

ADMINISTRATIVE PANEL DECISION

Nowhere Co., Ltd v. Client Care, Web Commerce Communications Limited
Case No. D2023-5352

1. The Parties

The Complainant is Nowhere Co., Ltd, Japan, represented by Dreyfus & associés, France.

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

2. The Domain Name and Registrar

The disputed domain name <abathingapefrance.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 December 25, 2023. On December 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 27, 2023, 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 (Not disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 4, 2024, 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 January 8, 2024.

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 January 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 1, 2024. The Respondent sent three email communications to the Center on January 13, 2024. On February 2, 2024, the Center notified the Commencement of Panel Appointment Process.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on February 8, 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 is a Japanese company founded in 1993 exploiting the street fashion business and having its clothes sold in stores in Japan, France, the United States of America, China, Taiwan Province of China as well as other countries in Asia.

The Complainant is the owner of the following, amongst other, trademark registrations:

- International trademark registration No. 861352, for the figurative mark A BATHING APE, registered on December 7, 2004, successively renewed, in classes 9, 14, 16, 28, 20, 24, 25, 26 and 28;
- Japanese trademark registration No. 6487029, for the word and device mark ABATHINGAPE, filed on January 7, 2021, registered on December 16, 2021, in classes 20, 21, 24 and 27; and
- European Union trademark registration No. 003714359, for the figurative mark A BATHING APE, registered on October 20, 2009, successively renewed, in classes 9 and 18.

The disputed domain name was registered on May 24, 2023, and presently does not resolve to an active webpage. In the past, it resolved to an online shop displaying the Complainant's trademark purportedly offering the products bearing the Complainant's trademark.

On June 23, 2023, representatives of the Complainant sent a blocking request to the Registrar as well as a deactivation request to the hosting company (Annex 6).

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 reproduces in its entirety the Complainant's well-known trademark with the addition of the term "france" which is insufficient to avoid a finding of confusing similarity between the disputed domain name and the Complainant's trademark, as recognized by past UDRP panels.

As to the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, the Complainant contends that: (i) the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register its trademark, or to seek registration of any domain name incorporating said trademark; (ii) the Respondent cannot claim prior rights or legitimate interest in the disputed domain name as the A BATHING APE trademarks precede the registration of the disputed domain name for years; (iii) the Respondent is not commonly known by the disputed domain name; (iv) the disputed domain name used to resolve towards a fake website that reproduced the Complainant's trademark purportedly offering products under the trademark A BATHING APE for sale, that were most likely to be counterfeit goods; and (v) the Respondent fails to show any intention of noncommercial or fair use of the disputed domain name given the past use of the disputed domain name with intent for commercial gain to misleadingly divert consumers from Complainant's official website.

As to the registration of the disputed domain name in bad faith, the Complainant asserts that given the well-known status of its trademark and the use made of the disputed domain name purportedly offering the Complainant's products shows that the Respondent was evidently aware of the Complainant's rights and intentionally registered and used the disputed domain name in an attempt to pass off as the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions, having merely submitted what appear to be automated email communications to the Center on January 13, 2024.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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 Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

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

The entirety of the mark is reproduced 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. Although the addition of other terms "france" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name 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 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.

Panels have held that the use of a domain name for illegal activity such as the sale of counterfeit goods, impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

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.

This case presents the following circumstances which indicate under the balance of probabilities bad faith registration and use of the disputed domain name:

- a) the composition of the disputed domain name reproducing the entirety of the Complainant's trademark (previous UDRP 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. See [WIPO Overview 3.0](#), section 3.1.4);
- b) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name;
- c) the use of the disputed domain name in connection with online shop purportedly offering the Complainant's products bearing the Complainant's logo without authorization or disclaimer;
- d) the lack of reply to notices sent prior to this procedure.

Furthermore, and considering the circumstances of this case, the Panel finds the current non-use of the disputed domain name does not prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.3.

Based on the available record, the Panel finds that the Complainant has established the third element of 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 <abathingapefrance.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: February 20, 2024