

ADMINISTRATIVE PANEL DECISION

Saks.com LLC v. Privacy service provided by Withheld for Privacy ehf /
musora pidorasi
Case No. D2022-2679

1. The Parties

Complainant is Saks.com LLC, United States of America (“United States”), represented by Loeb & Loeb, LLP, United States.

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / musora pidorasi, United States.

2. The Domain Name and Registrar

The disputed domain name <saksfiifthavenue.com> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 21, 2022. On July 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 22, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on July 25, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on July 29, 2022.

The Center verified that the Complaint together with the amendment to the 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 August 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2022. Respondent did not submit any response. Accordingly, the Center

notified Respondent's default on August 26, 2022.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on September 7, 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

Complainant is the ecommerce business spin-off of Saks & Company, LLC (Saks & Co.), which is a retail store chain providing luxury goods. Saks & Co. opened its first store, Saks Fifth Avenue, in New York City in the early 1900s, followed soon after by stores in other cities of the United States. In addition to its Saks Fifth Avenue stores, Saks & Co. has operated the Saks Fifth Avenue Off 5th stores, a source of discount designer clothing and accessories, throughout the United States since 1992. Currently, 42 Saks Fifth Avenue stores and 66 Saks Fifth Avenue Off 5th stores are operational.

Saks & Co. owns, promotes and markets the SAKS and SAKS FIFTH AVENUE trademarks (collectively, the "SAKS trademarks"), throughout the United States and in other countries. In 2019, Saks had revenue of nearly USD 5 billion. In early 2021, Complainant was formed in a spin-off of the SAKS-branded ecommerce business, and Saks & Co. assigned the SAKS trademarks to Complainant.

Complainant now owns registrations of the SAKS trademarks in more than sixty countries worldwide, including the United States, Canada, China and the European Union, including:

- United States registered trademark number 627814 for SAKS FIFTH AVENUE word mark, registered on May 29, 1956;
- United States registered trademark number 620917 for SAKS FIFTH AVENUE design and word mark, registered on February 7, 1956; and
- United States registered trademark number 5647775 for SAKS word mark, registered on January 8, 2019.

Complainant also owns and operates its online business at the following domains:

- <saksfifthavenue.com>;
- <saks.com>; and
- <saksoff5th.com>.

The Domain Name was registered on July 8, 2022, and at the time of filing of the Complaint, the Domain Name resolved to what appeared to be a site that duplicated Complainant's website, for example, prominently featuring features "Saks Fifth Avenue" in stylized form, "SAKS SERVICES", "SAKS" and "SAKS STYLIST". At the time of the Decision, the Domain Name resolved to an error page.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) the Domain Name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith.

In particular, Complainant contends that it has trademark registrations for SAKS and that Respondent registered and is using the Domain Name with the intention to confuse Internet users looking for *bona fide* and well-known SAKS products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use a domain name, which includes Complainant's trademarks, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name. Rather, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Name, when Respondent clearly knew of Complainant's rights.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the complainant's contentions 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.

Thus, although in this case Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant provided evidence of its rights in the SAKS trademarks, as noted above. Complainant has also submitted evidence, which supports that the SAKS trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the SAKS trademarks.

With Complainant's rights in the SAKS trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level Domain ("TLD") in which it is registered (in this case, ".com"), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Name is confusingly similar to Complainant's SAKS trademarks. These trademarks, which are fanciful and inherently distinctive, are recognizable in the Domain Name. In particular, the Domain Name inclusion of Complainant's trademark SAKS and/or the trademark SAKSFIFTHAVENUE in its entirety, in the latter case with an addition of the letter "i" between the letters "i" and "f" in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the SAKS trademarks. See [WIPO Overview 3.0](#), section 1.8.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its SAKS trademarks, and does not have any rights or legitimate interests in the Domain Name. Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the SAKS trademarks or to seek registration of any domain name incorporating the trademarks. Respondent is also not known to be associated with the SAKS trademarks and there is no evidence showing that Respondent has been commonly known by the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, Complainant asserts that the Domain Name previously redirect to a website that appeared to duplicate Complainant's website, including prominently displaying Complainant's trademark "Saks Fifth Avenue", "SAKS SERVICES" and featuring products such as luxury goods that are also offered on Complainant's website, in a display format that appeared to be a duplication of Complainant's website, which has not been rebutted by Respondent. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

"(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 Panel finds that Complainant provided ample evidence to show that registration and use of the SAKS trademarks long predate the registration of the Domain Name. Complainant is also well established and known. Indeed, the record shows that Complainant's SAKS trademarks and related products and services are widely known and recognized. Therefore, Respondent was likely aware of the SAKS trademarks when it registered the Domain Name, or knew or should have known that the Domain Name was confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Name incorporating Complainant's SAKS trademark in its entirety suggests Respondent's actual knowledge of Complainant's rights in the SAKS trademarks at the time of registration of the Domain Name and its effort to opportunistically capitalize on the registration and use of the Domain Name. In addition, while, at the time of filing of the Complaint, the Domain Name includes Complainant's trademark SAKS and/or SAKS FIFTH AVENUE in its entirety, in the latter case with an addition of the letter "i" between "i" and "f" (an apparent misspelling of the words "saksfifthavenue") which is nearly identical to Complainant's domain name <saksfifthavenue.com>, directly associated with Complainant's SAKS trademarks and business activities, and directly evokes Complainant's activities in the field of retail luxury goods, further indicating Respondent's actual knowledge of Complainant and its trademarks, and that Respondent's registration of the Domain Name is in bad faith.

Moreover, Respondent registered and is using the Domain Name to confuse and mislead consumers looking for *bona fide* and well-known SAKS products and services of Complainant or authorized partners of Complainant. The use of the SAKS mark as the dominant part of the Domain Name is intended to capture Internet traffic from Internet users who are looking for Complainant's products and services. Such use and association of the Domain Name to divert users to a webpage that appeared to duplicate Complainant's website, could result in causing confusion with Complainant's business activities. It may confuse Internet users who are looking for Complainant's legitimate website and deceive Internet users into thinking that Respondent is somehow connected to Complainant, which is not the case. In addition, Respondent's website also provides the opportunity for Internet users to provide personal data, which may result in use of such data for malicious or fraudulent purposes.

Moreover, the Panel also notes the distinctiveness and reputation of the SAKS trademarks, Respondent's use of a privacy service, the failure of Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, and the implausibility of any good faith use to which the Domain Name may be put.

Accordingly, the Panel finds that Respondent has registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 Domain Name, <saksfiifthavenue.com>, be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: September 21, 2022