

Decision for dispute CAC-UDRP-105762

Case number	CAC-UDRP-105762
Time of filing	2023-09-11 14:01:29
Domain names	orkielyuk.com, orlaiely.online, orlakiely.online, ukorkielysale.shop, orlaclearence.shop, orlakielysale.store, orlaoutlet.shop, orlakiely-shop.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Olive & Orange Limited
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Complainant representative

Organization	Stobbs IP
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Respondents

Name	dsad adsad
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Name	
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Organization	PrivacyGuardian.org
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Name	
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Name	Chalres Li
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Name	Philbrick Antonio
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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 Olive & Orange Limited is the licensee of numerous trademark registrations for ORLA KIELY around the world such as:

- United Kingdom Trademark n° UK00002135954 ORLA KIELY, registered on 20 March 1998 in classes 18 and 25;
- United States trademark n° 2619238 ORLA KIELY, registered on 17 September 2002 in classes 3, 9, 18 and 25;

- United States trademark n° 3529693ORLA KIELY, registered on 11 November 2008 in classes 16, 20, 21, 24 and 27;

- European Union Trademark n° 003683992 - ORLA KIELY, registered on 5 July 2005 in classes 3, 4, 16, 20, 21, 24;

Among many others in numerous countries.

The registrations are owned by Dermott Rowan and Orlay Kiely, the officers of the Complainant, Olive & Orange Limited, as duly proved.

FACTUAL BACKGROUND

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

The Request for Consolidation is based on: the proximity in the dates of registration of the Additional Domains to the First Disputed Domain Name; evidence of identical and/or highly similar content at the resolving websites; and the similarity of the Additional Domains' anatomy to one another (incorporation of the Complainant's Mark either in identical or varied form alongside descriptors such as "shop", "sale", "uk", paired with specific TLDs such .shop, .store, .online, .com). On this basis, the Complainant submits that it is beyond pure coincidence that these registrations all exist, and that they are ultimately part of a common control by a domain registrant. Therefore, a request is made that the Additional Domains are assessed and decided as part of a single consolidated complaint alongside the First Disputed Domain subject to proceedings CAC-UDRP-105762.

The Complaint is based on the following grounds:

The Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

Background to the Complainant

1. The Complainant is the legal owner of the ORLA KIELY brand ("the Brand"). The Brand independent brand that designs and creates a range of products using bold prints, many of which have become well-known. The Complainant operates a unique online retail destination at <https://orkiely.com/> ("the Official Website"). The online retail destination sells a wide range of products, such as bags, accessories (e.g. wallets and sunglasses) and homeware (e.g. kitchenware and furniture). The United Kingdom is the Complainant's domestic market and the territory within which it is incorporated. As part of its retail activities, the Complainant also operates social media channels, such as Instagram (<https://www.instagram.com/orkiely/>) and Facebook (<https://www.facebook.com/orkielyofficial/>).
2. The Complainant holds extensive rights in the ORLA KIELY trade mark ("the Mark") in the United Kingdom as well as globally. The Brands' global trade mark coverage includes Europe, China and the United States. The Complainant's trade mark applications and registrations for the Mark have been attached to this Complaint. Additionally, the Complainant has built a significant reputation and goodwill in the Brand and Mark in the United Kingdom in relation to a wide range of goods and services. The Brand's reputation also extends globally, as evidenced, which details the location of internet users to the Official Website, and includes the US, Australia, Norway, and the Netherlands featuring as the top countries sending traffic to the Official Website as of July 2023.
3. Further, the Brand's online reach can be demonstrated through its sizeable user following on mainstream platform; the Brand has 145,000 followers on Instagram and 90,455 followers on Facebook. The domain for the Official Website was registered in 1999 and has been used for the purpose of a live site promoting the Complainant's Brand for over 15 years.
4. Aside from its online presence, the Brand has also been featured in world famous fashion print, such as Vogue (accessible to readers worldwide), and was exhibited in the famous Fashion and Textile Museum in London. The Brand has also collaborated with known fashion and retail companies such as Uniqlo, Regatta, Jaspal and Barker & Stonehouse. The Complainant's goods are also sold in brick and mortar retailers such as John Lewis in the United Kingdom, an established British high-end department store.
5. The Complainant submits that the Brand has not only been widely present in the lives of UK consumers for many years but has also been accessible to internet users around the world as a result of its established online presence.

The Complainant's Mark and Domain Names' Confusing Similarity

1. The Complainant's rights in its Mark date back to 1998, which predates the Registration of the Disputed Domain Names by over 20 years.

The Complainant submits that the Disputed Domain Names are confusingly similar to the Complainant's Mark for the following reasons:

Disputed Domains <orlakielysale.store>, <ukorlakielysale.shop>, <orlakiely.online>, <orlakielyuk.com>, <orlakielyuk.com>

Disputed Domain Names <orlakielysale.store>, <ukorlakielysale.shop>, <orlakiely.online>, <orlakielyuk.com>, <orlakiely-shop.com> either incorporate the Mark in its entirety with no additional descriptors (see <orlakiely.online>), or, are show the Mark prefixed or suffixed with descriptors such as "uk", "sale", or "shop". In *Britannia Building Society v. Britannia Fraud Prevention*, WIPO Case No. D2001-0505, it was held that '[t]he incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark.'

The Mark is clearly the dominant and distinctive feature of Disputed Domain Names <orlakielysale.store>, <ukorlakielysale.shop>, <orlakiely.online>, <orlakielyuk.com>, <orlakiely-shop.com>. It is well established in case law (for example, see *Philip Morris Products S.A. v. WhoisGuard Protected, WhoisGuard, Inc. /Tommy Chi*, WIPO Case No. D2018-0843) and confirmed in Section 1.8 of the WIPO Overview 3.0 that:

Where the relevant trademark is recognizable within the Disputed Domain Names, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

Accordingly, the inclusion of the terms "uk", "sale", "shop" are insufficient to prevent a finding of confusing similarity in the case of Disputed Domain Names <orlakielysale.store>, <ukorlakielysale.shop>, <orlakiely.online>, <orlakielyuk.com>, <orlakiely-shop.com>. In fact, considering the Complainant's nature of business (a fashion retailer) and their substantial reputation and commercial presence amongst consumers in the United Kingdom, the descriptors can in fact be said to reinforce the confusing similarity of the Disputed Domain Names <orlakielysale.store>, <ukorlakielysale.shop>, <orlakiely.online>, <orlakielyuk.com>, <orlakiely-shop.com> to the Mark.

Disputed Domain Names <orlaoutlet.shop> and <orlaclearence.shop>

Disputed Domain Names <orlaoutlet.shop> and <orlaclearence.shop> and as evidenced, host imitation sites targeting the Complainant's brand.

With further reference to discussions in Paragraphs 3-7 of the Complaint, in light of the fact that the Disputed Domain Names stem from a sole operator who has evidenced persistent targeting of the Complainant, the Complainant requests that a holistic approach is adopted to the assessment of the Disputed Domain Names subject to the Complaint.

Disputed Domain Name <orlaiely.online>

Disputed Domain Name <orlaiely.online> is an instance of "typosquatting". The Respondent has simply omitted the "k" from the Disputed Domain Name, which in no way detracts from the confusing similarity between the Disputed Domain Name and the Complainant's Mark. It is widely accepted under the Policy (s.1.9, WIPO Overview 3.0) that domain registrations which incorporate deliberate misspellings of a brand name do not impart on the confusing similarity assessment between a domain and a trade mark, under the first "limb" of the Policy:

"A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element"

Finally, the Complainant submits that the gTLD suffixes for the Disputed Domain Names (.com, .online, .shop, .store), which are an integral technical part of the Disputed Domain Names, may be disregarded in the determination of confusing similarity under the conventions of the UDRP (for example, see *Intel Corporation v The Pentium Group*, WIPO Case No. D2009-0273). The Complainant requests that the panel omit the gTLD suffixes when assessing the Disputed Domain Names, as these are merely a technical requirement used for domain name registration. This principle is further confirmed in WIPO Overview 3.0, Paragraph 1.11, which states that '[t]he applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.'

Based on the above, the Complainant submits that the Disputed Domain Names are confusingly similar to the trade mark in which the Complainant has rights (Rule 3(b)(ix)(1)).

The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names

The Complainant submits that the Respondent does not have any rights or legitimate interests in the Disputed Domain Names under Policy, Paragraph 4(c). The Complainant acknowledges that a Respondent may demonstrate a right or legitimate interest in the domain name if it can be established that:

- the Respondent's use of the domain name or a name corresponding to the domain name is in connection with a bona fide offering of goods or services;
- the Respondent has been commonly known by the domain name, even if they have acquired no trademark or service mark rights; or
- the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent or commercial gain to misleadingly divert consumers.

The Complainant will rebut each of the defenses below. The burden of proof will then shift to the Respondent to put forward evidence that it does have rights or legitimate interests in the Disputed Domain Names.

Bearing in mind the considerable reputation of the Complainant's Brand, there is no believable or realistic reason for the registration or use of the Disputed Domain Names other than to take an unfair advantage of the Complainant's reputation and Mark.

As stated previously, the Disputed Domain Names were created recently, in 2023. By this date, the Complainant already had extensive registered rights in their Mark and brand in the United Kingdom and in other territories around the world.

The Respondent's use of the Disputed Domain Name in connection with a bona fide offering of goods or services

The Complainant submits that the Disputed Domain Names show evidence of resolving to live websites ("the Infringing Websites"). The Respondent is using the Disputed Domain Names for the purpose of luring consumers to their own 'Orla Kiely' websites, which replicate the Complainant's Official Website. In some cases, (<orlaiely.online> and <orlaoutlet.shop>), the Respondent is featuring content of third party brands. It is more likely than not that the Respondent is seeking to financially gain from the deception (for example, through the interception of customers' credit card information when they attempt to make a purchase – see non exhaustive evidence of card payment facilities offered on one of the Infringing Websites. Fraudulent use cannot constitute a bona fide offering of goods or services. Therefore, the Respondent cannot claim a defence under Policy, Paragraph 4(c)(i).

The Complainant submits that, to the best of its knowledge, the Respondent has never been known as 'Orla Kiely' at any point in time. As stated in *Vestel Elektronik Sanayi ve Ticaret AS v. Kahveci.*, WIPO Case No. D2000-1244, 'merely registering the domain name is not sufficient to establish rights or legitimate interests for purposes of paragraph 4(a)(ii) of the Policy.' The inclusion of the Complainant's Mark (either in its entirety or as variation of), within the Disputed Domain Names leads the Complainant to conclude that the only or main reason that the Respondent registered the Disputed Domain Names was to take advantage of the Complainant's goodwill and reputation and Mark. No other logical or plausible conclusion can be inferred.

The Complainant submits that nothing about the Disputed Domain Names suggest that the Respondent is making a legitimate non-commercial or fair use of them. As discussed in Sections B and C of this Complaint, the Disputed Domain Names do not resolve to any legitimate content and, instead, are merely being used to profit from the Complainant's reputation and Mark as either website imitating the Complainant's Official Website and purporting to offer goods for sale under the Complainant's Mark, or, hosting content of third party brands (consequently causing a disruption to the Complainant's business as a result of diverted traffic). Therefore, the Respondent cannot come within Policy, Paragraph 4(c)(iii).

The Complainant submits that the Disputed Domain Names have been registered, used and continue to be used in bad faith in accordance with Policy, Paragraph 4(a)(iii).

The Complainant submits that its Mark, as well as trading and commercial activities of its business, significantly pre-date the registration of the Disputed Domain Names. As evidenced in Section A of the Complaint, the Complainant's Brand undoubtedly has recognition in the UK and globally, supported by substantial endorsements, partnerships and social media activity, at the date of the registration of the Disputed Domain Names. A simple check on any of the most commonly used Internet search engines would have revealed the Complainant's brand and business.

The Complainant therefore submits that the Respondent had actual knowledge of the Complainant's brand before and at the time of the registration, and that the Disputed Domain Names were registered with prior knowledge of the Complainant's Mark. The Respondent has registered the Disputed Domain Names in order to prevent the Complainant, the owner of the Mark from reflecting the Mark in a corresponding domain name. In view of the use of the Complainant's Mark, it is implausible that the Respondent had no knowledge of the Complainant's Brand when registering the Disputed Domain Names.

Furthermore, the Complainant submits that the use of the Complainant's Mark, branding and copyright images constitutes bad faith. This 'imitation' of the Complainant's Official Website demonstrates that the Respondent was (and continues to be) aware of the Brand when registering the Disputed Domain Names. Such activity is merely a means of phishing and deceiving the Complainant's customer base and internet users in general. In *Halifax Plc v Sontaja Sunducl*, WIPO Case No. D2004-0237, it was held that '... evidence of duplication in complainant's trading get-up, branding and imagery is direct evidence of the domain name is being used in bad faith. In particular, the availability of the online registration pages, and the apparent potential for 'phishing' and obtaining information by deception, is not just evidence of bad faith but possibly suggestive of criminal activity....

there is no other possibility than the site being registered in bad faith.’

Additionally, the Complainant submits that the Respondent is using the Disputed Domain Names to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's Brand as to the source, sponsorship, affiliation, or endorsement of its website or of a product on its website (Policy, Paragraph 4(b)(iv)). The Respondent is using the Disputed Domain Names, which are confusingly similar to the Complainant's Brand and Mark, to attract Internet users generally and the Complainant's customers to the Respondent's own websites. Further, the sale of Complainant's goods on the Respondent's websites has not been authorised by the Complainant.

The Complainant submits that even if the goods sold at the Respondent's websites are for re-sale purposes, the Disputed Domain Names fail to satisfy the three-part test set out in WIPO Overview 3.0, Paragraph 2.8 and confirmed in *Oki Data Americas v. ASD, Inc.*, WIPO Case No. D2001-0903 (the 'Oki Data test'):

- the Respondent must actually be offering the goods or services at issue;
- the Respondent must use the site to sell only the trade marked goods;
- the site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trade mark owner, or that the website is the official site, if, in fact, it is only one of many sales agents; and
- the Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

On these facts, the Complainant submits that the Respondent fails to satisfy the third requirement under the Oki Data test, requiring it to accurately disclose its relationship with the Complainant. The websites do not disclose anything that could be construed as notice to unsuspecting customers or internet users. As a result, the Respondent fails the Oki Data test. Similar findings were made in *All Saints Retail Limited v. Mao Guo.*, WIPO Case No. D2018-2907.

Previous Panels have also considered that in absence of any license or permission from the Complainant to use such a widely known Mark, no actual or contemplated legitimate use of the Disputed Domain Names could reasonably be claimed (for example, see *Alstom, Bouygues v Webmaster D2008-0281* and *Guerlain S.A v Peikang*, WIPO Case No. D2000-0055). As the Disputed Domain Names are confusingly similar to the Complainant's Mark, previous Panels have ruled that there is a presumption of a likelihood of confusion with such confusion inevitably resulting in the diversion of Internet traffic from the Complainant's Official Website to the Respondent's website (for example, see *MasterCard International Incorporated v Wavepass AS*, WIPO Case No. D2012-1765 and *com, Inc v Triple E Holdings Limited*, WIPO Case No. D2006-1095).

Consequently, the Respondent is intending to draw unsuspecting users to the Disputed Domain Names, for its own commercial gain, which in turn is likely to cause detriment to the Complainant.

Based on the submissions above, the Complainant maintains that the Disputed Domain Names have been registered and are being used in bad faith. Consequently, all elements of the Policy are satisfied.

PARTIES CONTENTIONS

Complainant's contentions are summarized above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, 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 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.

The Complainant has submitted reasonable evidence that the Disputed Domain Names in dispute are effectively controlled by the same person and/or entity. The domain names in the present dispute are similarly constructed, the Disputed Domain Names address websites that are substantially similar to each other, etc. Therefore, the Disputed Domain Names in dispute appear to be under the same control.

As of the language of the proceedings, despite the fact the Chinese is the registration language for three out the eight Disputed Domain Names, it is accepted to Complainant's request to issue a decision in English, particularly in view of the fact that the corresponding web pages are written in English and therefore the Respondent works in or is familiar with that language.

Lastly, in the form of amended complaint the disputed domain name <orlakiely-shop.com> contains a typo and the domain name is inserted as orlakiely-shop.con. Both from the Complainant's statements and evidence and from the provided Registrar's verification it is quite clear that the disputed domain name is <orlakiely-shop.com>.

PRINCIPAL REASONS FOR THE DECISION

1. RIGHTS

The Disputed Domain Names are confusingly similar to the Complainant's registered trademark since most of them reproduce the Complainant's mark ORLA KIELY merely adding generic words or country codes as "UK", "sales", "clearance", "shop" or "outlet". Others engage in "typosquatting" since those disputed domain names simply omitted the "k" from the trademark, which in no way detracts from the confusing similarity between the Disputed Domain Name and the Complainant's Mark.

As stated in *Crédit Industriel et Commercial v. Manager Builder, Builder Manager*, WIPO Case No. D2018-2230:

"The disputed domain name incorporates the CIC trademark in its entirety. Numerous UDRP panels have recognized that incorporating a trademark in its entirety can be sufficient to establish that the disputed domain name is at least confusingly similar to a registered trademark (see e.g., *PepsiCo, Inc. v. PEPSI, SRL* (a/k/a P.E.P.S.I.) and *EMS Computer Industry* (a/k/a EMS), WIPO Case No. D2003-0696). Moreover, it has been held in many UDRP decisions and has become a consensus view among panelists (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.8), that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element of the UDRP. Accordingly, the addition of the term "banks", which even is the English translation of the French term "banques" as it is reflected in Complainant's CIC BANQUES trademark, does not avoid the confusing similarity arising from the incorporation of Complainant's CIC trademark in the disputed domain name."

2. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondents have not submitted any response. Therefore, they have submitted no information on possible rights or legitimate interests they might hold. On its part, the Complainant has submitted information and arguments which, prima facie, allow it to be reasonably assumed that the Respondents have no rights or legitimate interest in the domain names in dispute.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D2002-0856:

"As mentioned, [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed domain name, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists." WIPO Case No. D20020273 <sachsenhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

Furthermore, the Complainant has provided evidence that its trademark has a huge reputation and success and the Respondents' websites sell products that could be imitations or falsifications of the Complainant's luxury and/or have not been authorized. Some of the websites actually contain third party brand. Obviously, this use cannot be considered as legitimate.

Accordingly, the Panel finds that the Respondents have no rights or legitimate interests in the disputed domain names.

3. BAD FAITH

The Respondents have, as a result of their default, not invoked any circumstances which could invalidate the Complainant's allegations and evidence with regard to the Respondents' registration and use of the Disputed Domain Names in bad faith.

The Complainant has filed evidence of its relevant activity under the ORLY KIELY trademark and that the Respondents' websites sell products under this trademark. As alleged by the Complainant, even if the goods sold at the Respondent's websites are for re-sale purposes, the Disputed Domain Names fail to satisfy the three-part test set out in WIPO Overview 3.0, Paragraph 2.8 and confirmed in *Oki Data Americas v. ASD, Inc.*, WIPO Case No. D2001-0903 (the 'Oki Data test'): It seems clear that the Respondents are trying to impersonate the Complainant.

It is therefore clear that the Respondents registered the disputed domain names for this fraudulent purpose.

Paragraph 4(b) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the domain name, the respondent has intentionally attempted 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 its website or location or of a product or service on its website or location.

As mentioned in *Andrey Ternovskiy dba Chatroulette v. Alexander Ochki*, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the Disputed Domain Names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see *AT&T Corp. v. Amjad Kausar*, WIPO Case No. D2003-0327)."

A similar case was decided in favour of the Complainant in *Olive & Orange Limited, Orla Kiely, and Diarmuid Jonathan (D.J.) Rowan v. xia li*, WIPO Case No. D2023-0652.

It has, therefore, been satisfactorily demonstrated to the Panel that the Disputed Domain Names have been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **orlakielyuk.com**: Transferred
 2. **orlaiely.online**: Transferred
 3. **orlakiely.online**: Transferred
 4. **ukorlakielysale.shop**: Transferred
 5. **orlclearance.shop**: Transferred
 6. **orlakielysale.store**: Transferred
 7. **orlaoutlet.shop**: Transferred
 8. **orlakiely-shop.con**: Transferred
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PANELLISTS

Name	José Ignacio San Martín
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DATE OF PANEL DECISION 2023-11-08

Publish the Decision
