

## **ADMINISTRATIVE PANEL DECISION**

No Ordinary Designer Label Limited t/a Ted Baker v. li xiao lei  
Case No. D2023-3116

### **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 li xiao lei, China.

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

The disputed domain name <tedbakerclothing.com> is registered with Bizcn.com, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 19, 2023. On July 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 21, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 26, 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 in English on July 26, 2023.

On July 26, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On July 27, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Chinese of the Complaint, and the proceedings commenced on August 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 14, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on September 21, 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, and has been for many years, a manufacturer of apparel, accessories, footwear, homeware and beauty products with large, global-scale business operations and has advertised, marketed, distributed and sold such products worldwide under its TED BAKER brand.

The Complainant provides evidence that it owns a large international trademark portfolio for TED BAKER, including, but not limited to, the following trademark registrations: United States Trademark Registration number 2644551 for the word mark TED BAKER, registered on October 29, 2002 and United States Trademark Registration number 2672649 for the word mark TED BAKER, registered on January 7, 2003. The Complainant also has a strong online presence through its official websites and social media accounts.

The disputed domain name was registered on May 31, 2020 and is therefore of a later date than the abovementioned trademarks adduced by the Complainant. Based on the Complainant's evidence, the disputed domain name resolves to a website prominently displaying the TED BAKER trademarks on the home page and offers for sale what purport to be the Complainant's products at heavily discounted prices.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the Respondent is trying to pass off the website linked to the disputed domain name as the Complainant's website to sell competing and unauthorized goods. The Complainant also argues that the Respondent has been actively using the TED BAKER trademarks in the disputed domain name and on the website to promote its website for illegitimate commercial gains, more specifically, by operating a fake TED BAKER website offering unauthorized and/or counterfeit TED BAKER goods. The Complainant contends that such unauthorized use of the TED BAKER trademarks is likely to trick consumers into erroneously believing that Complainant is somehow affiliated with the Respondent or endorsing its commercial activities while in fact, no such relationship exists. The Complainant essentially contends that such use of the disputed domain name confers no rights or legitimate interests on the Respondent and that the registration and use of the disputed domain name in such circumstances constitutes registration and use of the disputed domain name in bad faith.

##### **B. Respondent**

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

## 6. Discussion and Findings

### *Language of the Proceeding*

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the content of the website to which the disputed domain name resolves contains extensive use of English, from which it appears that the Respondent understands and is able to communicate in English; and the fact that the Complainant claims not to be in a position to conduct these proceedings in Chinese without additional expense and delay due to the need for translation of the Complaint into Chinese.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms, here "clothing", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In this case, the Panel accepts that, given the unclear origin, the lack of any clear disclaimer and false suggestions of affiliation on the website linked to the disputed domain name and given the heavily discounted product prices, it is very likely that the products offered by the Respondent on such website are counterfeit products.

Panels have 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. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

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

In the present case, the Panel notes that the Respondent has registered a domain name which is confusingly similar to the Complainant's internationally famous trademarks for TED BAKER. The Panel deducts from this fact that by registering the disputed domain name, the Respondent deliberately and consciously targeted the Complainant's prior trademarks for TED BAKER, which creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4, which states "[p]anels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

Furthermore, the Panel also notes that the Complainant's trademarks for TED BAKER were registered many years before the registration date of the disputed domain name. The Panel deducts from these elements that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks at the time of registering the disputed domain name. In the Panel's view, these elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Panel notes that, based on the evidence submitted by the Complainant, the Respondent used the disputed domain name to connect it to a website prominently displaying the TED BAKER trademarks on the home page and offers for sale what purport to be the Complainant's products at heavily discounted prices. In this case, the Panel accepts that, given the unclear origin, the lack of any clear disclaimer and false suggestions of affiliation on the website linked to the disputed domain name and given the heavily discounted product prices, it is very likely that the products offered by the Respondent on such website are counterfeit products.

Panels have 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) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

## **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 <tedbakerclothing.com> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: October 5, 2023