

ADMINISTRATIVE PANEL DECISION

Jonathan Adler Enterprises, LLC v. Hui Wu
Case No. D2022-3268

1. The Parties

The Complainant is Jonathan Adler Enterprises, LLC, United States of America (“United States” or “US”), represented by Kaplan Levenson, United States.

The Respondent is Hui Wu, China.

2. The Domain Name and Registrar

The disputed domain name <jonathanadlerus.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 1, 2022. On September 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 7, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 September 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 30, 2022.

The Center appointed Federica Togo as the sole panelist in this matter on October 12, 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 is the registered owner of several trademarks for JONATHAN ADLER, e.g. US trademark registration no. 2,860,439 JONATHAN ADLER registered on July 6, 2004 for goods in classes 11, 20, 21, 24, 27 and 28; US trademark registration no. 4,272,320 JONATHAN ADLER registered on January 8, 2013 for goods in classes 4, 8, 11, 18 and 20. The Complainant is a limited liability company registered in the State of New York (US). It is a premier home furnishing design company with a national and international retail, wholesale, e-commerce, and licensing business.

The disputed domain name was registered on June 23, 2022 and resolves to an online shop allegedly selling the Complainant's goods, reproducing without any authorization the Complainant's trademarks.

5. Parties' Contentions

A. Complainant

It results from the Complainant's undisputed allegations that the Complainant is a limited liability company registered in the State of New York (US). It is a premier home furnishing design company with a national and international retail, wholesale, e-commerce, and licensing business. Its first store launched in New York City in 1998 and has been in continuous operation since then both online and in its stores.

In addition, the Complainant operates the domain name <jonathanadler.com> in order to promote its products.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's earlier trademarks: The inclusion of "us" at the end of the disputed domain name does nothing to ameliorate the confusion as it implies that the site is the US based version of the Complainant's website.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, it has been using the mark JONATHAN ADLER for online retail store services since at least December 31, 1998. Moreover, it has never authorized or allowed the Respondent to use, register, or imply any kind of affiliation with the Complainant nor has it otherwise condoned the Respondent's actions in registering the disputed domain name and use of the Complainant's marks.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant provided evidence that the disputed domain name resolves to an online shop allegedly selling the Complainant's goods, reproducing without any authorization the Complainant's trademarks.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

- (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 Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of various trademark registrations for JONATHAN ADLER, e.g. US trademark registration no. 2,860,439 JONATHAN ADLER registered on July 6, 2004 for goods in classes 11, 20, 21, 24, 27 and 28; US trademark registration no. 4,272,320 JONATHAN ADLER registered on January 8, 2013 for goods in classes 4, 8, 11, 18 and 20.

Many UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark for purposes of the first element, where the relevant trademark is recognizable within the disputed domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). This Panel shares the same view and notes that the disputed domain name contains the Complainant's registered trademark JONATHAN ADLER in full. The additional geographical element "us" (*i.e.* the geographical abbreviation for the United States of America) does not prevent a finding of confusing similarity. Consequently, this Panel is of the opinion that the trademark JONATHAN ADLER remains recognizable within the disputed domain name.

Finally, the generic Top-Level Domain ("gTLD") ".com" of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the trademark JONATHAN ADLER, e.g., by registering the disputed domain name comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation, since the disputed domain name contains the Complainant's trademark JONATHAN ADLER followed by the letters "us", which are the geographical abbreviation for the United States of America. Geographic terms are seen as tending to suggest sponsorship or endorsement by the trademark owner, see [WIPO Overview 3.0](#), section 2.5.1.

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, 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 (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant’s documented allegations that the disputed domain name resolves to a website allegedly selling the Complainant’s goods and reproducing without any authorization the Complainant’s trademarks. For the Panel, it is therefore evident that the Respondent positively knew the Complainant’s mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant’s trademarks when it registered the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant’s registered trademark JONATHAN ADLER followed by the letters “us”, which are the geographical abbreviation for the United States of America. Registration of the disputed domain name which contains a third party’s mark, in awareness of said mark and in the absence of rights or legitimate interests amounts to registration in bad faith (see *e.g.*, *DPDgroup International Services GmbH & Co. KG v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Mark Minami*, WIPO Case No. [D2021-3767](#)).

Finally, the further circumstances surrounding the disputed domain name’s registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at point 3.2.1):

- (i) the nature of the domain name (*i.e.* a domain name incorporating the Complainant’s mark plus an additional term such as a geographic term);
- (ii) the content of any website to which the domain name directs (*i.e.* an online shop allegedly selling the Complainant’s goods, reproducing without any authorization the Complainant’s trademarks);
- (ii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the disputed domain name.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) 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, <jonathanadlerus.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: October 25, 2022