

ADMINISTRATIVE PANEL DECISION

BA&SH v. Tbcxs Onxw, Jnhd Oneui

Case No. D2022-4548

1. The Parties

The Complainant is BA&SH, France, represented by Cabinet Bouchara, France.

The Respondents are Tbcxs Onxw and Jnhd Oneui, Hong Kong, China.

2. The Domain Names and Registrar

The disputed domain names <boutiquebh.com> and <soldesba.com> are registered with Name.com, Inc. Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 29, 2022. On November 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 1, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 1, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to amend the Complaint adding the Registrar-disclosed registrants as formal Respondents and provide relevant arguments or evidence demonstrating that all named Respondents are, in fact, the same entity and/or that all domain names are under common control; and/or file a separate complaint for any domain name for which it is not possible to demonstrate that all named Respondents are in fact the same entity and/or that all domain names are under common control and indicate (by short amendment or reply email) which domain name will no longer be included in the current Complaint. The Complainant filed an amended Complaint on December 1, 2022.

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 Respondents of the Complaint, and the proceedings commenced on December 6, 2022.

In accordance with the Rules, paragraph 5, the due date for Response was December 26, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on December 29, 2022. The Center appointed Edoardo Fano as the sole panelist in this matter on January 5, 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 Panel has not received any requests from the Complainant or the Respondents regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to the Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a response from the Respondents.

The language of the proceeding is English, being the language of the Registration Agreements, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is International BA&SH, a French company operating in the fashion field and owning several trademark registrations for BA&SH, including the following:

- French Trademark Registration No. 3444110 for BA&SH and design, registered on January 5, 2007;
- European Union Trade Mark Registration No. 005679758 for BA&SH and design, registered on February 10, 2012.

The Complainant also operates on the Internet, being "www.ba-sh.com" its main website.

The Complainant provided evidence in support of the above.

According to the WhoIs records, the disputed domain name <soldesba.com> was registered on May 23, 2022, and the disputed domain name <boutiquebh.com> was registered on August 13, 2022. They resolve to almost identical websites where the Complainant's trademark is reproduced and fashion products are offered for sale.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain names are confusingly similar to its trademark BA&SH, as the disputed domain name <soldesba.com> reproduces the first half and dominant sequence "BA" of the Complainant's trademark, with the addition of the term "soldes", while the disputed domain name <boutiquebh.com> reproduces the first and last letters of the Complainant's trademark and is therefore phonetically similar to it, with the addition of the term "boutique".

Further to section 6.1 below, the Complainant argues that the disputed domain names are under common control and thus addresses the Respondents in the singular. The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names since it has not been authorized by the Complainant to register the disputed domain names or to use its trademark within the

disputed domain names, it is not commonly known by the disputed domain names and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names: the disputed domain names are resolving to almost identical websites where the Complainant's trademark is reproduced and fashion products are offered for sale, with the aim to divert consumers and/or to capitalize on the Complainant's notoriety.

The Complainant submits that the Respondent has registered the disputed domain names in bad faith, since the Complainant's trademark BA&SH is distinctive and known in the fashion field. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain names and the Complainant contends that the use of the disputed domain names with the purpose to sell fashion goods and attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark as to an affiliation between the Respondent and the Complainant, qualifies as bad faith registration and use.

B. Respondent

The Respondents have made no reply to the Complainant's contentions and are in default. In reference to paragraphs 5(f) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn (see, e.g., *Reuters Limited v. Global Net 2000, Inc.*, WIPO Case No. [D2000-0441](#); *Microsoft Corporation v. Freak Films Oy*, WIPO Case No. [D2003-0109](#); *SSL International PLC v. Mark Freeman*, WIPO Case No. [D2000-1080](#); *Altavista Company v. Grandtotal Finances Limited et. al.*, WIPO Case No. [D2000-0848](#); and *Confédération Nationale du Crédit Mutuel, Caisse Fédérale du Crédit Mutuel Nord Europe v. Marketing Total S.A.*, WIPO Case No. [D2007-0288](#)).

6. Discussion and Findings

6.1 Consolidation of Multiple Respondents

The Complainant has requested consolidation of multiple Respondents and stated that both the disputed domain names belong to the same person or organization. No objection to this request was made by the Respondents.

Pursuant to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") section 4.11.2, "[w]here a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario". The Panel may consider a range of factors to determine whether consolidation is appropriate, such as examining relevant registrant contact information, and any naming patterns in the disputed domain names, or other evidence of respondent affiliation that indicate common control of the disputed domain names.

The Panel notes that both the disputed domain names follow the same naming pattern and are resolving to the almost identical websites, in which the same products as the Complainant's are offered for sale and the Complainant's trademark is reproduced. The Panel finds that there is plausible evidence that the disputed domain names are subject to common control, and that it would be procedurally efficient, fair, and equitable to all Parties to accept the Complainant's consolidation request. The Panel further notes that the Respondents did not object to the consolidation request. The Panel therefore accepts the Complainant's consolidation request. Hereinafter, the Panel will refer to the Respondents in the singular, *i.e.*, "the Respondent".

6.2 Substantive Issues

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (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 respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark BA&SH both by registration and acquired reputation and that the disputed domain names are confusingly similar to the trademark BA&SH.

Regarding the addition of the terms “soldes” (“sales” in English) and “boutique”, the Panel notes that it is now well established that the addition of terms or letters to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark (see, e.g., *Aventis Pharma SA., Aventis Pharma Deutschland GmbH v. Jonathan Valicenti*, WIPO Case No. [D2005-0037](#); *Red Bull GmbH v. Chai Larbthanasub*, WIPO Case No. [D2003-0709](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#)). The addition of the terms “soldes” and “boutique” does not therefore prevent the disputed domain names from being confusingly similar to the Complainant’s trademark. See [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a generic gTLD, in this case “.com”, is typically ignored when assessing the confusing similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain names are confusingly similar to the Complainant’s trademark, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Respondent has failed to file a formal response in accordance with the Rules, paragraph 5.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not commonly known by the disputed domain names and is not using the disputed domain names for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services, but instead on the websites at the disputed domain names the Complainant’s trademark is reproduced and fashion products are offered for sale.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain names. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain names, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

Should the products sold on the websites to which the disputed domain names are directing Internet users be the Complainant’s genuine products, legitimately acquired by the Respondent, the question that would arise is whether the Respondent would therefore have a legitimate interest in using the disputed domain names that are confusingly similar to the Complainant’s trademark in circumstances that are likely to give rise to confusion.

According to the current state of UDRP decisions in relation to the issue of resellers as summarized in the [WIPO Overview 3.0](#), section 2.8.1:

“[...] resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the “Oki Data test”, the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.”

This summary is based on the UDRP decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Even if the products sold by the Respondent were the Complainant’s genuine products, from inspection of the Respondent’s websites, in addition to the composition of the disputed domain names themselves which give an impression of being affiliated with the Complainant, the Panel finds that the use of the Complainant’s trademark unadorned and very prominently on the top and center of the homepages and the lack of any disclaimer would falsely suggest to Internet users, under the Oki Data principles (see above), that the websites to which the disputed domain names resolve are owned by the Complainant or at least affiliated to the Complainant. The Panel also notes that the “Contactez-nous” link on the pages leads to a page where only users can fill in a form but there is no actual contact information about the Respondent.

The Panel therefore concludes that the disputed domain names are not being used in connection with a *bona fide* offering of goods or services.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that “for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 its documented out-of-pocket costs directly related to the domain name; or
- (ii) that [the respondent has] registered the 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) that [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] website or other on-line location, by creating a likelihood of

confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] web site or location or of a product or service on [the respondent's] web site or location".

Regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant's trademark BA&SH in the fashion field is clearly established and the Panel finds that the Respondent likely knew of the Complainant and deliberately registered the disputed domain names, especially because the disputed domain names resolve to websites consisting of advertising for the sale of fashion products and where the Complainant's trademark is reproduced.

The Panel further notes that the disputed domain names are also being used in bad faith since the Respondent is trying to attract Internet users to its websites by creating likelihood of confusion with the Complainant's trademark in order to sell what appears to be the same products as the Complainant's, an activity detrimental to the Complainant's business.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain names in order both to disrupt the Complainant's business, in accordance with paragraph 4(b)(iii) of the Policy, and to attract, for commercial gain, Internet users to its websites in accordance with paragraph 4(b)(iv) of the Policy.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain names in bad faith.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been 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 names <boutiquebh.com> and <soldesba.com> be transferred to the Complainant.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: January 16, 2023