

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. yanlu lu Case No. D2023-2877

1. The Parties

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

The Respondent is yanlu lu, China.

2. The Domain Name and Registrar

The disputed domain name <tedbakera.com> is registered with Realtimeregister B.V. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 6, 2023. On July 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 10, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 13, 2023 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 amendment to the Complaint on July 13, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on July 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 10, 2023.

The Center appointed Torsten Bettinger as the sole panelist in this matter on August 29, 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 is the owner of the TED BAKER brand, which it has used for over 35 years in respect of goods including apparel, accessories, footwear, homeware, and beauty in the United States and internationally.

The Complainant owns numerous trademark registrations relating to the TED BAKER mark covering a wide variety of goods and services as well as copyright in images used in association with the advertising, marketing, and sale of TED BAKER-branded products globally.

The Complainant's relevant trademark rights include, in particular, the following, details of which were annexed to the Complaint:

- United States trademark registration no. 2644551 for TED BAKER in Class 25, registered on October 29, 2002;
- United States trademark registration no. 2672649 for TED BAKER in Classes 9, 14, 18 and 24, registered on January 7, 2003.

The disputed domain name <tedbakersale.com> was registered on November 7, 2022, and is being used to resolve to a website with pornographic content.

5. Parties' Contentions

A. Complainant

The Complainant submits that it is the owner of the world-famous TED BAKER brand which is currently, and for many years has been, one of the world's leading manufacturers of apparel, accessories, footwear, homeware and beauty.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant argues that:

- the disputed domain name consists of the Complainant's trademark TED BAKER followed by the descriptive term "sale", and is therefore recognizable within the disputed domain name;
- the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) such as "sale" does not prevent a finding of confusing similarity.

With regards to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the Respondent has not been licensed, contracted, or otherwise permitted by the Complainant in any way to use the TED BAKER trademark or to apply for any domain names incorporating the TED BAKER trademark, nor has the Complainant acquiesced in any way to such use or application of the TED BAKER trademark by the Respondent;
- there is no evidence that the Respondent is using or plans to use the TED BAKER trademark or the domain names incorporating the TED BAKER trademark for a *bona fide* offering of goods or services that doesn't infringe the Complainant's intellectual property rights;

- the Respondent has been actively using the TED BAKER trademarks in the domain names and on the physical website to promote its website for illegitimate commercial gains, more specifically, the Respondent has been intentionally attempting to create a likelihood of confusion by using the disputed domain name containing the TED BAKER trademark to increase Internet user traffic for its pornographic and online gambling website;
- the Respondent has not been commonly known by the disputed domain name, and
- the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

Finally, with regards to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Respondent was well aware of the Complainant's trademark at the time Respondent registered the disputed domain name;
- the Complainant's trademarks are well-known around the world;
- a simple Google search would have disclosed the Complainant's marks and business;
- the Respondent registered the disputed domain name at least 35 years after the Complainant established registered trademark rights in the TED BAKER mark;
- the Respondent used a privacy shield to mask its identity, which makes it difficult for Complainant to contact the Respondent and amicably settle a domain dispute;
- the Respondent's use of the disputed domain name to offer pornographic content; such conduct qualifies as " pornosquatting", a practice "where confusion with a well-known trademark is used to divert customers to a pornographic website for commercial purpose";
- pornographic content on a respondent's website is in itself sufficient to support a finding of bad faith, irrespective of the respondent's motivation;
- the Respondent has in bad faith tried to obtain financial gain by registering and using a well-known, non-generic domain name in which it has no rights or legitimate interests to generate revenue through increased Internet user traffic and app downloads and to promote its pornography and online gambling businesses;
- by using the disputed domain name in connection with pornographic content/websites.

B. Respondent

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

6. Discussion and Findings

The Complainant has demonstrated that it owns multiple trademark registrations for the mark TED BAKER prior to the registration of the disputed domain name on November 7, 2022.

It is well-established that the test of identity or confusing similarity between the trademark and the disputed domain name under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other use factors usually considered in trademark infringement cases (see sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

In this case, the disputed domain name contains the Complainant's trademark TED BAKER in its entirety and only differs from the Complainant's trademark TED BAKER by the addition of the term "sale".

The Panel notes that it has long been established under the UDRP that the addition of descriptive wording to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of the [WIPO Overview 3.0](#)). The Panel therefore agrees with the Complainant's assertion that the addition of the term "sale" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark TED BAKER.

Furthermore, it is well accepted under the UDRP that the Top-Level Domain ("TLD") designation (such as ".com", ".net", or ".org") is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable TLD suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#), section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to the Complainant's TED BAKER trademark.

A. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

"(i) before any notice to you [the Respondent] 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 [the Respondent] (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 [the Respondent] 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 Complainant stated that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to register the disputed domain name and provided evidence that the disputed domain name was used to redirect Internet users to a website with pornographic and online gambling website.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent chose not to contest the Complainant's allegations and has failed to come forward with any evidence to refute the Complainant's *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, there is no other evidence to support the assumption that the Respondent has used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

The Panel therefore concludes that the Respondent lacks rights and legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

B. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of 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 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) 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 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 the Respondent's website or location.

The Complainant has been using the TED BAKER trademark for a wide range of goods including apparel and accessories for some 35 years, and therefore since long before the disputed domain name was registered. The Complainant's registered trademark rights long pre-date the registration of the disputed domain name.

Since the disputed domain name contains the TED BAKER in its entirety, it is likely that the Respondent did not coincidentally register the disputed domain name but had knowledge of the Complainant's rights in the TED BAKER marks when registering the disputed domain name.

Furthermore, the disputed domain name is used by the Respondent on a website with pornographic content and online gambling. This shows that the Respondent is capitalizing on the reputation of the TED BAKER mark by creating a likelihood of confusion with the Complainant's mark in order to divert customers to its pornographic website.

Such use of the disputed domain name entitles the Panel to find bad faith registration and use under 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 name <tedbakersale.com> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: September 12, 2023