on August 4, 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

Complainant is the owner of registrations for the trademark TED BAKER on the register of the United Kingdom Intellectual Property Office (UK IPO), including registration number UK00003250250, registration dated December 29, 2017, in international classes (ICs) 3, 4, 8, 9, 11, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 28, 35, 41, 43, and 44, covering, *inter alia*, textiles and clothing, leather goods, cosmetic and skin care products; registration number UK00002320837, registration dated August 15, 2003, in ICs 3, 9, 14, 18, 20, 21, 24, and 25, covering, *inter alia*, perfumes, jewelry, leather goods and clothing; registration number UK00911370467, registration dated April 12, 2013, in IC 18; registration number UK00905210661, registration dated April 25, 2007, in IC 35, and; registration number UK00910245827, registration dated January 11, 2012, in ICs 3, 9, 14, 18 and 25. Complainant is also owner of registration of the trademark TED BAKER on the register of the Intellectual Property Office of Singapore, registration number T03/00247E, registration dated January 13, 2003, in IC 25, covering articles of clothing.

Complainant is a manufacturer and seller of apparel, accessories, footwear, houseware and beauty products. Complainant asserts ownership of more than 500 trademarks globally. Complainant states that it spends millions of dollars marketing its goods and services globally, and that it maintains strict quality control measures over goods and services offered in connection with its trademark. Complainant operates a commercial website generally accessible at “www.tedbaker.com”, with subdirectories for different geographic areas.

According to the Registrar’s verification, Respondent Allan Molina is registrant of the disputed domain name <tedbakersingapore.com>. According to a Whois search record provided by Complainant, the creation date for this disputed domain name was March 30, 2022. According to the Registrar’s verification, Respondent Muhammad Adaya is registrant of the disputed domain name <tedbaker-uk.com>. According to a Whois search record provided by Complainant, the creation date for this disputed domain name was March 28, 2022. There is no indication on the record of this proceeding that any party other than Respondent has owned or controlled the disputed domain names since their creation dates.

According to information furnished by Complainant, the hosting service provider for the two disputed domain names is identical, *i.e.* Fibergrid, based in Riga, Latvia. Both disputed domain names are associated with IP addresses beginning with “196.196.52...” The Registrar of the two disputed domain names is the same.

The Rules, paragraph 3(c) provide that “[t]he complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.” Practice of the Center permits a complainant to provide evidence that named respondents are the same entity and/or that the disputed domain names are under common control.

In the present case, the disputed domain names were registered within two days of each other, with the same Registrar, and with the named registrants using the same hosting service based in Latvia. The websites (see below) associated with the disputed domain names use a substantially identical format, and are directed to the same purpose. Neither of the physical addresses of the registrants of the disputed domain names appears to be valid. Based on these circumstances, the Panel is satisfied that the two disputed domain names are under the common control of a single entity, and that Complainant may proceed against Respondent as a single entity.

The disputed domain names each are directed to substantially identical homepages using as the header the trademark TED BAKER, with the geographic identifier "London" immediately underneath. It is the same design used by Complainant on its commercial website. Each of the homepages associated with the disputed domain names includes a model posing in a photograph and an identical "SHOP NOW" button. According to Complainant, the websites operated by Respondent have been used to offer and sell "competing and unauthorized goods". Complainant has not provided direct evidence of merchandise sales through those websites.

5. Parties' Contentions

A. Complainant

Complainant alleges that it owns rights in the trademark TED BAKER and the disputed domain names are identical or confusingly similar to that trademark.

Complainant alleges that Respondent lacks rights or legitimate interests in the disputed domain names because: (1) Complainant has not licensed or otherwise authorized Respondent to use its trademark in the disputed domain names or otherwise; (2) there is no evidence that Respondent is using or plans to use Complainant's trademark in the disputed domain names or otherwise for a *bona fide* offering of goods or services, and; (3) Respondent has used the disputed domain names to promote its website for illegitimate commercial gains and in a way likely to trick consumers into believing that Respondent is affiliated with Complainant.

Complainant contends that Respondent registered and is using the disputed domain names in bad faith because: (1) Respondent must have been aware of Complainant's trademark when it registered the disputed domain names; (2) Respondent registered the disputed domain names long after Complainant acquired rights in its trademark; (3) Respondent used a privacy shield, and; (4) Respondent is "trying to pass off the [disputed domain names] as the Complainant's website to sell competing and unauthorized goods." Therefore Respondent is using Complainant's trademark in the disputed domain names to create a likelihood of confusion as to Complainant serving as source, sponsor, affiliate or endorser of Respondent's websites.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain names to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

The registration agreement between Respondent and the Registrar subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, one of which is the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical address provided in its record of registration. Courier delivery of the Written Notice to Respondent could not be completed because of inaccurate address information in the record of registration. There is no indication of problems with the transmission of email to Respondent. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

A. Identical or Confusingly Similar

Complainant has provided evidence of rights in the trademark TED BAKER, including by registration at the UK IPO and the Intellectual Property Office of Singapore, and through use in commerce. Respondent has not challenged Complainant's assertion of rights. The Panel determines that Complainant owns rights in the TED BAKER trademark.

The disputed domain names directly and fully incorporate Complainant's TED BAKER trademark. This is sufficient to establish confusing similarity between Complainant's trademark and the disputed domain names within the meaning of the Policy. Addition by Respondent of "singapore" to Complainant's trademark in one of the disputed domain names, and addition by Respondent of "-uk" to Complainant's trademark in the other, does not prevent a finding of confusing similarity as to either of the disputed domain names.¹

The Panel determines that Complainant owns rights in the trademark TED BAKER, and that the disputed domain names are each confusingly similar to that trademark.

B. Rights or Legitimate Interests

Complainant's allegations to support Respondent's lack of rights or legitimate interests in the disputed domain names are outlined above, and the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain names.

Respondent has not replied to the Complaint and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

Respondent has used the disputed domain names to direct Internet users to websites using the same design used by Complainant on its commercial website. Each of the homepages associated with the disputed domain names includes a model posing in a photograph and a "SHOP NOW" button. According to Complainant, the websites associated with the disputed domain names are being used to sell unauthorized and/or counterfeit goods. Respondent has not sought to challenge the evidence submitted by Complainant.

¹ Use of the generic top level domain ".com" in these circumstances is not relevant to the Panel's assessment of confusing similarity.

Such activity by Respondent does not establish rights or legitimate interests because Respondent is making use of Complainant's trademark to identify Respondent as source of similar products without Complainant's consent.

Respondent is not making a *bona fide* offering of goods or services. Respondent's use of Complainant's trademark to deceptively represent itself as Complainant is not fair or legitimate noncommercial use of Complainant's trademark. It is not authorized by Complainant, and it is likely to damage Complainant's reputation.

Respondent's actions do not otherwise manifest rights or legitimate interests in the disputed domain names.

The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

In order to prevail under the Policy, Complainant must demonstrate that the disputed domain names "ha[ve] been registered and is being used in bad faith" (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy states that "for the purposes of paragraph 4(a)(iii), 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". These include that, "(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".

Respondent registered and used the disputed domain names that are confusingly similar to Complainant's TED BAKER trademark after Complainant acquired rights in its trademark, and likewise after Complainant established a substantial online presence under its trademark. Respondent has directly incorporated Complainant's TED BAKER branding on its website and has deliberately designed its website to appear as if it is affiliated with Complainant. Respondent knew or should have known of Complainant's trademark rights when it registered and used the disputed domain names.

Respondent has used the disputed domain names to direct Internet users to websites that are designed to convey the appearance that they are operated by or affiliated with Complainant. Each of the homepages associated with the disputed domain names includes a model posing in a photograph and a "SHOP NOW" button. Given the reuse by Respondent of distinctive elements of Complainant's website, Respondent was specifically seeking to take advantage of Internet user association with Complainant's branding to direct traffic to Respondent's websites.

Whether Respondent has shipped products to Internet users (which is unclear from the record) is not material in the context of this proceeding to a determination of bad faith. Without authorization from Complainant, Respondent is holding itself out to be associated with Complainant. It is operating under false pretenses in a manner likely to injure Complainant.

Such activities on the part of Respondent are undertaken for commercial gain to create Internet user confusion regarding Complainant acting as the source, sponsor, affiliate or endorser of Respondent's deceptive websites.

The Panel determines that Respondent registered and is using the disputed domain names in bad faith within the meaning of paragraph 4(b)(iv) 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, <tedbakersingapore.com> and <tedbaker-uk.com> be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: August 18, 2023