

## ADMINISTRATIVE PANEL DECISION

C. & J. Clark International Ltd v. Client Care, Web Commerce Communications Limited  
Case No. D2022-0813

### 1. The Parties

The Complainant is C. & J. Clark International Ltd, United Kingdom (“UK”), represented by SafeNames Ltd., UK.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

### 2. The Domain Names and Registrar

The disputed domain names <clarksaustraliastores.com>, <clarksblackfridaysale.com>, <clarkscanadastore.com>, <clarksdanmarkudsalg.com>, <clarksfactoryoutlet.com>, <clarksirelandoutlet.com>, <clarksmalaysiaonline.com>, <clarksnlnederland.com>, <clarksoutletfactory.com>, <clarksoutletonlineireland.com>, <clarksretailstore.com>, <clarksshoesphilippines.com>, <clarkssingaporeoutlet.com>, <clarkssverigewebshop.com>, <clarksturkeyonline.com>, and <lojasclarksportugal.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

### 3. Procedural History

The Complaint<sup>1</sup> was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 8, 2022. On March 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 10, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on March 11, 2022 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 March 15, 2022.

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

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<sup>1</sup> The Complaint originally involved 17 domain names, one of which was removed from the proceedings by the Complainant.

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 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 6, 2022.

The Center appointed William R. Towns as the sole panelist in this matter on May 12, 2022. 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 an international shoe manufacturer and retailer founded in the UK in 1825. The Complainant has traded under the CLARKS brand for many years, and today operates not only in the UK but also in 500 branded stores and franchises in the United States of America (“United States”), Europe, the Pacific, and Asia. The Complainant’s CLARKS brand is well known and has been associated with other major brands such as Disney and Marvel, and featured in recognized publications including GQ, Esquire, and Vogue.

The Complainant has registered its CLARKS brand in various jurisdictions including the UK, United States, and European Union (EUTM), and through the Madrid System, as follows:

CLARKS – UK Reg. No. UK0000504405A, filed July 11, 1929, with a registration date of July 11, 1929;

CLARKS – United States Reg. No. 0691307, applied for February 2, 1959, and registered January 12, 1960 (first use in commerce 1947);

CLARKS – EUTM Reg. No. 000167940, filed April 1, 1996, and registered July 16, 1998;

CLARKS (stylized) – EUTM Reg. No. 000167916, filed April 1, 1996, and registered July 16, 1998;

CLARKS (stylized) – International Trademark Reg. No. 1278277, registered August 10, 2015 (Madrid Protocol).

The disputed domain names were registered on various dates between October 7 and December 15, 2021. The record reflects that 14 of the 16 disputed domain names have been used with websites seeking to impersonate the Complainant and purportedly offering to sell online CLARKS shoes and footwear. Two of the other disputed domain names do not appear to resolve to active websites. The Respondent has not included on its websites any disclaimer respecting the lack of any relationship with the Complainant.

#### **5. Parties’ Contentions**

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

The Complainant submits that the disputed domain names <clarksaustraliastores.com>, <clarksblackfridaysale.com>, <clarkscanadastore.com>, <clarksdanmarkudsalg.com>, <clarksfactoryoutlet.com>, <clarksirelandoutlet.com>, <clarksmalaysiaonline.com>, <clarksnl nederland.com>, <clarksoutletfactory.com>, <clarksoutletonlineireland.com>, <clarksretailstore.com>, <clarksshoesphilippines.com>, <clarkssingaporeoutlet.com>, <clarkssverigewebshop.com>, <clarksturkeyonline.com>, and <lojasclarksportugal.com> are each confusingly similar to the Complainant’s distinctive and well-known CLARKS mark.

The Complainant maintains that the Complainant's registered CLARKS mark is clearly recognizable in the disputed domain names, emphasizing that the inclusion of additional geographical and descriptive terms, whether pejorative, meaningless or otherwise, does not preclude a finding of confusing similarity under the first element of the Policy. Further, according to the Complainant, the additional geographical and descriptive terms in the disputed domain names engender clear connotations to the sale of the Complainant's CLARKS shoes across multiple jurisdictions.

The Complainant contends that the Respondent lacks rights or legitimate interests in respect of the disputed domain names. The Complainant represents that the Respondent has not been authorized or otherwise permitted to license, register or use the disputed domain names. According to the Complainant, the 14 disputed domain names that resolve to the websites prominently display the Complainant's CLARKS mark. The Complainant represents that the Respondent has not been commonly known by any of the disputed domain names, that the Respondent prior to any notice of this disputed has neither used nor made demonstrable preparations to use the disputed domain names in connection with a *bona fide* offering of goods or services, and that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names.

The Complainant maintains that the Respondent registered and is using disputed domain names in bad faith. According to the Complainant, the Respondent has sought to capitalize on the reputation of the Complainant's well-known CLARKS mark, diverting Internet users seeking the Complainant's products to the Respondent's websites, seeking to impersonate the Complainant on the websites resolved from the 14 disputed domain names, and creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation, or endorsement of its websites and the goods offered or sold thereon. The non-use of the remaining two disputed domain names, under the circumstances of this case, also constitutes bad faith under the doctrine of passive holding.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Scope of the Policy**

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. [D2002-0774](#). Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain names", also known as "cybersquatting". *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. [D2000-0187](#). See Final Report of the First WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169-177. The term "cybersquatting" is most frequently used to describe the deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks or service marks. *Id.* at paragraph 170. Paragraph 15(a) of the Rules provides that the panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the panel deems applicable.

Paragraph 4(a) of the Policy requires that the complainant prove each of the following three elements to obtain a decision that a domain name should be either cancelled or transferred:

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

Cancellation or transfer of the domain name is the sole remedy provided to the complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the view is that the burden of production shifts to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a *prima facie* showing. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.1. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

## **B. Identical or Confusingly Similar**

The Panel finds that the disputed domain names are confusingly similar to the CLARKS mark, in which the Complainant has demonstrated rights through registration and use. In considering identity and confusing similarity, the first element of the Policy serves essentially as a standing requirement.<sup>2</sup> The threshold inquiry under the first element of the Policy involves a relatively straightforward comparison between the complainant’s trademark and the disputed domain name.

The Complainant’s CLARKS mark is clearly recognizable in each of the disputed domain names.<sup>3</sup> The first element 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 disputed domain name.<sup>4</sup> Applying this comparison, the Complainant’s mark is recognizable.<sup>5</sup> When the relevant trademark is recognizable in the disputed domain names, the addition of other terms does not preclude a finding of confusing similarity under paragraph 4(a)(i) of the Policy.<sup>6</sup> Further, the inclusion in the disputed domain names of geographical, meaningless, or descriptive words such as – for example, “australia”, “malaysia”, “singapore”, “ireland”, and “portugal” (emphasis added) – does not prevent a finding of the confusing similarity between the disputed domain names and the Complainant’s mark.<sup>7</sup>

When at least a dominant feature of the relevant trademark is recognizable in the disputed domain names, the domain names will normally be considered confusingly similar to that mark for purposes of UDRP standing.<sup>8</sup> See *Autodesk, Inc. v. Brian Byrne, meshIP, LLC*, WIPO Case No. [D2017-0191](#) (addition in disputed domain names <autocadcloud.com> and <hostedautocad.com> of descriptive words “cloud” and “hosted” does not prevent confusing similarity). See, e.g., *National Association for Stock Car Auto Racing, Inc. v. Racing Connection / The Racin’ Connection, Inc.*, WIPO Case No. [D2007-1524](#).

Top-Level Domains (“TLDs”), in this case “.com”, generally are disregarded in determining identity or confusing similarity under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the TLD.<sup>9</sup>

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<sup>2</sup> See [WIPO Overview 3.0](#), section 1.7.

<sup>3</sup> *Id.* When the relevant trademark is recognizable in the disputed domain name, the domain name normally will be considered confusingly similar to the mark for purposes of paragraph 4(a)(i) of the Policy.

<sup>4</sup> *Id.*

<sup>5</sup> See [WIPO Overview 3.0](#), section 1.8 and cases cited therein.

<sup>6</sup> *Id.*

<sup>7</sup> See [WIPO Overview 3.0](#), section 1.8 and cases cited therein. The addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy.

<sup>8</sup> See [WIPO Overview 3.0](#), section 1.7 and cases cited therein.

<sup>9</sup> See [WIPO Overview 3.0](#), section 1.11 and cases cited therein.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

### C. Rights or Legitimate Interests

As noted above, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, the burden of production shifts to the respondent to come forward with evidence of rights or legitimate interests in a domain name. The Panel is persuaded from the record of this case that a *prima facie* showing under paragraph 4(a)(ii) of the Policy has been made. It is undisputed that the Respondent has not been authorized to use the Complainant's CLARKS mark. Regardless, the Respondent has registered multiple disputed domain names appropriating the Complainant's CLARKS mark, and has pointed the 14 disputed domain names to websites prominently displaying the Complainant's CLARKS mark and logo, purportedly offering for sale online the Complainant's branded CLARKS products. Insofar as the record reflects, the Respondent has not included on its websites any disclaimer as to their lack of relationship with the Complainant. The remaining two disputed domain names do not resolve to any active websites.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain names by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent has been commonly known by the disputed domain names, even if it has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent has not submitted any response to the Complaint, in the absence of which the Panel may accept all reasonable inferences and allegations in the Complaint as true. See *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#). Regardless, the Panel has carefully reviewed the record in this case, and finds nothing therein that would bring the Respondent's registration and use of the disputed domain names within any of the "safe harbors" of paragraph 4(c) of the Policy.

It is evident to the Panel that the Respondent was aware of the Complainant and had the Complainant's CLARKS mark in mind when registering the disputed domain names, each of which is confusingly similar to the Complainant's mark. To the extent the Respondent might claim to be making a fair use of the disputed domain names, any reliance by the Respondent on decisions such as *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (hereinafter "*Ok! Data*") would be misplaced. Fundamentally, a respondent's use of a domain name would not be considered "fair" if it falsely suggests affiliation with the trademark owner, and UDPR panels generally have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1. The use of a domain name cannot be "fair" if it suggests a non-existent affiliation with the trademark owner; nor can such use be "fair" if it is pretextual. See *201 Folsom Option JV, L.P. and 201 Folsom Acquisition, L.P. v. John Kirkpatrick*, WIPO Case No. [D2014-1359](#); *Project Management Institute v. CMN.com*, WIPO Case No. [D2013-2035](#).

As previously noted, the Respondent insofar as the record reflects has made no effort to prominently and accurately disclose its relationship if any to the Complainant. Internet users anticipating the Complainant's website but arriving instead at one or more of the Respondents' websites (to which the multiple disputed domain names resolve) would be likely to anticipate that the websites they have arrived at are affiliated with, endorsed or otherwise sponsored by the Complainant. See *Levantur, S.A. v. Media Insight*, WIPO Case No. [D2008-0774](#).

Having regard to all of the relevant circumstances in this case, and absent any explanation by the Respondent, the Panel concludes that the Respondent has neither used nor made demonstrable preparations to use the disputed domain names in connection with a *bona fide* offering of goods or services within the contemplation of paragraph 4(c)(i) of the Policy. See *Autodesk, Inc. v. Brian Byrne, meshIP, LLC*, WIPO Case No. [D2017-0191](#). Further, and for the reasons discussed above, the Panel holds that the Respondent has not made a legitimate noncommercial or fair use of the disputed domain names. As previously noted, the Respondent has not been authorized to use the Complainant's CLARKS mark, and the Panel has found no indication in the record that the Respondent has been commonly known by any of the disputed domain names within the meaning of paragraph 4(c)(ii) of the Policy.

In short, nothing in the record before the Panel would support a claim by the Respondent of rights or legitimate interests in the disputed domain names. Furthermore, the Panel finds that the nature of the disputed domain names, comprising the Complainant's CLARKS mark in its entirety in combination with additional terms, carries a risk of implied affiliation and cannot constitute a fair use as they effectively impersonate the Complainant or otherwise suggest sponsorship or endorsement by the Complainant.<sup>10</sup>

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the Respondents' documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its 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 its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

For the reasons discussed under this and the preceding heading, the Panel considers that the Respondent's conduct in this case constitutes bad faith registration and use of the 14 disputed domain names within the meaning of paragraph 4(b)(iv) of the Policy. The Panel also considers that the non-use of the remaining two disputed domain names, under the circumstances of this case, constitutes bad faith registration and use under the doctrine of passive holding. See [WIPO Overview 3.0](#), section 3.3. The record is convincing that the Respondent had the Complainant's CLARKS mark firmly in mind when registering the disputed domain

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<sup>10</sup> See [WIPO Overview 3.0](#), section 2.5.1 and cases cited therein.

names. The Respondent's registration and use of multiple disputed domain names appropriating the Complainant's CLARKS mark as set forth above clearly is demonstrative of bad faith in the attendant circumstances of this case.

Moreover, panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

The Panel thus 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 identified below be transferred to the Complainant:

<clarksaustraliastores.com>, <clarksblackfridaysale.com>, <clarkscanadastore.com>, <clarksdanmarkudsalg.com>, <clarksfactoryoutlet.com>, <clarksirelandoutlet.com>, <clarksmalaysiaonline.com>, <clarksnlnederland.com>, <clarksoutletfactory.com>, <clarksoutletonlineireland.com>, <clarksretailstore.com>, <clarksshoesphilippines.com>, <clarkssingaporeoutlet.com>, <clarkssverigewebshop.com>, <clarksturkeyonline.com>, and <lojasclarksportugal.com>.

*/William R. Towns/*

**William R. Towns**

Sole Panelist

Date: May 24, 2022