

ADMINISTRATIVE PANEL DECISION

Shoe Show, Inc. v. 李思恒 (li si heng)

Case No. D2023-4572

1. The Parties

The Complainant is Shoe Show, Inc., United States of America ("United States"), represented by Fox Rothschild LLP, United States.

The Respondent is 李思恒 (li si heng), China.

2. The Domain Name and Registrar

The disputed domain name <shoe-dept.com> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 3, 2023. On November 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 7, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 9, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on November 28, 2023.

The Center verified that the Complaint together with the amendment to 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 5, 2024.

The Center appointed Cherise Valles as the sole panelist in this matter on January 15, 2024. 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 Complainant Shoe Show, Inc. (“Shoe Show”) is a nationwide footwear retailer, established in 1960.

The Complainant has been providing retail services and shoes under its federally registered SHOE DEPT. mark, its SHOE DEPT. COLLECTION mark and its SHOE DEPT. ENCORE mark (collectively, the “trademarks”). The Complainant is the owner of registrations for the trademarks in the United States, as follows:

- United States Trademark Registration No. 1720873 for SHOE DEPT., registered on September 29, 1992;
- United States Trademark Registration No. 4134246 for SHOE DEPT. COLLECTION, registered on May 1, 2012;
- United States Trademark Registration No. 4198626 for SHOE DEPT. ENCORE, registered on August 28, 2012;
- United States Trademark Registration No. 4198627 for SHOE DEPT. ENCORE, registered on August 28, 2012; and,
- United States Trademark Registration No. 4471540 for SHOE DEPT. ENCORE, registered on January 21, 2014.

The disputed domain name <shoe-dept.com> was registered on December 22, 2022. The content of the webpages to which the disputed domain name resolves consists of product listings and advertisements with links to attract and divert Internet traffic to third-party web pages for the purpose of generating revenues from the advertised products on a pay-per-click basis.

5. Parties’ Contentions

A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The disputed domain name is confusingly similar to the Complainant’s registered SHOE DEPT. trademark, in light of the fact that it wholly incorporates the Complainant’s mark.

The Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant states that the Respondent should be considered as having no rights or legitimate interests in the disputed domain name. The Complainant has never licensed or otherwise permitted the Respondent to use its trademarks or to register any domain name that included its trademarks.

The disputed domain name has been registered and is being used in bad faith.

The Complainant asserts that the disputed domain name was registered and is being used in bad faith. The mere fact of registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to that mark is itself evidence of bad faith registration and use.

Furthermore, the Respondent's impersonating and/or competing uses of the disputed domain name is clear evidence of bad faith.

The Complainant requests the Panel to issue a decision finding that the disputed domain name be transferred to the Complainant, in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In terms of paragraph 4(a) of the Policy, for a Complaint to succeed, the Complainant must prove each of the following elements:

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

The Respondent has failed to file a Response in this proceeding. The Panel may draw appropriate inferences from the available evidence submitted by the Complainant.

A. Identical or Confusingly Similar

To prove this element, the Complainant must have relevant rights in a trademark and the disputed domain name must be identical or confusingly similar to such trademark.

The Complainant submits that the disputed domain name is confusingly similar to the trademark in which it has rights. The disputed domain name incorporates the SHOE DEPT. trademark in its entirety with the addition of a hyphen between "shoe" and "dept". Given the Complainant's trademark registration as detailed above, the Panel finds that the Complainant has established its trademark rights in SHOE DEPT. for the purposes of paragraph 4(a)(i) of the Policy.

As stated in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

The Complainant asserts that the disputed domain name is confusingly similar to such mark. It argues that the disputed domain name is virtually identical to, and does nothing to distinguish itself from, the Complainant's trademarks, and that therefore consumers will mistakenly understand that the Respondent's domain refers to the Complainant.

The generic Top-Level Domain ("gTLD") ".com" may also be disregarded under the first element. See *Foundation Le Corbusier v. Mercado M.*, WIPO Case No. [D2004-0723](#) and section 1.11.1 of the [WIPO Overview 3.0](#). In the light of the foregoing, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark and that the Complainant has met its burden with respect to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a non-exhaustive set of circumstances, any of which, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy, namely:

- (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.”

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, whether on the basis of the non-exhaustive examples set out in paragraph 4(c) of the Policy or on any other basis, and the Panel draws inferences from this failure, where appropriate, in accordance with paragraph 14(b) of the Rules.

It is recognised in cases under the Policy that it is sufficient for a complainant to make a *prima facie* case under the second element of the Policy, not rebutted by the respondent, that the respondent has no rights or legitimate interests in the domain name concerned upon which the burden of production of evidence shifts to the Respondent (see, for example, *Paris Saint-Germain Football v. Daniel Macias Barajas, International Camps Network*, WIPO Case No. [D2021-0019](#); *Spinrite Inc. v. WhoisGuard, Inc. / Gabriella Garlo*, WIPO Case No. [D2021-0012](#) and section 2.1 of the [WIPO Overview 3.0](#)). If a respondent fails to rebut such a *prima facie* case by demonstrating rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy, or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

On the evidence before the Panel, it appears that there has never been any relationship between the Complainant and the Respondent. The Respondent does not seem to be licensed, or otherwise authorized, be it directly or indirectly, to register or use the Complainant’s SHOE DEPT. trademark in any manner, including in, or as part of, the disputed domain name.

The Complainant asserts that the Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy in order to demonstrate rights or legitimate interests in the disputed domain name. In particular, the Respondent cannot assert that, prior to any notice of this dispute, he was using, or had made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy. Rather, the evidence presented illustrates that the Respondent sought to capitalize on the risk of implied affiliation shown in the composition of the disputed domain name by using the disputed domain name to host pay-per-click links.

The Complainant submits that the Respondent is not a licensee, authorized agent of the Complainant, or in any other way authorized to use the Complainant’s trademark. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain name.

In light of the foregoing, the Panel finds that the Complainant has established an unrebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

For this element, the Complainant is required to prove that the disputed domain name was registered and that it was being used in bad faith. The term “bad faith” is “broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”. See section 3.1 of the [WIPO Overview 3.0](#). Paragraph 4(b) of the Policy sets out four non-exhaustive examples of circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, namely:

(i) circumstances indicating that the respondent registered or 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 the documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

In the present case, the Complainant's submissions relate to paragraph 4(b)(iv) of the Policy.

Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typographical errors or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

Furthermore, the nature of the disputed domain name, consisting of the Complainant's trademark with the addition of a hyphen between "shoe" and "dept", carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#). In the present case, the Respondent seeks to attract Internet users interested in the products and retail services to its website by creating a likelihood of confusion with the Complainant's trademark.

The disputed domain name currently resolves to a parking page containing pay-per-click links to third party business (Annex 6 to the Complaint). The Respondent appears to be using the disputed domain name in an intentional attempt to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the SHOE DEPT as to the source, sponsorship, and affiliation of the website to which the disputed domain name resolves. Given the well-known status of the trademark SHOE DEPT. and the Complainant's global business including in the United States market, the Respondent was likely aware of the Complainant's trademarks. Hence, the purpose of the registration of the disputed domain name was to create an impression of an association with the Complainant.

The Respondent has not participated in the administrative proceeding and has not answered the Complainant's contentions. The fact that the Respondent has decided not to provide any legitimate explanation or to assert any alleged good faith motivation in respect of the registration or use of the disputed domain name in the face of the Complainant's contentions can be regarded as an indication of registration and use in bad faith.

Accordingly, the Panel concludes that the Complainant has satisfied its burden of showing bad faith registration and use of the disputed domain name under paragraph 4(a)(iv) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <shoe-dept.com> be transferred to the Complainant.

/Cherise Valles/

Cherise Valles

Sole Panelist

Date: January 29,2024