

ADMINISTRATIVE PANEL DECISION

Urban Outfitters Inc. v. Privacy service provided by Withheld for Privacy ehf /
Grech Kevin
Case No. D2022-2166

1. The Parties

The Complainant is Urban Outfitters Inc., United States of America (“United States”), represented by Safenames Ltd., United Kingdom.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Grech Kevin, United Arab Emirates.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 14, 2022. On June 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 21, 2022, 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 amended Complaint on the same date.

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 the Respondent of the Complaint, and the proceedings commenced on June 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 8, 2022.

The Center appointed Marilena Comanescu as the sole panelist in this matter on August 16, 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

The Complainant was founded in 1970 in Philadelphia, United States. The "URBAN OUTFITTERS" brand has become famous for apparel and accessories primarily targeted towards young adults.

The Complainant was listed on the NASDAQ stock exchange in 1993, had revenues of USD 4 billion in 2018, has more than 20,000 employees across over 200 retail locations located in North America, Europe and the Middle East.

The Complainant owns trademark registrations for URBAN OUTFITTERS, such as the following:

- the United States word trademark registration number 1323901 for URBAN OUTFITTERS, filed on June 11, 1984 and registered on March 5, 1985, covering services in Nice class 42; and

- the European Union word trademark registration number 010182061 for URBAN OUTFITTERS, filed on August 8, 2011 and registered on January 10, 2012, covering services in Nice class 35.

The Complainant is the owner of the domain name <urbanoutfitters.com>, its official website and online store launched in 2000.

The disputed domain name <urbanoutfittersfranchise.com> was registered on December 15, 2021 and at the time of filing the Complaint, it was used in connection with a website allegedly offering franchise services in relation to the trademark URBAN OUTFITTERS, and was displaying the Complainant's URBAN OUTFITTERS trademark and official marketing images. The website under the disputed domain name encourages the visitors to enter their personal details. Furthermore, evidence provided as Annex 16 to Complaint submits evidence of MX records associated with the disputed domain name, indicating that the Respondent has set up an email account using the disputed domain name.

Before commencing this proceeding, on February 1, 2022, the Complainant sent a cease and desist letter to the Respondent. No response was received.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its distinctive and well-known trademark URBAN OUTFITTERS, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent registered and is using the disputed domain name in bad faith. The Complainant requests the transfer of the disputed domain name to it.

B. Respondent

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

6. Discussion and Findings

In view of the Respondent's default, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the URBAN OUTFITTERS trademark.

The disputed domain name <urbanoutfittersfranchise.com> incorporates the Complainant's URBAN OUTFITTERS trademark with an additional term, "franchise". However, such addition does not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain name.

Numerous UDRP panels have considered that the addition of other terms (whether geographical wording, descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name does not prevent a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

Further, it is well established in decisions under the UDRP that the Top-Level Domain ("TLD") (e.g., ".com", ".site", ".info", ".shop") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark URBAN OUTFITTERS, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license or authorization whatsoever to use the mark URBAN OUTFITTERS, that the Respondent is not commonly known by the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Under the Policy, "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 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 has not replied to the Complainant's contentions and has not come forward with relevant evidence to rebut the Complainant's *prima facie* case.

There is nothing in the record suggesting that the Respondent has ever been commonly known by the disputed domain name.

Further, there is no evidence before the Panel to suggest that the Respondent has made a *bona fide* use of the disputed domain name, or has been known by this disputed domain name, or is making any legitimate noncommercial or fair use of the disputed domain name.

In fact, at the time of filing the Complaint the disputed domain name resolved to a commercial website featuring the URBAN OUTFITTERS trademark and official images of the Complainant, falsely claiming to offer franchise services related to the Complainant's trademark URBAN OUTFITTERS and asking visitors to provide their personal details.

Panels have categorically held that the use of a domain name for illegal activity (e.g. impersonation/passing off, phishing, distributing malware, or other types of fraud) can never confer rights or legitimate interests on a respondent. See section 2.13.1 of the [WIPO Overview 3.0](#).

In addition, and without prejudice to the above, UDRP panels have found that domain names identical or highly similar to a complainant's trademark carry a high risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant holds trademark rights in URBAN OUTFITTERS since at least 1985, respectively in the domain name <urbanoutfitters.com> since 2000.

The Complainant's URBAN OUTFITTERS trademark is distinctive and has gained considerable reputation worldwide. See also *Urban Outfitters Inc. v. Super Privacy Service LTD c/o Dynadot / Domain Administrator, Domain Name Corporation*, WIPO Case No. [D2021-3651](#); or *Urban Outfitters Inc. v. Domain Administrator, See PrivacyGuardian.org / Luong Quang Ninh*, WIPO Case No. [D2020-0103](#).

The disputed domain name was created in December 2021 and incorporates the Complainant's trademark with an additional non-distinctive term "franchise".

For the above reasons, the Panel finds that the disputed domain name was registered in bad faith, with knowledge of the Complainant, its business and particularly targeting the Complainant's trademark.

The Respondent is using without permission the Complainant's distinctive trademark in order to get traffic on its web portal and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant. This impression is created particularly by the incorporation of the Complainant's trademark in the disputed domain name, the content on the website provided thereunder which includes the Complainant's trademark, official images, and the lack of any disclaimer on such website.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "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" is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant's trademark and the website operated under the disputed domain name displays the Complainant's logo trademark, product images and has no disclaimer, indeed in this Panel's view, the Respondent intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated or related to the Complainant, for its commercial gain.

Furthermore, according to evidence on the record, the disputed domain name has active MX records. This entails that the Respondent can send emails through the email address “@urbanoutfittersfranchise.com”. The Respondent can therefore use (or may already have used) the disputed domain name to send fraudulent emails such as messages containing spam, phishing attempts, etc. See also *Confédération Nationale du Crédit Mutuel, Crédit Industriel et Commercial v. Khodor Dimassi*, WIPO Case No. [D2016-1980](#); or *Statoil ASA v. Registration Private, Domains By Proxy, LLC / Eldar Saetre*, WIPO Case No. [D2018-0563](#).

The Respondent provided inaccurate contact details in the Whois, did not respond to the Complainant’s letter and refused to participate in the present proceedings in order to provide arguments in its favor. Having in view the other circumstances of this case, such facts constitute further evidence of bad faith.

Furthermore, it was consistently found by previous UDRP panels that the mere registration of a domain name that is identical or confusingly similar to a third party’s well-known trademark constitutes, by itself, a presumption of bad faith registration for the purpose of Policy. See section 3.1.4 of the [WIPO Overview 3.0](#).

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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 <urbanoutfittersfranchise.com> be transferred to the Complainant.

/Marilena Comanescu/
Marilena Comanescu
Sole Panelist
Date: August 30, 2022