

ADMINISTRATIVE PANEL DECISION

Internet Services Australia 1 Pty Ltd v. Qhyue Puyehf
Case No. D2022-4024

1. The Parties

The Complainant is Internet Services Australia 1 Pty Ltd, Australia, represented by Bird & Bird LLP, Australia.

The Respondent is Qhyue Puyehf, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <shopaere.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 31, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 7, 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 amended Complaint on November 15, 2022.

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 November 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 13, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on December 27, 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 has provided online retail, shopping and related services in Australia and New Zealand.

The Complainant sells its own clothing, shoes and accessories under the brand AERE.

The Complainant is the owner of the following trade mark registrations and applications for AERE and AERE-formative marks:

- New Zealand Trade Mark (“NZTM”) registration no. 1154239 for AERE in classes 14, 18 and 25 registered on January 27, 2021;
- NZTM registration no. 1169609 for AERE in classes 3, 4, 16, 20, 21, 24, 27 and 35 registered on July 29, 2021;
- NZTM registration no. 1169611 for AERE HOME in classes 3, 4, 16, 20, 21, 24, 27 and 35 registered on November 2, 2021;
- Australian Trade Mark (“AUTM”) application no. 2105434 for AERE in classes 14, 18 and 25 with a priority date of July 22, 2020;
- AUTM application no. 2151914 for AERE in classes 3, 4, 16, 20, 21, 24, 27 and 35, January 28, 2021; and
- AUTM application no. 2151915 for AERE HOME in classes 3, 4, 16, 20, 21, 24, 27, and 35 with a priority date of January 28, 2021.

The disputed domain name was registered on March 18, 2022 and resolves to a website purportedly selling the Complainant’s products without the Complainant’s authorization.

5. Parties’ Contentions

A. Complainant

The Complainant has promoted and sold a range of clothing, shoes and accessories for women, men and children as well as beauty products, homewares and sports equipment and provided retailing and shopping services in relation to these products through its website and its mobile app.

Since the launch of the AERE brand in 2019, the Complainant’s AERE websites have been captured several times between September 20, 2020 to February 14, 2022 via the Wayback Machine, an Internet archiving service.

The Complainant operates several social media accounts and pages where, since before the registration date of the disputed domain name.

The Complainant has advertised and promoted its goods and services (including shopping services) under the AERE trademarks.

In 2017, the Complainant launched an online blog titled THE ICONIC Edition on which the Complainant has published articles on style, fashion, sport and lifestyle with editorials linking consumers to the Complainant’s good and services (including shopping services).

Since 2019, the Complainant has also promoted its goods and services (including shopping services) under the AERE trademarks on this blog.

The disputed domain name wholly contains the Complainant's trademark AERE and is confusingly similar to the Complainant's AERE trademarks. The AERE trade mark is not a descriptive word and does not describe any fashion or lifestyle products or services. The addition of the word "shop" in front of the mark AERE is descriptive and does not detract from the identical or confusing similarity between the disputed domain name and the Complainant's AERE trade marks.

The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services.

The Respondent is using the disputed domain name to promote products without the Complainant's approval or authorisation, Consumers have complained to the Complainant that they have purchased goods from the website operated at the disputed domain name and never received those goods.

The Complainant sent a cease and desist letter to the email address listed on the "contact us" page of the Infringing Website. However, the email was unable to be delivered and a message that the "recipient email address is possibly incorrect" was received on October 12, 2022. The Respondent, by registering the disputed domain name, is intentionally attempting to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's AERE trade mark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name.

The Respondent's use of the disputed domain name indicates an attempt to use, in bad faith and without authorisation, the Complainant's well-established reputation in the Complainant's AERE trademarks for its own commercial gain.

The Respondent's bad faith is evident from the content posted on the Respondent's website. All content, including photographs, images, logos and texts appear to have been directly lifted from the Complainant's AERE websites.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (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. Considering these requirements, the Panel rules as follows:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the AERE trademarks on the basis of its multiple trademark registrations in several countries. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name is normally sufficient to establish that the domain name is confusingly similar to a trademark (see section 1.7 of [WIPO Overview 3.0](#)). The Respondent's incorporation of the Complainant's mark in the disputed domain name is sufficient to establish that the disputed domain name is confusingly similar to the Complainant's marks. The addition of the term "shop" as a prefix to the Complainant's trademark AERE in the disputed domain name does not prevent a finding of confusing similarity with the Complainant's marks. Furthermore, the addition of the generic Top-Level Domain ("gTLD") ".com" does not prevent a finding of confusing similarity either.

The Panel is satisfied that the disputed domain name is identical or confusingly similar to the Complainant's mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent, will lead to this ground being set forth. Refraining from submitting any Response, the Respondent has brought to the Panel's attention no circumstances from which the Panel could infer that the Respondent has rights to or legitimate interests in the disputed domain name.

The Panel will now examine the Complainant's arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain name. The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademarks in a domain name or in any other manner. The Complainant also contends that the Respondent is not known under the disputed domain name.

Furthermore, the disputed domain name directs to a website whereby promotes products without the Complainant's approval or authorisation, users have complained to the Complainant that they have purchased goods from the website operated at the disputed domain name and never received those goods. The Panel also finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant's trademarks (see [WIPO Overview 3.0](#), section 2.5.1).

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain names, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy stipulates that any of the following circumstances, *inter alia*, shall be considered as evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its 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 its website or location.

With regard to the bad faith at the time of registration, the Panel notes that it is not likely that the Respondent was not aware of the Complainant and its trademark. On the contrary, the Panel finds that it is likely that the Respondent was aware of the Complainant and its rights and reputation in the AERE mark at the time the disputed domain name was registered.

Bad faith can be presumed based on the widely evidenced recognition of the Complainant's marks and moreover can be imputed from the use made of the disputed domain name, such that the Respondent was aware or should have been aware of the Complainant's well-known marks and rights thereto. In the Panel's view, the Complainant's mark is famous and registration by the unrelated Respondent creates a presumption of bad faith in this case. On this subject, section 3.1.4 of the [WIPO Overview 3.0](#) says: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar [...] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

Noting the composition of the disputed domain name, it is difficult to conceive of any use that the Respondent might make of the disputed domain name without the Complainant's consent that would not involve bad faith. See, e.g., *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#); *DPDgroup International Services GmbH & Co. KG v. Wise One, Wilson TECH*, WIPO Case No. [D2021-0109](#); and *Monster Energy Company v. PrivacyDotLink Customer 116709 / Ferdinand Nikolaus Kronschnabl*, WIPO Case No. [D2016-1335](#). Indeed, the Respondent's website offers similar products as to which offered by the Complainant, and the Respondent's website has a similar look and feel as the Complainant's website.

The Respondent has ignored the Complainant's attempts to resolve this dispute outside of this administrative proceeding. Previous UDRP panels have held that failure to respond to a cease-and-desist letter may properly be considered a factor in finding bad faith. See *Encyclopedia Britannica v. Zuccarini*, WIPO Case No. [D2000-0330](#); and *RRI Financial, Inc., v. Chen*, WIPO Case No. [D2001-1242](#).

The Panel finds that the filed evidence about the received complaint from one of its customers is plausible evidence of such bad faith activities of the Respondent. The fact that this is not denied by the Respondent only strengthens this conclusion.

Consequently, the Panel finds that the disputed domain names were registered and used by the Respondent in bad faith within 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 <shopaere.com> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: January 10, 2023