

ADMINISTRATIVE PANEL DECISION

BJ's Wholesale Club, Inc. v. Annie Tong
Case No. D2025-1253

1. The Parties

The Complainant is BJ's Wholesale Club, Inc., United States of America ("United States"), represented by Nelson Mullins Riley & Scarborough LLP, United States.

The Respondent is Annie Tong, Malaysia / Annie Tong, Hong Kong, China.

2. The Domain Names and Registrar

The disputed domain names <bjsaffiliate.cc> and <bjsaffiliate.com> are registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 25, 2025. On March 27, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Undisclosed) and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 7, 2025 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaints for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amended Complaint on April 8, 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 April 17, 2025. In accordance with the Rules, paragraph 5,

the due date for Response was May 7, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 9, 2025.

The Center appointed Federica Togo as the sole panelist in this matter on May 16, 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

It results from the Complainant's undisputed allegations that it was founded in the mid-1980's and is an operator of membership warehouse clubs concentrated primarily on the eastern half of the United States.

It provides a curated assortment of products and services focused on groceries, continuously refreshed general merchandise, gasoline and other ancillary services, coupon books, and promotions to deliver a differentiated shopping experience that is further enhanced by the Complainant's omnichannel capabilities. Since its founding in the New England region of the United States, the Complainant has expanded its current footprint in the United States to include 243 warehouse locations and 174 gas stations spanning 20 states. In addition to the Complainant's brick and mortar warehouse locations, the Complainant's members can also shop online through the Complainant's website located at the domain name <bjs.com> or through the Complainant's mobile app.

The Complainant is the registered owner of some trademarks consisting and or containing BJ'S, e.g., United States Trademark Registration No. 1751720, "BJ'S" (word), registered on February 9, 1993, for services in class 42.

The disputed domain names concerned were registered as follows:

<bjsaffiliate.com> on November 21, 2024, and
<bjsaffiliate.cc> on January 4, 2025

Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name <bjsaffiliate.com> resolved to log-in website displaying "BJ'S Join the club" reproducing without authorization the Complainant's trademark and logo, as allegedly being operated by or officially affiliated with the Complainant.

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 names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to the Complainant's trademark BJ'S since they wholly incorporate its BJ'S trademark plus the descriptive/generic term "affiliate", a word that would be viewed as being directly related to the Complainant's business.

The Complainant further contends that the Respondents have no rights or legitimate interests in the disputed domain names. According to the Complainant, it has not authorized the Respondent to use the BJ'S trademark nor is the Respondent a licensee of the BJ'S trademark. The disputed domain name is undeniably confusingly similar to the Complainant's BJ'S Mark, which is enhanced because of the combination of the BJ's trade mark and the related word "affiliate". Accordingly, the disputed domain name carries with it a high risk of implied affiliation. In addition, the Respondent used the disputed domain names to resolve to log-in pages ("Website") that held themselves out being operated by or officially affiliated with

the Complainant. A screen shot of the website to which the disputed domain name <bjsaffiliate.com> resolved was attached to the Complaint. However, the Complainant failed to provide evidence of the website to which the disputed domain name <bjsaffiliate.cc> resolved.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. According to the Complainant, the Respondent's bad faith is evidenced by the Respondent's intentional attempts to attract, for commercial gain, Internet users to the Website by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Website through unauthorized use of the Complainant's BJ'S trademark. The Complainant further adds that can be no doubt that the Respondent knew of, and specifically targeted the Complainant, when the Respondent registered the disputed domain names, as evidenced by the Respondent's infringing use of the BJ'S mark on the Website, and this is further evidence of the Respondent's bad faith. In addition, the provision of false or inaccurate Whois information is also indicia of registration and use of a domain name in bad faith: the addresses associated with the disputed domain name <bjsaffiliate.cc> is unquestionably a false an inaccurate address as it lists "Hong Kong", as the street address and city.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural issues

Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that the Complainant submitted sufficient evidence to justify the consolidation in terms of common control of the domain names or corresponding websites.

As set forth in section 4.11.2 of [WIPO Overview 3.0](#): "Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of

respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).”

The Panel considers the consolidation as appropriate, taking into consideration the following factors: in particular 1) the name and surname of the Registrants for both disputed domain names is the same; 2) the email address used when registering both the disputed domain names is the same; 3) both disputed domain names follow the same naming pattern by incorporating the Complainant’s trademark BJS followed by the term “affiliate”. All these elements give evidence of a common control of the disputed domain names.

On the balance of probabilities and taking into account the above circumstances of the present case, the Panel finds that the disputed domain names are under common control.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as “the Respondent”) in a single proceeding.

6.2 Substantive issues

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”. Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that each disputed domain name be transferred or cancelled:

- (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 Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

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 names. 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 Panel finds the mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are 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, affiliate) 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 names 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 names. 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 names such as those enumerated in the Policy or otherwise.

Moreover, the Panel notes that the disputed domain names are clearly constituted by the Complainant’s registered trademark and a term “affiliate”, clearly tending to suggest sponsorship or endorsement by the Complainant. This is also confirmed by the content of the website to which the disputed domain names resolved – at least the disputed domain name <bjsaffiliate.com> – : a log-in website displaying “BJ’S Join the club” reproducing without authorization the Complainant’s trademark and logo, as allegedly being operated by or officially affiliated with the Complainant.

The composition of the disputed domain names enhances the false impression that the disputed domain names are somehow officially related to the Complainant and its official website promoting the Complainant’s business, which is not the case.

In addition, such composition of the disputed domain names cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#). This is the case in the present proceeding.

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 disputed domain names contain the Complainant’s trademark plus the term “affiliate”. For the Panel, it is therefore evident that the Respondent positively knew the Complainant’s mark.

In addition, the time the disputed domain names were registered, the panel considers it to be unlikely that the Respondent did not have knowledge of the Complainant and its mark, which has been existing by many years at the time the disputed domain names were registered. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain names included the Complainant’s trademark when it registered the disputed domain names.

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 this regard, the further circumstances surrounding the disputed domain names' registration and use confirm the Panel's findings that the Respondent has registered and is using the disputed domain names in bad faith:

(i) the nature of the disputed domain names (incorporating the Complainant's mark plus the addition of the term affiliate, clearly tending to suggest sponsorship or endorsement by the Complainant);

(ii) the content of the website to which the disputed domain names resolved – at least the disputed domain name <bjsaffiliate.com> –, a log-in website displaying “BJ'S Join the club” reproducing without authorization the Complainant's trademark and logo, as allegedly being operated by or officially affiliated with the Complainant, which the Respondent is not;

(iii) absence of rights or legitimate interests coupled with no response for the Respondent's choice of the disputed domain name;

(iv) the Respondent concealing its identity through a privacy service and providing inaccurate information in relation to the disputed domain name <bjsaffiliate.cc>.

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 names <bjsaffiliate.cc> and <bjsaffiliate.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: May 30, 2025