

ADMINISTRATIVE PANEL DECISION

Charles & Keith International Pte. Ltd. v. li houchang
Case No. DCO2023-0101

1. The Parties

The Complainant is Charles & Keith International Pte. Ltd., Singapore, represented by Strategic IP Information Pte Ltd., Singapore.

The Respondent is li houchang, China.

2. The Domain Name and Registrar

The disputed domain name <charleskeith.co> 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 December 1, 2023. On December 1, 2023, 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 December 4, 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 amended Complaint on December 8, 2023.

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 December 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 12, 2024.

The Center appointed Taras Kyslyy as the sole panelist in this matter on January 18, 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 incorporated in 2005 and is a Singapore-based label which manufactures and retails footwear, bags and fashion accessories globally and online through its website, “www.charleskeith.com”, utilizing the CHARLES & KEITH trademark.

The Complainant owns a number of registrations for its CHARLES & KEITH trademark in various jurisdictions, including, for instance, European Union trademark registration No. 004520672, registered on July 3, 2006, and International trademark registration No. 1070666, registered on December 17, 2010, designating among others China.

The Complainant invests in the promotion its trademark. Efforts to increase the global reach and recognition of the Complainant’s trademark include, *inter alia*, collaborations with global non-governmental organization, Save the Children, Disney, and Tokyo-based illustrator Walnut. The Complainant also maintains different social media accounts to further reach out to its customers and to build brand recognition for its trademark.

The disputed domain name was registered on July 14, 2021, and at the time of filing of the Complaint, resolved to a website with pay-per-click links, some of which competed with the Complainant’s business. At the time of this decision, the disputed domain name does not resolve to any active 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 identical or confusingly similar to the Complainant’s trademark. The disputed domain name reproduces the distinctive part of the Complainant’s well-known trademark and corporate name.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Registrant cannot have any right or legitimate interest in the disputed domain name because it incorporates the well-known Complainant’s trademark, to which the Complainant has sole and exclusive rights. The Complainant has not authorized the Respondent to use the Complainant’s trademark or trade name, neither in whole nor in part, in any manner whatsoever, including as a domain name. The disputed domain name does not serve to distinguish from the Complainant’s trademark, business name, and registered domain name, and consumers are likely to deem the use of the disputed domain name as a natural extension of the Complainant’s trademark, trade name, domain name, which is clearly not the case. The use of the Complainant’s trademark as a part of the disputed domain name is *mala fide* and solely intended towards portraying the disputed domain name as associated with or related to the Complainant, its products and activity.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. The Respondent, who has no relationship whatsoever to the Complainant or any entity associated with the Complainant, has registered the disputed domain name in bad faith and is using the disputed domain name, which is confusingly similar to the Complainant’s trademark, in bad faith. Although the disputed domain name is not attached to a web page, its landing URL may lead to confusion among the users that the disputed domain name is associated with the Complainant, which is misleading and false.

It is no coincidence that the Respondent chose and registered the disputed domain name that is confusingly similar to the Complainant's official website at "www.charleskeith.com". The Complainant has a long and well-established reputation in its trademark through its exclusive use throughout the world in relation to footwear, bags, and accessories. There can be no doubt that the Respondent was aware of the Complainant's trademark and trade name when the disputed domain name was chosen and registered well after the Complainant's lengthy and worldwide use of its trademark and trade name.

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 (service mark) for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the Complainant's CHARLES & KEITH 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.

The applicable Top-Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards the TLD ".co" for the purposes of the confusing similarity test. [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 available evidence does not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, and the use of the disputed domain name to host a parked page comprising pay-per-click links does not represent a *bona fide* offering of goods or services. [WIPO Overview 3.0](#), section 2.9. Thus, no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

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 Respondent registered the disputed domain name almost identical to the Complainant's trademark, mocking the Complainant's domain name and trade name, and placed at the disputed domain name a website with pay-per-click links, some of which competed with the Complainant. Therefore, the Panel finds that the Respondent knew or should have known of the Complainant and its prior trademark rights at the time of registering the disputed domain name, which confirms the bad faith. [WIPO Overview 3.0](#), section 3.2.2.

According to paragraph 4(b)(iv) of the Policy the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: by using the domain name, the Respondent has intentionally attempted 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 the 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. By using the disputed domain name to host a pay-per-click parking page, the Respondent has created a likelihood of confusion with the Complainant's trademarks and has potentially obtained revenue from this practice, which confirms the bad faith.

At the time of this decision, the disputed domain name does not resolve to any active website. 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. Having reviewed the available record, the Panel finds the current non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, the composition of the disputed domain name being almost identical to the Complainant's trademark, domain name and its trade name, and previous use of the disputed domain name to host the competing pay-per-click links, 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 <charleskeith.co> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: January 30, 2024