

## **ADMINISTRATIVE PANEL DECISION**

All Saints Retail Limited v. Client Care, Web Commerce Communications Limited

Case No. D2023-0209

### **1. The Parties**

Complainant is All Saints Retail Limited, United Kingdom (UK), represented by Stobbs IP Limited, UK.

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

### **2. The Domain Name and Registrar**

The disputed domain name <allsaintsuae.com> (the “Domain Name”) is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 17, 2023. On January 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 18, 2023, 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 January 18, 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 January 20, 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 January 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on February 21, 2023.

The Center appointed John C. McElwaine as the sole panelist in this matter on February 27, 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.

The Registrar confirmed that the language of the registration agreement for the Domain Name is English. Thus, pursuant to paragraph 11(a) of the Rules the language of this proceeding shall be English.

#### **4. Factual Background**

Complainant is a fashion retailer headquartered in London, UK. Complainant is the owner of ALLSAINTS and ALL SAINTS trademark registrations in multiple countries and jurisdictions, including registrations in the European Union (“EU”) and UK, such as the EU trademark registration No. 004702601 for ALLSAINTS registered on November 4, 2009. A chart of Complainant’s registrations was attached to the Complaint as Annex 4.

On December 2, 2022, Respondent registered the Domain Name with the Registrar. The Domain Name resolved to a functioning website that displays Complainant’s ALLSAINTS Mark, as well as, uses images owned by Complainant.

#### **5. Parties’ Contentions**

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

As background, Complainant alleges that it was founded in 1994 and incorporated in October 2000 (UK Company Registration No. 04096157). Complainant asserts that the brand name “AllSaints” was named after the former founder’s pseudonym, “The Saint”, based on his initials “ST” and updated at the 1993 Notting Hill Carnival that he attended, spending much of his time on AllSaints Road.

Complainant asserts that it began business as a wholesale menswear brand that sold exclusively to high-end retailers, such as Harvey Nichols and Harrods. Since those beginnings, Complainant has grown and now sells menswear, womenswear, apparel, footwear, and accessories in 232 stores, and has approximately 3,200 employees across 27 countries and jurisdictions including the UK, United Arab Emirates (UAE), United States of America (“United States”), Canada, Russian Federation, South Korea and Taiwan, China. Complainant alleges that it acquired the domain name <allsaints.com> in 2009 and commenced use of it to market products later that year. Complainant contends that it now delivers products to over 200 countries, that visits to its website in 2018 amounted to nearly 28 million, and its global mailing list includes 760,000 members. Complainant further alleges that by 2017 its annual turnover was over GBP 303 million. Complainant also asserts that it well-known through its extensive social media presence, shown by the large number of followers on the following platforms: Instagram - over 900,000 followers, Facebook - over 1,000,000, Twitter - over 81,000, YouTube - over 23,000 subscribers, and Pinterest - over 48,000 followers. Collectively, Complainant’s unregistered and registered trademark rights in the ALLSAINTS word marks and stylized marks are referred to herein as the “ALLSAINTS Mark.” Based upon the foregoing allegations, Complainant asserts that it has built extensive reputation and goodwill in the ALLSAINTS Mark.

With respect to the first element of the Policy, Complainant points out that the Domain Name includes the words “all” “saints” and “UAE” and that Complainant has exclusive rights in the ALLSAINTS Mark. Complainant further contends that the word “UAE” is a geographic term and that its addition does nothing to distinguish the Domain Name from its ALLSAINTS Mark. Complainant alleges that it has a physical store in the United Arab Emirates in which products are sold adding to the likelihood of confusion.

With respect to the second element of the Policy, Complainant points out that Respondent has not received any authorization or permission to use the ALLSAINTS Mark. Complainant further contends that Respondent is not commonly known by the term ALLSAINTS. Due to Complainant’s extensive Internet presence, Complainant asserts that it is impossible that Respondent was not aware of Complainant at the time the Domain Name was registered and could have no rights or legitimate interests in the Domain Name.

With respect to the third element of the Policy, Complainant alleges that the Domain Name resolves to an active website that displays Complainant’s ALLSAINTS Mark, as well as, uses images owned by

Complainant. Complainant further alleges that this website has been set up with the intention of creating a connection with Complainant's genuine website. Complainant points out that Respondent is offering goods for sale on its website at significantly reduced prices. Complainant asserts that the sale of the goods has not been authorized by Complainant, nor do the goods originate from Complainant. Complainant further alleges that the intention of Respondent is to lure consumers to the false site with the promise of significant reductions in the cost of products and Complainant has reason to suspect that no actual product is available and Respondent is using the Domain Name to obtain personal data from customers, including financial data, amounting to fraudulent use of the Domain Name. Complainant also alleges that if products are available to be purchased from the website, it is likely to be counterfeit product on the basis of the low price point. Even if the product is genuine, Complainant submits that Respondent cannot use a domain name confusingly similar to Complainant's trademark to sell Complainant's goods at a steep discount.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Even though Respondent has defaulted, paragraph 4 of the Policy requires that, in order to succeed in this UDRP proceeding, Complainant must still prove its assertions with evidence demonstrating:

- (i) the 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. Anonymous Speech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kasso Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules and applicable principles of law, the Panel's findings on each of the above cited elements are as follows.

### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires Complainant show that the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights. 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2. Here, Complainant alleged that it is the owner of multiple trademark registrations in a chart detailing registrations of the ALLSAINTS Mark in multiple countries and jurisdictions. No actual evidence of such registrations were provided; however, the Panel verified using the WIPO Global Brand Database that Complainant has registrations in the UK, United States, and UAE, among others. [WIPO Overview 3.0](#) section 4.8 (a panel may undertake limited factual research into matters of public record, including "accessing trademark registration databases".) Thus, the evidence submitted by Complainant is sufficient to establish valid trademarks rights and, accordingly, standing to bring this proceeding.

It is well-established, and the Panel agrees, that the addition of a descriptive word to a trademark in a domain name does not avoid a finding of confusing similarity. See [WIPO Overview 3.0](#), Section 1.8; *Mastercard International Incorporated v. Dolancer Outsourcing Inc.*, WIPO Case No. [D2012-0619](#); *Air France v. Kitchkulture*, WIPO Case No. [D2002-0158](#); *DHL Operations B.V. and DHL International GmbH v. Diversified Home Loans*, WIPO Case No. [D2010-0097](#). The Domain Name contains Complainant's

ALLSAINTS Mark in its entirety, as a dominant element. The addition of the three letter initials “UAE” does not prevent a finding of confusing similarity between the Domain Name and the ALLSAINTS Mark.

Accordingly, the Panel finds that the Domain Name is confusingly similar to Complainant’s ALLSAINTS Mark in which Complainant has valid trademark rights. Therefore, Complainant has satisfied paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

Under the Policy, paragraph 4(a)(ii), Complainant has the burden of establishing that Respondent has no rights or legitimate interests in the Domain Name. Complainant need only make a *prima facie* showing on this element, at which point the burden of production shifts to Respondent to present evidence that it has rights or legitimate interests in the Domain Name. If Respondent has failed to do so, Complainant is deemed to have satisfied its burden under paragraph 4(a)(ii) of the Policy. See *Vicar Operating, Inc. v. Domains by Proxy, Inc. / Eklin Bot Systems, Inc.*, WIPO Case No. [D2010-1141](#); see also *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Case No. [D2000-1415](#); *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, WIPO Case No. [D2000-0252](#).

In this matter, Complainant contends that Respondent developed a website at the Domain Name using Complainant’s ALLSAINTS Mark and images of Complainant’s products to sell products directly competitive with Complainant’s products, and which might be counterfeit. Section 2.13.2 of the [WIPO Overview 3.0](#) provides the following guidance concerning such allegations, even when the respondent is in default:

“Evidence that the goods are offered disproportionately below market value, that the goods are only sold under license or through a prescription (especially with pharmaceutical products), that the images of the goods *prima facie* suggest (e.g., where the relevant logo is distorted) that they are not genuine, that the respondent has misappropriated copyrighted images from the complainant’s website, that the goods are extremely rare, that the goods have prompted consumer complaints, or that a respondent has improperly masked its identity to avoid being contactable, have each been found relevant [to proving a lack of legitimate interest based upon illegal activity].”

Complainant asserts that the products for sale on the website are being offered at a steeply discounted price to lure customers into giving Respondent personal and financial information. Even if the products being sold are legitimate, Complainant contends that it did not authorize registration of the Domain Name or development of Respondent’s website which contains no other indicators of source and appeared to be intended to convince visitors that it is Complainant’s legitimate website when it is not.

Respondent has been properly notified of the Complaint by the Center; however, Respondent failed to submit any response concerning these serious accusations. As such, Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name.

Although Complainant has satisfied its burden, Respondent may establish a right or legitimate interest in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Panel finds that Respondent has failed to show rights or legitimate interests under any of the three conditions.

As an initial matter, there is no evidence that Respondent is commonly known by the Domain Name, as the Registrar disclosed Respondent as “Client Care, Web Commerce Communications Limited” located in Kuala Lumpur, Malaysia. Respondent cannot rely upon paragraph 4(c)(ii) of the Policy.

Also, the Panel finds that Respondent’s use is not legitimate use of the Domain Name. Respondent is using the Domain Name to resolve to a website allegedly engaged in unlawfully selling infringing or counterfeit goods, or may have been harvesting personal and financial information from consumers. [WIPO Overview 3.0](#), section 2.13.1 (“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”) In addition, the use of the Domain Name to divert Internet traffic to an infringing or misleading webpage is not a *bona fide* offering of goods or services. See *Chicago Mercantile Exchange Inc., CME Group Inc. v. Registration Private, Domains By Proxy, LLC, DomainsByProxy.com / Nikolay Korobeynikov*, WIPO Case No. [D2016-0654](#) (finding no legitimate interest in a website resolving from the disputed domain name, which mirrored, and purported to be, the website of “CME Group” and which provided information relating to the trading of futures and options). Even if the products sold on the website are genuine, there’s no disclosure of Respondent’s lack of relationship with Complainant on the website thus the Oki Data test cannot be met. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Lastly, Respondent’s use of the Domain Name is not noncommercial or fair use under paragraph 4(c)(iii) of the Policy, given that Respondent is allegedly selling counterfeit or competing products from an infringing online retail website. Such activity does not amount to a fan site, criticism, or other activity that may be considered noncommercial or fair use. See, e.g., *Sermo, Inc. v. CatalystMD, LLC*, WIPO Case No. [D2008-0647](#).

Accordingly, for the reasons detailed above, Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent had the opportunity to put forth evidence of its rights or legitimate interests yet provided no substantive response as to why its conduct amounts to a right or legitimate interest in the Domain Name under the Policy. In the absence of such a response and combined with the factors as detailed above, the Panel finds that Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

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

According to paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Bad faith registration can be found where a respondent “knew or should have known” of a complainant’s trademark rights and nevertheless registered a domain name in which it had no right or legitimate interest. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#). As detailed above, Respondent registered the Domain Name which is confusingly similar to the ALLSAINTS Mark. There is no explanation for Respondent to have chosen to register the Domain Name other than to intentionally trade off the goodwill and reputation of Complainant’s trademark or otherwise create a false association with Complainant. With no response from Respondent, this claim is undisputed.

As discussed herein, Respondent registered the Domain Name and linked it to a website using Complainant’s ALLSAINTS Mark, including a reproduction of Complainant’s images and fonts to mimic the look and feel of Complainant’s website. Complainant further alleges that Respondent is either selling counterfeit clothing, if products are provided, or harvesting consumer personal and financial information. This amounts to bad faith use of the Domain Name by Respondent. See *Identigene, Inc. v. Genetest Labs*, WIPO Case No. [D2000-1100](#) (finding bad faith where the respondent’s use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing that the complainant is the source of or is sponsoring the services offered at the site); *MathForum.com, LLC v. Weiguang Huang*, WIPO Case No. [D2000-0743](#) (finding bad faith under paragraph 4(b)(iv) of the Policy where the respondent registered a domain name confusingly similar to the

complainant's mark and the domain name was used to host a commercial website that offered similar services offered by the complainant under its mark).

As detailed above, the Panel finds on the record before it that Respondent's intention in registering the Domain Name was to attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with the ALLSAINTS Mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location. Thus, the Panel holds that Complainant has met its burden of providing sufficient evidence that Respondent registered and is using the Domain Name in bad faith under paragraph 4(b)(iv) of the Policy.

For these reasons, the Panel holds that Complainant has met its burden of showing that Respondent registered and is using the Domain Name in bad faith under 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 Domain Name <allsaintsuae.com> be transferred to Complainant.

*/John C McElwaine/*

**John C McElwaine**

Sole Panelist

Date: March 13, 2023