

## **ADMINISTRATIVE PANEL DECISION**

Debbie Morgan Macao Commercial Offshore Limited, Missguided Limited v.  
Samir Vora  
Case No. D2013-0737

### **1. The Parties**

The Complainants are Debbie Morgan Macao Commercial Offshore Limited of Macao, China and Missguided Limited of Manchester, United Kingdom of Great Britain and Northern Ireland, both represented by Mishcon de Reya, Solicitors, United Kingdom of Great Britain and Northern Ireland.

The Respondent is Samir Vora of Mumbai, Maharashtra, India, self-represented.

### **2. The Domain Names and Registrars**

The disputed domain names <missguidedasia.com>, <missguidedaustralia.com>, <missguidedbrazil.com>, <missguidedcanada.com>, <missguidedeurope.com>, and <missguidednewzealand.com> are registered with SafeNames Ltd. The disputed domain names <missguidedbritain.com> and <missguideduk.com> are registered with EuroDNS S.A.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 23, 2013.

On April 24, 2013, the Center transmitted by email to SafeNames Ltd. and EuroDNS S.A. (the "Registrars") a request for registrar verification in connection with the disputed domain names. On April 24 2013, the Registrar EuroDNS S.A. transmitted by email to the Center its verification response confirming that the Respondent Samir Vora is listed as the registrant for the disputed domain names <missguidedbritain.com> and <missguideduk.com> and providing corresponding contact details. On April 26 2013, the Registrar SafeNames Ltd. transmitted by email to the Center its verification response confirming the registrant for the remaining disputed domain names, and behind the Whois privacy protection, is Samir Vora and providing corresponding contact details. In response to a notification by the Center that the Complaint was administratively deficient, the Complainants filed an amended Complaint on May 2, 2013.

The Center verified that the Complaint together with the amended Complaint (collectively hereinafter the "Complaint") satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and that the proceedings commenced on May 6, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was May 26, 2013.

On May 17, 2013, the Center received an email communication from the Respondent requesting that the Center defer the present proceeding in light of the Respondent's pending trademark application (for the mark "Missguided") before the Australian Trademark Office and the Complainant's opposition of that application before the same office. The Center, through its email response of the same date to the Respondent, acknowledged receipt of this email communication. Through that response, the Center also informed the Respondent that the effect of this trademark dispute between the parties during the course of this UDRP proceeding and a determination of any appropriate procedural steps herein that may result are matters within the discretion of the Panel. The Center further informed the Respondent of the due date of its response (May 26, 2013) and, that should it file a substantive response, the Center would bring that response to the attention of the Panel.

The Respondent timely filed his Response with the Center on May 25, 2013.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on May 31, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Respondent registered the disputed domain names <missguideduk.com> and <missguidedbritain.com> with Registrar EuroDNS S.A. on August 21, 2012 and February 4, 2013, respectively. These registrations will expire on August 20, 2013 and February 3, 2014, respectively. As to the six remaining disputed domain names, the Respondent registered all those disputed domain names with the Registrar SafeNames Ltd. on May 24, 2012. Though all these six remaining registrations expired on May 24, 2013, the Respondent in its May 17th email communication to the Center acknowledged that it has renewed all of them. A copy of the Whois records for all the disputed domain names appears in Annex 1 to the Complaint.

##### **A. Complainants' MISSGUIDED Marks**

The Complainant, Debbie Morgan Macao Commercial Offshore Limited ("Debbie Morgan"), owns a Community Trademark (CTM) registration for the mark MISSGUIDED, in block letters, and various foreign registrations for the same or similar mark. In Annex 4 to the Complaint, the Complainant has provided a copy of its CTM registration certificate and copies of records from the web-accessible public trademark search files of the Australian Intellectual Property (IP) Office and the United States Patent and Trademark Office for its Australian and United States registrations. Pertinent details of its registrations are as follows:

- (1) MISSGUIDED (block letters)  
Community trademark registration No. 008946329  
registered: September 2, 2010

This mark is registered for use in connection with: "Spectacle glasses, sunglasses" in International class 9; "jewelry and watches, watch bands, and straps, cufflinks, tie pins, bracelets, necklaces, rings and bangles" in International class 14; "Bags, handbags, suitcases, travelling bags, umbrellas" in International class 18; and "Clothing, footwear, headgear, including hats, shoes, scarves and gloves" in International class 25.

- (2) MISSGUIDED (stylized with a design element)  
Australian trademark registration No. 1450916 (based on the Complainant Debbie Morgan's international application no. 1090389)  
registered: August 2, 2011

This mark is registered for use in connection with: "Spectacle glasses, sunglasses" in International class 9; "jewelry and watches, watch bands, and straps, cufflinks, tie pins, bracelets, necklaces, rings and bangles" in International class 14; "Bags, handbags, suitcases, travelling bags, umbrellas" in International class 18; and "Clothing, footwear, headgear, including hats, shoes, scarves and gloves" in International class 25.

- (3) MISSGUIDED (stylized with a design element)  
United States trademark registration No. 4148443  
registered: May 29, 2012; filed August 2, 2011 (based on the Complainant Debbie Morgan's international application no. 1090389)

This mark is registered for use in connection with: "Spectacle glasses, sunglasses" in International class 9; "jewelry and watches, watch bands, and straps, cufflinks, tie pins, bracelets, necklaces, rings and bangles" in International class 14; "Tote bags, handbags, suitcases, travelling bags, umbrellas" in International class 18; and "Clothing, namely footwear, headgear, namely hats, shoes, scarves and gloves" in International class 25.

## **B. Complainants**

The Complainant, Debbie Morgan, owns and licenses the MISSGUIDED marks and various domain names which include the mark MISSGUIDED, including <missguided.co.uk>, <missguided.eu>, <missguidedau.com>, and <missguidedus.com>. The other Complainant, Missguided Limited, is the exclusive licensee of these marks and the domain names. For simplicity, all references hereinafter to the "Complainant" will be to both Debbie Morgan and Missguided Limited, unless the specific context indicates otherwise.

Since 2008, the Complainant has operated an e-commerce business at the website "www.missguided.co.uk" through which it sells women's fashion clothing and accessories. A copy of screen shots of various pages from that site appears in Annex 7 to the Complaint. This site was and continues to be commercially successful. In 2010, 2011 and 2012, sales exceeded 3.8m pounds, 14.7m pounds and 38.2m pounds, respectively.

In early 2013, the Complainant expanded its business internationally by launching e-commerce in Australia (at the website "www.missguidedau.com") and in the United States (at the website "www.missguidedus.com").

As of the date the Complaint was filed, the Complainant has over 1 million registered customers, and its e-commerce sites receive on average more than 4 million visits per month. It also has over 370,000 fans on Facebook, 50,000 followers on Twitter, and 22,000 followers on Instagram.

To attain this growth and level of sales and customers, the Complainant has undertaken comprehensive marketing campaigns across the world including, e.g., bill board and television advertisements in the United Kingdom, Australia and United States, and has also sponsored high-profile fashion and music events around the world, including, e.g., the Manchester Fashion Week and the Coachella Music Festival in California.

The Complainant conducts all its business through its e-commerce sites with all its merchandise bearing one or more of the Complainant Debbie Morgan's MISSGUIDED marks, with those sites being a key mechanism through which the Complainant's customers learn of its products.

The Complainant has received nominations and accolades from various sections of the fashion industry in the United Kingdom, including Reveal Magazine's Click To Buy Awards, Company Magazine's High Street Fashion Awards and being named as Drapers' "Best New Etailer" in 2011. Copies of relevant supporting documents are also provided in Annex 7 to the Complaint.

Moreover, the Complainant, from its own analyses, states that the Respondent's website draws relatively little traffic. Further, there is no corporate entity registered in Australia in the name of Direct Desires Limited or Missguided Pty Limited (which are the entities stated on the Respondent's Australian website as being responsible for its operation). Further, the Complainant discovered the existence of a United Kingdom company registered in the name of Direct Desires Limited (incorporated on December 10, 2012).

### **C. Respondent**

The Respondent first came to the Complainant's attention in February 2013. At that time, one of the Complainant's customers telephoned the Complainant's customer service department and informed it of the Respondent's Australian website "www.missguided.com.au" (the "Australian website"); this particular domain name is not one of the presently disputed domain names). Through that site, the Respondent offers for sale various adult sexually-based goods and related novelty products.

Previously and as shown by Whois history data in Annex 8 to the Complaint, the domain name <missguided.com.au> was registered to Wasabi Frog Limited t/a Boohoo ("Boohoo"). Boohoo, a United Kingdom-based online retailer of women's fashion, is one of the Complainant's direct competitors in the United Kingdom (a copy of relevant materials describing Boohoo appears in Annex 16 to the Complaint).

The Respondent has advertised his product offerings on Australian television during January, February and March 2013.

As shown by copies in Annex 9 to the Complaint of trademark records from publicly searchable online databases from national trademark offices in Australia, New Zealand, United States and Canada, the Respondent has also either applied to register or has registered the following marks in Australia and/or New Zealand: Fashion Union, Axparris, Quiz Clothing, Forever Unique, Rare London And Chelsea Girl. These marks are brand names of some of the Complainant's other online competitors in the United Kingdom (copies of screen shot extracts from the corresponding websites appear in Annex 10 to the Complaint), all of whom are also online retailers of women's fashion.

The Respondent states that he included a country or regional identifier in each of the disputed domain names to effectively localize that name to a corresponding area where he intended to conduct business and use that name in that area.

Currently, none of the disputed domain names appears to resolve to an operating website.

On October 29, 2012, the Respondent filed a trademark application with the Australian IP Office to register the term "Missguided" for use in conjunction with various adult sexually-related products in International class 35. The Complainant has initiated an opposition proceeding in the Australian IP Office against registration of this application. The Respondent has also filed trademark applications to register this mark in Canada and the United States.

### **D. The Parties' Interactions**

On February 19, 2013, the Complainant's Representative sent a cease and desist letter to the Respondent which demanded that the Respondent transfer all the disputed domain names to the Complainant (a copy of all correspondence between the parties appears in Annex 18 to the Complaint). On March 5, 2013, the Complainant received a response from the Respondent's solicitors through which the Respondent denied infringement of the Complainant's IP rights and refused to transfer the disputed domain names. The Respondent, through his solicitors, stated that he would not use the mark MISSGUIDED or the domain name of his Australian website for goods covered by any of the Complainant's trademark registrations.

On March 22, 2013, the Complainant's Representative sent a letter to the Respondent's solicitors containing further explanation underlying its allegations of IP infringement. On April 17, 2013, the Complainant's Representative received a responding letter from the Respondent's solicitors stating that "our client has decided to close his website "www.missguided.com.au" and cease his operations under this mark". That response did not address the present disputed domain names nor did he provide the assurances which the Complainant sought that the Respondent would cease his allegedly infringing activities. The Respondent apparently did terminate use of his Australian website to avoid further solicitor costs and in light of possible uncertainty, given the demands made and the actions threatened by the Complainant's Representative over the ultimate ownership of the disputed domain names.

Further, on April 17, 2013, the Complainant's Representative again wrote to the Respondent's solicitors demanding that the Respondent cease its infringing activities and comply with the Complainant's prior demand. That letter enclosed a draft of the present Complaint and stated that the Complaint would be filed unless a satisfactory response was received from the Respondent by April 19, 2013. No response was received by this deadline. Moreover, although the Respondent's solicitors replied, with a letter dated April 22, 2013, that they would respond in seven days, to date, the Complainant's Representative has not

received any such response.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that each of the disputed domain names is identical or, at the least, confusingly similar to the Complainant's MISSGUIDED marks as each name contains the term "missguided", either alone or in combination with an apparently well-known country or regional name or abbreviation.

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, for various reasons, the Respondent has no rights or legitimate interests in any of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

First, the Respondent is not licensed or authorized to use any of the Complainant's MISSGUIDED marks.

Second, the Respondent is neither commonly known by the name Missguided nor has he been previously known under any of the disputed domain names. The Respondent appears to have no discernible connection with the name Missguided; there appears to be no genuine business operated by the Respondent's Australian Website or any of the disputed domain names.

Third, the Respondent is not using any of the disputed domain names in a legitimate, noncommercial or fair use. Rather, the Respondent appears to be using the disputed domain names solely to:

- a) benefit from the Complainant's MISSGUIDED marks and the Complainant's reputation in order to attract consumers looking for the Complainant's website(s);
- b) cause such consumers to make an unwelcome association between (i) the business operated by the Complainant and (ii) the Respondent's offering of adult sexually-based goods and related novelty products; and
- c) cause detriment to the Complainant and derail its plan for international expansion as a consequence of creating an unwarranted association in the minds of its consumers between the Complainant and the Respondent.

In addition, the Respondent uses the disputed domain names in a manner which takes unfair advantage of the Complainant's trademark rights, specifically to cause confusion to consumers and thus injure the reputation of the Complainant's registered marks.

#### **(iii) Registered and Used in Bad Faith**

The Complainant contends that the Respondent has registered and is using the disputed domain names in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent has registered and is intentionally using the disputed domain names to besmirch the Complainant's goodwill and reputation, and derail the international expansion of its e-commerce business and interfere with the legitimate commercial interests of the Complainant, among others. This is particularly evident inasmuch as the Respondent's Australian website is not a legitimate business, the Respondent is connected to one of the Complainant's closest United Kingdom competitors (Boohoo) and the Respondent exhibited a worldwide pattern of registering domain names and trademarks (some of which matured into actual trademark registrations) involving not only the Complainant's marks but also those of its

closest competitors.

## **B. Respondent**

### **(i) Identical or Confusingly Similar**

Contrary to the Complainant's view, the Respondent contends, for various reasons, that none of the disputed domain names is identical or confusingly similar to the "Complainant's domain name" (which the Panel interprets as meaning the Complainant's MISSGUIDED marks).

First, the Complainant may have been well-known in 2012 in the United Kingdom, but at that time it was not well-known outside the United Kingdom. In that regard, the Complainant noted that its international expansion did not start until 2013 which was after the Respondent started its online business in Australia.

Second, though, as the Respondent acknowledges, the disputed domain names may be similar to the Complainant's trading name (which here too the Panel interprets as meaning the Complainant's registered mark MISSGUIDED), all the names include a "geographic addition" but "apart from missguidedbritain and missguideduk the Complainant did not have a business in any of the regions referred to in any of the other domains."

Third, in spite of any similarity between the disputed domain names and Complainant's trading name, there is no likelihood of purchaser confusion due to: (a) the differences between their respective products, *i.e.* women's clothing for the Complainant and adult sexually-based goods and related novelty products for the Respondent; and (b) their respective widely separated geographic territories in when, in 2012, the Complainant only sold its goods in the United Kingdom while the Respondent only sold its goods in Australia.

### **(ii) Rights or Legitimate Interests**

The Respondent also contends that he has rights and legitimate interests in each of the disputed domain names.

Specifically, before the Respondent received notice of this dispute, he had already started conducting his online business in Australia under his business name Missguided. He chose that name because the name hinted that his sexually related adult products were a bit "naughty".

### **(iii) Registered and Used in Bad Faith**

The Respondent contends, for various reasons, that he neither registered nor used any of the disputed domain names in bad faith,

First, the Respondent's website does not benefit from "someone looking for women's clothing from a British Company", *i.e.* from exploiting possible purchaser confusion, for the simple reason that otherwise the Respondent's website would likely have experienced more web traffic than it did.

Second, the goods offered through the Respondent's website differ considerably from women's clothing. Moreover, the Respondent's business is not conducted in the United Kingdom but rather Australia. In that regard, the Respondent is not interfering with or disrupting the Complainant's United Kingdom business.

Third, the Respondent started offering his goods in the Australian market through his website prior to entry of the Complainant into that market.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

When distilled to its core, the Respondent's basic argument as to this requirement of the Policy rests on a false premise. The Respondent takes the position that none of the disputed domain names is either identical or confusingly similar to the Complainant's registered Australian mark MISSGUIDED simply because the Respondent registered all the disputed domain names and commenced his online operation in Australia prior to the date in 2013 when the Complainant entered that market, and as such the Respondent's activities apparently predated any rights which the Complainant could legally assert against the Respondent.

Paragraph 4(a) of the Policy sets forth three general but essential requirements which a complainant must satisfy in order to put forth a *prima facie* case entitling it to relief under the Policy. One of those requirements, as set forth in paragraph 4(a)(i) of the Policy, is the existence of "a trademark or service mark in which the complainant has rights". While the Policy is silent as to the effect of the date of registration of a trademark, it has long been recognized by previous panelists that the date of registration of a trademark is irrelevant for purposes analyzing the first element (see paragraph 1.4 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), "Registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the UDRP. The UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired rights. However, in such circumstances it may be difficult to prove that the domain name was registered in bad faith under the third element of the UDRP"). In this case, the Complainant has established trademark rights in MISSGUIDED for purposes of the Policy. The Panel notes that all of the Complainant's trademarks, including its registered Australian mark, predate the registration of all the disputed domain names. Even if the Panel were to accept the Respondent's view, the governing date here would not be when the Respondent entered the Australian market, but rather when did the Complainant first acquire exclusive trademark rights in Australia for its mark MISSGUIDED that would suffice to legally preclude the Respondent from using that or a confusingly similar mark there. The date is no later than the date on which that particular mark was registered, *i.e.* August 2, 2011. Accordingly, as the earliest of the Respondent's disputed domain name registrations occurred on May 24, 2012 (including <missguidedaustralia.com>) - some 10 months after the Complainant acquired legally exclusive trademark rights in Australia, the Complainant would in any event have acquired trademark rights at a sufficiently early date.

The Panel takes note of the Respondent's pending trademark application in Australia and the ongoing opposition proceeding being conducted by the Complainant against that application. However, these aspects are irrelevant to this proceeding as, from the evidence of record, the Respondent does not appear to be challenging the Complainant's own registration of its mark MISSGUIDED. It is through that registration from which the Complainant is deriving and asserting its exclusionary trademark rights under paragraph 4(a)(i) of the Policy against the Respondent.

As the Panel has now found that the Complainant possesses requisite trademark rights sufficient to invoke paragraph 4(a)(i) of the Policy, the analysis shifts as to determine whether each of the disputed domain names is identical or confusingly similar to the Complainant's registered Australian mark MISSGUIDED. Doing so entails that the Panel simply compare each of the disputed domain names with the mark to assess whether each of the former is either identical or confusingly similar to that mark.

From such a comparison, no doubt exists that each disputed domain name is confusingly similar to Complainant's registered mark MISSGUIDED.

The primary difference between each one of the disputed domain names and the mark MISSGUIDED is appending of a country or continent name, specifically "asia", "australia", "brazil", "britain", "canada", "europe", "new zealand" or "uk", to the mark to form a composite term, along with, quite secondarily, appending the generic Top Level Domain (gTLD) ".com" to the composite term to form the disputed domain names - with the last addition typically 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 a short letter or number group, or even generic or highly

descriptive words, or geographic identifiers, such as a country name or well-known regional identifier, 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 a country or continent name in the manner which the Respondent did, to the Complainant's registered mark MISSGUIDED clearly resulted in such a minor variation. See, particularly *We Sell Businesses, Inc. v. Paul Yates*, WIPO Case No. D2013-0584; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. FA 791657; *Google Inc. v. Jennifer Burns*, NAF Claim No. FA 726096; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. FA 155896; and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. FA 117876.

Therefore, the Panel finds that each of the disputed domain names is confusingly similar to the Complainant's MISSGUIDED marks 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 to any of the disputed domain names under paragraph 4(c) of the Policy.

As the Respondent has yet to use any of the disputed domain names to resolve to an operational website, let alone one through which he would make a *bona fide* offering of goods and has not provided any evidence of preparations to use the disputed domain names, he cannot claim the safe harbor protection of paragraph 4(c)(i) of the Policy, *i.e.* that he used or made demonstrable preparations to use any of those names in conjunction with a *bona fide* offering of goods or services before he received notice of the present dispute.

The Complainant has never authorized the Respondent to utilize the Complainant's registered mark MISSGUIDED nor does either of 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 registered mark or one confusingly similar thereto in connection with the identical or even similar goods to those currently provided by the Complainant, in circumstances as are present here, may violate the exclusive trademark rights now residing with the Complainant. See, *e.g.*, *We Sell, GM, National Westminster, Amy Stran v. EzDomainSearch.com, Juan Curtis*, WIPO Case No. D2011-1710; *Tommy Bahama, Space Needle, Oakley, Burberry, 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; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc., supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. FA 173362; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Claim No. FA 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. FA 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in this Panel's view, the Respondent could not legitimately acquire any public association between himself and the Complainant's registered mark MISSGUIDED or even any mark similar thereto, at least for the goods provided by the Complainant under that mark as well as those sufficiently related thereto to cause purchaser confusion.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by any of the disputed domain names or more generally the mark MISSGUIDED. Nor could the Respondent likely ever become commonly known by either any of those names or the mark without possibly infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back to no later than August 2, 2011 - the registration date of the Complainant's Australian trademark application for MISSGUIDED, and which predate, by more than a year, the December 2012 date on which the Respondent launched his online business in Australia and, by nearly ten months, the earliest date (May 24, 2012) on which the Respondent registered any of the disputed domain names (specifically <missguidedaustralia.com>). See, e.g. *We Sell, National Westminster, Tommy Bahama, Amy Stran, Space Needle, Oakley, Burberry, Starline Publications, HRB Innovations Inc., MySpace and Treeforms, Inc.*, all cited *supra*. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Lastly, there are no facts of record that appear to qualify the Respondent's actions as satisfying paragraph 4(c)(iii) of the Policy through showing a legitimate noncommercial or fair use of any of the disputed domain names.

As such, based on the evidence before the Panel, the Respondent does not fall within any of paragraphs 4(c)(i)-(iii) of the Policy.

The Panel additionally notes that the Respondent's mere trademark application does not grant rights or legitimate interests as such for purposes of the Policy.

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

### **C. Registered and Used in Bad Faith**

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

The Panel believes that the Respondent was well aware of the Complainant and its MISSGUIDED mark when the Respondent registered the disputed domain names. Yet, in spite of that knowledge, the Respondent intentionally chose and registered the names to opportunistically exploit their potential to generate purchaser confusion for the Respondent's eventual pecuniary benefit.

This is clearly evident from the Respondent's actions - as noted by the Complainant and not disputed by the Respondent - of having registered various marks in various foreign countries and which include the brand names of some of the Complainant's direct online competitors of women's clothing in the United Kingdom. Obviously, the Respondent would not have chosen to register any of those marks, including the brand name Missguided for the Complainant's own clothing, if the Respondent's intention was not to eventually exploit the reputation and goodwill of all those brand names, in some manner, for his own benefit. There is no

plausible reason from the evidence of record for the Panel to view that the Respondent had any different goal in mind when he registered the disputed domain names. The Panel views any statement to the contrary by the Respondent as lacking credibility.

Thus far, based on the Panel's understanding of the Response, the Respondent has not used any of the disputed domain names to resolve to an operational website. However, the Panel infers from the Respondent's statement in paragraph 16 of the Response that, but for the intervention of the Complainant and its Representative, the Respondent may well have established a functioning website at one or more of the disputed domain names. To date, the Respondent just continues to passively hold each of these disputed domain names.

By intentionally registering multiple disputed domain names which each included the Complainant's registered mark MISSGUIDED, coupled with the Respondent's prior knowledge of the Complainant, it is reasonable to infer that, by doing so, the Respondent intended to prevent the Complainant from reflecting its mark in a corresponding domain name, thus violating paragraph 4(b)(ii) of the Policy.

Moreover, had the Complainant and the Complainant's Representative not intervened when they did, the Respondent, based on the evidence of record, would likely have established an operational website through one or more of the disputed domain names. By so doing, the Respondent would likely and intentionally have caused purchaser confusion between that name(s) and the Complainant's registered mark MISSGUIDED which, in turn, could readily damage the Complainant's reputation and business to the unjust benefit of the Respondent. Even though the respective goods sold by each party differ (Complainant's women's clothing *vis-à-vis* the Respondent's adult sexually-based goods and related novelty products), there may well be common purchasers of both parties' goods. The Respondent's bald statement that the parties' products differ is the sole evidence on this issue in the present record. The Panel is not convinced, from just this statement, that the inter-product differences - whatever they might actually be (and of which no evidence exists of record) are sufficient in and of themselves to adequately ameliorate purchaser confusion that would likely occur. Consequently, those purchasers could well believe that a relationship of some sort, whether by source, sponsorship, affiliation or endorsement, would exist between the parties when, in fact, no such relationship occurs at all. Hence, the Respondent's intended actions, had they not been thwarted by the Complainant, would very likely have injured the Complainant's reputation and damaged its international business by, e.g., diverting customers away from the Complainant's website or causing an illicit gain in traffic to the his own website at the expense of the Complainant, and thus would have violated paragraph 4(b)(iv) of the Policy.

Hence, the Panel concludes that the Respondent violated the general bad faith provision of paragraphs 4(a)(iii) and 4(b) of the Policy, and also the specific bad faith provision 4(b)(ii).

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain names, 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 names <missguidedasia.com>, <missguidedaustralia.com>, <missguidedbrazil.com>, <missguidedbritain.com>, <missguidedcanada.com>, <missguidedeuropa.com>, <missguidednewzealand.com> and <missguideduk.com> are all ordered to be transferred to the Complainant Debbie Morgan Macao Commercial Offshore Limited.

**Peter L. Michaelson**

Sole Panelist

Date: June 14, 2013