



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2201625
Complainant:	WEBSTER USA INC.
Respondent:	Yu Hao Huo
Disputed Domain Name(s):	<thewebstershop.com>

1. The Parties and Contested Domain Name

The Complainant is WEBSTER USA INC., of 1220 Collins Avenue, Miami Beach, FL 33139, USA.

The Respondent is Yu Hao Huo, of Shenzhen, Guangdong, CN.

The domain name at issue is <thewebstershop.com>, registered by Respondent with GoDaddy.com, LLC, of Scottsdale, AZ, United States.

2. Procedural History

Complainant submitted a Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“Centre”) electronically on May 30, 2022; the Centre confirmed the receipt of the Complaint on May 30, 2022.

On May 30, 2022, the Centre served an email to the Registrar to confirm the WHOIS information. On June 2, 2022, the Registrar confirmed by email to the Centre that the disputed domain name was registered with the Registrar. The current Registrant of the disputed domain name is Yu Hao Huo. The Registrar has verified that Respondent is bound by its registration agreement which is in the English language, and has thereby agreed to resolve domain disputes brought by third parties following ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”).

On June 2, 2022, the Centre notified the Complainant with the WHOIS information of the Disputed Domain Name and the Language of Registration Agreement being English and requested the Complainant to revise the Complaint on or before June 7, 2022. On June 2, 2022, the Centre invited Complainant to substantiate its arguments on the language of proceedings by June 7, 2022. On June 2, 2022, the Complainant submitted the amended Complaint. On June 6, 2022, the Complainant

submitted the Complaint in English, per the Registration Agreement. On June 6, 2022, the Centre confirmed that the Complaint is in administrative compliance with the Policy and its Rules.

On June 6, 2022, the Centre served the Complaint and all Annexes, setting a deadline of June 26, 2022, by which Respondent could file a Response to the Complaint via email.

On June 27, 2022, the Centre confirmed no Response was received within the deadline.

On June 29, 2022, according to Complainant's request to have the dispute decided by a single-member Panel, the Centre served a panelist appointment notice to Mr. Rodolfo Carlos Rivas Rea.

On the same day, having declared no conflict of interests between the parties, Mr. Rivas Rea is appointed as the Panelist. The Panelist shall render a decision on or before July 12, 2022.

3. Factual background

A. Complainant

The Complainant established “The Webster” shop in South Beach, Miami, United States, in June 2009, selling international fashion clothing. The Complainant has expanded to other locations in Bal Harbour, Houston, Costa Mesa, New York City, Los Angeles, Montecito, Sawgrass Mills in the US, and Toronto in Canada.

Starting in 2015, the Complainant began running an e-commerce platform for a variety of consumer products under 400 different brand names from cosmetics, designer handbags & clothing via the domain name <thewebster.us> along with its expanding physical shops.

The disputed domain name was registered on December 24, 2021.

The Complainant owns the following trademarks:

- a. EU Trade Mark Registration No. 013414991 “THE WEBSTER & device” registered on October 9, 2015, in classes 3, 14, 18, 25, 35, 43.
- b. US Trade Mark Registration No. 6383460 “THE WEBSTER” registered on June 15, 2021, in class 35.
- c. US Trade Mark Registration No. 6414148 “THE WEBSTER” registered on July 13, 2021, in Classes 35.
- d. Chinese Trade Mark Registration No. 48585176 “THE WEBSTER” registered on September 28, 2021, in Class 35.
- e. Chinese Trade Mark Registration No. 48571258 “THE WEBSTER” registered on August 28, 2021, in Class 35.

B. Respondent

The Respondent is an individual in Shenzhen, Guangdong, CN.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is confusingly similar to the Complainant's trade marks and names "Webster" and/or "the Webster". The word "shop" should be disregarded as it is merely descriptive and indistinctive in nature. The public will be misconceived and misled into believing that the services provided on the website originate from the Complainant.
- ii. The Respondent has not asserted any purported legitimate interest. According to a Complainant's search on the trademark register in the US, EU, China, and Hong Kong, there is no registration or pending application for trademarks bearing "WEBSTER" as of the date of the submission of the Complainant.
- iii. The Respondent's registration of the disputed domain name appears to have been intended to exploit the Complainant's "WEBSTER" and "THE WEBSTER" trademarks and/or business names rather than using it in a bona fide offering of goods and/or services and/or a legitimate non-commercial use without intent for commercial gain.
- iv. The Complainant or its associated companies all over the world have not licensed or otherwise permitted the Respondent to register the disputed domain name incorporating the trademark "WEBSTER", and there is no affiliation between the parties. Therefore, the Respondent is not an authorized agent or licensee of the Complainant's products and/or services in any way.
- v. The Respondent would not have registered the disputed domain name had he or she conducted a proper trademark search before registering it.
- vi. Owing to the renowned reputation arising from the long and extensive use of "WEBSTER" and "THE WEBSTER" marks and business names for fashion clothing and cosmetic products by the Complainant, the Respondent must have deliberately selected and registered the disputed domain name in bad faith/without justification.

B. Respondent

The Respondent did not file an administratively compliant Response during the required period.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, in Paragraph 4(a), that each of three findings must be made for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

A) Procedural Matters

According to paragraph 11(a) of the Rules, 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. The Registration Agreement is in English. The Amended Complaint was filed in English on June 6, 2022.

B) Identical / Confusingly Similar

The Panel is satisfied that the Complainant has shown it owns rights in the trademark "THE WEBSTER" trademark, with various registrations, with evidence provided dating the earliest trademark registration back to October 2015.

Turning to analyze if there is a confusing similarity between the disputed domain name and the trademark, the Panel notes, based on the record at hand, that the disputed domain name reproduces the trademark in its totality, namely "THE WEBSTER", with one exception. This exception is the addition of "SHOP". The generic term "SHOP" is not enough to dispel the confusing similarity between the disputed domain name and the Complainant's trademarks.

This addition may add to the confusing similarity; however, further analysis of this fact pattern is more appropriate under the second and third elements of the UDRP Policy set out below. For what concerns the first element, the minor differences consisting of the addition of the generic term "SHOP" prove insubstantial enough to eliminate the confusing similarity between the disputed domain name and the Complainant's trademarks.

Consequently, the Panel determines that the Complaint has satisfied the Policy's first element set under paragraph 4(a)(i).

C) Rights and Legitimate Interests

Based on the evidence on record and acknowledging that the Respondent failed to produce any allegations or evidence necessary to demonstrate its

rights or legitimate interests in the disputed domain name, the Panel must turn to the uncontested facts.

The uncontended indicate that a) the Respondent is not affiliated with the Complainant; b) the Respondent has no license or authorization to use the trademarks; c) the Respondent is not authorized to carry out any activity for the Complainant and has no business dealings with the Complainant and d) the Respondent is not commonly known by the disputed domain name.

In failing to respond to the Complainant's contentions, the Respondent has not rebutted the *prima facie* case, as described in paragraph 2.1 of WIPO 3.0 Overview.

In failing to do so, the Panel draws adverse inferences from this failure, where appropriate, per the Rules, paragraph 14(b).

In addition to this, the Respondent's use of the trademark plus the use of a generic term, namely "SHOP", seems to indicate that the Respondent likely was aware of the Complainant and targeted the Complainant to benefit from the association with the Complainant and confuse Internet users as to the source of sponsorship. A practice like this can never be considered a bona fide offering under the Policy.

This conclusion arises from the combination of all facts and evidence on the table, which on their own perhaps would not amount to a definitive conclusion, but in conjunction paint a persuasive picture, which the Respondent has not refuted. Therefore, on the balance of probabilities, the Panel is led to conclude that the Respondent did not have rights or legitimate interests in the disputed domain name.

Consequently, the Panel determines that the Respondent has no rights or legitimate interests in the disputed domain name. Subsequently, the Complainant has fulfilled the second requirement set under paragraph 4(a)(ii) of the Policy.

D) Bad Faith

In determining the third element, it is important to look at the evidence at hand and make inferences, if not with absolute certainty, at least on the balance of probabilities. In doing so, the Panel finds that it is very likely the Respondent was aware of the Complainant and had the Complainant's trademark in mind when registering the disputed domain name. This conclusion is possible since the trademark "THE WEBSTER" is included in its entirety in the disputed domain name. If we were talking about a disputed domain name with only part of the trademark, namely "WEBSTER", it would be a big jump to arrive at that conclusion. But in this case, the combination of "THE" plus "WEBSTER" makes it a plausible conclusion.

In addition, the Complainant provides evidence of sales through dozens of orders from various parts of China, the Respondent's location, from April 2021 to July 2021, which is five months before the disputed domain name's registration. This, if anything, shows that the Respondent could have been likely aware of the Complainant's trademark. As per the analysis above, the Respondent likely targeted the Complainant by registering the disputed domain name.

Without the benefit of an explanation from the Respondent, the Panel is left with no choice but to rely on the preceding analysis, on the balance of probability. Therefore, the Panel concludes that the most likely intention of the Respondent was to intentionally attempt to attract, for commercial gain, Internet users to its website/disputed domain name, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and/or disputed domain name, as per illustrated under paragraph 3.1 of WIPO 3.0 Overview.

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

6. Decision

For the preceding reasons and in concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the Disputed Domain Name to the Complainant.



Rodolfo Carlos Rivas Rea
Panelist

Dated: July 6, 2022