

ADMINISTRATIVE PANEL DECISION

Sugartown Worldwide LLC v. Xuemei Kuang

Case No. D2022-2562

1. The Parties

The Complainant is Sugartown Worldwide LLC, United States of America (“United States”), represented by Kilpatrick Townsend & Stockton LLP, United States.

The Respondent is Xuemei Kuang, China.

2. The Domain Name and Registrar

The disputed domain name <lillypulitzer-us.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 July 13, 2022. On July 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 14, 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 July 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 11, 2022.

The Center appointed Theda König Horowicz as the sole panelist in this matter on August 17, 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 a designer, marketer and distributor of upscale collections of women's and girl's dresses, sportswear and other products, including furniture and bedding. The brand was created as an apparel line in the late 1950's.

The Complainant operates many retail stores throughout the United States, established signature stores with authorized wholesale customers and sells in well-known stores such as Bloomingdales and Saks Fifth Avenue.

Since at least as early as 1961, the Complainant used the LILLY PULITZER trademark exclusively in relation with apparel and related accessories, and later to other type of goods such as furniture, bedding and home fashions.

The Complainant operates a website at the domain name <lillypulitzer.com> which features information about LILLY PULITZER and widely advertises its brand.

The Complainant is the owner of various trademark registrations for LILLY PULITZER, specifically for clothing, the earliest of which date to 1981 (e.g., United States Trademark Registration No. 1157374, registered on June 9, 1981). The Complainant also registered its trademark LILLY PULITZER in other countries, including China (e.g., China Trademark Registration No. 6163046, registered on February 14, 2010).

The disputed domain name was registered on April 21, 2022, and is linked to a website entitled "Lilly Pulitzer Outlet Store" on which the LILLY PULITZER trademark is used.

5. Parties' Contentions

A. Complainant

The Complainant alleges to own valid and enforceable trademark and service mark rights in LILLY PULITZER for use in connection with apparel, accessories, and other lifestyle products. The disputed domain name incorporates the LILLY PULITZER trademark in its entirety and is thus confusingly similar. The addition of the geographic term "us" in the disputed domain name is insufficient to prevent confusing similarity. According to the Complainant, this addition actually increases the risk of confusion, particularly since the Complainant sells goods and operates numerous retail stores in the United States and is in fact based in the United States. Moreover, the likelihood of confusion is greater in instances in which a geographic term is associated with a well-known trademark such as LILLY PULITZER.

The Complainant further alleges that its rights in the trademark LILLY PULITZER long predate any use of the Respondent who registered the disputed domain name and the Respondent must have had constructive knowledge of the Complainant's prior LILLY PULITZER trademark. The Complainant notes that the Respondent lacks rights or legitimate interests in the disputed domain name notably for the following reasons:

- (i) There is no relationship between the Complainant and the Respondent and no license to use the LILLY PULITZER trademark was given by the Complainant to the Respondent.
- (ii) The Respondent cannot establish that it is commonly known by the disputed domain name, as there is no indication that the Respondent has conducted a legitimate business under the disputed domain name.
- (iii) The Respondent is using the disputed domain name to impersonate the Complainant, by operating a website that falsely claims to be "Lilly Pulitzer Outlet Store", uses the Complainant's LILLY PULITZER trademark prominently on the home page and throughout the website, uses numerous of the Complainant's

copyrighted images, copies the look and feel of the Complainant's official website, and purports to offer genuine Lilly Pulitzer products for sale at deeply discounted prices.

- (iv) The Respondent thus appears to offer counterfeit products.
- (v) The Respondent is conducting a fraudulent scam to take payment without providing a product and/or phishing scheme to obtain consumers' personal information.
- (vi) The disputed domain name falsely suggests that it is the Complainant and the official outlet store for the Complainant's LILLY PULITZER brand.

The Complainant states that the Respondent has registered and is using the disputed domain name in bad faith for commercial gain and to benefit from the goodwill and fame associated with the Complainant's LILLY PULITZER trademark. In fact, the disputed domain name purposefully incorporates the well-known LILLY PULITZER trademark and was registered long after this mark became well known to consumers. There is no question that the Respondent was aware of the Complainant's LILLY PULITZER trademark. Further, the Respondent's bad faith is evidenced by the fact that it is using the website at the disputed domain name to either offer counterfeit goods or to conduct a scam to perpetrate fraud on consumers and/or to harvest their personal information.

B. Respondent

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

6. Discussion and Findings

Under the Policy, in order to prevail, a complainant must prove the following three elements for obtaining the transfer of a domain name:

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

A. Identical or Confusingly Similar

The Complainant showed to have trademark rights in LILLY PULITZER through several registrations in the United States and in other countries, including in China where the Respondent is based.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. 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 disputed domain name contains the LILLY PULITZER trademark in entirety. The addition of "-us.com" at the end of the disputed domain name does not prevent confusing similarity, as the LILLY PULITZER trademark remains recognizable in the disputed domain name.

Under these circumstances, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's mark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in the use of a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services;
- (ii) being commonly known by the domain name; or
- (iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made some submissions in order to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name, in particular that the Complainant has exclusive rights over LILLY PULITZER, that the Respondent is not known by the said name, and that the disputed domain name falsely suggests that it is the Complainant and the official outlet store for the Complainant's LILLY PULITZER brand.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case and the burden of production shifts to the Respondent who has chosen not to reply.

The Panel notes that the case file does indeed not show that the Respondent is commonly known by the disputed domain name or by LILLY PULITZER, a trademark on which the Complainant has rights for decades and which is used without authorization in entirety in the disputed domain name which creates a risk of implied affiliation. Such composition cannot constitute fair use as it effectively suggests sponsorship or endorsement by the trademark owner, particularly with the addition of the geographic acronym "us" likely used as a reference to the "United States" where the Complainant's is primarily based. (See section 2.5.1. of the [WIPO Overview 3.0](#)).

The disputed domain name fully incorporates the Complainant's LILLY PULITZER trademark which is widely used in the United States by the Complainant and which enjoys notoriety in relation to clothes and other goods of this type. It is therefore difficult to imagine that the disputed domain name legitimately includes the Complainant's trademark in the disputed domain name.

Furthermore, there is no doubt that the Respondent aimed at profiting from the Complainant's name and business, as the disputed domain name is linked to a website prominently using the LILLY PULITZER trademark without the Complainant's authorization and which commercializes many products of the same nature than the goods sold by the Complainant, for commercial gain which shows that the Respondent is gaining or seeking reputational advantage (see section 2.5.3. of the [WIPO Overview 3.0](#)). In this context, it is to be noted that the website reproduces the look and feel of the Complainant's official website which reinforces the fact that the Respondent aims at unduly taking profit from the Complainant's trademark and reputation.

Consequently, the Panels finds that the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant has shown to have trademark rights in LILLY PULITZER for decades and for having widely used the said mark in the United States and on the Internet through its official website “www.lillypulitzer.com”.

The Respondent must thus have known about the LILLY PULITZER trademark and business when registering the disputed domain name. See section 3.2.2 of the [WIPO Overview 3.0](#). Moreover, the use made of the disputed domain name leaves no doubt about the Respondent’s awareness of and intent to target the Complainant.

The Panel agrees with the Complainant that the bad faith use of the disputed domain name is supported by several findings, notably the absence of any license or permission from the Complainant to use its trademark and the fact that the disputed domain name points to a website copying the look and feel of the Complainant’s website. The Respondent obviously leans on the Complainant’s notoriety to sell exactly the same type of goods, in particular by using the Complainant’s trademark without authorization of any kind, for commercial gain. The absence of response in the present proceedings is an additional element of bad faith.

In light of the above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith and that the Complainant has established its case under 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 <lillypulitzer-us.com> be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: September 9, 2022