



Asian Domain Name Dispute Resolution Centre
hongkong

(Kuala Lumpur Office)

ADMINISTRATIVE PANEL DECISION

Case No.	AIAC/ADNDRC-1314-2024
Complainant:	Brooks Brothers Retail Malaysia Sdn Bhd
Respondent:	Web Commerce Communications Limited
Disputed Domain Name(s):	<brooksbrothersmalaysia.com>

1. The Parties and Contested Domain Name

The Complainant is Brooks Brothers Retail Malaysia Sdn Bhd of 12th Floor, Menara Symphony, No. 5, Jalan Professor Khoo Kay Kim, Seksyen 13, 46200 Petaling Jaya, Selangor Darul Ehsan, Malaysia.

The Respondent is Web Commerce Communications Limited of Bukit Jalil, Kuala Lumpur, Malaysia.

The domain name at issue is <brooksbrothersmalaysia.com> (“the Domain Name”), registered by the Respondent with Alibaba.com Singapore E-Commerce Private Limited of 51 Bras Basah Road #04-08 Lazada One Singapore, 189554 Singapore (“Registrar”)

2. Procedural History

On May 6, 2024, the Complainant filed a Complaint with the Kuala Lumpur Office of the Asian Domain Name Dispute Resolution Centre (“ADNDRC”), pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on 24 October 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”), approved by ICANN Board of Directors on 28 September 2013 and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“Supplemental Rules”) effective from 31 July 2015. The Complainant chose to have a sole panelist to handle the dispute.

On 21 May 2024, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On 11 June, the Registrar transmitted by email to the ADNDRC its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The ADNDRC formally notified the Respondent of the Complaint and the proceedings commenced on 11 June 2024. The ADNDRC did not receive any formal response from the Respondent within 20 calendar days as required under paragraph 5 of the Rules.

Accordingly, on 5 July 2024, the ADNDRC informed the parties that no response has been received.

On the same day, the ADNDRC appointed Ms. Karen Fong as sole Panelist in this matter. The Panelist accepted the appointment and has submitted a statement to the ADNDRC that she is able to act independently and impartially between the parties.

3. Factual background

The Complainant is part of a group of companies which has an exclusive licence to use the trade marks BROOKS BROTHERS IN China, Hong Kong, Taiwan, Macau, Singapore and Malaysia. The BROOKS BROTHERS trade marks are owned by the successors in title of the Brooks Brothers Group, Inc., a company in the fashion, beauty and accessories industry. With a legacy dating back to its establishment in 1818 as a traditional men's clothier in the United States, the company has expanded globally making its goods and services accessible to consumers in numerous countries including Malaysia. There are currently four branches of Brooks Brother's stores in Malaysia. In addition to retail outlets, the BROOKS BROTHERS goods and services are available to purchase through its official website at www.brooksbrothers.com ("Official Website").

The BROOKS BROTHERS trade marks are registered in many countries worldwide. The following are some of the trade marks for which the Complainant has a licence:

- Malaysia Trade Mark Registration No. 94004469 for BROOKS BROTHERS registered on 6 June 1994;
- Malaysia Trade Mark Registration No. 2011051353 for BROOKS BROTHERS registered on 26 May 2011;
- Malaysia Trade Mark Registration No. 2011051735 for BROOKS BROTHERS registered on 21 June 2011;

(individually and collectively, the "Trade Mark").

The Respondent registered the Domain Name on 5 September 2023. The Domain Name resolved to a website which displays the Trade Mark prominently, mimics the Complainant's own website including using images from the Official website and purportedly offers for sale merchandise that bears the Trade Mark at discounted or "sale" prices and purports to be the Complainant's licensed products (the "Website"). It is likely that these products are unauthorised or counterfeit products. The Website is currently inactive.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

The Domain Name is identical or confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the Domain Name, and that the Domain Name has been registered and is being used in bad faith. The Complainant requests cancellation of the Domain Name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

5. Findings

A. General

The Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

B. Procedural Matter

The Complainant states in the Complaint that the disputed domain name in these proceedings is <www.brooksbrothersmalaysia.com>. This has been incorrectly set out as domain names do not include the www. before the second level domain. The Whois results submitted in evidence is for the domain name <brooksbrothersmalaysia.com> and the Website content submitted in evidence is also for the domain name <brooksbrothersmalaysia.com>. Further the Registrar's verification response is for the domain name <brooksbrothersmalaysia.com>. The Panel finds that the Complaint filed is in relation to <brooksbrothersmalaysia.com> and the Panel is therefore referring to the Domain Name as <brooksbrothersmalaysia.com>.

C. Identical / Confusingly Similar

The Panel is satisfied that the Complainant has established that it has rights to the Trade Mark.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trade mark and the domain name to determine whether the domain name is confusingly similar to the trade mark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the domain name.

In this case the Domain Name contains the Trade Mark in its entirety plus the geographical term "Malaysia". The addition of this term does not prevent a finding of confusing similarity. For the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain ("gTLD"), which in this case is ".com", since it is viewed as a standard registration requirement (section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0")).

The Panel finds that the Domain Name is confusingly similar to trade marks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

D. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's 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) the respondent has been commonly known by the domain name, even if it has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trade mark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with some allegations of evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

Moreover, the nature of the Domain Name is inherently misleading as it effectively impersonates or suggests sponsorship or endorsement by the Complainant (WIPO Overview 3.0, section 2.5.1).

The Panel finds that the Complainant has made out a prima facie case, a case calling for an answer from the Respondent. The Respondent has not provided any reasons why it chose to register the Domain Name comprising a trade mark with which it has no connection. The Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the Domain Name.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name. In all the circumstances, the Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

E. Registered and Used in Bad Faith

To succeed under the Policy, the Complainant must show that the Domain Name has been registered and is being used in bad faith.

The Panel is satisfied that the Respondent must have been aware of the Complainant's trade mark when it registered the Domain Name. It is implausible that it was unaware of the Complainant when it registered the Domain Name especially since the Website

displays the Trade Mark and images from the Official Website, and the products offered for sale appear to be licensed BROOKS BROTHERS products.

In the WIPO Overview 3.0, section 3.2.2 states as follows:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.”

The above together with the fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the Domain Name are also significant factors to consider. The Panel finds that the Respondent’s registration is in bad faith.

The Panel also finds that the actual use of the Domain Name is in bad faith. The products offered for sale on the Website are likely to be counterfeit and/or unauthorised BROOKS BROTHERS products considering the products sold on the Website are heavily discounted, the difference in prices from genuine products and the fact that there is no relationship between the Parties.

The use by a respondent of a domain name which includes a well-known trade mark to resolve to a website which offers and sells counterfeit products under that trade mark may be evidence of bad faith registration and use. (See *Burberry Limited v Jonathan Schefren*, WIPO Case No. D2008-1546 and *Prada SA v. Domains for Life*, WIPO Case No. D2004-1019). There is a clear intention to attract for commercial gain by confusing and misleading Internet users into believing that the Website was and the products sold on it are authorised or endorsed by the Complainant. This is clearly bad faith under paragraph 4(b)(iv) of the Policy.

The fact that the Domain Name is now inactive does not prevent a finding of bad faith given that the distinctiveness and reputation of the Trade Mark, the composition of the Domain Name and the lack of a response from the Respondent. The Panel finds that the Domain Name was registered and is being used in bad faith.

6. Decision

For the foregoing reasons, and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <brooksbrothersmalaysia.com> be cancelled.



Karen Fong
Panelist

Dated: 23 July 2024