

## **ADMINISTRATIVE PANEL DECISION**

ABG-Nine West, LLC v. Sabrina Herz

Case No. D2023-0295

### **1. The Parties**

Complainant is ABG-Nine West, LLC, United States of America (“United States”), represented by Authentic Brands Group, United States.

Respondent is Sabrina Herz, Germany.

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

The disputed domain name <ninewesthrvatska.com> (the “Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 23, 2023. On January 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same date, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Name which differed from named Respondent (John Doe / See PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to Complainant on January 26, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on the same date.

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 Respondent of the Complaint, and the proceedings commenced on February 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on February 24, 2023.

The Center appointed Clive L. Elliott, K.C., as the sole panelist in this matter on March 10, 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

Complainant is the owner of the NINE WEST brand, a global fashion, footwear and accessories brand established in 1978. Its goods are sold worldwide in Nine West stores and select department stores, as well as on Complainant's website "www.ninewest.com".

Complainant is the registered owner of more than 1,200 trade marks covering a wide variety of goods and services, and a portfolio of copyrights for images used in association with the advertising, marketing and sale of Complainant's NINE WEST branded products globally. More particularly, Complainant owns the following European Union Trade Marks ("Complainant's Mark"):

Mark	Registration No	Registration Date	Class
NINE WEST	000906073	March 2, 2000	9, 14, 18, 25
9 WEST	000903419	March 2, 2000	9, 14, 18, 25

According to the publicly available Whois the Domain Name was registered on July 3, 2021. Complainant has submitted evidence showing that in the past the Domain Name resolved to an online shop in Croatia displaying Complainant's Mark and purportedly offering for sale Complainant's trademarked goods.

#### 5. Parties' Contentions

##### A. Complainant

Complainant asserts that the Domain Name is confusingly similar to Complainant's Mark as it contains Complainant's Mark in its entirety together with the geographically descriptive term "hrvatska", which is a Croatian term for "Croatian".

Complainant states that Respondent has not been licensed, contracted or otherwise permitted in any way to use Complainant's Mark. Further, Complainant contends that Respondent has been actively using Complainant's Mark in the Domain Name and on the physical website to promote its website for illegitimate commercial gains by operating a fake NINE WEST website offering counterfeits of Complainant's goods.

Complainant therefore asserts that on the date of this Complaint, the Domain Name resolved to a website offering Complainant's counterfeit goods and that this activity is likely to trick consumers into believing that Complainant is affiliated with Respondent or endorsing its commercial activities while no such relationship exists.

Complainant submits that Respondent has registered and is using the Domain Name in bad faith and is not making a legitimate noncommercial or fair use of the Domain Name.

##### B. Respondent

Respondent did not reply to Complainant's contentions.

#### 6. Discussion and Findings

##### A. Identical or Confusingly Similar

Complainant is the owner of a number of trade mark registrations, including in the European Union, where

Respondent purports to reside. These marks are set out above and are referred to as “Complainant’s Mark”.

The Domain Name reproduces Complainant’s Mark containing the element NINE WEST in its entirety. The Domain Name also includes the term “hrvatska”, which is said to be a Croatian term for “Croatian”. For those consumers who speak Croatian that meaning would be readily apparent to them. The inclusion or addition of this word does not prevent a finding of confusing similarity. See section 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Importantly, Complainant’s Mark is readily recognizable in the Domain Name. See section 1.7 of [WIPO Overview 3.0](#).

The Domain Name is therefore confusingly similar to Complainant’s Mark.

The first ground under the Policy is made out.

## **B. Rights or Legitimate Interests**

As noted above, Complainant asserts that Respondent is using Complainant’s Mark in the Domain Name, which resolved to a website that was allegedly offering counterfeits of Complainant’s goods (the Panel notes that the website currently resolves to a blank page). Respondent has had the opportunity to do so, but has failed to respond to these allegations. Given that it appears Respondent or its associate’s website is offering for sale (possibly counterfeit) goods associated with Complainant, Respondent’s conduct is likely to mislead members of the public. The Panel further finds that the composition of the Domain Name incorporating the Complainant’s Mark in its entirety together with the term “hrvatska”, which is a Croatian term for “Croatian” carries a risk of implied affiliation, especially when considering the impersonating nature of the Domain Name. In addition, the Domain Name is suggestive of sponsorship or endorsement by the trade mark owner, namely Complainant See section 2.5.1 of the [WIPO Overview 3.0](#). Such conduct is not legitimate. Respondent cannot establish rights or legitimate interests pursuant to paragraph 4(c)(iii) of the Policy.

In addition, the above conduct does not represent a *bona fide* offering of goods or services and cannot constitute fair use. Instead, it appears to be an attempt to utilize Complainant’s name and its products for commercial gain.

Further, Respondent cannot claim to have been commonly known by the Domain Name.

Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the Domain Name.

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

In terms of registration and use of the Domain Name, allegedly in bad faith, Complainant submits that Respondent has registered and is using the Domain Name in bad faith and is not making a legitimate noncommercial or fair use of the Domain Name. Section 3.1.4 of the [WIPO Overview 3.0](#) notes that: “[T]he mere registration of a domain name that is identical or confusingly similar [...] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.” Complainant’s Mark has been widely registered and appears to be widely known.

Most relevantly in terms of this ground, the Domain Name appears to have been used in connection with a website impersonating Complainant. The Panel finds that the Domain Name was registered with the requisite knowledge on Respondent’s part and has since been used in a manner likely to mislead members of the public.

Given the above considerations, the Panel is satisfied that the Domain Name was registered and used in bad faith.

Complainant has therefore established the third ground under 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 Domain Name <ninewesthrvatska.com> be transferred to the Complainant.

*/Clive L. Elliott/*

**Clive L. Elliott**

Sole Panelist

Date: March 27, 2023