

ADMINISTRATIVE PANEL DECISION

A&S Holdings (AUS) Pty Ltd v. Jonas Duerr
Case No. D2025-0719

1. The Parties

The Complainant is A&S Holdings (AUS) Pty Ltd, Australia, represented by Corrs Chambers Westgarth, Australia.

The Respondent is Jonas Duerr, Germany.

2. The Domain Name and Registrar

The disputed domain name <iamgiaaustralia.com> is registered with Metaregistrar BV (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2025. On February 21, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 February 23, 2025, 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 February 27, 2025.

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 February 27, 2025. In accordance with the Rules, paragraph 5, the due date for Response was March 19, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 24, 2025.

The Center appointed Olga Zalomiy as the sole panelist in this matter on March 27, 2025. 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 a part of the A&S Group, which operates a women's fashion clothing business. The Complainant owns numerous I AM GIA and I.AM.GIA trademark registrations around the world, such as:

- The Australian trademark registration No. 1876551 for the I AM GIA mark registered on September 28, 2017;
- The European Union trademark registration No. 1364010 for the I. AM. GIA mark registered on June 27, 2017; and
- The Australian trademark registration No. 1829873 for the I.AM.GIA mark registered on March 8, 2017.

The Complainant's group of companies also owns the domain name <iamgia.com> that directs to its official website. In addition, the Complainant has a strong social media presence on Facebook, Instagram and TikTok social media channels.

The Respondent registered the disputed domain name on December 19, 2024. Currently, the disputed domain name does not resolve to an active website. Previously, it directed users to an online store that offered purported Complainant's goods for sale. The website associated with the disputed domain name also displayed the Complainant's I.AM.GIA trademark and images of the Complainant's products sourced from the Complainant's website.

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 disputed domain name is confusingly similar to its I AM GIA trademark, as it incorporates the trademark in full. The Complainant further argues that the inclusion of the term "Australia" does not prevent a finding of confusing similarity between the disputed domain name and its trademark because it only indicates the geographical location where the goods are sold or sourced.

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name because the Respondent is neither affiliated with nor connected to the Complainant. The Complainant argues that the Respondent is not making legitimate noncommercial or fair use of the disputed domain name or uses it for bona fide offering of goods or services, because it is using the disputed domain name for the sale of goods purporting to be the Complainant's. In the Complainant's view, such use amounts to impersonation/passing off and "the sale of counterfeit goods", which can never confer rights or legitimate interests on the Respondent.

The Complainant claims that the Respondent registered the disputed domain name in bad faith, because the Respondent registered the disputed domain name with the Complainant's trademark in mind and engages in consumer deception by impersonating the Complainant. According to the Complainant, the Respondent's website prominently displays the Complainant's trademark and images of the Complainant's products, allegedly copied from the Complainant's official website, as well as adopts a similar format to the Complainant's official website. The Complainant further argues that the Respondent's actions demonstrate bad faith, as the disputed domain name was registered to achieve financial gain through a website designed to create a false impression of being affiliated with the Complainant.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the disputed domain name:

- (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

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.

Although the addition of other terms here, the geographical term "Australia", 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 inclusion of the generic Top-Level Domain ".com" is typically disregarded in the context of the confusing similarity assessment, being a technical requirement for registration. [WIPO Overview 3.0](#), section 1.11.1.

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 evidence on record shows that the Respondent is not commonly known by the disputed domain name. The Respondent is not making legitimate noncommercial or fair use of the disputed domain name or uses it for bona fide offering of goods or services, because the disputed domain name does not currently direct to an active website. The Respondent has not been authorized by the Complainant to use the Complainant's distinctive trademark in a domain name.

Nor does the Respondent's prior use of the disputed domain name establish any rights or legitimate interests to the Respondent. Previous UDRP panels have recognized that resellers or distributors using domain names containing the complainant's trademark to undertake sales of the complainant's goods may be making a bona fide offering of goods and thus have rights or legitimate interests in such domain names in some situations.

Outlined in the *Oki Data* case¹, the following cumulative requirements must be satisfied for the respondent to make a bona fide offering of goods and services:

- “(i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to corner the market in domain names that reflect the trademark” (the “Oki Data test”).

In this case, the disputed domain name directed users to an online store that displayed the Complainant's trademark and images of Complainant's goods sourced from the Complainant's website. The infringing website replicated the look and feel of the Complainant's official online store and offered goods purporting to be those of the Complainant for sale. Additionally, the website provided no information about the Respondent or its lack of affiliation with the Complainant. As a result, the Respondent failed to satisfy the Oki Data test.

The passive holding of the disputed domain name, which currently does not resolve to an active website, does not grant the Respondent any rights or legitimate interests.

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.

Under the UDRP, “bad faith” registration and use of a domain name, as outlined in paragraph 4(b)(iv), may be established by demonstrating circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to source, sponsorship, affiliation or endorsement of the respondent's website or location, or of a product or service on the respondent's website or location.

¹ See [WIPO Overview 3.0](#), section 2.8.1; and *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Previous UDRP panels have identified various types of evidence supporting a finding of bad faith registration for commercial gain, including “(i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent’s commercial benefit, even if unsuccessful, (iii) the lack of a respondent’s own rights to or legitimate interests in a domain name, (vi) absence of any conceivable good faith use.” [WIPO Overview 3.0](#), section 3.1.4.

In the present case, the Panel notes that the Respondent registered the disputed domain name, incorporating the Complainant’s trademark along with the geographical term “Australia,” seven years after the Complainant’s first trademark registration. The Respondent’s lack of rights or legitimate interests in the domain name, the absence of a credible explanation for selecting these terms, the use of the disputed domain name to direct users to a website selling the purported Complainant’s goods all indicate that the registration was made in bad faith. Furthermore, the Respondent’s prior use of the disputed domain name for the website that recreated the look and feel of the Complainant’s website, its use of photographs from the Complainant’s website, and sale of the purported Complainant’s goods without any disclaimer indicating lack of any relationship with the Complainant, as well as lack of Respondent’s rights or legitimate interests in the disputed domain name, all indicate the Respondent’s bad faith use of the disputed domain name.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant’s trademark, and the composition of the disputed domain name, false contact information provided by the Respondent at the time of the disputed domain name registration and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of 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 <iamgiaustralia.com> be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: April 9, 2025