

ADMINISTRATIVE PANEL DECISION

Ben Sherman IP Holding LP v. Yun Yang
Case No. D2023-0449

1. The Parties

The Complainant is LP Ben Sherman IP Holding, United States of America (“U.S.”), represented by Tucker & Latifi, LLP, U.S.

The Respondent is Yun Yang, China.

2. The Domain Name and Registrar

The disputed domain name <bensherman-store.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2023. On February 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 3, 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 amended Complaint on February 16, 2023.

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 February 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 10, 2023.

The Center appointed Miguel B. O’Farrell as the sole panelist in this matter on March 16, 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, LP Ben Sherman IP Holding, is a U.S. company which deals in clothing, accessories, footwear, fragrance, home goods, and online retail services around the world. The Ben Sherman brand was established in 1963 when its namesake Mr. Ben Sherman decided to launch his own line of shirts.

The Complainant owns several trademark registrations for BEN SHERMAN in various jurisdictions, including the following:

U.S. Trademark Registration No. 3,109,886 BEN SHERMAN, registered on June 27, 2006, in classes 14, 16, and 18;

U.S. Trademark Registration No. 2,104,981 BEN SHERMAN, registered on October 14, 1997, in class 25;

European Union Trademark Registration No. 000217232 BEN SHERMAN, registered on August 12, 2004, in class 25;

European Union Trademark Registration No. 000398354 BEN SHERMAN, registered on December 10, 1998, in class 25.

The disputed domain name was registered on June 16, 2022, which since the Complaint was filed, has been resolving to a website which offers for sale products similar to those of the Complainant under the trademark BEN SHERMAN.

5. Parties' Contentions

A. Complainant

The Complainant, in essence, claims that the disputed domain name is confusingly similar with the trademark BEN SHERMAN, in which the Complainant has rights, and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, the BEN SHERMAN trademarks are registered around the world in over 114 countries.

In addition to the above-mentioned BEN SHERMAN trademark registrations, the Complainant maintains and operates "www.bensherman.com" as its primary website on the Internet.

The Respondent is not commonly known by the disputed domain name.

The Complainant has not authorized or licensed the use of the trademark BEN SHERMAN to the Respondent.

The Respondent has no rights in, nor does it have any legitimate interests in the disputed domain name.

The disputed domain name resolves to an online store that is dedicated to being purposely confusingly similar to the Complainant's online retail store and seeks to sell itself as a retailer of genuine BEN SHERMAN apparel, which could not be further from the truth. The Complainant claims the goods offered are counterfeit.

Finally, the Complainant requests the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainant's BEN SHERMAN trademark.

The disputed domain name incorporates the Complainant's trademark BEN SHERMAN in its entirety with the addition of a hyphen, and the word "store", which do not prevent a finding of confusing similarity.

The ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark BEN SHERMAN in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it of the dispute, the respondent's 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production 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.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

Likewise, and as further discussed under section 6.C of this decision, it does not seem that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name, but rather that it intends to use the disputed domain name for the purpose of deriving unfair monetary advantage by confusing Internet users and leading them to believe that the website to which the disputed domain name relates is an official site of the Complainant. That being said, even if the nature of the goods offered at the disputed domain name were genuine, given the impersonating nature of the website at the disputed domain name, which copies information and images from the Complainant's official website and does not disclose its relationship (lack thereof) to the Complainant, the Respondent cannot be said to be using the disputed domain name for a *bona fide* offering of goods or services. [WIPO Overview 3.0](#), section 2.8.

As established in section 2.5 of [WIPO Overview 3.0](#): "Fundamentally, a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry." Here, the nature of the disputed domain name carries a risk of implied affiliation.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent must have been aware of the Complainant's trademark BEN SHERMAN mentioned in section 4 above (Factual Background) when it registered the disputed domain name on June 16, 2022. By that time, the Complainant's trademark had been registered and widely used for many years.

By registering the disputed domain name, the Panel finds that the Respondent was targeting the Complainant and its business by incorporating the Complainant's distinctive trademark BEN SHERMAN, with a hyphen, and the descriptive word "store", which only adds to confusion to make Internet users believe that the website to which the disputed domain resolves belongs to or is affiliated with the Complainant, particularly since they both offer the same type of goods.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name, the nature of the disputed domain name, the use of the disputed domain name to resolve to a website offering similar and possibly counterfeits of the Complainant's apparel are indications of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)).

The Panel therefore finds that the Respondent registered and is using the disputed domain name in bad faith.

For the above reasons, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy have been

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 <bensherman-store.com> be transferred to the Complainant.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

Date: March 24, 2023