



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Burberry Limited v. Domain Admin

Case No. D2009-0703

1. The Parties

The Complainant is Burberry Limited of London, United Kingdom of Great Britain and Northern Ireland internally represented.

The Respondent is Domain Admin, of Tuvalu.

2. The Domain Name and Registrar

The disputed domain name <burberrygroup.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), which was adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, and approved on October 24, 1999, and also in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) as approved on October 24, 1999, and the World Intellectual Property Organization (“WIPO”) Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the “Supplemental Rules”).

The Complaint, with accompanying Annexes A-I, was filed with the WIPO Arbitration and Mediation Center (the “Center”) by email on May 28, 2009 and subsequently by hardcopy on June 3, 2009.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this

proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on May 29, 2009, the Center requested confirmation from the Registrar as to: whether the registrar received a copy of the Complaint from the Complainant, contact and registrant information set forth in the Complaint relative to the disputed domain name, and whether the name is indeed registered with the Registrar. The Center also requested the registrar to specify for the disputed domain name: (a) the dates on which the registration was made and will expire, (b) whether the Policy applies to that name, (c) the language of the registration agreement, and (d) whether the name will remain “locked” during the proceeding.

Subsequently, on May 29, 2009, the Registrar provided its response to the Center through which it specified name and contact information pertinent to the disputed domain name to the extent, as it then existed, in its WhoIs database. Further, the Registrar stated that: it had received a copy of the Complaint, the Respondent was listed as the registrant for the name and the name is registered with Dynadot, LLC. The Registrar’s response further indicated that: (a) the registration and expiration dates were July 30, 2008 and July 30, 2009, respectively, (b) the Policy applies to the name, (c) the registration agreement is in English, and (d) the name will remain locked during the proceeding.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On June 4, 2009, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its exhibits, by post or courier and also by email. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on June 4, 2009, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on June 24, 2009, to file its Response with the Center and the Complainant.

As of June 24, 2009, the Center had not received a formal Response to the Complaint from the Respondent; hence, the Center, in an email letter dated June 26, 2009, notified the Respondent of its default.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated July 8, 2009, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as sole Panel for this dispute. Subsequently, on the same date,

Mr. Michaelson accepted and returned, by email attachment to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated July 14, 2009, notified the Parties of the appointment of Mr. Michaelson as sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before July 28, 2009. Owing to unexpected time conflicts issues experienced by the Panel which constituted unforeseen circumstances, the Center, at the request of the Panel, subsequently notified the Parties that this due date had been extended to August 11, 2009.

This dispute concerns one domain name, specifically <burberrygroup.com>.

4. Factual Background

As indicated in the WhoIs registration records provided in Annex A to the Complaint, the disputed domain name was registered on July 30, 2008.

A. Complainant's BURBERRY Marks

The Complainant owns various United States of America and foreign trademark registrations for the mark BURRBERRY in block letters or a stylized pattern. The Complainant has provided, in Annex E to the Complaint, printouts of entries from the publicly available on-line TARR (Trademark Applications and Registration Retrieval) database provided by the United States Patent and Trademark Office for its United States of America marks. Pertinent details of some of those United States of America registrations are as follows:

1. BURBERRY (block letters)

United States registration 259,571; registered: August 6, 1929

This mark is registered for use in connection with "Piece goods - namely cloths, and stuffs of wool, worsted, or hair" in international class 24. The record indicates that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced at least as of December 31, 1910.

2. BURBERRY (block letters)

United States registration 260,843; registered: August 27, 1929

This mark is registered for use in connection with "Clothing - namely, coats and topcoats for men, women, and children; jackets for men, women and children; breeches for men and boys; suits for men and boys; riding habits for women and girls; waistcoats for men, women, and children; overalls for men, women, and children; skirts for outer wear for women, and children; capes for men, women, and children; hats and caps for men, women and children; bonnets, hoods, and toques for men, women and children; neckties for men, women and children; stockings and socks for men, women, and children; braces and suspenders for men, women, and children; belts for outer wear for men, women and

children; boots of rubber and fabric or combinations of these materials for men, women, and children; shoes and slippers of leather, rubber, and fabric or combinations of these materials for men, women, and children; gloves for men, women and children, of leather and fabric” in international class 25. The record indicates that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced at least as of December 31, 1910.

3. BURBERRY (stylized)

United States registration 510,077; registered: May 24, 1949

This mark is registered for use in connection with “Clothing - namely, coats and topcoats for men, women, and children; jackets for men, women and children; breeches for men and boys; suits for men and boys; waistcoats for men, women, and children; overalls for men, women, and children; skirts for outer wear for women, and children; capes for men, women, and children; hats and caps for men, women and children; helmets for men and women; bonnets, hoods, and toques for men, women and children; neckties for men, women and children; stockings and socks for men, women, and children; braces and suspenders for men, women, and children; belts for outer wear for men, women and children; boots for men, women, and children of leather and rubber or combinations of these materials; shoes and slippers for men, women, and children of leather, rubber and fabric or combinations of these materials; gloves for men, women and children, of leather and fabric” in international class 25. The record indicates that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced at least as of December 31, 1903.

4. BURBERRY (block letters)

United States registration 2,629,931; registered: October 8, 2002

This mark is registered for use in connection with “Non-mediated toilet preparations, namely, perfumes, eau de cologne, and toilet water, essential oils for personal use, cosmetic preparations for the teeth and for the hair, namely, toothpastes, shampoos, conditioners, hair sprays, hair gels, soaps for the body, shower gels and bath gels and bath foams; antiperspirants and deodorants; shaving preparations and pot pourri” in international class 3. This mark is based on the registrant’s underlying UK trademark registration 2225986 registered on August 25, 2000.

B. Complainant

The Complainant is a well-known global luxury brand company involved in the design, manufacture, advertising, distribution and sale of high-quality apparel, bags, scarves, cosmetics, perfumes, glasses, watches, and other accessories. Over the past 85 years, the Complainant has continuously and extensively used its BURBERRY Marks in connection with its products.

As of March 31, 2009, the Complainant operated 417 retail locations consisting of 119 BURBERRY stores, 253 concessions and 47 outlet stores, and 81 franchise stores throughout Europe, North America, Asia and the Middle East. The Complainant also sells its products to international wholesale customers including leading department

stores, specialty retailers and franchise partners. The Complainant also has numerous licensees operating under its control who sell the Complainant's marked products through specialized distribution channels. In that regard, the Complainant exercises direct control over the character and quality of the products and services associated with the BURBERRY Marks. In the fiscal year ending March 31, 2008, the total estimated global revenue for the Complainant was nearly UK £1 billion. As a result, the BURBERRY Marks have become distinctive of the Complainant's goods and are well-known, with considerable goodwill having arisen in those marks.

The Complainant's goods are advertised and sold on its own website located at <burberry.com> which directs users to specific pages based upon the Internet user's geographic location, i.e., United States, United Kingdom, Europe and the rest of the world. For example, the United States homepage (a copy of which appears in Annex F) enables Internet users to access information regarding the Complainant's goods, purchase any of those goods, learn more about the Complainant, and obtain the locations of its retail stores.

C. Respondent

Whenever an Internet user types the disputed domain name into his(her) Internet browser, (s)he is directed to the Respondent's webpage (a copy of which appears in Annex G to the Complaint) which presents a link that states: "This domain may be for sale by its owner". The webpage is a parking page with other links to third-party websites that sell a wide range of goods and services. Once a user clicks on the former link, that user is redirected to a website at "Sedo.com" which provides an auction site through which domain names can be bought and sold and is invited to submit a monetary offer of at least Euro 300, through that site, to purchase the disputed domain name. The corresponding page from the "Sedo.com" site (a copy of which appears in Annex H to the Complaint) expressly states: <burberrygroup.com> (BURBERRYGROUP.COM) is for sale

Seller's price expectation: 300 EUR

Offer Details

This domain name without content is available for sale by its owner through Sedo Marketplace. Submit your offer to the above."

5. Parties' Contentions

A. The Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark.

Specifically, the Complainant states that the name includes the Complainant's mark BURBERRY followed by a generic term "group". The latter not only fails to adequately distinguish the resulting name from the mark but, owing to the high degree of similarity existing between the name and the mark, actually exacerbates ensuing confusion of Internet users.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Respondent is not a licensee of the Complainant nor has the Complainant ever consented to the Respondent's use of the BURBERRY Marks.

Second, the Respondent has never been known by the disputed domain name, unlike the Complainant which has used its mark BURBERRY since 1856.

Third, the Respondent's use of the disputed domain name is not in connection with a *bona fide* offering of goods or services. Specifically, the name resolves to a parking page which states that the name is for sale by its owner and also contains links to third party websites that sell various goods and services.

Fourth, the Respondent is intentionally using the name to attract consumers who might be seeking the Complainant's products. The Respondent is profiting from the popularity and fame associated with the BURBERRY Marks and misleadingly diverting consumers to third-party websites. This results in tarnishing and diluting the BURBERRY Marks and on detrimentally effects the Complainant's online presence. Such use does not constitute a legitimate commercial use of the name.

(iii) Registered and Used in Bad Faith

Lastly, the Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Specifically, the Complainant alleges that the Respondent registered the name and its inclusion on the "Sedo.com" auction web site as being for sale reflects the Respondent's intent to sell it for a sum (at least Euro 300) in excess of the Respondent's costs of registration (allegedly USD 9.25), hence contravening paragraph 4(b)(i) of the Policy.

Further, given the Complainant's widespread and continuous use, dating back to 1856, and attendant fame of its mark BURBERRY, the use by the Respondent of that mark can not constitute anything but bad faith.

B. The Respondent

The Respondent failed to file any Response to the contentions raised in the Complaint.

6. Discussion and Findings

In view of the lack of a Response filed by the Respondent as permitted under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under

paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel may in its discretion decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's BURBERRY Marks.

From a simple comparison of the disputed domain name to the Complainant's mark BURBERRY, no doubt exists that the name is confusingly similar to the Complainant's marks.

The primary difference between the disputed domain name and the mark BURBERRY is the addition of the generic word "group" to form a separate corresponding composite term along with, secondarily, appending the gTLD (generic top level domain) ".com" to that term to form the name with the last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding short letter or number groups or even generic or highly descriptive words to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, adding such a word, that being "GROUP", in the manner which the Respondent specifically did, to the mark BURBERRY clearly resulted in such a minor variation. See, e.g., *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099 (April 20, 2009); *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008 (March 25, 2009); *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072 (September 4, 2008); *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505 (May 28, 2008); *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265 (May 5, 2008); *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878 (March 12, 2008); *Blackrock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627 (January 4, 2008); *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359 (November 14, 2007); *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. 791657 (November 13, 2006); *Google Inc. v. Jennifer Burns*, NAF Claim No. 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); *National Collegiate Athletic*

Association v. Dusty Brown, WIPO Case No. D2004-0491 (August 30, 2004); *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. 155896 (July 1, 2003); and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. 117876 (December 16, 2002).

Moreover, by including the word “group” with the Complainant’s mark BURBERRY to form the corresponding disputed domain name, the potential for user confusion is likely to be exacerbated, not reduced. By appending that word to the Complainant’s mark, such an Internet user would likely be deceived into thinking that the Respondent’s site and the products offered there through were somehow affiliated, related to or sponsored by the Complainant when, in fact, they are not. Thus, the Panel finds that that the disputed domain name here, which contains the word “group” along with the Complainant’s mark BURBERRY, tends to aggravate, rather than ameliorate, user confusion and does so to the Respondent’s ultimate benefit. See *Krispy Kreme, Dreamworks* and *MySpace*, cited *supra*.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s mark BURBERRY as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent were one made of the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize its mark BURBERRY in conjunction with any of the goods with which the Complainant uses that mark or for similar goods, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant’s mark BURBERRY or one confusingly similar thereto in connection with the identical or even similar goods to those currently provided by the Complainant, as recited in its any of its trademark registrations, may in circumstances as are present here violate the exclusive trademark rights now residing with the Complainant. See, e.g., *HRB Innovations Inc., Dreamworks, MySpace, Blackrock, F. Hoffmann-La Roche AG, National Football League, Toilets.com, Inc., and Associated Bank*, all cited *supra*; also *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823 (February 2, 2009); *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303 (May 7, 2007); *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Claim No. 97092 (June 4, 2001); *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. 95856 (December 18, 2000); and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000).

Consequently, in the Panel's view, the Respondent could not legitimately acquire any public association between it and either the mark BURBERRY or one similar thereto, at least for the goods rendered by the Complainant, in the manner so used here.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark BURBERRY. Nor could the Respondent in this case likely ever become commonly known by either the disputed domain name or the mark, in light of the Complainant's exclusive trademark rights, with its first use of its mark dating back to 1856 and the widespread reputation, notoriety and ultimately fame which the Complainant has gained in its mark during that time, without infringing on the exclusive trademark rights of the Complainant. See, e.g., *Starline Publications*, *HRB Innovations Inc.*, *MySpace* and *Treeforms, Inc.*, all cited *supra*.

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Lastly, the record is devoid of any evidence which would persuade the Panel that the Respondent has made or is making demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services prior to its having received notice of this dispute. Specifically, as indicated in the record, the name resolves to page through which the name is offered for sale through the "Sedo.com" auction site. Nor does such use constitute either a legitimate noncommercial or fair use of the name, without intent on the Respondent for commercial gain to misleadingly divert consumer or tarnish any of the Complainant's BURBERRY Marks. Consequently, the Respondent's conduct does not fall within paragraph 4(c)(i) or 4(c)(iii) of the Policy either.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Panel infers, from the lack of any Response, that the Respondent was well aware of the Complainant's mark BURBERRY when the former registered the domain name. Yet, in spite of that knowledge, the Respondent intentionally registered the name in an effort to exploit the Complainant's reputation and goodwill in that mark. The result of this is rather evident in the Respondent having placed the name for sale and then soliciting offers in excess of its costs of registration -obviously to gain some measure of profit from doing so.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy including specifically paragraph 4(b)(i) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name, <burberrygroup.com>, is ordered transferred to the Complainant.

Peter L. Michaelson
Sole Panelist

Dated: August 11, 2009