

## **ADMINISTRATIVE PANEL DECISION**

No Ordinary Designer Label Limited t/a Ted Baker v. Client Care, Web Commerce Communications Limited  
Case No. D2023-1767

### **1. The Parties**

The Complainant is No Ordinary Designer Label Limited t/a Ted Baker, United States of America ("United States"), represented by Authentic Brands Group, United States.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

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

The disputed domain names <tedbakerukstore.com> and <tedbakerukstores.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 20, 2023. On April 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 24, 2023, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 28, 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 amendment to the Complaint on May 11, 2023. 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 the Respondent of the Complaint, and the proceedings commenced on May 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 6, 2023.

The Center appointed Angela Fox as the sole panelist in this matter on June 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 is the owner of the TED BAKER brand, which it has used for over 35 years in respect of goods including apparel, accessories, footwear, homeware, and beauty in the United States and internationally. The Complainant owns numerous trademark registrations relating to the TED BAKER mark covering a wide variety of goods and services as well as copyright in images used in association with the advertising, marketing, and sale of TED BAKER-branded products globally. The Complainant's relevant trademark rights include, in particular, the following, details of which were annexed to the Complaint:

- United Kingdom trademark registration no. 3250250 for TED BAKER in Classes 3, 4, 8, 9, 11, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 28, 35, 41, 43 and 44, filed on August 14, 2017;
- United Kingdom trademark registration no. 2320837 for TED BAKER in Classes 3, 9, 14, 18, 20, 21, 24 and 25, filed on January 15, 2003;
- United Kingdom trademark registration no. 911370467 for TED BAKER in Class 18, filed on November 23, 2012.
- United Kingdom trademark registration no. 905210661 for TED BAKER in Class 35, filed on July 20, 2006.
- United Kingdom trademark registration no. 910245827 for TED BAKER LONDON in Classes 3, 9, 14, 18 and 25, filed on September 7, 2011.

The disputed domain name <tedbakerukstore.com> was registered on September 15, 2022, and the disputed domain name <tedbakerukstores.com> was registered on May 18, 2022. They are being used to link to a fake TED BAKER website offering unauthorized and/or counterfeit TED BAKER goods at steeply discounted prices.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant submits that the disputed domain names are identical or confusingly similar to the Complainant's registered TED BAKER trademarks. The disputed domain names consist of the Complainant's trademark "TED BAKER", the geographic abbreviation "UK", and the descriptive term "store" or "stores", and the generic Top-Level Domain ("gTLD") ".com". The Complainant observes that where the relevant trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity (see, e.g., *Rakuten, Inc. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Matthew Connor, No Company*, WIPO Case No. [D2019-2983](#); *Advance Magazine Publishers Inc. v. Marcellod Russo*, WIPO Case No. [D2001-1049](#), finding <vogueaustralia.com> confusingly similar to VOGUE); and *Yahoo! Inc. v. Microbiz, Inc.*, WIPO Case No. [D2000-1050](#), finding <yahooflorida.com> and <yahoousa.com> confusingly similar to the YAHOO! Mark).

The Complainant further submits that the Respondent has no rights or legitimate interests in the disputed domain names. The Complainant has not licensed or otherwise permitted the Respondent to use the Complainant's trademarks or to apply for domain names incorporating them. The Respondent has not been commonly known by a name corresponding to the disputed domain names. The Respondent is not making

a legitimate noncommercial or fair use of the disputed domain names. There is also no evidence that the Respondent has used or plans to use the disputed domain names in respect of any *bona fide* offering of goods or services not infringing the Complainant's intellectual property rights. On the contrary, the Respondent has been actively using the disputed domain names to host a website purporting to be a legitimate website of the Complainant, but offering unauthorized and/or counterfeit TED BAKER goods. The Complainant submits that such use is not a *bona fide* offering of goods within the meaning of the Policy because it is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorses its commercial activities when in fact no such relationship exists.

Finally, the Complainant submits that the disputed domain names were registered and have been used in bad faith. The Complainant submits that the Respondent must have been aware of the Complainant's TED BAKER trademarks when it registered the disputed domain names, and that it has been using the disputed domain names to pass its website off as that of the Complainant, and is selling unauthorized and/or counterfeit TED BAKER merchandise through the website. Thus, the Complainant submits that the Respondent is intentionally trying to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement (see *e.g. Urban Outfitters Inc. v. Super Privacy Service LTD c/o Dynadot / Domain Administrator, Domain Name Corporation*, WIPO Case No. [D2022-2928](#) citing *Gilead Sciences, Inc. v. Adewale Tokosi*, WIPO Case No. [D2021-0961](#).)

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions and is in default. No exceptional circumstances explaining the default have been put forward. Therefore, in accordance with paragraphs 14 (a) and (b) of the Rules, the Panel will decide the Complaint and shall draw such inferences as it considers appropriate from the Respondent's default.

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the panel finds that:

- (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.

All three elements must be present before a complainant can succeed in an administrative proceeding under the Policy.

### **A. Identical or Confusingly Similar**

The Complainant has proved that it has registered trademark rights in TED BAKER. The disputed domain names include TED BAKER in its entirety, followed only by "ukstore" or "ukstores" and the gTLD ".com". The "ukstore" and "ukstores" portion of the disputed domain names does not prevent a finding of confusing similarity. As noted in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("the WIPO Overview"), at paragraph 1.11.1, the Top-Level Domain suffix is a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Panel concludes that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

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

The Complainant has provided evidence that the disputed domain names have been used for a website which purports to be a legitimate TED BAKER branded website and which offers TED BAKER branded clothing, bags and shoes but at steeply discounted prices. The “ukstore” and “ukstores” portion of the disputed domain names is likely to be understood descriptively as denoting a website at which goods directed at United Kingdom consumers can be purchased. This is not a website of the Complainant and the Complainant submits that the goods offered through the website are unauthorized or counterfeit TED BAKER goods. The Respondent has made no effort to respond to these allegations and the Panel finds the Complainant’s assertions to be credible.

[WIPO Overview 3.0](#), section 2.13.1 states, “Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”

The Panel finds that the Complainant has no rights or legitimate interests in the disputed domain names.

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

The Complainant has been using the TED BAKER trademark for a wide range of goods including apparel and accessories for some 35 years, and therefore since long before the disputed domain names were registered. The Complainant’s registered trademark rights long pre-date the registration of the disputed domain names.

The use of the disputed domain names to host a website offering unauthorized or counterfeit TED BAKER clothing, bags and footwear demonstrates that the Respondent registered the disputed domain names in the knowledge of the Complainant’s TED BAKER trademark and with the intention of masquerading as the Complainant, in order to attract, for commercial gain, Internet users to its website under the false impression that they were in fact visiting a website of the Complainant. Such activities entitle the Panel to find bad faith registration and use under paragraph 4(b)(iv) of the Policy.

The Panel finds that the disputed domain names were registered and have been used in bad faith.

## **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, <tedbakerukstore.com> and <tedbakerukstores.com>, be transferred to the Complainant.

*/Angela Fox/*

**Angela Fox**

Sole Panelist

Date: July 17, 2023