

ADMINISTRATIVE PANEL DECISION

Wax London Ltd v. Theresa W Chavez
Case No. D2024-2424

1. The Parties

The Complainant is Wax London Ltd, United Kingdom, represented by Sipara Limited, United Kingdom.

The Respondent is Theresa W Chavez, United States of America.

2. The Domain Name and Registrar

The disputed domain name <waxlondon.shop> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 13, 2024. On June 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 13, 2024, 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 (unidentified individual) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 14, 2024, 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 June 19, 2024.

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 June 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 15, 2024.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on July 22, 2024. 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 was founded in 2015 and sells menswear, through a bricks and mortar shop in London, United Kingdom, and through a website at <waxlondon.com> which offers shipping worldwide.

The Complainant holds numerous trademarks for WAX / WAX LONDON, inter alia:

- European Union Trademark Registration WAX, registration n° 010409886, registered September 24, 2018;
 - United Kingdom Trademark Registration WAX, registration n° UK00910409886, registered September 24, 2018;
 - United States of America Trademark Registration WAX LONDON, registration n° 6856062, registered September 27, 2022 (where the Respondent is apparently located).
- The registrations will hereafter be referred to as the WAX Trademark, respectively the WAX LONDON Trademark, and together, in singular, as the "Trademark".

The disputed domain name was registered on March 3, 2024. It resolves to a website on which the WAX LONDON Trademark is prominently visible in the upper left corner of every page and where a number of different clothing products are offered for sale. The website is in the English language.

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.

As a preliminary remark, the Complainant claims that its Trademark has a significant reputation, as it sells its products through prominent United Kingdom, United States of America and European Union retailers. In the period from May 2022 to February 2023 it had worldwide sales of GBP 4.6 million.

On the first element of the Policy, the Complainant indicates that the disputed domain name encompasses the WAX LONDON Trademark, and is therefore identical to the WAX LONDON Trademark and highly similar to the WAX Trademark as it encompasses the WAX Trademark.

On the second element of the Policy, the Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Also, the Complainant contends that the Respondent is not making a bona fide use of the disputed domain name: "it is submitted that the apparent intention of the Respondent is to mislead consumers into believing that the domain name has some form of connection with the Complainant, and/or to cause harm to the reputation in WAX or WAX LONDON".

On the third element of the Policy, the Complainant claims that the disputed domain name was registered and is being used in bad faith. On the bad faith registration, it highlights the fact that the disputed domain name is identical to the widely-known Trademark. This can be a clear indication of bad faith on the part of the Respondent.

The Complainant further argues that on the website under the disputed domain name, the Respondent offers for sale a number of different clothing products characterized as the Complainant's products. According to the Complainant, promotional images of the Complainant's products from the Complainant's own website at <waxlondon.com> are unauthorizedly used throughout the Respondent's website; the Complainant owns copyright to these images. On that website also, wording is used that is identical to that which is used on the Complainant's website.

The Respondent is not an authorized retailer of the Complainant's products.

The Complainant requests 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

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain name is identical or confusingly similar to 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 has been registered and is being used in bad faith.

The burden of proof of each element is borne by the Complainant. The Respondent's default does not by itself mean that the Complainant is deemed to have prevailed. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.3.

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.

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 entirety of the WAX LONDON Trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the WAX LONDON Trademark.

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

Although the addition of other terms, here "LONDON", 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.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available 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 the 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.

The Respondent registered the disputed domain name for its e-commerce website where in the upper left corner of every page the Trademark WAX LONDON is prominently displayed and that offers for sale a number of different clothing products characterized as WAX LONDON products, thereby using promotional images of the Complainant's products from the Complainant's own website, as well as wording that is identical to that which is used on the Complainant's website. Therefore, the disputed domain name carries a risk of implied affiliation. The Respondent clearly misleads the consumers and diverts them from the real and official Complainant's website, in order to create a commercial gain for himself.

Panels have held that the use of a domain name for illegal activity, here impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Moreover, the disputed domain name consists of the Complainant's WAX LONDON Trademark. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

The Panel draws an adverse inference from the Respondent's failure to take part in the present proceeding where an explanation is certainly called for. [WIPO Overview 3.0](#) at section 4.3.

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.

Bad faith requires the Respondent to be aware of the Complainant's Trademark.

The Complainant Trademark enjoy a strong reputation and the disputed domain name consists solely of the identically reproduced WAX LONDON Trademark.

Moreover, taking into account the fact that the website attached to the disputed domain name in the upper left corner of every page prominently shows the WAX LONDON Trademark, offers for sale a number of different clothing products characterized as WAX LONDON products, uses promotional images of the Complainant's products from the Complainant's own website, as well as wording that is identical to that which is used on the Complainant's website, the Panel finds that the Respondent must have been aware of the Complainant's Trademark when he registered the disputed domain name.

The Respondent has sought to create a misleading impression of association with the Complainant. The disputed domain name is ideally suited to misleading the public, especially as the disputed domain name resolves to a website described above. As a result, the consumer gets the impression that the website is an official website of the Complainant, or a corporation associated with it, and is thus being misled. Such a use of a domain name, in a blatant targeting of the Complainant's trademark rights, obviously amounts to a use in bad faith.

Panels have held that the use of a domain name for illegal activity, here impersonation/passing off, 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.

The Panel finds that the Complainant has established the third element 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 <waxlondon.shop> be transferred to the Complainant.

/Richard C.K. van Oerle/

Richard C.K. van Oerle

Sole Panelist

Date: July 31, 2024