

ADMINISTRATIVE PANEL DECISION

No Ordinary Designer Label Limited t/a Ted Baker v. Client Care, Web
Commerce Communications Limited
Case No. D2023-4123

1. The Parties

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

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

2. The Domain Name and Registrar

The disputed domain name <tedbaker-india.com> is 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 October 3, 2023. On October 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 7, 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 October 10, 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 the same day.

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 October 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 2, 2023.

The Center appointed Gonalo M. C. Da Cunha Ferreira as the sole panelist in this matter on November 20, 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 No Ordinary Designer Label Limited t/a Ted Baker owner of the well-known TED BAKER brand. The Complainant is since many years, one of the world's leading manufacturers of apparel, accessories, footwear, homeware and beauty products, and has advertised, marketed, promoted, distributed and sold such worldwide under its well-known TED BAKER trademark ("Complainant's Mark"). The TED BAKER brand is supported by a global portfolio of more than 500 trademarks covering a wide variety of goods and services and a large portfolio of copyrights for images used in association with the advertising, marketing and sale of TED BAKER branded products globally. The Complainant's trademark portfolio includes but is not limited to, the following in India:

TED BAKER- India Reg. No. 1221767, registered on May 23, 2007, in Class 25,
TED BAKER- India Reg. No. 1221768, registered on October 6, 2005, in Class 18,
TED BAKER- India Reg. No. 1221769, registered on November 28, 2005, in Class 9,
TED BAKER- India Reg. No. 1221770, registered on February 19, 2008 in Class 3,
TED BAKER- India Reg. No. 3005450, registered on August 9, 2019, in Classes 14, 35.

According to the publicly available WhoIs, the disputed domain name was registered on May 8, 2023, and at the time of filing the Complaint, the disputed domain name resolved to a site that purportedly offered for sale Complainant's products at discounted prices.

According to the evidence submitted by the Complainant, this website linked to the disputed domain name indicates in the menu "about us" the following description "We've been serving customers some of the best deals and discounted fashion online since 2012. We're unique in the marketplace, offering thousands of new styles, authentic brands and a huge variety of fashion for the whole family. Stock runs out quickly, so if you see something you like, buy it! We want to exceed your expectations by giving you great value from a trusted source."

According to a search conducted by the Panel, the disputed domain name currently redirects to website "www.tedbakerindia.co.in".

5. Parties' Contentions

A. Complainant

The Complainant claims that:

- a) the disputed domain name is confusingly similar to its own trademark registrations TED BAKER.
- b) began using the Complainant's Mark over 35 years ago.
- c) the disputed domain name consists of the usual "www." prefix, Complainant's trademark TED BAKER (not case sensitive) followed by the geographic term "India" (not case sensitive), and the generic suffix ".com." and once the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

- d) spends millions of dollars marketing its goods and services globally, using the TED BAKER Mark, and has undertaken extensive efforts to protect its name and enforce such trademarks. The Complainant exerts careful control over use of the TED BAKER Mark and imposes strict quality control measures over goods and services offered in connection with the trademarks. The Complainant further protects its brand, and the TED BAKER mark by diligently pursuing infringers.
- e) the Respondent has not been licensed, contracted, or otherwise permitted by the Complainant in any way to use the TED BAKER Mark or to apply for any domain names incorporating the TED BAKER Mark, nor has the Complainant acquiesced in any way to such use or application of the TED BAKER Mark by the Respondent
- f) the Respondent has been actively using the TED BAKER Mark in the disputed domain name and on the physical 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.
- g) the Respondent was aware of the Complainant's trademark at the time the Respondent registered the disputed domain name on May 8, 2023.
- h) the Complainant's trademarks are well-known around the world and a simple Google search would have disclosed the Complainant's marks and business.
- i) the Respondent used a privacy shield to mask its identity, which makes it difficult for the Complainant to contact the Respondent and amicably settle a domain dispute.
- j) the Respondent is intentionally trying to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement.

Finally, the Complainant argues that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1. Substantive Matters

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (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 Complainant has been using its trademarks TED BAKER over 35 years ago and nowadays the Complainant is one of the world's leading manufacturers of apparel, accessories, footwear, and other related products. The Complainant has also registered the Complainant's Mark in a number of countries including India. The Complainant has therefore established it has trademark rights for TED BAKER. The disputed domain name reproduces the Complainant's trademark TED BAKER in its entirety adding the country name "India". Therefore, the TED BAKER trademark is recognizable within the disputed domain name. As well established by previous Panels the addition of the word "india" does not prevent a finding of confusing similarity.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has not licensed, contracted, or otherwise permitted the Respondent in any way to use the TED BAKER Mark or to apply for any domain names incorporating the TED BAKER Mark, nor has the Complainant acquiesced in any way to such use or application of the TED BAKER Mark by the Respondent. The Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent did not submit a response and has failed to invoke any circumstance which could have demonstrated rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation. The disputed domain name resolves to a website purportedly offering TED BAKER goods without providing a visible disclaimer describing the (lack of) relationship between the Parties. The Panel also notes that the general look and feel of the website linked to the disputed domain name is very similar to the Complainant's website at <tedbaker.com>. Panels have held that the use of a domain name for illegal activity (e.g., impersonation) can never confer rights or legitimate interests on a respondent.

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

C. Registered and Used in Bad Faith

The Panel accepts and agrees with the Complainant that the disputed domain name was registered and is being used in bad faith, noting the well-known status of the Complainant's trademark, it is clear that the Respondent was aware of the Complainant's trademark at the time the Respondent registered the disputed domain name. Moreover, the disputed domain name resolves to a website purportedly offering the Complainant's TED BAKER branded goods. By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation.

As evidenced by the Complainant, the website that resolves to the disputed domain name the Respondent states in the "about us" menu the following description "We've been serving customers some of the best deals and discounted fashion online since 2012. We're unique in the marketplace, offering thousands of new styles, authentic brands and a huge variety of fashion for the whole family. Stock runs out quickly, so if you see something you like, buy it! We want to exceed your expectations by giving you great value from a trusted source."

It is clear for the Panel finds that the Respondent registered and is using the disputed domain name in bad faith. Therefore, the Complainant has satisfied paragraph 4(a)(iii) of 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 disputed domain name <tedbaker-india.com> be transferred to the Complainant.

/Gonçalo M. C. Da Cunha Ferreira/

Gonçalo M. C. Da Cunha Ferreira

Sole Panelist

Date: December 4, 2023