# Decision for dispute CAC-UDRP-106643

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| Case number | CAC-UDRP-106643 |
| Time of filing | 2024-06-28 12:57:28 |
| Domain names | BurberryBeauty.com |

## Case administrator

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

## Complainant

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| Organization | Burberry Limited |

## Complainant representative

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| Organization | Coöperatie SNB-REACT U.A. |

## Respondent

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| Name | Fei Cheng |

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the domain name <burberrybeauty.com> ('the disputed domain name').

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks, amongst others:

- International trade mark registration no. 733385, registered on 25 April 2000, designating inter alia China, for the mark BURBERRY, in classes 3, 18, and 25 of the Nice Classification; and
- International trade mark registration no. 1050774, registered on 20 May 2010, designating inter alia China, for the mark BURBERRY, in class 3 of the Nice Classification.

(Collectively or individually referred to as 'the Complainant's trade mark', 'the Complainant's trade mark BURBERRY', or 'the trade mark BURBERRY').

The disputed domain name was registered on 1 May 2021. At the time of writing this decision, it resolves to a parked page featuring pay-per-click ('the PPC') advertisements for goods and services related to the Complainant's business sector, as well as a notice which reads as follows:

> "Buy this domain
>
> The owner of burberrybeauty.com is offering it for sale for an asking price of 3500 GBP!"

(For present purposes, 'the Respondent's website').

FACTUAL BACKGROUND

A. Complainant's Factual Allegations

The Complainant is a British luxury fashion house established in 1856 by Thomas Burberry and headquartered in London, England. It designs, manufactures and commercialises high-end luxury goods, including bags, scarves, cosmetics, perfumes, glasses, and other accessories.

The Complainant has a global presence spanning across 400 retail, outlet and concession locations worldwide. The Complainant had an estimated revue of c. GBP 3bn in the 2023/2024 fiscal year.

In addition to the trade marks mentioned in the above section 'Identification of Rights', and other trade marks in its portfolio, the Complainant also owns domain names bearing the trade mark BURBERRY, mostly notably <burberry.com> (registered in 1997) and <burberry.co.uk> (registered in 1999).

The Complainant also relies upon case law from US state courts and WIPO domain name disputes (including WIPO Case No. D2010-1304, Burberry Limited v Ruo Chang (for present purposes, 'the past WIPO decision')), according to which the Complainant's trade mark BURBERRY have achieved the status of well-known and even famous trade mark.

The Complainant seeks to obtain the transfer of the disputed domain name <burberrybeauty.com> on the grounds set out in section A.2 below.

B. Respondent's Factual Allegations

The Respondent has defaulted in this UDRP administrative proceeding and has consequently made no factual allegations.

PARTIES CONTENTIONS

A. Complainant

A.1 Preliminary Issue - Language of the Proceeding Request

With respect to the language of the proceedings, the Panel notes as follows:

• The Complaint is written in English;

• According to the registrar's verification response ('the RVR'), the language of the registration agreement for the disputed domain name <burberrybeauty.com> is Chinese;

• Following the RVR, and at the request of CAC, the Complainant submitted a request for English to be the language of this UDRP administrative proceeding, on the following grounds: (i) the disputed domain name contains English words, namely 'burberry', owned by the Complainant (a British company), followed by the English word 'beauty'; (ii) the Respondent's email address as shown by the RVR is made up exclusively of English words; (iii) a reverse Whois search indicates that the Respondent has used its email address to register domain names bearing other well-known trade marks (e.g. <playstationplus.cn> and <onedrive.cn>); (iv) the Respondent's website displays content in English giving notice that the disputed domain name is being offered for sale for the asking price of GBP 3,500 through the domain broker Sedo.com; and (v) it would be cumbersome and disadvantageous for the Complainant to proceed in Chinese owing to the delay and costs associated with translation.

A.2 Substantive grounds

The Complainant's contentions can be summarised as follows.

A.2.1 The disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's trade mark BURBERRY, in so far as it wholly incorporates the Complainant's trade mark. The additional word 'beauty', which brings to mind the type of goods for which the Complainant has registered and is using the BURBERRY trade mark, does not prevent a finding of confusing similarity under this UDPR Policy ground.

The Complainant further takes stock of (i) the past WIPO decision, under which the same disputed domain name was adjudicated, and in which the panel found the Complainant's trade mark to be distinctive; and (ii) the WIPO Panel Views on Selected UDRP Questions, Third Edition, paragraph 4.1 ('the WIPO Jurisprudential Overview 3.0'), according to which panels strive for consistency with prior decisions to ensure that the UDRP operates in a fair and predictable manner for all stakeholders.

A.2.2 The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not authorised the Respondent to make any use of the Complainant's trade mark, nor is the Respondent commonly known by the disputed domain name.

The Complainant further submits that the disputed domain name resolves to a parked page comprising PPC commercial links, and such use - Internet traffic monetisation business - is neither bona fide nor legitimate non-commercial or fair use.

The Complainant also alludes to the past WIPO decision to further evidence the Respondent's lack of rights or legitimate interests in connection with the disputed domain name.

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain name.

**A.2.3 The Respondent registered and is using the disputed domain name in bad faith**

**Registration**

The Complainant submits that the trade mark BURBERRY long predates the registration of the disputed domain name, and that the Complainant's worldwide reputation in the sector of luxury fashion makes it reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trade mark. The past WIPO decision has sided with this rationale.

In addition, the Complainant relies upon paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0, according to which panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trade mark by an unaffiliated entity can itself create a presumption of bad faith.

**Use**

Under this UDRP Policy ground, the Complainant submits that the Respondent has used the disputed domain name in bad faith in so far as the Respondent offers the disputed domain name for sale in excess of the initial registration costs (namely, GBP 3,500). The Respondent's offer to sell the disputed domain name in excess of out-of-pocket costs may evidence bad faith under paragraph 4(b)(i) of the UDRP Policy. The past WIPO decision has found the then asking price of EUR 3,000 to be in excess of the actual costs directly related to the disputed domain name.

The Complainant further submits that the use of the disputed domain name evidences the Respondent's underlying intention to capitalise on the reputation of the trade mark BURBERRY by diverting Internet users seeking BURBERRY products to the Respondent's website, for financial gain, by intentionally creating a likelihood of confusion with the trade mark BURBERRY as to the source, sponsorship, affiliation, or endorsements of the Respondent's website and/or the goods offered through the Respondent's website (paragraph 4(b)(iv) of the UDRP Policy).

As additional factor giving rise to a presumption of bad faith, the Complainant refers to the Respondent's use of a privacy shield.

The Complainant therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith.

**B. Respondent**

The Respondent has defaulted in this UDRP administrative proceeding and, consequently, it has failed to advance any substantive case on the merits.

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RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP Policy).

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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 UDRP Policy).

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BAD FAITH

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

PROCEDURAL FACTORS

1. Complainant's Language Request

The Panel is given discretion under Rule 11 of the UDRP Rules to determine the appropriate language of the UDRP administrative proceeding. The Panel notes Rule 10 of the UDRP Rules, which vests the Panel with authority to conduct the proceedings in a manner it deems appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

With regard to this particular matter, the Panel takes the liberty to adopt the Writera test (applied in CAC Case no. 104144, Writera Limited v. alexander ershov), which helpfully sets out the following six guiding factors:

(i) **the language of the domain name string**: the Panel considers that English words are the only identifiable language in the disputed domain name string;

(ii) **the content of the Respondent's website**: the Respondent's website contains PPC links and a written notice in English only;

(iii) **the language(s) of the Parties**: the Complainant is incorporated in England and the Respondent appears to be an individual/entity resident or incorporated in China. The English language would therefore not be considered a common language for both Parties. Nevertheless, the Respondent's e-mail address on record [chinadns@***], particularly the abbreviation 'dns' for 'domain name system' points towards the Respondent's knowledge of, or interest in communicating in, English;

(iv) **the Respondent's behaviour**: the Panel notes that the Respondent has shown no inclination to participate in this UDRP administrative proceeding;

(v) **the Panel's overall concern with due process**: the Panel has discharged its duty under Rule 10 (c) of the UDRP Rules; and

(vi) **the balance of convenience**: while determining the language of the UDRP administrative proceeding, the Panel has a duty to consider who would suffer the greatest inconvenience as a result of the Panel's determination. On the one hand, the determination of English as the language of this UDRP administrative proceeding – a widely spoken language – is unlikely to cause the Respondent any inconvenience, not least given the above circumstances. The determination of Chinese as the language of this UDRP administrative proceeding, on the other hand, is very likely to cause the Complainant inconvenience, and to interfere with the overall due expedition of the proceedings under the UDRP Rules.

In view of the above factors, the Panel has decided to accept the Complainant's language request, such that the decision in the present matter will be rendered in English.

2. Miscellaneous

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

A. Deference to past UDRP decisions

The Panel notes that the disputed domain name was subject to a past WIPO decision, which resulted in the Complainant prevailing and the disputed domain name being transferred to the Complainant.

Understandably, the Complainant has made several references to the past WIPO decision in the Complaint to elucidate and strengthen the Complainant's position across the UDRP Policy grounds.

Notwithstanding the above, the Panel is mindful that the determination of the past WIPO decision has no binding effect and therefore no precedential value to the present factual and legal matrices. The Panel however recognises that the finding in past WIPO decision has a material impact on the assessment of the UDRP threshold in the present dispute.

B. UDRP Threshold

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint based on the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy sets out the grounds which the Complainant must establish to succeed:

> i. The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
>
> 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 are being used in bad faith.

It is incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP administrative proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three UDRP Policy grounds in turn.

C. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has UDRP-relevant rights in the registered trade mark BURBERRY since at least 2000.

The disputed domain name <burberrybeauty> was registered in May 2021 and contains the Complainant's trade mark BURBERRY in its entirety, together with the generic word 'beauty'. The additional word 'beauty' has no material impact on the recognisability of the Complainant's trade mark in the disputed domain name string.

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

D. Rights or Legitimate Interests

The Respondent has defaulted in this UDRP administrative proceeding, and the Panel is empowered to draw adverse inferences therefrom (Rule 14 (b) of the UDRP Rules).

The Panel notes that the Complainant firmly denies any affiliation and/or association with the Respondent of any nature. Moreover, the Complainant argues that the Respondent is not known by the disputed domain name; and that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.

The Respondent has submitted no evidence to refute any of the Complainant's assertions.

In addition, the Panel has taken note of paragraph 2.9 of the WIPO Jurisprudential Overview 3.0, according to which UDRP panels have found that the use of a domain name to host a parked page containing PPC links does not represent a bona fide offering where such links compete with, or capitalise on, the reputation and goodwill of the complainant’s trade mark or otherwise mislead Internet users. The Panel notes that the case circumstances mirror the above scenario.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

E. Registered and Used in Bad Faith

Registration

The following facts are compelling evidence to this Panel that the disputed domain name was registered in bad faith:

• The Complainant has trade marks rights since as early as 2000 in China, where the Respondent appears to be based;

• The Complainant operates its activities through the domain name <burberry.com>, which was registered in 1997;

• The disputed domain name <burberrybeauty.com> was registered in May 2021; and

• UDRP panels have consistently found that the registration of a domain name which consists of a widely-known trade mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant’s area of activity or natural zone of expansion, can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant’s trade mark is widely-known in its market field.

Use

The Complainant has adduced evidence to demonstrate that the disputed domain name had been offered for sale for a total price of GBP 3,500, which may evidence bad faith under paragraph 4(b)(i) of the UDRP Policy.

The Complainant further refers to the Respondent as being engaged in the conduct described in paragraph 4(b)(iv) of the UDRP Policy.

As mentioned earlier, the disputed domain name presently resolves to a parked page featuring PPC advertisements for goods and services related to the Complainant's business sector, as well as a notice which reads as follows:

> "Buy this domain
>
> The owner of burberrybeauty.com is offering it for sale for an asking price of 3500 GBP!"

The Panel has considered in tandem paragraphs 3.1.1 and 3.1.4 of the WIPO Jurisprudential Overview 3.0, according to which panels have found various types of evidence to support a finding under the above circumstances, most compellingly in the present matter: (i) the Respondent's likely knowledge of the Complainant's rights; (ii) the distinctiveness of the Complainant's trade mark; (iii) the risk of actual confusion between the disputed domain name and the Complainant's trade mark; (iv) the lack of the Respondent's own rights to, or legitimate interests in, the disputed domain name; (v) the failure of the Respondent to present a credible-backed rationale for registering the disputed domain name; and (vi) the absence of any conceivable good faith use of the disputed domain name.

F. Decision

For the foregoing reasons, in accordance with paragraph 4(a) of the UDRP Policy and Rule 15 of the UDRP Rules, the Panel orders that the disputed domain name <burberrybeauty.com> be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BurberryBeauty.com**: Transferred

## PANELLISTS

| Name | **Yana Zhou** |
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DATE OF PANEL DECISION 2024-08-07

Publish the Decision