

## **ADMINISTRATIVE PANEL DECISION**

Madewell Inc. v. Whois Agent, Domain Protection Services, Inc. /  
Tyudsh Hfgds  
Case No. D2022-1756

### **1. The Parties**

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

The Respondent is Whois Agent, Domain Protection Services, Inc., United States / Tyudsh Hfgds, China.

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

The disputed domain names <madewellshop.com> and <well-clothing.com> are registered with Name.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 13, 2022. On May 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. Also on May 16, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant on May 20, 2022 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 amended Complaint on May 23, 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 Respondent of the Complaint, and the proceedings commenced on May 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 21, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on July 4, 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**

Madewell Inc. is an affiliate of J. Crew International, Inc., a manufacturer and retailer of apparel and fashion accessories. The Complainant re-introduced the MADEWELL brand in 2006 as a modern version of the clothing brand originally founded in 1937 by the Complainant's predecessor-in interest, Madewell Manufacturing Co., Inc. In 2018, the Complainant's sales associated with the MADEWELL brand were worth over USD 529 million.

The Complainant is the owner of the following trademark registrations of the sign "MADEWELL" (the "MADEWELL trademark"):

- the United States trademark MADEWELL with registration number 968,685, registered on September 18, 1973 for goods in International Class 25;
- the United States trademark MADEWELL with registration number 3,878,162, registered on November 16, 2010 for goods and services in International Classes 18, 25 and 35;
- the United States trademark MADEWELL with registration number 4,205,559, registered on September 11, 2012 for goods and services in International Classes 9 and 35; and
- the United States trademark MADEWELL with registration number 4,162,102, registered on June 19, 2012 for goods and services in International Classes 16 and 41.

The Complainant is also the owner of the domain name <madewell.com>, registered on November 4, 1997.

The disputed domain names were registered on December 29, 2021. They resolve to similar in layout and content websites that offer clothing and feature the MADEWELL trademark.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant submits that it has extensively advertised and promoted its goods and services, as a result of which the MADEWELL trademark has developed a substantial public recognition.

The Complainant submits that the disputed domain names are confusingly similar to the MADEWELL trademark. The disputed domain name <madewellshop.com> incorporates the entirety of the MADEWELL trademark which is clearly recognizable in it, with the addition of the dictionary word "shop". The disputed domain name <well-clothing.com> contains the dominant element of the MADEWELL trademark in combination with the dictionary word "clothing". According to the Complainant, these additional elements in the disputed domain names do not prevent a finding that they are confusingly similar to the MADEWELL trademark.

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain names, as it is not commonly known by either of them, has no relationship with the Complainant, and has not been authorized by the Complainant to register or use the Complainant's MADEWELL trademark. The Complainant adds that the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods and services and is not carrying out a legitimate noncommercial or fair use of them. Rather, it is using the disputed domain names to exploit the Complainant's MADEWELL trademark and copyrighted materials for fraudulent activities in an attempt to mislead consumers into thinking that the websites at the disputed domain names are authorized by the Complainant.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. It submits that the Respondent is fraudulently using them to mislead consumers to believe that the websites at the disputed domain names are affiliated to the Complainant. According to the Complainant, the Respondent has registered and is using the disputed domain names with knowledge of the Complainant's pre-existing rights in the MADEWELL trademark, which is evident from the fact that the Respondent is using them to direct traffic to websites that feature and prominently display the MADEWELL trademark and contain the Complainant's copyrighted materials.

## **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain names:

- (i) each of the disputed domain names 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]."

The Respondent has however not submitted a Response and has not disputed the Complainant's contentions and evidence in this proceeding.

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

The Complainant has provided evidence that it is the owner of the MADEWELL trademark and has thus established its rights in this trademark for the purposes of the present proceeding.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the Top-Level Domain ("TLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" TLD of the disputed domain names.

The disputed domain name <madewellshop.com> incorporates the MADEWELL trademark entirely with the addition of the dictionary word “shop”, and the trademark is easily recognizable in it. As discussed in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element.

The disputed domain name <well-clothing.com> contains one of the elements of the MADEWELL trademark in combination with the dictionary word “clothing”. As summarized in section 1.7 of the [WIPO Overview 3.0](#), in specific limited instances, while not a replacement as such for the typical side-by-side comparison, where a panel would benefit from affirmation as to confusing similarity with the complainant’s mark, the broader case context such as website content trading off the complainant’s reputation, or a pattern of multiple respondent domain names targeting the complainant’s mark within the same proceeding, may support a finding of confusing similarity. The Panel finds that the circumstances of the case support such a finding, because this disputed domain name refers to goods marketed by the Complainant under the MADEWELL trademark and is associated to a website that offers the same type of goods and features the same trademark, similarly to the other disputed domain name, which reproduces the MADEWELL trademark in full.

In view of the above, the Panel finds that the disputed domain names are confusingly similar to the MADEWELL trademark in which the Complainant has rights.

## **B. Rights or Legitimate Interests**

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names, as it is not commonly known by either of them, has no relationship with the Complainant, and has not been authorized by the Complainant to register or use the Complainant’s MADEWELL trademark. The Complainant adds that the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods and services, but to exploit the MADEWELL trademark to fraudulently mislead consumers that the websites at the disputed domain names are authorized by the Complainant. The Complainant adds that these websites feature the MADEWELL trademark and display copyrighted materials of the Complainant. Thus, the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names.

The Respondent has not submitted a Response and has not disputed the Complainant’s allegations in this proceeding. It has not alleged having rights or legitimate interests in the disputed domain names.

As summarized in section 2.8.1 of [WIPO Overview 3.0](#), UDRP panels acting under the Policy have recognized that resellers and distributors using a domain name containing the complainant’s trademark to undertake sales of the complainant’s goods may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name, but only if the respondent is actually offering the complainant’s goods and only these goods, the respondent’s website is accurately and prominently disclosing the registrant’s relationship with the trademark holder, and the respondent is not trying to “corner the market” in domain names that reflect the complainant’s trademark.

The evidence in the case file shows that at least two of these requirements have not been complied with in the present case, so there are no reasons to accept that the Respondent is carrying out a *bona fide* offering of goods and services. The Respondent has registered two disputed domain names that are confusingly similar to the MADEWELL trademark, and they resolve to similar websites that offer clothing products and

display the MADEWELL trademark and logo of the Complainant without identifying the supplier of the offered goods and without disclosing the lack of relationship between the Parties. There is no evidence in the case file that the Respondent's websites offer original or legitimate products of the Complainant and the Respondent does not allege this.

In view of the above, the Panel is satisfied that the Respondent, being aware of the goodwill of the Complainant's MADEWELL trademark, has registered and used the disputed domain names in an attempt to exploit the trademark's goodwill to attract Internet users to the Respondent's websites which offer products of unknown origin under the MADEWELL without disclosure of the lack of relationship between the Parties and without authorization of this conduct by the Complainant. To the Panel, such conduct is not legitimate and does not give rise to rights or legitimate interests of the Respondent in the disputed domain names.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain names.

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

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

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

(ii) you have 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 you have engaged in a pattern of such conduct; or

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

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The disputed domain names incorporate the MADEWELL trademark or the element “WELL”, and this trademark was registered many years prior to the registration of the disputed domain names. The Respondent does not deny that the disputed domain names are linked to websites that offer products of unknown origin under the MADEWELL trademark without identifying the supplier of the offered goods and without disclosing the lack of relationship between the Parties. The Respondent also does not deny that this conduct has not been authorized by the Complainant.

Taking the above into account, the Panel concludes that the Respondent has registered the disputed domain names with knowledge of the Complainant and targeting the MADEWELL trademark in an attempt to attract traffic to the disputed domain names by confusing Internet users that they are reaching official online locations where the Complainant's MADEWELL products are offered for sale and then offer them products of unknown origin for commercial gain, which supports a finding of bad faith under Paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the disputed domain names have been registered and used in bad faith.

## **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 <madewellshop.com> and <well-clothing.com> be transferred to the Complainant.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: July 18, 2022