

ADMINISTRATIVE PANEL DECISION

Perry Ellis International Europe Limited v. Adam Frederick James
Case No. DAU2025-0003

1. The Parties

The Complainant is Perry Ellis International Europe Limited, Ireland, represented by Ashurst Australia, Australia.

The Respondent is Adam Frederick James, Australia.

2. The Domain Name and Registrar

The disputed domain name <morecoredivision.com.au> is registered with Web Address Registration Pty Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 14, 2025. On January 15, 2025, the Center transmitted by email to Web Address Registration Pty Ltd a request for registrar verification in connection with the disputed domain name. On January 16, 2025, Web Address Registration Pty Ltd 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 .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 24, 2025. In accordance with the Rules, paragraph 5(a), the due date for Response was February 13, 2025. The Respondent did not submit a formal response, but sent a few informal communications on January 29, 2025, February 3, 2025, and February 18, 2025.

The Center appointed Andrew F. Christie as the sole panelist in this matter on February 24, 2025. 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 a designer, distributor, and licensor of men's and women's apparel, fashion accessories, sporting goods, housewares, and fragrances. It acquired the MORE CORE DIVISION brand in 2005 and has sold MORE CORE DIVISION branded clothing and sporting goods throughout the world. The target group of the brand is surfers and skateboarders.

The Complainant is the owner of a number of registrations in a range of jurisdictions for trademarks consisting of or containing the words "More Core Division". It is the owner of Canada Trade Mark No. TMA436709 (registered December 9, 1994), Germany Trade Mark No. 2040453 (registered July 14, 1993), and Swiss Trade Mark No. 388017 (registered November 13, 1991), all for the word trademark MORE CORE DIVISION. It is the applicant for Australia Trade Mark No. 2479718 (filed September 4, 2024) for the word trademark MORE CORE DIVISION, which has been published and is under examination. The Complainant is the owner of Australia Trade Mark No. 564167 (registered from September 24, 1991), Canada Trade Mark No. TMA470636 (registered February 6, 1997), Germany Trade Mark No. 2011465 (registered March 19, 1992), and Swiss Trade Mark No. P-389239 (registered January 22, 1992), all for the figurative trademark of a diamond shape containing the letters "MCD" and the words "More Core Division" (the "MCD figurative trademark").

In its verification response the Registrar specified March 15, 2021, as the creation date of the disputed domain name. The Complainant provided screenshots, taken in July and August 2024, showing pages of the website to which the disputed domain name then resolved. These pages contained a banner heading "MORE CORE DIVISION," and showed pictures of various items of clothing offered for sale, on which were prominently displayed the Complainant's MORE CORE DIVISION word trademark or MCD figurative trademark.

The Complainant sent a cease and desist letter to the Respondent on September 4, 2024. On September 27, 2024, lawyers for the Respondent sent a reply saying the Respondent "has ceased carrying on business and using any of the MCD mark and now regards this matter as at an end without any admission of liability."

On October 1, 2024, the Complainant's United States of America lawyers received an email from the Respondent, using an address that contained the string "morecoredivision", in which he stated he was one of two owners of the business name, domain name and Instagram handle in Australia for "more core division"; that he had intended "to start a Concrete core drilling business and call it More core division as I was a big fan of Andy Irons and MCD as a clothing label in the 90s"; that he had learnt "the original MCD went bankrupt 20+ years ago"; and that "we genuinely thought we could make it our own and resurrect it". He also said: "It took us a long time to source a supplier that does print on demand (POD) to deliver a quality product".

The email then stated: "Ultimately we would love to work with you and actually resurrect MCD to better than before from the Gold Coast and open shops all over Australia and the world but if that's not a negotiable option then we would like for your client to buy the business name, domain and instagram as a package and then you have everything not just a TM which as you well know in today climate all sales go through Instagram then websites. It will not be surrendered for free like asked. We are obviously limited as to who we can sell this off to and I have not reached out to any of the other MCD sellers (mostly in Brazil) on Instagram so if it does not sell in the next couple of months we will go ahead with starting the Concrete Core drilling business under our More Core Division business name in Australia."

On or around October 15, 2024, the Complainant's lawyers responded by email to the Respondent, again requesting the Respondent to transfer the disputed domain name to the Complainant and to delete the Respondent's MORE CORE DIVISION social media profiles on Instagram and Facebook, for no payment. On the same day, the Respondent replied, stating, among other things: "without some sort of financial compensation our Domain and business name, Instagram etc will be kept and renewed. [...] I would prefer that your client the rightful owner purchase everything we have for no less than one million Australian dollars

but if that isn't suitable we will simply sit on it indefinitely but rest assured will not be using it for any sales of TM violating products again."

The Complainant provided screenshots dated January 13, 2025, showing the disputed domain name did not resolve to an active location, but that the Respondent had continued to use the MORE CORE DIVISION trademark on his social media pages.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical and confusingly similar to a trademark in which the Complainant has rights on the following grounds, among others. The disputed domain name is identical to the Complainant's MORE CORE DIVISION word trademark. The ".com.au" part of the disputed domain name should be disregarded. The disputed domain name is confusingly similar to the Complainant's MCD figurative trademark. The diamond design elements of the figurative trademark are incapable of representation in a domain name and should be disregarded for the purpose of assessing confusingly similarity with a domain name.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name on the following grounds, among others. The disputed domain name does not correspond to the Respondent's personal name, to a trademark owned by the Respondent, to the name of a genuine, legitimate business conducted by the Respondent, or to legitimate goods or services sold or supplied by the Respondent. A search of the Australian Trade Marks Register shows that the Respondent has never owned a trademark application or registration for a trademark containing "more core division". A search of the Australian Securities & Investments Commission register shows that the Respondent does not hold any Australian business name registration for a name containing "more core division" and there are no Australian company name registrations for names containing "more core division". Even if the Respondent were taken to be the holder of the business name registration for "more core division", this does not establish that the Respondent has genuine rights or legitimate interests in the disputed domain name. The registration of a business name is a legislative requirement that needs to be satisfied where an entity trades under a name that is not the entity's own personal name or company name. Therefore, a business name registration does not, in itself, grant the holder any rights in the business name. The Respondent did not meet the .au Domain Administration ("auDA") eligibility requirements for holding the licence for the disputed domain name when he applied to register it, which is contrary to the representations and warranties he provided to auDA when registering the disputed domain name (being that the statements he made about his eligibility were complete and accurate). While the Respondent has operated a business selling clothing through a website using the disputed domain name, such conduct does not amount to honest, good faith use of the MORE CORE DIVISION trademark which would allow the Respondent to establish a genuine right or legitimate interest in the disputed domain name. The Respondent knew of the Complainant's rights and reputation in the MORE CORE DIVISION word trademark and the MCD figurative trademark when he registered the disputed domain name, the business name and the social media profile names, and he deliberately sought to derive financial gain by taking advantage of the Complainant's rights and valuable goodwill in the MORE CORE DIVISION brand. Despite the Respondent stating in his email of October 1, 2024, that his original intention was to establish a concrete core drilling business under the name "More Core Division", this was still directly connected to the fame of the Complainant's MORE CORE DIVISION brand. The Respondent's name is Adam Frederick James. He is not commonly known by the disputed domain name.

The Complainant contends that the Respondent registered or has used the disputed domain name in bad faith on the following grounds, among others. The disputed domain name was registered primarily for the purpose of selling it for valuable consideration; to prevent the Complainant from reflecting its trademark in the corresponding domain name; for disrupting the business or activities of the Complainant; and for intentionally attempting to attract commercial gain by creating a likelihood of confusion with the Complainant's MORE CORE DIVISION trademark as to the source, sponsorship, affiliation or endorsement

of the disputed domain name and products on the website to which it resolves. The Respondent has breached his representations and warranties and is not eligible to register the disputed domain name.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. However, the Respondent did send a number of communications to the Center.

On January 29, 2025, in response to receipt of the Center's Notification of Complaint and Commencement of Administrative Proceeding, the Respondent sent an email stating: "This website is closed indefinitely and has been for some time now."

On February 3, 2025, the Respondent sent an email stating: "Are you aware that the deactivated domain name (morecoredivision.com.au) as well as the trading name in Australia, the instagram (@morecoredivision) all in the same name is for sale? Let us know if you are interested in the whole package. We would like to sell them all together."

On February 18, 2025, in response to receipt of the Center's notification of passing of the due date for Response, the Respondent sent an email stating: "We responded on February 3 stating that the website, business trading name in Australia and the Instagram are all for sale. No action will be taken with the website by us again until sold. Any offers need to be made directly to this email address and the details confirmed. The domain name and business name still have over 12 months left before renewal."

6. Discussion and Findings

A. Identical or Confusingly Similar

As noted in paragraph 1.1.2 of the Overview of Panel Views on Selected auDRP Questions, Second Edition ("auDRP Overview 2.0"), the .auDRP does not restrict a complainant's registered trademark rights to a trademark registered with the Australian trademark authority. Thus, a trademark registered outside of Australia satisfies the requirements of the Policy to the same extent that a trademark registered in Australia does.

The Complainant is the owner of trademark registrations outside of Australia for the word trademark MORE CORE DIVISION. Once the second-level domain ("2LD") and the country code Top-Level Domain ("ccTLD") are ignored (which is appropriate in this case), the disputed domain name consists of the Complainant's registered word trademark MORE CORE DIVISION. The disputed domain name is identical to the Complainant's trademark for purposes of the Policy.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

As noted in paragraph 2.1.1 of the auDRP Overview 2.0, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests in the domain name. The complainant will usually make out a prima facie case by establishing that none of the paragraph 4(c) circumstances are present. Once such a prima facie case is made, the burden of production shifts to the respondent, requiring it to provide evidence or plausible assertions demonstrating rights or legitimate interests in the domain name. If the respondent fails to provide evidence or plausible assertions demonstrating rights or legitimate interests in the domain name, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In communications with the Complainant, the Respondent claimed to have registered a business name for "More Core Division". However, no evidence of such a registration was provided. In any event, as noted in

paragraph 2.12.3 of the auDRP Overview 2.0, a business name registration does not, of itself, necessarily establish that the respondent has rights or legitimate interests in a domain name corresponding to the business name. Furthermore, the Respondent claimed knowledge of the Complainant's MORE CORE DIVISION trademark and sought to "resurrect it" – indicating that the Respondent's actions were not the result of independent adoption, but rather trading off of or otherwise taking advantage of the Complainant's trademark.

The Respondent is not a licensee of the Complainant, is not otherwise affiliated with the Complainant, and has not been authorized by the Complainant to use its MORE CORE DIVISION trademark. The Respondent has not provided any evidence that it has been commonly known by, or has made a bona fide use of, the disputed domain name, or that it has, for any other reason, rights or legitimate interests in the disputed domain name. The evidence provided by the Complainant shows that the disputed domain name has been used to resolve to a webpage that offered for sale items of clothing on which were prominently displayed the Complainant's MORE CORE DIVISION word trademark or MCD figurative trademark. The Complainant said that these items were counterfeit. The Respondent did not deny that; indeed, he appeared to admit that they were when he told the Complainant that it had taken him "a long time to source a supplier that does print on demand". Given the identity of the disputed domain name to the Complainant's trademark, the absence of any relationship between the Respondent and the Complainant, and the risk of implied false affiliation with the Complainant, the Respondent's use of the disputed domain name in this way is neither a bona fide use, nor a legitimate noncommercial or fair use.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered or Subsequently Used in Bad Faith

The disputed domain name was registered many decades after registration of the Complainant's MORE CORE DIVISION word trademark. In a communication with the Complainant's lawyers, the Respondent admitted that he "was a big fan of Andy Irons and MCD as a clothing label in the 90s", and that he was aware that "the original TM kite image was still active so we did all we could to change it so we didn't step on any of the old TM specifications". It seems clear that the Respondent registered the disputed domain name aware of the existence of the MORE CORE DIVISION word trademark and the MCD figurative trademark, aware that there had been an Australian trademark registration for the word trademark MORE CORE DIVISION (this having been removed due to failure to pay the renewal fee in 2018), and aware that there still was an Australian trademark registration for the MCD figurative trademark.

The Respondent's assertion that he registered the disputed domain name for use in a concrete core drilling business is unsupported by any evidence, and appears fanciful. Given the use which the Respondent actually made of the disputed domain name – namely, to resolve to a website selling clothing containing the MORE CORE DIVISION word trademark and MCD figurative trademark – it seems clear that his motivation for registering the disputed domain name was to take advantage of the goodwill in those trademarks. That goodwill belonged to the Complainant. The Respondent was not entitled to seek to appropriate it. The Respondent's registration of the disputed domain name for this purpose was in bad faith.

In any event, it is clear that the Respondent's use of the disputed domain name was in bad faith. It was an attempt to attract, for commercial gain, Internet users to a website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of that website.

The Panel finds the third element of the Policy has been established.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <morecoredivision.com.au> be transferred to the Complainant.

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: March 11, 2025