

ADMINISTRATIVE PANEL DECISION

ABG-Nine West, LLC v. Client Care, Web Commerce Communications Limited

Case No. D2022-2851

1. The Parties

The Complainant is ABG-Nine West, LLC, United States of America, represented by Authentic Brands Group, United States of America.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <ninewestisraelonline.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 2, 2022. On August 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 4, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 5, 2022 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 amendment to the Complaint on August 5, 2022.

The Center verified that the Complaint together with the amendment to the 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 August 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 1, 2022.

The Center appointed Philippe Gilliéron as the sole panelist in this matter on September 6, 2022. 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 active in the fashion industry; it notably manufactures and sells footwear and related accessories.

The Complainant owns several trademarks, including the Israeli trademark NINE WEST registration number 229178, registered in class 3 with a priority date as of April 21, 2010.

The NINE WEST brand has been used in connection with a wide variety of goods and services which are now sold worldwide in NINE WEST stores and select department stores, as well as on the Nine West official website, *i.e.* “www.ninewest.com”. The NINE WEST brand has been worn by various celebrities including Black Panther actress Lupita Nyong'o, and featured in countless magazines and websites released all over the globe, including but not limited to, Good Housekeeping USA, Cosmopolitan, US Weekly, InStyle, Marie Claire, Elle, Glamour.com, Bet.com, ET.com and Manrepeller.com.

On April 14, 2022, the Respondent registered the disputed domain name <ninewestisraelonline.com>.

5. Parties' Contentions

A. Complainant

The Complainant first argues that the disputed domain name <ninewestisraelonline.com> is similar to its NINE WEST trademark as it entirely incorporates such trademark, since the additional terms “Israel” and “online” are merely descriptive.

The Complainant then affirms that the Respondent has no rights or legitimate interests in the disputed domain name. It has never been authorized by the Complainant to use the NINE WEST trademark and is not known under that name. Furthermore, the Respondent has been actively using the NINE WEST trademark to promote the website linked to the disputed domain name for illegitimate commercial gains, more specifically, by operating a fake NINE WEST website offering counterfeit NINE WEST goods. Such a use cannot be considered as a *bona fide* offering of goods and services.

Taking into account the high recognition enjoyed by the NINE WEST trademark, the fact that the Respondent has used a privacy shield to mask its identity and the fact that it has exploited a counterfeit website under the disputed domain name, the Complainant finally considers 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

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.”

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements to obtain an order that the disputed domain name should be cancelled or transferred:

- (i) The disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or a 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.

A. Identical or Confusingly Similar

According to the Policy, paragraph 4(a)(i), the Complainant has to prove that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant proves to be the holder of several verbal trademarks consisting of the term NINE WEST.

UDRP panels widely agree that incorporating a trademark into a domain name can be sufficient to establish that the domain name is identical or confusingly similar to a registered trademark for purpose of the Policy (see, e.g., *Uniroyal Engineered Products, Inc. v. Nauga Network Services*, WIPO Case No. [D2000-0503](#); *Thaigem Global Marketing Limited v. Sanchai Aree*, WIPO Case No. [D2002-0358](#); and *F. Hoffmann-La Roche AG v. Relish Entreprises*, WIPO Case No. [D2007-1629](#)).

The trademark NINE WEST is recognizable within the disputed domain name, and the added elements would not prevent a finding of confusing similarity (see Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, "[WIPO Overview 3.0](#)").

As a result, the Panel considers paragraph 4(a)(i) of the Policy to be satisfied.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant has to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name.

As the UDRP panel stated in *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#), demonstrating that a respondent has no rights or legitimate interests in a domain name "[...] would require complainant to prove a negative, a difficult, if not impossible, task". Thus, in that decision, the panel opined that "[w]here a complainant has asserted that the respondent has no rights or legitimate interests in respect of the domain name, it is incumbent upon the respondent to come forward with concrete evidence rebutting this assertion."

Following that decision, subsequent UDRP panels developed a consensus view that it is deemed sufficient for a complainant to make a *prima facie* case that the respondent lacks rights or legitimate interests in a domain name. Once a *prima facie* case has been made, the burden of production shifts to the respondent to come forward with evidence to demonstrate its rights or legitimate interests. If it fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see, e.g., section 2.1 [WIPO Overview 3.0](#)).

In the present case, the Complainant is the owner of numerous NINE WEST trademarks. The Complainant has no business or other relationships with the Respondent, and claims the disputed domain name has been used to sell counterfeits of the Complainant's products. The Complainant thus has made a *prima facie* case showing that the Respondent has no rights or legitimate interests in the disputed domain name.

Far from carrying out any *bona fide* business in relation to the disputed domain name, the Respondent uses it to sell counterfeit goods on a website that displays the NINE WEST brand on several accounts. It goes

without saying that such a use cannot be considered legitimate.

Considering the fact that the Respondent is neither commonly known by the disputed domain name, nor has made a legitimate noncommercial or fair use of the disputed domain name, and the Respondent is in default, the Panel finds that the Respondent has failed to demonstrate any rights or legitimate interests in the disputed domain name.

In addition, the Panel notes the nature of the disputed domain name. The addition of terms such as “Israel” and “online” to the NINE WEST trademark will lead Internet users to believe that they are mistakenly on a website affiliated to the Complainant in Israel, while this obviously is not the case.

Consequently, in light of the above, the Panel considers paragraph 4(a)(ii) of the Policy to be fulfilled.

C. Registered and Used in Bad Faith

For a complaint to succeed, a panel must be satisfied that a domain name has been registered and is being used in bad faith (Policy, paragraph 4(a)(iii)).

In the present case, the Complainant is the owner of numerous NINE WEST trademarks. Taking into account the fact that the Respondent registered the disputed domain name so as to betray users and have them purchase counterfeit goods on a website that mislead them to believe that they are on the official Israeli website of the Complainant or an affiliated one, there is no doubt in the Panel’s opinion that the disputed domain name was registered and is being used in bad faith (see *Balenciaga v. liu zhixian, zhixian liu*, WIPO Case No. [D2010-1831](#), determining that the sale of counterfeit handbags through a registered domain name amounts to a registration and use in bad faith). Even if the disputed domain name was not being used to sell counterfeits, noting the composition of the disputed domain name and its use, the Panel finds that the Respondent had intentionally attempted to attract, probably for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of its website.

Consequently, the Panel finds that the disputed domain name has been registered and is being used in bad faith under the paragraph 4(a)(iii) 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 <ninewestisraelonline.com> be transferred to the Complainant.

/Philippe Gilliéron/

Philippe Gilliéron

Sole Panelist

Date: September 20, 2022