

ADMINISTRATIVE PANEL DECISION

Shoshanna Lonstein v. Juan Zhao

Case No. D2022-3939

1. The Parties

The Complainant is Shoshanna Lonstein, United States of America (“United States”), represented by Pryor Cashman, LLP, United States.

The Respondent is Juan Zhao, China.

2. The Domain Name and Registrar

The disputed domain name <shoshannasale.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 October 20, 2022. On October 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 24, 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 November 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 22, 2022.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on November 25, 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 in this proceeding is Shoshanna Lonstein, founder and creative director of Shoshanna, her eponymous clothing collection, which debuted in stores in November 1998. The Shoshanna collection can be found at luxury retailers like Bergdorf Goodman, Neiman Marcus, Saks Fifth Avenue, and Bloomingdales, as well as at over 500 specialty stores in the United States, Canada, Europe, and Asia.

The Complainant is, *inter alia*, the owner of:

United States trademark SHOSHANNA registration number 3939088, registered on March 29, 2011.

In addition, the Complainant holds the domain name <shoshanna.com>, where the Complainant's collection is displayed. The Complainant also operates several social media accounts, including on Facebook at <facebook.com/shopshoshanna>, Twitter at <twitter.com/shopshoshanna>, and Instagram at <instagram.com/shopshoshanna>.

The disputed domain name was registered on August 23, 2022.

The disputed domain name directs visitors to a commercial website (the "Respondent's website") that purports to offer SHOSHANNA-branded clothing for sale. In addition, the Respondent's website displays images copied from the Complainant's SHOSHANNA brand Facebook page.

The Complainant's trademark registration predates the registration of the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant claims that:

- (a) the disputed domain name is confusingly similar to the Complainant's trademark;
- (b) the Respondent lacks any rights or legitimate interests in the disputed domain name; and
- (c) the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to obtain a transfer of the disputed domain name, paragraphs 4(a)(i) – (iii) of the Policy require that the Complainant must demonstrate to the Panel that:

- (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.

A. Identical or Confusingly Similar

The Complainant has established rights in the SHOSHANNA trademark.

The disputed domain name contains the Complainant's SHOSHANNA trademark with the addition of the term "sale" and the generic Top-Level Domain ("gTLD") ".com".

The addition in the disputed domain name of these elements does not prevent the SHOSHANNA trademark from being recognizable in the disputed domain name.

Pursuant to section 1.8 of the Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") which states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements."

Therefore, the Panel finds the disputed domain name to be confusingly similar to the SHOSHANNA trademark in which the Complainant has rights.

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

B. Rights or Legitimate Interests

This Panel finds that the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent has no connection or affiliation with the Complainant, and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademark. The Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services.

Indeed, it appears that the Respondent has attempted to usurp the Complainant's goodwill in the trademark, in an attempt to confuse and deceive Internet users into doing business with the Respondent. In addition, the Respondent does not appear to be commonly known by the disputed domain name or by a similar name. Moreover, the Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name.

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

C. Registered and Used in Bad Faith

Based on the evidence put forward by the Complainant, the Panel is of the opinion that the Respondent was aware of the Complainant's trademark registrations and rights to the SHOSHANNA mark when it registered the disputed domain name.

The Complainant's SHOSHANNA trademark has been registered and used for many years.

The disputed domain name is used for a website where the content displayed shows the Complainant's trademark and logo as well as purported SHOSHANNA-branded clothing, and displays images copied from the Complainant's SHOSHANNA brand Facebook page.

Consequently it is clear that the Respondent registered the disputed domain name while aware of the Complainant's trademark and activity, and did so with the intention to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of either the Respondent and/or its website, so as to trick those users into doing business with the Respondent. This constitutes bad faith registration and use as well as a disruption of the Complainant's business under the Policy.

Inference of bad faith can also be found in the failure to respond to the Complainant's contentions, and the Respondent's lack of any rights or legitimate interests in the disputed domain name.

Another factor supporting the conclusion of bad faith registration and use of the disputed domain name, based on the documents filed by the Complainant, and not refuted by the Respondent, is given by the fact that the Respondent apparently provided incorrect, if not false, details regarding its contact references to the Registrar.

Further inference of bad faith can be seen in the fact that the Respondent has also registered the domain names <tods-store.com> and <guerlainshop.com> (which incorporate the renowned third-party trademarks TODS and GUERLAIN).

Accordingly, the Panel finds, on the basis of the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith.

Therefore, the Complainant has satisfied 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 <shoshannasale.com> be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: December 5, 2022