

ADMINISTRATIVE PANEL DECISION

Deluxe Gain Holdings Limited v. Xavier Faurot
Case No. D2022-3198

1. The Parties

Complainant is Deluxe Gain Holdings Limited, Hong Kong, represented by Bryan Cave Leighton Paisner LLP, United States of America (“United States”).

Respondent is Xavier Faurot, United States.

2. The Domain Name and Registrar

The disputed domain name <madamalexandergame.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 29, 2022. On August 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 30, 2022, the Registrar transmitted by email to the Center its verification response confirming that 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 Respondent of the Complaint, and the proceedings commenced on September 19, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was October 9, 2022. Respondent did not submit any response. Accordingly, the Center notified the Parties of Respondent’s default on October 17, 2022.

The Center appointed Ingrīda Kariņa-Bērziņa, Carol Anne Been and W. Scott Blackmer as panelists in this matter on November 15, 2022. The Panel finds that it was properly constituted. Each member of 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

Complainant markets collectible dolls under the MADAME ALEXANDER brand. It is the proprietor of several trademark registrations, including the following:

- United States Registration No. 2410485 for MADAME ALEXANDER (word mark), registered on December 5, 2000 for goods in class 20 and 28;

- United States Registration No. 4986240 for MADAME ALEXANDER (word mark), registered on June 28, 2016 for goods in classes 14 and 28 (claiming a date of first use of January 2, 1930 for goods in class 28).

Complainant operates its primary business website at the domain name <madamealexander.com>, which was registered in 1999.

The disputed domain name was registered on November 29, 2017. It resolves to a website headlined "Madam Alexander Doll" featuring images and descriptions of various dolls, along with links stating "More info on eBay."

5. Parties' Contentions

A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that it and its predecessors have been selling dolls under the famous MADAME ALEXANDER mark since at least 1930. In the collectible market for dolls, MADAME ALEXANDER is one of the most highly regarded, well-known and respected doll brands in the world. Madame Alexander dolls have been featured in the Smithsonian Museum and have been inducted into the Toy Industry Hall of Fame. Complainant has collaborated with a recognized fashion and film company in connection with these dolls. They are sold in over 2,000 retail stores. The disputed domain name wholly incorporates Complainant's MADAME ALEXANDER mark, except for the missing "e" in the misspelling of the word "madame" and the addition of the term "game."

Under the second element, Complainant states that it has not licensed its MADAME ALEXANDER trademark, nor granted Respondent permission to register the disputed domain name. Instead, Respondent's website purports to provide information regarding the sale of the MADAME ALEXANDER dolls and is replete with unauthorized uses of Complainant's MADAME ALEXANDER trademarks. Respondent's website contains links to third-party auction sites that feature sellers of purported Madame Alexander dolls and other third-party sites that host content related to Madame Alexander dolls. The use of the MADAME ALEXANDER trademarks in the disputed domain name and throughout the website falsely suggests that Complainant owns and is operating Respondent's website or that Complainant is affiliated with Respondent's website.

Under the third element, Complainant states that Respondent plainly knew of Complainant's mark at the time of the registration of the disputed domain name. Complainant and its predecessors had been continuously using the MADAME ALEXANDER trademark since 1930 and had registered trademark rights in 2000. Complainant operates its own website since 1999. Respondent's website, which displays a misspelling of Complainant's mark, diverts potential customers away from Complainant's website and toward third-party sites through links on Respondent's website. Respondent did not reply to Complainant's cease-and-desist letter.

Complainant requests transfer of the disputed domain name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

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

(ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall 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".

A. Identical or Confusingly Similar

Complainant has provided evidence establishing that it is the assignee of trademark rights in the MADAME ALEXANDER mark through registrations in the United States. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1.

In comparing Complainant's mark with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to this trademark as the trademark is clearly recognizable within the disputed domain name, save for the omission of the letter "e." This is clearly a deliberate misspelling of Complainant's trademark. See [WIPO Overview 3.0](#), section 1.9.

The disputed domain name additionally contains the word "game", which is a dictionary term that does not mitigate confusing similarity. UDRP panels have consistently held that, 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. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

It is the well-established view of UDRP panels that a generic Top-Level Domain such as ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, respondent's use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

- (ii) respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) 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 or service mark at issue.

The Panel finds that there is no evidence that Respondent is commonly known by the disputed domain name nor that it is using the MADAME ALEXANDER mark with the permission of Complainant. The nature of the disputed domain name, which reflects a misspelling of Complainant's mark together with a descriptive term, cannot constitute fair use since it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel therefore finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

Respondent, in failing to file a response, has not submitted any evidence or arguments demonstrating such rights or legitimate interests, nor has it rebutted any of Complainant's contentions.

Nevertheless, interpreting the evidence in the light most favorable to Respondent, the Panel has considered whether the evidence might support a finding that Respondent is a reseller or distributor of Complainant's goods. If that were found to be the case, Respondent could be making a *bona fide* offering of goods and services under certain conditions and thus have a legitimate interest in the disputed domain name.

UDRP Panels have held that the proper test to apply in such cases is set forth in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Applying the "Oki Data test" to the facts set forth in the record, the Panel finds that Respondent does not have a legitimate interest on such a basis. Respondent is not actually offering the goods at issue, but rather is hosting pictures and links directing Internet users to a third-party site. The website does not in any way disclose the registrant's relationship with the trademark holder. Indeed, the copyright notice on the website states "© Madam Alexander Doll." Such a notice indicates that Respondent is impersonating Complainant. The composition of the disputed domain name also does not indicate that Respondent is a reseller or distributor. Under these circumstances, the Panel concludes that Respondent cannot be recognized as a reseller or distributor making a *bona fide* offering of goods or services. See also [WIPO Overview 3.0](#), section 2.8.1.

The Panel concludes that the circumstances of the case prevent the inference of rights or legitimate interests on the part of Respondent.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Complainant has demonstrated the probability of Respondent's bad faith registration and use of the disputed domain name. Complainant's rights in its MADAME ALEXANDER mark predate by decades the registration of the disputed domain name. The disputed domain name reflects Complainant's well-established mark in a misspelled form, together with the dictionary term "game". UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith on the part of Respondent. See [WIPO Overview 3.0](#), section 3.1.4.

In this case, the record shows that Respondent deliberately targeted Complainant and its MADAME ALEXANDER mark. The Panel finds the evidence in the record establishes that Respondent used the disputed domain name to attract traffic to its online auction listings, without any disclaimer clarifying the lack of a relationship between Complainant and Respondent. See [WIPO Overview 3.0](#), section 3.7. The website prominently features Complainant's mark. Respondent identifies the operator of the website as "Madam Alexander Doll," further confusing Internet users. The Panel finds that Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's mark. See [WIPO Overview 3.0](#), section 3.1.4.

Respondent has provided no evidence of actual or contemplated good-faith use of the disputed domain name and the Panel does not find any such use plausible.

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) of the Policy, 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 name, <madamalexandergame.com>, be transferred to Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa
Presiding Panelist

/Carol Anne Been/

Carol Anne Been
Panelist

/W. Scott Blackmer/

W. Scott Blackmer
Panelist

Date: November 29, 2022