Decision for dispute CAC-UDRP-108114

Case number	CAC-UDRP-108114
Time of filing	2025-11-18 13:35:35
Domain names	burberry-cqq.shop, burberry-outlet.shop, burberry-outlets.shop, burberry-us.shop, us-burberry-cqm.shop, us-burberry.shop, burberry-vip.top

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Burberry Limited

Complainant representative

Organization	Coöperatie SNB-REACT U.A.

Respondents

Name	chen qihui
Name	deng deng

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 owns an international portfolio of registered trademarks including the following:
- UKTM no. 405317 registered on 18 June 1920, in classes 24 and 25.
- UKTM no. 1428264 registered on 29 November 1991, in classes 14, 18 and 25.
- UKTM no. 2225986 registered on 25 August 2000, in classes 3, 18, and 25.
- UKTM no. 2299458 registered on 4 October 2002, in classes 9 and 14.
- EUTM no. 1058312 registered on 27 March 2000, in classes 3, 18 and 25.
- EUTM no. 2680460 registered on 31 July 2003, in classes 9, 14 and 16.
- USTM no. 260843 registered on 27 August 1929, in classes 10, 25 and 26.
- USTM no. 1133122 registered on 15 April 1980, in class 18.
- USTM no. 3879249 registered on 23 November 2010, in class 25.
- USTM no. 2624684 registered on 24 September 2022, in class 35.

The Complainant has also registered the Burberry.com domain name, on 17 January 1997 and the Complainant operates e-commerce websites in over 27 countries.

Panels in the following cases have found the Complainant’s mark is well-known or famous.

a. WIPO Case No. D2005-1114 <burberrybluelabel.com> “The Panel finds that the trademark BURBERRY is a unique and well-known trademark on a worldwide level (…)”
b. WIPO Case D2006-0186 <e-burberry.com>, “the Complainant’s trademark, BURBERRY, has become internationally famous.”
c. WIPO Case No. D2006-1076 <burberryapparel.com>: “BURBERRY” is a well-known and distinctive designation that is entitled to a strong level of protection” (cited in WIPO Case C2011-0132 (<BurberryWatchesStore.com>).
d. WIPO Case No. D2010-1304 <BurberryBeauty.com>: “[…] the trademark is highly recognizable and famous, as in the instant case. In fact, Complainant has provided sufficient evidence that the trademark BURBERRY is well known.”
e. CAC- Case No. 104567 < com>, < berberry.com> “ […] In consideration of the reputation achieved by "BURBERRY" it is clear that the Respondent was surely aware of the Complainant’s trademark when he registered the domain names..”

FACTUAL BACKGROUND

The Complainant is Burberry Limited, established in 1856 in England. It is a global luxury brand involved in the design, manufacture, advertising, distribution and sale of high-quality apparel, bags, scarves, cosmetics, perfumes, glasses, and other accessories. Since 1856, Complainant has continuously used the BURBERRY word mark in connection with its products and services. Currently, the Complainant operates over 400 retail, outlet and concession locations around the world. Its merchandise is also sold in department stores, boutiques, and online at Burberry.com, and in other authorized retail establishments. Burberry has spent substantial time, effort and money advertising, promoting and protecting its various trademarks, including the BURBERRY word mark. As a result, the BURBERRY word mark has become internationally famous and has acquired a very valuable goodwill. It is considered one of the most valuable fashion brands worldwide. In the 2024 Fiscal Year, the Complainant’s revenue was £2,461 million as outlined in the Burberry Fiscal Year 2024/25 Annual Report.

The seven disputed domain names are:
burberry-cqq.shop, burberry-outlet.shop, burberry-outlets.shop, burberry-us.shop, us-burberry.shop, us-burberry-cqm.shop, and burberry-vip.top.

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 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).

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).

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 Policy).

PROCEDURAL FACTORS

Consolidation

The Panel accepts the request for consolidation. Although two nominal registrants are listed, the evidence shows strong indicia of common control:
(i) similar domain name patterns incorporating the BURBERRY mark with generic or geographic terms;
(ii) registration through the same registrar;

(iii) registrations within a short time frame;
(iv) highly similar website content and commercial purpose;
(v) similar registrant data patterns and contact details.

Applying established UDRP principles, including CAC Case 103259 (joyaspandora.net), the Panel finds it more likely than not that the disputed domain names are subject to common control. Consolidation is therefore procedurally efficient and fair.

The Panel also accepts the request for the proceedings and the decision to be provided in English as this is provided for in the Registrar's Agreement.

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

Under paragraph 4(a) of the UDRP (the Policy), the Complainant must demonstrate:
"4. Mandatory Administrative Proceeding... a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that:
(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
(ii) you have no rights or legitimate interests in respect of the domain name; and
(iii) your domain name has been registered and is being used in bad faith.
In the administrative proceeding, the complainant must prove that each of these three elements are present(emphasis added)."...
The Policy does not provide for a default decision and the Complainant must discharge its burden of proof on all limbs of the Policy.

3.1 Identical or Confusingly Similar

Each disputed domain name incorporates the BURBERRY trademark in its entirety with
the addition of generic and descriptive terms such as "outlet," "shop" and "vip."
The Panel finds the disputed domain names are confusingly similar to the word mark for the first limb of the Policy, the similarity analysis, as they all contain and indeed start with the full word mark of the Complainant, combined with endings that are generic/descriptive terms. Most have a .shop ending. It is established under the Policy that the addition of generic terms to a trade mark will not prevent a finding of confusing similarity. Further, for this limb of the Policy, the suffix is not relevant.

The Panel finds the first element of the Policy satisfied.

3.2 Rights or Legitimate Interests

This case is really about the second limb of the Policy. Is the Respondent a genuine reseller making fair and legitimate use? This is an issue that arises even on the face of the case.
The Policy provides on this limb:

"c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint..... Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):
(i) 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; or
(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.
However, Paragraph 4(c) is not exhaustive and includes the language, "[a]ny of the following circumstances, in particular but without limitation…"

It is well established that there is a shifting evidential burden under this limb. 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. See WIPO Case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd.

Past panels have held that a respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name. See the Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group. The Respondents, Chen Gihui and Deng Deng, are not known by the disputed domain names in the WHOIS. The Respondent is not connected to nor affiliated with the Complainant and has not received any license or consent to use the marks.

It is highly likely these are grey goods or genuine goods –technically second-hand goods as sold once at wholesale --and that they are genuine and that this is reseller case. However, no trade mark owner has the unlimited right to monopolize all of the resales of second hand or previously lawfully sold goods. This is the limit to and/or exhaustion of the rights of a trade mark owner. This balances the rights of owners against those of retailers, second hand dealers and consumers and distributors. The rule also protects descriptive uses necessary to indicate the kind, quality or purpose of goods, provided the use is exercised in accordance with honest practices — which encompasses a duty to act fairly in relation to the legitimate interests of the trade mark owner. This is called in US trade mark law, nominative fair use. That use is descriptive and nominative—calling something by its name in order to identify it. It is not trade mark use as such –provided that it is fair and respects the legitimate interests of the trade mark owner.

The WIPO Overview 3.0, section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner: “Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. As outlined in the “Oki Data test”, the cumulative requirements will be applied in the specific conditions of a UDRP case.

This is from the OKI DATA principles in WIPO Case No.D2001-0903 which provide that a reseller/distributor can make a bona fide offering of goods and services under rule 4(c) (i) of the Policy and have a legitimate interest in a domain name, provided that: (a) The use involves the actual offering of goods and services in issue; (b) The site sells only the trade - marked goods; (c) The site accurately and prominently discloses the registrant's relationship with the trade mark holder; (d) The Respondent must not try to "corner the market" in domain names that reflect the trademark.

According to the Complainant the Respondent fails to comply with these as the Respondent is not an authorized retailer of the Complainants. But that is not the test. It applies to unofficial as well as official resellers. It is well established in UDRP jurisprudence, that the OKI DATA rule applies to unauthorized or unofficial resellers and repairers just as it does to official agents, per WIPO Case D2001- 1292 (Volvo Trademark Holdings AB) (OKI DATA principles apply as long as he operates a business genuinely revolving around the owners’ goods and services) and WIPO Case D2007 -1524 (nascartours) (OKI DATA applies to authorized and unauthorized sellers). See also Bettinger, 2nd Ed. P1387 IIIE.310.

This test is highly fact sensitive and the criteria must be applied in a sensible way. So applying the factors here: the Respondent is actually offering the goods at issue; the Respondent does use the site to sell only the trademarked goods or services; however the site does not appear from what was placed in evidence to accurately and prominently discloses that it is a reseller. However, we were not provided with the whole contents of the site and we do not have the About Us or Contact Us and other pages so it is not possible to be certain.
There is also no evidence in the proceeding to suggest the goods sold are not genuine and there was no test purchase. We will proceed on the basis that they are selling genuine goods under the trade name of those goods. There is no evidence that consumers placed orders that were not delivered either.

The Panel has viewed the screenshots of the website to which the disputed domain names resolve provided in evidence. But the site itself has been taken down and there is no capture on the Internet Archive and we were not provided with the whole contents of the site and we do not have the About Us or Contact Us and other pages so it is not possible to be certain. The Panel notes that the term “outlet” arguably signals that it is not the brand or entity and an outlet will usually sell discounted and last season’s goods and is a third party offering selling genuine branded goods. The Panel notes that the email addresses shown on some of the sites webpages include: onlinevip@higlobalhelp.com and service@snapneuro.com . That does not suggest or indicate a misrepresentation that it is official.

However, applying the Oki Data test the Panel finds that the Respondent appears to fail to meet the cumulative conditions for bona fide reseller use. In particular: The website prominently displays the BURBERRY name and logo mark and has a Copyright notice that suggests rights or ownership/officialdom or affiliation and there is no clear and prominent disclaimer of the lack of any other relationship to or with the Complainant. So the overall presentation suggests an official site or endorsement. The average internet user is savvy enough to understand when it is a third party retailer selling a discounted or last season’s range of genuine goods and they are not often confused.
However the site here is confusing and it does cross the line. The Panel finds that the OKI DATA criteria are not met mainly due to factor (c). In this case it is not clear to the public that the Respondent is a reseller and not the Complainant so the Complainant has made out the second limb and the Respondent has not come forward to answer.

3.3. Bad Faith Registration and Use

Under Paragraph 4(b) of the Policy, the following can evidence Bad Faith: “(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or (ii) you have 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 you have engaged in a pattern of such conduct; or (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.”

The combined use of: (i) the BURBERRY mark in the disputed domain names, (ii) the BURBERRY logo on the websites, (iii) the copyright notices, and (iv) the absence of clear full and fair disclosure of any reseller's independent status, together creates a likelihood of confusion as to source, sponsorship, or affiliation, contrary to paragraph 4(b)(iv) of the Policy. This cannot be saved by the use of the words "outlet" or "shop" and the email addresses and this limb follows the findings on the second limb of the Policy. Here there is no legitimate and fair use, and as is often the case, the registration and use is also in Bad Faith. No finding is made on the issue of a pattern of conduct.

The Panel finds that the disputed domain names were 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. **burberry-cqq.shop**: Transferred
2. **burberry-outlet.shop**: Transferred
3. **burberry-outlets.shop**: Transferred
4. **burberry-us.shop**: Transferred
5. **us-burberry-cqm.shop**: Transferred
6. **us-burberry.shop**: Transferred
7. **burberry-vip.top**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2025-12-18

Publish the Decision