

ADMINISTRATIVE PANEL DECISION

BEXLEY SAS v. Lu Ni La

Case No. D2024-2457

1. The Parties

The Complainant is BEXLEY SAS, France, represented by Cabinet Regimbeau, France.

The Respondent is Lu Ni La, United States of America.

2. The Domain Name and Registrar

The disputed domain name <bexleyshoes.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 17, 2024. On June 17, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 18, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 18, 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 20, 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 Rodrigo Velasco Santelices 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 is BEXLEY SAS, a French company founded in Lyon in 1985. Although it is mainly specialized and known for its high-quality shoes for men, the Complainant has diversified overtime to adapt to its consumers' new clothing habits.

The Complainant contends that it has extended its expertise to sneakers and men's clothing. These goods are exclusively sold in the Complainant's physical stores or on its website.

After almost 40 years of existence, the Complainant contends that it has largely developed and now owns 35 stores, situated across France, Belgium, Luxembourg, and Spain. The Complainant's shops have a very particular appearance as their storefront is made entirely out of wood with green blinds and their inside is specifically fitted out, thus attracting the attention of consumers on the trademark.

A large part of the Complainant's activity is also carried out online through its websites at "www.bexley.fr" and "www.bexley.com", which allow the company to reach a larger range of customers worldwide. The Complainant further contends that 35 percent of their sales are made online, and the company has had over 1 million clients since its creation in 1985.

The disputed domain name was registered on February 2, 2024.

The Complainant has provided evidence that the disputed domain name resolves to a website that is an almost exact copy of the Complainant's website at "www.bexley.com".

The Complainant is the owner of close to a hundred trademark registrations worldwide composed, in whole or in part, of the word BEXLEY, inter alia, the following:

- BEXLEY, French trademark No. 1330125, filed on November 5, 1985 (duly renewed) and covering goods in classes 18 and 25;
- BEXLEY, International trademark No. 1101074, registered on November 10, 2011, and covering goods in classes 3, 9, 14, and 24.

Further, the Complainant owns numerous domain name registrations composed, in whole or in part, of the mark BEXLEY, in particular:

- <bexley.fr>, registered by the Complainant on February 1, 1996;
- <bexley.com>, registered by the Complainant on November 26, 1997;
- <bexleyshoes.co.uk>, registered by the Complainant on September 11, 2013.

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 it is the owner of trademark BEXLEY in various jurisdictions and it cannot be questioned that the disputed domain name is confusingly similar to the trademark registrations of the Complainant.

The disputed domain name identically adopts the Complainant's BEXLEY trademarks. Further, the disputed domain name reproduces the BEXLEY trademarks in its entirety. It is standard practice when comparing a domain name to a complainant's trademarks, to not take the extension into account, in this case ".com". Further, the additional term "shoes" also does not prevent a finding of confusing similarity. Thus, any Internet user when visiting a website provided under the disputed domain name will reasonably expect to find a website commercially linked to the owner of the BEXLEY trademarks.

The Complainant contends that the Respondent does not have any rights or legitimate interests in the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["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 mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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

Although the addition of other terms, here "shoes", may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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. Furthermore, the Panel considers that the composition of the disputed domain name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that 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, or endorsement of the Respondent's website, UDRP paragraph 4(b)(iv). There is in fact no such connection between the website and the Complainant.

The Complainant's trademarks were registered many years prior to the registration of the disputed domain name. At the time of filing the Complaint, the disputed domain name resolved to a website prominently displaying the Complainant's trademarks and impersonating the Complainant's own website.

Consequently, it is evident that the Respondent was well aware of the Complainant's trademarks when registering the disputed domain name.

The Complainant's trademark BEXLEY is well known and has no descriptive meaning for the goods and services in question. Thus, the adoption by the Respondent can therefore not be a coincidence.

Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, the composition of the disputed domain name, and the Respondent's failure to file a response, finds that in the circumstances of this case the use of the disputed domain name does not prevent a finding of bad faith under the Policy.

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 <bexleyshoes.com> be transferred to the Complainant.

/Rodrigo Velasco Santelices/

Rodrigo Velasco Santelices

Sole Panelist

Date: August 2, 2024