

ADMINISTRATIVE PANEL DECISION

Madewell Inc. v. Ting Wang, Blue Face, DAVID GIRE, SU Luo, rcl,
and Qin Zhang

Case No. D2022-2002

1. The Parties

The Complainant is Madewell Inc., United States of America (“United States” or “U.S.”), represented by Cowan, Liebowitz & Latman, P.C., United States.

The Respondents are Ting Wang, China; Blue Face, United States; DAVID GIRE, France; SU Luo, rcl, China; Qin Zhang, China.

2. The Domain Names and Registrars

The disputed domain names <madewellfashion.com>, <madewellonlinestore.com>, <madewelloutletsale.com>, <madewellsale.com>, <madewellstyle.com>, and <madewellswim.com> are registered with 1API GmbH (the “Registrar”).

The disputed domain names <new-madewell-shop.com> and <themadewell.com> are registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 2, 2022. On June 3, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On June 6, 2022 and June 7, 2022 respectively, the Registrars transmitted by email to the Center their verification responses disclosing registrants and contact information for the disputed domain names which differed from the named Respondents and contact information in the Complaint. The Center sent an email communication to the Complainant on June 10, 2022, providing the registrants and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 10, 2022.

The Center verified that the Complaint together with the amended 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 Respondents of the Complaint, and the proceedings commenced on June 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on July 5, 2022.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on July 15, 2022. 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 Madewell Inc. ("Madewell") is a subsidiary of J. Crew Group, LLC and an affiliate of J. Crew International, Inc., one of the world's leading manufacturers and retailers of apparel and fashion accessories.

The Complainant owns trademark and service mark registrations for the MADEWELL in numerous jurisdictions around the world, including the United States. The earliest U.S. trademark for MADEWELL (Registration No. 968685) was registered on September 18, 1973.

The Complainant also owns the domain name <madewell.com>, which was registered in 1997.

The Respondents registered the disputed domain names <madewellfashion.com>, <madewellonlinestore.com>, <madewelloutletsale.com>, <madewellsale.com>, <madewellstyle.com>, <madewellswim.com>, <new-madewell-shop.com> and <themadewell.com> respectively on April 21, 2022; May 19, 2022; May 11, 2022; April 21, 2022; April 25, 2022; April 27, 2022; May 7, 2022; and May 6, 2022.

The Panel accessed the disputed domain names on July 28, 2022, when the disputed domain names <madewellfashion.com>, <madewelloutletsale.com>, <madewellsale.com>, <madewellstyle.com>, <madewellswim.com>, <new-madewell-shop.com>, and <themadewell.com> were all linked to webpages reproducing the Complainant's trademark, logo, and official website, offering fashion items for sale. On that date, the disputed domain name <madewellonlinestore.com> was not linked to any active webpage. However, the Complainant provided evidence that all of the disputed domain names resolved to active websites reproducing the Complainant's trademark, logo, and official website, offering fashion items for sale at the time of submission of the Complaint.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

(i) The disputed domain names are identical or confusingly similar to the Complainant's trademark. Each of the disputed domain names comprises the entirety of the MADEWELL mark in combination with generic and/or fashion-related words. It is well established that the addition of a generic or descriptive term to the Complainant's mark does not influence the similarity between the trademark and the disputed domain names.

(ii) The Respondents have no rights or legitimate interests in the disputed domain names. None of the Respondents' personal names are related to the disputed domain names; none of the Respondents actually engage in any legitimate business or commerce under the disputed domain names; and none of the Respondents is a licensee of the Complainant, nor has any of the Respondents ever been authorized by the Complainant to register or use the Complainant's MADEWELL mark. The Respondents are not using the

disputed domain names in connection with any *bona fide* offering of goods and services. Indeed, the Respondents are using the disputed domain names to engage in fraud by exploiting and infringing the Complainant's trademarks and copyrights and engaging in fraudulent and phishing activities, all in an apparent attempt to mislead consumers into thinking that the websites linked to the disputed domain names are authorized by the Complainant, when in fact they are not.

(iii) The Respondents registered and are using the disputed domain names in bad faith. The Respondents are using the disputed domain names to engage in fraud by exploiting and infringing the Complainant's trademarks and copyrights and engaging in fraudulent and phishing activities, all in an apparent attempt to mislead consumers into thinking that the infringing websites linked to the disputed domain names are authorized by the Complainant, when in fact they are not. Since the disputed domain names are confusingly similar to the Complainant's MADEWELL mark, Internet users are likely to become confused as to the Complainant's possible affiliation with the infringing websites. There is no doubt whatsoever that the Respondents know of the Complainant's rights in the MADEWELL mark because the Respondents are using the disputed domain names to direct traffic to the infringing websites, which feature and prominently display the Complainant's MADEWELL mark in addition to the Complainant's copyrighted material.

B. Respondents

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

6. Discussion and Findings

6.1 Consolidation of Domain Names in One Proceeding

The Complainant made a request for the consolidation of the disputed domain names in the same proceeding, despite the fact the Whois database informs different registrants' names for some of the disputed domain names. The request for consolidation was not challenged by the Respondents.

According to section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties.

The [WIPO Overview 3.0](#), section 4.11.2, further emphasizes that a range of factors – typically present in some combination – are useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of:

- i) the registrants' identity(ies) including pseudonyms;
- ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities;
- iii) relevant IP addresses, name servers, or webhost(s);
- iv) the content or layout of websites corresponding to the disputed domain names;
- v) the nature of the marks at issue;
- vi) any naming patterns in the disputed domain names;
- vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue;
- viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s);
- ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s);
- x) any (prior) pattern of similar respondent behavior; or
- xi) other arguments made by the complainant and/or disclosures by the respondent(s).

In the present case, the websites to which the disputed domain names <madewellfashion.com>, <madewellonlinestore.com>, <madewelloutletsale.com>, <madewellsale.com>, <madewellstyle.com>, <madewellswim.com>, and <new-madewell-shop.com>, according to the evidence in the Complaint, present basically the same contents and layout, present a common format (incorporating the Complainant's MADEWELL mark and descriptive wording relating to the Complainant's goods and services), and were registered between April and May, 2022.

Therefore, in light of the evidence brought by the Complainant, the Panel accepts the consolidation request for such disputed domain names, in the present case.

However, the disputed domain name <themadewell.com> is linked to a webpage with a different design and the registrant is diverse from the other disputed domain names. These circumstances suggest there may be a lack of common control with the other disputed domain names, in this Panel's opinion.

Therefore, the disputed domain name <themadewell.com> will not be considered in the context of the present procedure.

6.2 Merits

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain names, the Complainant shall prove the following three elements:

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

A. Identical or Confusingly Similar

The Complaint has evidenced registrations for the MADEWELL trademark owned by the Complainant in the United States since 1973.

The trademark MADEWELL is wholly encompassed and recognizable within the disputed domain names.

The disputed domain names differ from the Complainant's trademark basically by the addition of the terms "fashion", "onlinestore", "outletsale", "sale", "style", "swim", "new-", and "-shop", as well as of the generic Top-Level Domain ("gTLD") ".com".

Previous UDRP decisions have found that additional terms (such as "fashion", "onlinestore", "outletsale", "sale", "style", "swim", "new-", and "-shop") do not prevent a finding of confusing similarity, where the relevant trademark remains recognizable within the disputed domain name. This has been held in many UDRP cases (see, [WIPO Overview 3.0](#), section 1.8).

It is also already well established that the addition of a gTLD extension such as ".com" is typically irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds the disputed domain names to be confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate a right or legitimate interest in a domain name:

(i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use 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; or

(iii) the respondent is 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 at issue.

Based on the Respondents' default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondents have no rights or legitimate interests in the disputed domain names.

The Complainant has not licensed nor authorized the use of its trademark to the Respondents, and the Panel finds no indication that the Respondents are commonly known by the disputed domain names.

Indeed, the disputed domain names are linked to websites unauthorizedly reproducing the Complainant's trademark and logo, as well as the contents of the Complainant's official website.

Consequently, the Panel is satisfied that the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Finally, paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

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

(ii) the respondent 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 its website or location or of a product or service on its website or location.

When the disputed domain names were registered by the Respondents (between April and May, 2022) the trademark MADEWELL was already directly connected to the Complainant's fashion products.

The disputed domain names encompass the trademark MADEWELL together with terms that are related to the Complainant's business. The websites linked to the disputed domain names reproduce the MADEWELL brand and logo, as well as the Complainant's official website.

Therefore, the Panel concludes that it is not feasible that the Respondents were not aware of the Complainant's trademark when they registered the disputed domain names, and that the adoption of the expressions "madewellfashion", "madewellonlinestore", "madewelloutletsale", "madewellsale", "madewellstyle", "madewellswim", and "new-madewell-shop" were mere coincidences.

Actually, the Panel is convinced that the registration and use of the Complainant's trademark MADEWELL together with terms such as "fashion", "onlinestore", "outletsale", "sale", "style", "swim", "new-", and "-shop" indicates that the Respondents intentionally attempted to attract Internet users to their websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of their websites, for commercial gain.

Accordingly, the Panel finds that the Complainant has proved that the disputed domain names were registered and are being used in bad faith, satisfying the third element 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 names <madewellfashion.com>, <madewellonlinestore.com>, <madewelloutletsale.com>, <madewellsale.com>, <madewellstyle.com>, <madewellswim.com>, <new-madewell-shop.com> be transferred to the Complainant.

Insofar as the Panel has declined to accept consolidation of the disputed domain name <themadewell.com>, the Complaint is denied as to that domain name but without prejudice to the Complainant's right to file a complaint under the Policy with respect to that domain name.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: July 31, 2022