

Decision for dispute CAC-UDRP-104136

Case number	CAC-UDRP-104136
Time of filing	2021-11-10 17:01:32
Domain names	off-whiteoutletstore.com, otherstoriesoutlet.com, tedbakerfashionoutlet.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainants

Organization	H & M Hennes & Mauritz AB
Organization	Off-White LLC
Organization	No Ordinary Designer Label Limited t/a Ted Baker

Complainant representative

Organization	Stobbs IP Ltd
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Respondent

Name	Liu Chan Yuan
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

A) OTHERSTORIESOUTLET.COM

The Complainant no. 1, H&M Hennes & Mauritz AB ("H&M"), is a registered owner of a following trademark containing a word element '& OTHER STORIES':

(i) & OTHER STORIES (word), EU Trademark, priority (filing) date 14 January 2011, registration date 23 June 2011, trademark application no. 9659848, registered for goods and services in the international classes 3, 9, 14, 16, 18, 21, 24, 25, 28, and 35. (referred to as "& OTHER STORIES trademark").

B) OFF-WHITEOUTLETSTORE.COM

The Complainant no. 2, Off-White, LLC ("Off-White"), is inter alia a registered owner of a following trademark containing a word element 'OFF-WHITE':

(i) OFF WHITE (word), EU Trademark, priority (filing) date 20 December 2013, registration date 15 July 2014, trademark application no. 12450466, registered for goods and services in the international classes 18, 25, and 35. (referred to as "OFF-WHITE trademark").

C) TEDBAKERFASHIONOUTLET.COM

The Complainant no. 3, No Ordinary Designer Label Limited t/a Ted Baker ("Ted Baker"), is inter alia a registered owner of a following trademark containing a word element 'TED BAKER':

(i) TED BAKER (word), EU Trademark, priority (filing) date 20 January 2016, registration date 29 August 2016, trademark application no. 15022064, registered for goods and services in the international classes 11, 16, and 35. (referred to as "TED BAKER trademark").

FACTUAL BACKGROUND

A) OTHERSTORIESOUTLET.COM

Complainant no. 1, H&M, owns and controls all rights in relation to the & OTHER STORIES trademark.

Across its core brands, the H&M Group offers customers a wealth of styles and trends across fashion, beauty, accessories, homeware and food. H&M operate in more than 5,000 stores across 74 markets and as of 2020, employed around 153,000 people. As of 2020, H&M brought in a total of 187 billion Swedish krona (crowns) in net sales.

The & OTHER STORIES brand was founded in 2010. The brand is most well-known in relation to its one-stop-shop function for women's fashion. The brand predominantly operates from the website <www.stories.com>, which has been active as a commercial website, since 2013.

The disputed domain name <otherstoriesoutlet.com> was registered on 26 January 2021 and is held by the Respondent.

The disputed domain name website <otherstoriesoutlet.com> (i.e. website available under internet address containing the disputed domain name <otherstoriesoutlet.com>) is an active website that mimics official website of H&M available at www.stories.com. It contains H&M's trade marks, H&M's copyrighted images and overall is designed to show an association with H&M, the & OTHER STORIES trademark and its business.

B) OFF-WHITEOUTLETSTORE.COM

Complainant no. 2, Off-White, is the owner and controller of the OFF-WHITE brand.

Off-White is a luxury fashion brand created by Virgil Abloh in 2013. Off-White's products have been widely promoted and sold worldwide and have received a great deal of recognition within the fashion industry and amongst celebrities.

The OFF-WHITE brand is internationally recognised as a luxury fashion brand and sold through exclusive retail outlets such as Harrods and Selfridges and via luxury e-commerce platforms such as Farfetch, Mr Porter and Net-a-Porter in the United Kingdom. Customers therefore expect and rely on the extremely high quality of the Off-White products which is reflected in the price point of those products.

The disputed domain name <off-whiteoutletstore.com> was registered on 20 March 2021 and is held by the Respondent.

The disputed domain name website <off-whiteoutletstore.com> (i.e. website available under internet address containing the disputed domain name <off-whiteoutletstore.com>) is an active website that mimics official website of Off-White. It contains Off-White 's trade marks, Off-White 's copyrighted images and overall is designed to show an association with Off-White, OFF-WHITE trademark and its business.

C) TEDBAKERFASHIONOUTLET.COM

Complainant no. 3, Ted Baker, is a British company founded in 1998, which operates in the clothing retail industry, offering menswear, womenswear and accessories. It has around 2,000 employees, 490 stores and concessions worldwide.

Ted Baker has several stand-alone stores in the UK. The Ted Baker range is also sold by other retailers (which it refers to as Ted Baker Trustees), in stores of the John Lewis Partnership and House of Fraser. Ted Baker also has stores at Bicester Village Retail Outlet, Swindon Designer Outlet, Portsmouth's Gunwharf Quays and Cheshire Oaks Designer Outlet. There is a Ted Baker concession in all Selfridges & Co stores; London, Birmingham, Manchester and the Trafford Centre. Ted Baker also has stores and outlets in Europe, the United States, Canada, Australia, Asia, South Africa and the Middle East.

Ted Baker's main e-commerce website can be found at www.tedbaker.com.

The disputed domain name <tedbakerfashionoutlet.com> was registered on 20 April 2021 and is held by the Respondent.

The disputed domain name website <tedbakerfashionoutlet.com> (i.e. website available under internet address containing the disputed domain name <tedbakerfashionoutlet.com>) is an active website that mimics official website of Ted Baker. It contains Ted Baker's trademarks, Ted Baker's copyrighted images and overall is designed to show an association with Ted Baker, TED BAKER trademarks and its business.

The Complainants request the Panel appointed in this administrative proceeding that the Disputed Domain Names be transferred in the following way:

<off-whiteoutletstore.com> transferred to Off-White LLC

<otherstoriesoutlet.com> transferred to H & M Hennes & Mauritz AB

<tedbakerfashionoutlet.com> transferred to No Ordinary Designer Label Limited t/a Ted Baker

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANTS:

CONFUSING SIMILARITY

The Complainants state that:

The disputed domain names are confusingly similar to the & OTHER STORIES, OFF-WHITE and TED BAKER trademarks.

A) OTHERSTORIESOUTLET.COM

The disputed domain name <otherstoriesoutlet.com> wholly incorporates OTHER STORIES trademark, along with the generic

word 'OUTLET', which does nothing to materially alter the overall impression of the domain name in the eyes of the average Internet user. On the contrary, the addition of these terms merely reinforces an association with H&M considering that 'OUTLET' is synonymous with the industry in which H&M operates.

Also it is widely recognised, that the use of the ampersand '&' cannot be reflected in domain names. The ampersand (present in the Complainant's trademark but absent from the disputed domain name) is not a valid character for the registration of a domain name.

B) OFF-WHITEOUTLETSTORE.COM

Off-White submits that the disputed domain name <off-whiteoutletstore.com> incorporates OFF-WHITE trademark with the additional terms 'OUTLET' and 'STORE'. As submitted above in relation to H&M, the additional generic terms do not alter the overall impression of the disputed domain name.

C) TEDBAKERFASHIONOUTLET.COM

Ted Baker submits that the term 'TED BAKER' is fully incorporated in the disputed domain name <tedbakerfashionoutlet.com>, along with two generic terms 'FASHION' and 'OUTLET'. As stated above, the additional words merely reinforce its association with Ted Baker, who is known for operating in fashion and has products which are sold in designer outlets.

The Complainants also argue that the TLD suffix '.COM' is irrelevant when assessing the disputed domain names, as it is merely a technical requirement, used for domain name registrations.

The Complainants refer to previous domain name decisions in this regard.

Thus, according to the Complainants the confusing similarity between Complainants' trademarks and the disputed domain names is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants state that:

The Respondent has not been commonly known by the disputed domain names.

The Complainant has not authorized, permitted or licensed the Respondent to use Complainants' trademarks in any manner. The Respondent has no connection or affiliation with any of the Complainants whatsoever. On this record, Respondent has not been commonly known by the any of the disputed domain names.

On the contrary, the disputed domain names were used for attracting internet users to goods or services provided by the Respondent and this why it is free riding on reputation of the Complainants' trademarks and their business. This is because all disputed domain names resolve to infringing websites, which in all cases, feature the Complainants' branding and offer for sale the Complainants' branded products.

The Complainants also refer to "Oki Data Test" and its applicability when assessing legitimate use of the disputed domain names (for detail see below). The Complainants submit that the Respondent fails to satisfy the third requirement under Oki Data Test requiring Respondent to accurately disclose its relationship with the Complainants – none of the disputed domain names websites discloses anything that could be construed as a notice to unsuspecting customers about lack of such relationship.

The Complainants refer to previous domain name decisions in this regard.

BAD FAITH REGISTRATION AND USE

The Complainants state that:

Seniority of the Complainants' Trademarks predates the registration of corresponding disputed domain name.

Furthermore, the Complainants' Trademarks have received widespread recognition, supported by their endorsement on social media. Therefore the Respondent must have been aware of such trademarks and their reputation. This clearly indicates bad faith registration of disputed domain names by the Respondent.

Prior to filing a UDRP complaint against the Respondent, H&M sent the Respondent a cease-and-desist letter on the 25 August 2021. The Respondent did not respond.

The disputed domain names were used for attracting internet users to services provided by the Respondent, which are similar to those provided by Complainant, and therefore it is free riding on reputation of the Complainant's trademark and its business.

The Complainants refer to previous domain name decisions in this regard.

RESPONDENT:

The Respondent has not provided any response to the Complaint.

RIGHTS

The Complainants have, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainants have, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

Consolidation of Cases:

Panel determines that the Complainants should be permitted to have their Complaints consolidated into a single Complaint for the purpose of the present proceedings under the Policy. Overall this is clearly a case fitting within the "common conduct" category in which it would be equitable and fair to permit consolidation.

Firstly, the Respondent is intending to cause confusion in the fashion industry by targeting the fashion consumers. There is a clear common pattern in registering the disputed domain names i.e. combining a trademark well-known in a fashion business with generic terms.

Also the arguments related to each of the domain names in question are the same, so filing separate complaints and reiterating the same arguments for each brand would be inefficient.

PRINCIPAL REASONS FOR THE DECISION

RIGHTS

Since the disputed domain names and the Complainants' trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain names are confusingly similar to the Complainants' trademarks.

The disputed domain name <otherstoriesoutlet.com> incorporates distinctive element 'OTHER STORIES' from the corresponding trademark, along with the generic word 'OUTLET'. The '&' must be omitted from the similarity test as it cannot be part of a domain name due to technical restrictions.

The disputed domain name <off-whiteoutletstore.com> wholly incorporates OFF-WHITE trademark with the additional terms 'OUTLET' and 'STORE'.

The disputed domain name <tedbakerfashionoutlet.com> fully incorporates TED BAKER trademark, along with two generic terms 'FASHION' and 'OUTLET'.

The Panel rules that addition of generic terms 'FASHION', 'STORE' and 'OUTLET' cannot prevent an association in the eyes of internet consumers between the disputed domain names and the Complainants' trademarks and thus the likelihood of confusion still exists.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity and confusing similarity tests, as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is confusing similarity in this case, it also concludes that the Complainants have satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants' assertions that the Respondent is not commonly known by either disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

The Panel also asserted whether use of the disputed domain names for promotion and offer to sale of (likely original) products of Complainants satisfy the Oki Data Test.

In general, in previous cases the panels have recognized that resellers or distributors using a domain name containing the complainant's trademark to undertake sales related to the complainant's goods may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the Oki Data Test (as introduced in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903), the following cumulative requirements shall be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and

(iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant’s trademark.

Here, the Panel concurs with the Complainants that requirement under letter (iii) is clearly not met. None of the disputed domain name websites discloses anything that could be construed as a notice to unsuspecting customers about lack of such relationship between the Respondent and the relevant Complainant. As a result, all disputed domain names fail the Oki Data Test.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that names. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a) (ii) of Policy).

BAD FAITH

The Panel finds it grounded that the Respondent registered and used the disputed domain names in bad faith.

As described above, the Complainants have proven that the Respondent has used (at least for some time) the disputed domain names for promotion and offer offering goods and services (i) likely with intention to free-ride on reputation and goodwill of Complainants' trademarks and business and, even more importantly, (ii) in a manner that was detrimental both to the customers as well the Complainants and their business.

Such unfair use of the disputed domain names for promotion of Respondent’s activities (sale of goods) cannot be considered as use thereof in good faith and in compliance with fair business practices.

Thus, the Panel has taken a view that all three disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **OFF-WHITEOUTLETSTORE.COM**: Transferred
2. **OTHERSTORIESOUTLET.COM**: Transferred
3. **TEDBAKERFASHIONOUTLET.COM**: Transferred

PANELLISTS

Name	JUDr. Jiří Čermák
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DATE OF PANEL DECISION	2022-01-03
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Publish the Decision
