

## **ADMINISTRATIVE PANEL DECISION**

Wax London Limited v. Lei Hu

Case No. D2023-1251

### **1. The Parties**

The Complainant is Wax London Limited, United Kingdom, represented by Sipara, United Kingdom.

The Respondent is Lei Hu, China.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 22, 2023. On March 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 23, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 the Respondent of the Complaint, and the proceedings commenced on March 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 18, 2023.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on April 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.

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

The Complainant was founded in 2015 and sells menswear, in particularly online where it operates a commercial website hosted under the domain name <waxlondon.com>.

As a basis for its Complaint, the Complainant relies in particular on the International Trade mark registrations No. 1522745 over WAX LONDON and No. 1552522 over WAX, both registered on November 27, 2019.

The disputed domain name was registered by the Respondent, an individual located in China, on July 21, 2022. It is used to host a commercial website which imitates the layout of the website of the Complainant. It reproduces in particular the WAX LONDON logo, the pictures that appear on the Complainant's website, and offers the same clothes for sale with substantial discounts. This website is available in English and each item for sale is presented under the brand name "Wax London". In a more recent version of its website, the Respondent has added new items for sale, that have apparently no relation with the Complainant and bear a third party brands: lunch boxes, plastic bottles, and cutlery.

#### **5. Parties' Contentions**

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

As a preliminary remark, the Complainant claims that its trade mark WAX LONDON has a significant reputation, as it sells its products through prominent United Kingdom, United States of America and European Union retailers. In the last year, its worldwide sales amounted to GBP 4.6 million.

On the first element of the Policy, the Complainant indicates that the disputed domain name encompasses the trade marks WAX and WAX LONDON, and is therefore highly similar. It adds the additional word "shop". Hence, according to the Complainant "The WAX and WAX LONDON Trade Marks are therefore confusingly similar to the domain name complained of. The confusing similarity of the relevant trade marks to the domain name is heightened by the inherent distinctiveness, acquired distinctiveness and reputation of the Complainant's Trade Marks".

On the second element of the Policy, the Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Also, the Complainant contends that the Respondent is not making a *bona fide* use of the disputed domain name: "it is submitted that the apparent intention of the Respondent is to mislead consumers into believing that the domain name has some form of connection with the Complainant, and/or to cause harm to the reputation in WAX or WAX LONDON".

On the third element of the Policy, the Complainant claims that the disputed domain name was registered, and is being used in bad faith. On the bad faith registration, it highlights that the Respondent must have been aware of the trade mark WAX LONDON prior to registering the disputed domain name, in particular because it has copied its logo. Actually, adds the Complainant, "there is no feasible situation or circumstance in which the domain name could be legitimately used by the Respondent without infringing the Complainant's Trade Marks". On the bad faith use, the Complainant believes that the Respondent is intentionally attracting users to its website for commercial gain, by creating a likelihood of confusion with its trade marks WAX and WAX LONDON. In this respect, the Complaint contains two important precisions: first, the Respondent is not an authorised retailer of the Respondent's products, and second the Respondent is not acting as a potential unaffiliated retailer of authentic goods: it passes itself off as the Complainant itself.

##### **B. Respondent**

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy requires that the Complainant prove all of the following three elements in order to be successful in this proceeding:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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 name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Complainant, under the first requirement of paragraph 4(a) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trade mark or a service mark in which it has rights. The first criterion is perceived primarily as a standing requirement for the Complainant.

The Complainant has shown that it holds rights in particular over the trade mark WAX LONDON, as registered in several jurisdictions.

The disputed domain name <waxlondonshop.com> includes the Complainant's trade mark in its entirety, combined with the term "shop". This addition does not prevent the Complainant's trade mark from being recognizable in the disputed domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "Where the relevant trade mark 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."

As the disputed domain name includes the Complainant's trade mark in its entirety combined with a term that does not prevent the Complainant's trade mark from being recognizable, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark.

Therefore, the first element of the Policy is satisfied.

### B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production to demonstrate rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see [WIPO Overview 3.0](#), section 2.1).

In this case, the Respondent has not rebutted the allegations made by the Complainant. The Respondent has no rights, and no legitimate interests, in the disputed domain name.

Besides, the Panel notes that the nature of the disputed domain name along with the operation by the Respondent of a website which impersonates that of the Complainant, and which uses the trade marks of the Complainant, is likely to mislead Internet users and does not amount to a *bona fide* offering of goods or services under the disputed domain name.

Even assuming that the Respondent acts as an unaffiliated retailer of authentic goods, which is doubtful, the Respondent did not disclose the nature of its relationship with the Complainant, and therefore the “Oki Data Test” fails. Indeed, section 2.8.1 of [WIPO Overview 3.0](#) requires, amongst other cumulative criteria, that the website of a reseller of authentic goods must accurately and prominently disclose the registrant’s relationship with the trademark holder. Additionally, the Respondent has extended the content of its commercial website by offering goods which are not related to the Complainant and bear a third party trade mark: this is another breach of the “Oki Data Test”.

For this reason, and failing any specific allegation by the Respondent, the second element of the Policy is deemed to be satisfied.

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

In order to prevail under the third element of paragraph 4(a) of the Policy, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy lists a number of circumstances, which, without limitation, are deemed to be evidence of the registration and use of a domain name in bad faith. These are:

- (i) circumstances indicating that [a respondent has] registered or acquired a disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of [the respondent’s] documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) [the respondent has] registered the disputed domain name in order to prevent the complainant from reflecting the complainant’s trade mark or service mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or
- (iii) [the respondent has] registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed 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.

The circumstances identified in 4(b)(iv) of the Policy are clearly met here:

The Respondent specifically targeted the Complainant when it configured the disputed domain name, by combining the distinctive trade mark WAX LONDON and the term “shop”.

Also, the Respondent has used the disputed domain name to host a commercial site that impersonates that of the Complainant and is highly likely to create a likelihood of confusion to the detriment of consumers and of the Complainant. Indeed, according to the Complainant, the images of the products listed on the website at the disputed domain name seem to be directly copied from the Complainant’s website.

Furthermore, the use of the disputed domain name to resolve to website passing itself off as that of the Complainant, whether for scamming purposes or otherwise seeking to take unfair advantage of the Complainant’s trade mark, supports a finding of bad faith.

Accordingly, the third element of the Policy is satisfied.

## 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 name <waxlondonshop.com> be transferred to the Complainant.

*/Benjamin Fontaine/*

**Benjamin Fontaine**

Sole Panelist

Date: May 8, 2023