

Decision for dispute CAC-UDRP-105589

Case number	CAC-UDRP-105589
Time of filing	2023-07-04 09:29:18
Domain names	allsaints-australia.com, allsaintsgreece.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	All Saints Retail Limited
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Complainant representative

Organization	Stobbs (IP)
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Respondents

Organization	Alibaba.com Singapore E-commerce Private Limited
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Organization	Web Commerce Communications Limited
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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

The Complainant relies on its numerous registered trademarks, in territories around the world, including but not limited to the following:

Mark	Territory	Registration No.	Application date	Registration date	Classes
ALL SAINTS (word)	GB	UK00002307473	07 August 2002	21 March 2003	3,14,18, 25
ALL SAINTS (stylised)	EU	004702601	24 October 2005	4 November 2009	18, 25, 35
ALL SAINTS	EU	004610945	30 August 2005	10 November	3, 9, 14, 18, 25,

(word)				2009	35
ALL SAINTS (word)	EU	006659817	12 February 2008	2 April 2009	4, 16, 24
ALL SAINTS (word)	MY	08010165	23 May 2008	7 May 2010	25
ALL SAINTS (word)	AU	1251695	16 July 2008	15 March 2010	3, 4, 6, 8, 20, 21, 24, 27

Further, the Complainant operates its business using the official website www.allsaints.com.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Key aspects of the Complainant's contentions are summarized below.

Complainant's Background

The Complainant – a fashion retailer - was founded in London in 1994 and incorporated in October 2000 with the UK company registration number 04096157. The brand "All Saints" derives from one of the co-founders, Stuart Trevor's, nickname, "The Saint", based on his initials "TS" and updated at the 1993 Notting Hill Carnival that he attended, where he spent much of his time on AllSaints Road. The Complainant has around 3,200 employees with nearly 2.3 million visits to its www.allsaints.com website in 2022 and a global mailing list of 760,000 members. Complainant has a significant presence on various social media platforms, including over 900,000 followers on Instagram, over 1,000,000 followers on Facebook and over 48,000 subscribers on Pinterest.

Registration of the Disputed Domain Names

On December 1, 2022, the Respondent Tanya Lemann - located in Germany - registered the disputed domain name <allsaints-australia.com>. On December 5, 2022, Web Commerce Communications Limited - based in Malaysia - registered the disputed domain name <allsaintsgreece.com> (each individually a "disputed domain name" and collectively, the "disputed domain names").

Consolidation Request

The Complainant claims that the disputed domain names are subject to common control due to the proximity of registration dates, evidence of the disputed domain names being used for similar phishing activity, and the similarity of the anatomy of the disputed domain names. Further, the Respondents were consolidated in the previous decisions Case No D2023-1403 and CAC-UDRP-105189.

First UDRP Element - Disputed Domain Names are Confusingly Similar to Complainant's Trademark

The Complainant asserts that the disputed domain names are confusingly similar to its ALL SAINTS trademarks, as they incorporate the ALL SAINTS in its entirety alongside the geographical descriptions "Greece" and "Australia" suffixed to the mark as part of the domain name string. Complainant pointed to numerous trademark registrations and the prior UDRP decisions Case D2018-0698, D2017-2492, D2016-1809, and DCO2015-0041 to support the Complainant's contention that it has a significant portfolio of trademark registrations and a reputation in the ALL SAINTS brand.

Second UDRP Element – The Respondents have no Rights or Legitimate Interests in the Disputed Domain Names

The Complainant contends that bearing in mind its considerable reputation in its business and brand for more than 20 years, there is no believable or realistic reason for the registration or use of the disputed domain names. Further, the Complainant claims there is no bona fide offering of goods or services associated with the disputed domain names, but rather specialist threat profiling software revealed presence of malware and/or phishing activity for the disputed domain names. To the best of the Complainant's knowledge, the Respondents have never been known as ALL SAINTS at any point of time. The Complainant asserts that the disputed domain names are being used to misleadingly divert consumers, supported by some evidence that one of the disputed domain names was identified by a customer of the Complainant, while searching on Google.

Third UDRP Element – The Disputed Domain Names were Registered and are Being Used in Bad Faith

The Complainant asserts that the Respondents intentionally attempted to attract for commercial gain internet users to their 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 their website or location. Complainant argues that this assertion is supported by the Complainant's rights pre-dating the registration of the disputed domain names by nearly 20 years, the evidence that one of the disputed domain names was found through an online search for the goods and services of the Complainant, and the use of the TLD ".com" as it could create an

impression of officialdom.

Additionally, the Complainant asserts bad faith targeting by the Respondent because the domain name was registered primarily for the purpose of disrupting the business of a competitor. The Complainant claims that such disruption is evident because the disputed domain name is used to divert customers searching for the Complainant on Google, and because of the evidence that the disputed domain names are being used for phishing and/or malware.

Lastly, the Complaint argues bad faith due to a pattern of conduct on the part of the Respondents in registering domain names to prevent the owner of a trademark from reflecting such mark in a corresponding domain name. The Complainant cites prior successful decisions against the Respondents Case No D2023-1403; Case No. D2023-0209 and CAC-UDRP-105189 as support for a finding of such a pattern of conduct in bad faith.

The above summarized facts and arguments asserted by the Complainant are not contested by the Respondents because no Response was filed.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name 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 Complainant has, 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 Complainant has, 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.

PRINCIPAL REASONS FOR THE DECISION

LANGUAGE OF PROCEEDING

According to Rule 11 in the [Rules for Uniform Domain Name Dispute Resolution Policy](#), (the "Rules") "...the language of the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

According to the information on the case file, the Registrar confirmed that the Respondents are the current registrants of the disputed domain names, and that the language of the respective registration agreements are English.

As neither party has asked to deviate from the English language as per the registration agreements, the Panel finds that this proceeding may be properly conducted in English.

CONSOLIDATION OF MULTIPLE RESPONDENTS

As stated in section 4.11.2 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#) (“WIPO Overview 3.0”), when considering consolidation requests panels should look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency underpins such consideration.

The Panel has concluded that consolidation is warranted in this case.

According to the Registrar Verification in the case file, the names and the addresses of the two Respondents are different. However, this difference in registrant details is not dispositive since registrars are not typically required to verify the identity of registrants.

Factors pointing to the disputed domain names being subject to common control include:

- the proximity in the dates of registration of the disputed domain names – namely just five days apart on December 1 and December 5, 2022;
- evidence of the disputed domain names being used for similar phishing activity as identified by specialist threat profiling software;
- the similarity of the disputed domain name’s anatomy to one another (namely, the ALL SAINTS mark suffixed with a geographical descriptive term); and
- in previous UDRP cases D2023-1403 and CAC-UDRP-105189 the two Respondents were found to satisfy the requirements for consolidation.

The above circumstances, taken together, lead the Panel to conclude that it is more likely than not that the disputed domain names are under common control, and that consolidation of the cases against the Respondents would be fair and equitable to all parties. Given such common control, hereinafter the two Respondents shall be referred to by the singular term “Respondent”.

PRINCIPAL REASONS FOR THE DECISION

THREE ELEMENTS COMPLAINANT MUST ESTABLISH UNDER THE POLICY

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

- (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 Panel has examined the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT’S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT’S RIGHTS

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term ALL SAINTS in classes 03, 14, 18 and 25. Such trademark rights were created and registered around 20 years prior to December 1 and December 5, 2022, the respective creation dates of the disputed domain names. A nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Accordingly, the Panel finds that the Complainant possesses rights in its ALL SAINTS trademark such that it has standing under the Policy.

UDRP panels have held that where the asserted trademark is recognizable within a disputed domain name, the addition of a descriptive, generic or geographical term does not prevent a finding of confusing similarity. In the present case, the disputed domain names consist of the ALL SAINTS trademark reproduced in its entirety, with the addition of the geographic terms “-australia” and “greece”. The trademark ALL SAINTS remains prominent in the disputed domain names, and its combination with geographic terms related to countries where the Complainant offers its goods for sale, infers that the domain name is somehow connected with the owner of the ALL SAINTS trademark, a well-established brand in the fashion retail sector.

The TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant’s trademark as it is technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

The inclusion of the terms “-australia” and “greece”, and use of the TLD “.com” in the disputed domains names do not avoid confusion with the Complainant’s ALL SAINTS trademark. Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain names are confusingly similar to Complainant’s mark.

(B) RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The second element of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests in the disputed domain name. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it; see, for example, [WIPO Overview 3.0, section 2.1](#) (“While 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 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.”). However, the burden of proof still remains with the Complainant to make out its prima facie case on a balance of probabilities. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

Paragraph 4(a)(ii) of the Policy contemplates an examination of the available facts to determine whether a respondent has rights or legitimate interest in the disputed domain name. Paragraph 4(c) sets out a list of circumstances through which a respondent may demonstrate that it does have such rights or interests.

The first circumstance, under Paragraph 4(c)(i), is where “before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services”. Here, the disputed domain names do not resolve to active website content - as shown by evidence submitted by the Complainant. The lack of any website content or other apparent use does not constitute a bona fide offering of goods or services and, thus, cannot support a claim of any rights or legitimate interests in a domain name. See, for example, *Guess ? IP Holder L.P. and Guess?, Inc. v. xi long chen*, [FA 18050011786533](#) (“The disputed domain name resolves to a parked page with the message, “website coming soon!” The Panel finds that this use does not amount to a bona fide offering of good or services or a legitimate noncommercial or fair use per Policy ¶¶ 4(c)(i) & (iii) and Respondent does not have rights or legitimate interests with respect of the domain name.”). Similarly, in this instant case, Panel thus finds there is no evidence indicating that the Respondent is using the disputed domain names in connection with the making of a bona fide offering of goods or services, nor is there any evidence whatsoever of demonstrable preparations by the Respondent to use.

The second circumstance, under Paragraph 4(c)(ii), concerns cases where the respondent is commonly known by the domain name. The Complainant - supported by evidence submitted by the Registrar - has made its prima facie case showing that the names used by the Respondents in the Whois record for the disputed domain names are respectively “Tanya Lemann” and “Web Commerce Communications Limited”. Neither of these names has any similarity to the denomination ALL SAINTS or the geographic descriptors “Greece” and “Australia” as used in the disputed domain names. No other evidence in the case file suggests that the Respondent is commonly known by the disputed domain name or that it has acquired any relevant trademark rights. As such, this second circumstance of legitimate rights or interests under the Policy is not applicable to the Respondent.

Regarding the third circumstance, under Paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s ALL SAINTS trademark. Because the disputed domain names do not resolve to any active content, none of the accepted categories of fair use - such as news reporting, commentary, political speech, education etc - are found to apply and the Panel concludes there is no legitimate non-commercial or fair use on the part of the Respondent.

Accordingly, the Complainant has sufficiently made out its prima-facie case on the second element of the Policy. Thus, the burden of proof is shifted to the Respondent to rebut the Complainant’s case. Here, because the Respondent has not participated in these proceedings, there is no such rebuttal to consider, and the Complainant prevails.

The Panel therefore concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES

The third element requires Complainant to show that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g. *Hallmark Licensing, LLC v. EWebMall, Inc.*, [WIPO Case No. D2015-2202](#) (“The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.”).

Further, Paragraph 4(b) of the Policy sets out a non-exhaustive list of four circumstances, any one of which may be evidence of the registration and use of a domain name in bad faith. The four specified circumstances are:

- (i) circumstances indicating that the respondent has 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) the respondent has 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) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s website or other on-line 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 the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith in general (ie under paragraph 4(a)(iii) of the Policy), and specifically with respect to paragraph 4(b) (iii) and 4(b) (iv) as set out below.

General bad faith

The Complainant’s ALL SAINTS trademark is distinctive and enjoys considerable reputation within the fashion retailing industry, as evidenced by the Complainant’s social media profiles and reach, and its primary website visitor statistics showing nearly 2.3 million visitors in 2022. In a prior case concerning the same Complainant and Respondent, concerning a similarly constructed domain name, namely www.allsaintsuae.com, the panel concluded “There is no explanation for Respondent to have chosen to register the Domain Name other than to intentionally trade off the goodwill and reputation of Complainant’s trademark or otherwise create a false association with Complainant” (see All Saints Retail Limited v. Client Care, Web Commerce Communications Limited, [WIPO Case No. D2023-0209](#)). The same logic applies in the instant case, and this Panel finds that the Respondent either knew, or should have known, that the disputed domain name would be confusingly similar to the Complainant’s trademarks and that they registered the disputed domain name with knowledge of the Complainant’s trademarks.

There is no evidence that the Respondent is commonly known by the disputed domain name and the Complainant asserts that the Respondent has never been affiliated with nor authorized by the Complainant to use the Complainant’s trademark(s) and/or register the disputed domain name. Nor is there any business or other association between the Complainant and the Respondent.

The evidence of targeting by Respondent is compelling. The disputed domain name comprises Complainant’s distinctive ALL SAINTS mark, with the addition of the related terms “-australia”, and “Greece” apparently meant to represent countries where Complainant offers its goods and with which the Complainant can therefore be closely and relevantly associated. The disputed domain names do not resolve to any active content that could potentially evidence an alternative purpose.

The non-active use of the disputed domain name in this case satisfies the doctrine of passive holding considering all of the circumstances of the case because (i) the Complainant’s trademark is distinctive and has a strong reputation in its sector,(ii) the Respondent failed to respond to these proceedings and thus has provided no evidence of actual or contemplated good-faith use, (iii) it is impossible to conceive of any plausible actual or contemplated good faith use of the disputed domain names by the Respondent in this case.

There is a pattern of conduct establishing the Respondent registered the domain names in order to prevent the Complainant from reflecting the mark in the corresponding domain names.

The Complainant has been successful in several prior cases against the Respondent as shown in the table below:

Case Number	Domain Names	Respondents
CAC-UDRP-105189	allsaintsmexico.com, allsaints-outlet.com	Web Commerce Communications Limited, Tanja Lemann
D2023-1403	allsaintsbelgium.com allsaintschile.com allsaintscolumbia.com allsaintsdubai.com allsaintsfrance.com allsaintsireland.com allsaintsmalaysia.com allsaintsmexicoshop.com allsaintsoutletsale.com allsaintsphilippines.com allsaintspolska.com allsaintsportugal.com allsaintssingapore.com allsaintssouthafrica.com allsaintsturkiye.com allsaintsuksale.com allsaints-usa.com	Tanja Lemann Web Commerce Communications Limited
D2023-0209	allsaintsuae.com	Web Commerce Communications Limited

This list, and the fact that bad faith was established in the above-mentioned cases, demonstrates that Respondent has engaged in a pattern of registering domain names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, and that the registration of the disputed domain names in the instant case is therefore in bad faith under Policy paragraph 4(b)(ii).

The Respondent intentionally attempted to attract, for commercial gain, internet users to its web site or online location, by creating a likelihood of confusion with the Complainant's ALL SAINTS mark

Evidence in the case file indicates that at least one of the disputed domain names was discovered through a Google search undertaken by a Complainant customer looking for Complainant's products and services. Further, the Complainant submitted evidence that Greece and Australia are countries in which it offers its products and services, thus showing the connection between its brand and such geographic descriptors as included in the disputed domain names. A customer looking for Complainant's products in the relevant countries could logically type "All Saints Australia" or "All Saints Greece" into a search engine. Upon finding the disputed domain names through such a search, such customer would likely be confused into thinking the disputed domain names were associated with or somehow endorsed by the Complainant. The apparent intention by the Respondent to improperly attract internet users in this manner constitutes bad faith under Policy paragraph 4(b)(iv)

Conclusions as to bad faith

As a final point, the Panel may draw a negative inference from Respondent's silence through these proceedings.

In light of the above analysis, the Panel concludes that the Complainant has made out its case that the disputed domain name was registered and is being used in bad faith, and thus has satisfied the requirements under paragraph 4(a)(iii), 4b(ii) and 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **allsaints-australia.com**: Transferred
2. **allsaintsgreece.com**: Transferred

PANELLISTS

Name	Claire Kowarsky
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DATE OF PANEL DECISION **2023-08-12**

Publish the Decision
