# Decision for dispute CAC-UDRP-106283

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| Case number | CAC-UDRP-106283 |
| Time of filing | 2024-03-06 09:43:05 |
| Domain names | peteralexander.shop |

## Case administrator

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

## Complainant

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| Organization | Peter Alexander Sleepwear Pty Ltd |

## Complainant representative

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| Organization | CSC Digital Brand Services Group AB |

## Respondent

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| Name | Yan Hu |

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of trademark registrations across various jurisdictions globally including but not limited to registrations at China National Intellectual Property Administration (CNIPA), IP Australia (IPA), and the World Intellectual Property Office (WIPO).

The most relevant registrations are

| TRADEMARK | JURISDICTION/TM OFFICE | REGISTRATION NUMBER | REGISTRATION DATE | IC CLASS |
|---|---|---|---|---|
| PETER ALEXANDER | CNIPA | 4456412 | October 7, 2008 | 024 |
| PETER ALEXANDER | CNIPA | 16416984 | December 7, 2016 | 018 |
| PETER | | | | |

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| ALEXANDER | CNIPA | 16416985 | September 7, 2017 | 025 |
| PETER ALEXANDER | IPA | 524244 | September 17, 1992 | 025 |
| PETER ALEXANDER | WIPO | 1356791 | March 8, 2017 | 024, 035, 003, 014, 025, 004, 016, 028, 018, 030, 020, 031, 010, 021 |

## FACTUAL BACKGROUND

The Complainant is a wholly owned subsidiary of Just Group Limited, which itself is a wholly owned subsidiary of Premier Investments Limited.

The Complainant claims to be Australia's leading sleepwear designer brand for women's pyjamas, men's sleepwear, and kids' pyjamas to bring fun to bedtime. Peter Alexander founded the Complainant company and established a supply connection to major department stores since 1988. Since 1995, the Complainant has operated its online store. In 2000, the Complainant became a wholly owned subsidiary of Just Group Limited. Following their large success and online presence in 2004, the Complainant opened their first standalone store in Melbourne. As at the end of Financial Year 2023, the Complainant traded from 111 stores in Australia and 16 stores in New Zealand.

The Complainant is clearly established among consumers, as reflected by its celebrity clientele including, Delta Goodrem, Dame Edna, Joanna Lumley, Jennifer Saunders, Kylie Minogue, Miranda Kerr, and Hugh Jackman. It claims to be a powerful designer brand and delivered record sales result for the Financial Year of 2023 of $478.9 million.

The Complainant owns the domain name <peteralexander.com.au> and maintains a strong Internet and retail presence through its primary sub-domain name <peteralexander.jgl.com.au> and the linked website, with delivery options globally. It also maintains a secondary website www.peteralexander.jgl.co.nz for customers in New Zealand to shop the Peter Alexander range online with the convenience of local delivery options.

The Complainant's various social media platforms include 397,000 page likes and 396,000 followers on Facebook, over 19,600 followers on Twitter, and 272,000 followers on Instagram.

The disputed domain name <peteralexander.shop> was registered on June 8, 2023.

## PARTIES CONTENTIONS

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

The Respondent failed to file any administratively compliant response.

## RIGHTS

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

The Complainant has established rights in the "Peter Alexander" trademark through its registrations as demonstrated by the evidence adduced. The question is whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

The Complainant contends that the disputed domain name <peteralexander.shop> is identical to its trademark.

Whether a disputed domain name is identical or confusingly similar to a trademark can be determined by making a side-by-side comparison with the disputed domain name. See F. Hoffmann-La Roche AG v. P Martin, WIPO Case No. D2009-0323.

A disputed domain name is identical to the trademark when it is a character for character match. It is confusingly similar when it varies the trademark by, for example, adding generic terms to the dominant part of the trademark.

Here, the Complainant's trademark is incorporated in its entirety in the disputed domain name. It is a character for character match. It is, therefore, identical to the Complainant's trademark.

It is also trite to state that the addition of the gTLD ".shop" does not add any distinctiveness to the disputed domain name and will be disregarded for the purposes of considering this ground.

Accordingly, the Panel considers that this ground is made out.

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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 name (within the meaning of paragraph 4(a)(ii) of the Policy).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. See Document Technologies, Inc. v. International Electronic Communications Inc, WIPO Case No. D20000270.

If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See Croatia Airlines d.d. v. Modern Empire Internet Ltd, WIPO Case No. D2003-0455.

The Complainant contends the Respondent has no rights to the disputed domain name for the following reasons:

1. The Complainant's ownership of the "Peter Alexander" trademark, granted by CNIPA, IPA, and WIPO, provides prima facie evidence of its exclusive rights to use this trademark in commerce.
2. The Respondent has not been sponsored, affiliated, authorised, or otherwise permitted by the Complainant to use the "Peter Alexander" trademark in any manner, including within the disputed domain name.
3. The Respondent is not commonly known by the disputed domain name, as evidenced by WHOIS data, indicating a lack of rights or legitimate interests. The WHOIS information also identifies the Registrar as 'redacted for privacy'.
4. The disputed domain name redirects users to a website that impersonates the Complainant's official website, attempting to deceive internet users into believing there is an association with the Complainant, which constitutes evidence against any rights or legitimate interests the Respondent might claim.
5. The redirected website purports to copy and duplicate the Complainant's website by copying the design, colour scheme, pictures, and/or text found on the Complainant's website, offering the Complainant's products. The absence of a disclaimer clarifying the lack of relationship with the Complainant fails the "Oki Data test" for a bona fide offering, further negating any claimed rights or legitimate interests.
6. The disputed domain name's website currently resolves to a blank page, showing no legitimate use, further supporting the absence of rights or legitimate interests.
7. The disputed domain name was registered significantly after the Complainant's trademark filings and use, indicating a lack of bona fide intentions.
8. The identical nature of the disputed domain name to the Complainant's trademark and the inclusion of the term "shop" imply a misleading affiliation with the Complainant, disqualifying any nominative fair use defence.

No challenge has been made by the Respondent to the Complainant's contentions and assertions as it has not filed any administrative compliant response.

Given the evidence adduced by the Complainant of its portfolio of trademarks and wide reputation which the Panel accepts as evidencing the strength of its reputation, the Panel accepts and finds that the Respondent has no rights or legitimate interests to the disputed domain name.

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BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

There are two elements that must be satisfied – registration and use in bad faith.

The Complainant contends that the Respondent registered and is using the disputed domain name in bad faith for the following reasons:

1. Given the international recognition and registration of the "Peter Alexander" trademark and the extensive use since 1988, the

Respondent demonstrated a knowledge of familiarity with the Complainant's trademark when registering the disputed domain name on June 8, 2023. The identical nature of the disputed domain name to the Complainant's trademark and its prior domain registration indicates bad faith.

2. The Respondent's effort to replicate the Complainant's official website by copying its design, colour scheme, and content further suggests knowledge of and an intention to deceive or confuse internet users, demonstrating bad faith.
3. Searches for "Peter Alexander Shop" primarily return links related to the Complainant, indicating the Respondent's likely knowledge of the Complainant's rights in the trademark at the time of the disputed domain name's registration.
4. The inclusion of the TLD ".shop" in the disputed domain name, corresponding to Complainant's area of business, further underscores the Respondent's awareness of the Complainant and suggests bad faith registration and use.
5. The current inactivity or passive holding of the disputed domain name does not negate findings of bad faith.
6. Given the disputed domain name's similarity to Complainant's trademark and the replication of Complainant's website design, any use by the Respondent could only be in bad faith. There is no conceivable good-faith reason for the Respondent's registration and use of the disputed domain name.
7. The Respondent's employment of a privacy service to conceal its identity is considered further evidence of bad faith registration and use.

The Panel is prepared to infer that the Respondent has been fully aware of the Complainant, its "Peter Alexander" trademark when registering the disputed domain name. The Panel is also prepared to draw the adverse inference that the Respondent registered the disputed domain name incorporating in its entirety the Complainant's trademark intentionally to take advantage of the Complainant's reputation and business goodwill.

The Panel also accepts the Complainant's uncontradicted assertion that the Respondent cannot claim any rights or legitimate interests in the disputed domain name.

The Panel finds that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services.

No challenge has been made by the Respondent to the Complainant's contentions and assertions as it has not filed any administrative compliant response.

Accordingly, the Panel accepts that the disputed domain name was registered by the Respondent and used in bad faith.

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PROCEDURAL FACTORS

**Language of proceedings request**

The Complainant requests that the English language should be the language of the proceeding rather than the Chinese language for the following reasons:

1. The Complainant does not speak Chinese, and translating the Complaint would cause undue delay, disadvantage, and burden, potentially harming the Complainant and misleading consumers due to the disputed domain name's abusive nature.
2. The disputed domain name consists of Latin characters, and its associated website uses English phrases, indicating an English-speaking audience.
3. The term "peteralexander" in the disputed domain name does not have meaning in Chinese, supporting the appropriateness of English for the proceedings.
4. Allowing the proceedings in English aligns with ensuring fairness and keeping domain dispute resolutions cost-effective and swift.

Rule 11(a) of the UDRP rules states:

Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, 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.

Here, the language of the registration agreement is Chinese as verified by the Registrar.

In conducting the administrative proceeding, the Panel is required to ensure under Rule 10 of the UDRP rules that the Parties are treated with equality and be given a fair opportunity to present its case.

The Respondent has not filed any administratively compliant response to the Complainant's Amended Complaint despite attempts

made to contact the person listed in the Registrar's information.

On balance, the Panel considers the proceedings can proceed in the English language given the disputed domain name uses an English language trademark “Peter Alexander” and the Respondent's purported duplication of the Complainant’s website uses the English language.

In the circumstances, the Panel accepts the Complainant's request and considers that it is appropriate to proceed to determine the proceeding in the English language.

**Notification of proceedings to the Respondent**

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC’s responsibility to achieve actual notice to the Respondent.

On March 29, 2024 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

That neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court. The CAC is therefore unaware whether the written notice was received by the Respondent or not.

The e-mail sent to postmaster@peteralexander.shop was returned back as undelivered. The e-mail notice was also sent to 9v3g1b0qtvgmt@163.com, but we never received any proof of delivery or notification of undelivery. No further e-mail address could be found on the disputed site.

The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, 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

The Complainant owns the trademark “Peter Alexander” registered in various countries, and the domain name <peteralexander.com.au>, which are used in connection with its goods or services.

The Respondent registered the disputed domain name <peteralexander.shop> on June 8, 2023.

The disputed domain name was registered after the Complainant’s trademark “Peter Alexander”.

The Complainant challenges the registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent failed to file any administratively compliant response.

For the reasons articulated in the Panel’s reasons above, the Complainant has satisfied the Panel of the following:

(a) The disputed domain name is identical to the Complainant’s widely known trademark;

(b) The Respondent has no rights or legitimate interests in respect of the disputed domain name;

(c) The disputed domain name has been registered and is being 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. **peteralexander.shop**: Transferred

## PANELLISTS

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|---|---|
| Name | **William Lye OAM KC** |

DATE OF PANEL DECISION 2024-04-08

DATE OF PANEL DECISION

Publish the Decision