

ADMINISTRATIVE PANEL DECISION

Pointe Noir Pty Ltd and J. Bloch Pty. Ltd. v. Client Care, Web Commerce Communications Limited
Case No. D2023-4009

1. The Parties

The Complainants are Pointe Noir Pty Ltd, Australia, and J. Bloch Pty. Ltd., Australia, represented by Venable, LLP, United States of America (“United States”).

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

2. The Domain Names and Registrar

The disputed domain names <blochaustralia.com> and <blochnewzealand.com> are 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 September 25, 2023. On September 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 27, 2026, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on September 27, 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 amendment to the Complaint on September 29, 2023.

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 October 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 3, 2023.

The Center appointed Anna Carabelli as the sole panelist in this matter on November 17, 2023. 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 Complainants are the owner of the BLOCH trademark. In particular, the evidence submitted with the Complaint shows that:

a) the Complainant Pointe Noir Pty, Ltd owns the following trademark registrations in the United States:

Trademark	Registration No.	International Class	First Use and Registration
BLOCH	1,898,161	25	First Use: 1993 Registration: 1995
BLOCH	3,101,147	35	First Use: 2003 Registration: 2006

b) the Complainant J. Bloch Pty, Ltd. owns the following trademark registrations in Australia:

Trademark	Registration No.	International Class	Registration
BLOCH	884655	25	August 2001
BLOCH	885017	35	August 2001

and in New Zealand:

Trademark	Registration No.	International Classes	Registration
BLOCH	643269	25, 35	March 2003

The BLOCH brand was born in 1932 in Sydney, Australia, where Mr. Jacob Bloch started to produce by hand ballet shoes, and since then have been used by the Complainants (or their predecessors in interests) in connection with the manufacturing and marketing of technical dance footwear and apparel, also through the websites “www.us.blochworld.com” and “www.bloch.com.au” operated by Pointe Noir Pty, Ltd and J. Bloch Pty, Ltd respectively.

The disputed domain names were both registered on July 20, 2023. The evidence in the Complaint is that the disputed domain names resolve to an active website that purports to offer BLOCH branded products such as ballet point shoes, and displays the Complainant’s BLOCH mark under which the words “since 1932” appear.

5. Parties’ Contentions

A. Complainant

The Complainants submit and contend that:

- The Complainants trademark BLOCH is widely promoted worldwide, including New Zealand and Australia where the BLOCH brand was founded more than 90 years ago. The Complainants’ BLOCH trademark enjoys a considerable goodwill with respect to dance footwear. BLOCH branded pointe shoes are made by hand and are used by leading dance companies throughout the world (such as the Royal Ballet, the American Ballet Theatre, the Bolshoi Ballet and the Australian Ballet) and have been worn by the world’s most elite ballerinas of the past and present;

- The disputed domain names are confusingly similar to the Complainants' trademark since they include the Complainants trademark BLOCH in its entirety. The addition of the descriptive geographic names "New Zealand" and "Australia" does not eliminate confusing similarity as the trademark remains clearly recognizable. The generic Top-Level Domain ("gTLD") ".com" should generally be ignored when assessing confusing similarity.

- The Respondent has no rights or legitimate interests in the disputed domain name. The disputed domain names were registered years after the Complainants have consistently used the BLOCH trademark. The Respondent is not affiliated with nor authorized by the Complainants to use the BLOCH trademark. There is no evidence that the Respondent is commonly known by the disputed domain names.

The use of the disputed domain names cannot be considered a *bona fide* offering of goods or services. The Respondent is not making any legitimate noncommercial or fair use of the disputed domain names. The disputed domain names are used to suggest affiliation with the Complainants for commercial gain and for phishing purposes to obtain personnel identifying information. In this connection the Complainants note that Internet users accessing the Respondent's website are requested to submit their personal information to be "contacted". The Complainants also submit that the Respondent sells suspected counterfeit products of the Complainants, as suggested by the fact that the BLOCH branded pointe shoes displayed on the Respondent's website are offered at very discounted prices.

- The disputed domain names were registered and are being used in bad faith by the Respondent to derive illegitimate commercial gains in an attempt to attract users, by creating a likelihood of confusion with the Complainant's mark. The disputed domain names were registered years after the Complainants have used and registered the BLOCH trademark, and the Respondent is likely to have had at least constructive notice of it.

Based on the above the Complainants request the disputed domain names be transferred to the Complainants.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Procedural Issue: Multiple Complainants

In the present case, the Complaint was filed by two separate Complainants. The Rules do not directly contemplate the consolidation of multiple complainants in a single administrative complaint, however numerous UDRP panels have found that in certain circumstances such a consolidation may be permitted. In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation (see section 4.11.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition - "[WIPO Overview 3.0](#)").

In the case at hand, both Complainants own trademarks for the sign BLOCH and the Respondent's conduct has affected the Complainants in a similar fashion. The Panel therefore finds that it is sufficiently established that the Complainants have a specific common grievance against the Respondent and that it would be equitable and procedurally efficient to consolidate the Complainants.

6.2 Substantive issues

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

- (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.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

The Panel finds that the Complainants have established rights over the trademark BLOCH based on the evidence submitted in the Complaint.

As highlighted in section 1.11 of the [WIPO Overview 3.0](#), the addition of the gTLD “.com” is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. Therefore, the relevant comparison to be made is with the second-level portion of the disputed domain names, *i.e.*; “blochnewzealand” and “blochaustralia”.

The disputed domain names entirely incorporate the Complainants' mark BLOCH and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (*e.g.*, *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the Complainants' trademark BLOCH and the Complainants have established element 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation;

- (i) before any notice to it of the dispute, its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name, even if it has acquired no trademark or service mark rights;

(iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainants contend that the Respondent has no rights or legitimate interests in respect of the disputed domain names, based on the following: (a) the Complainants hold prior rights in the registered and well-known BLOCH mark; (b) the Respondent has not been authorized to use the Complainants' trademark in any way, and is not commonly known by the disputed domain names; and (c) the disputed domain names resolve to a website which reproduces the Complainants' mark and logo without the Complainants' consent, and sells BLOCH branded products at a heavily discounted price, which according to the Complainants would suggest that they are counterfeit products.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, previous UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Here the Panel finds that the Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain names under paragraph 4(c) of the Policy.

While the Complainant has pointed to the discounted prices of the goods offered at the website to which the disputed domain names resolve to reflect the potential counterfeit nature of the goods, the Panel needs not come to a determination on the nature of the goods being offered, noting that the website at the disputed domain names contains the BLOCH mark at the home page (that is identical to the mark that is used at the Complainants' official websites) and reflect no information concerning the websites' relationship (or lack thereof) to the Complainants. See sections 2.8 and 2.13.2 of the [WIPO Overview 3.0](#). Further to the so-called "Oki Data test" enshrined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), even if the goods offered at the website to which the disputed domain name resolves were of a genuine nature, the disputed domain name cannot constitute fair use given its lack of disclaimers.

The Panel also finds that given that the disputed domain names consist of the Complainants' distinctive trademark BLOCH with the addition of the terms "newzealand" and "australia", the composition of the disputed domain names carries a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use.

The Panel concludes that the Respondent deliberately chose to include the Complainants' BLOCH trademark in the disputed domain name, in order to achieve commercial gain by misleading third parties, and that such use cannot be considered as a legitimate noncommercial or fair use.

Based on the above, the Panel finds that the Complainants have satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainants must establish that the disputed domain names have been registered and used in bad faith.

The BLOCH trademark is distinctive and the date of its first registration significantly precedes the date of registration of the disputed domain names. Moreover, given the use of the disputed domain names, the Panel concludes that the Respondent knew that the disputed domain names would be confusingly similar to

the Complainants' trademark. The fact that the website at the disputed domain names, features the Complainant's BLOCH trademark and allegedly offers the Complainants' trademarked goods, indicates that the Respondent targeted the Complainants when registering the disputed domain names.

The above conduct constitutes opportunistic bad faith registration (see section 3.2.1 of the [WIPO Overview 3.0](#)), as well as bad faith use of the disputed domain name under the Policy. Indeed, the Respondent has used the disputed domain names to capitalize on the goodwill of the Complainants' BLOCH mark.

By directing the disputed domain names to a commercial website allegedly offering the Complainants' goods, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its website (see section 3.1.3 of the [WIPO Overview 3.0](#)). Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith.

Based on the above, the Panel finds that the Complainants have established also 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 names, <blochaustralia.com> and <blochnewzealand.com>, be transferred to the Complainants.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: November 30, 2023