

ADMINISTRATIVE PANEL DECISION

Jonathan Adler Enterprises, LLC v. Tgdj Pncd
Case No. D2023-1297

1. The Parties

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

The Respondent is Tgdj Pncd, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <fr-jonathanadler.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 March 24, 2023. On March 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 29, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Whois Agent Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 3, 2023, 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 April 3, 2023.

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 April 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 30, 2023.

The Center appointed Taras Kyslyy as the sole panelist in this matter on June 11, 2023. 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 limited liability company registered in the State of New York. 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 worldwide.

The Complainant owns a number of JONATHAN ADLER trademark registrations in the US, including for instance registration No. 2,860,439, registered on July 6, 2004.

The Complainant has its website at “www.jonathanadler.com” registered on June 23, 1998.

The disputed domain name was registered on August 29, 2022, and resolves to a website in French designed similarly to the Complainant's official website, prominently featuring the Complainant's trademark and offering for sale products similar to the Complainant's at prices significantly lower compared to the Complainant's.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Complainant's trademark. The disputed domain name copies the entirety of the Complainant's trademark. The inclusion of “fr” at the beginning of the disputed domain name does nothing to ameliorate the confusion as it implies that the site is the French-based version of the Complainant's website. The confusion continues when the user is taken to the landing page of the disputed domain name which features the Complainant's trademark being used in association with the sale of items identical to those sold by the Complainant in its stores and online. Moreover, the landing page features the exact same images of items that are featured on the Complainant's website.

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant registered its website on June 23, 1998. The Complainant has been using its trademark for online retail store services worldwide since at least December 31, 1998. The Respondent registered the disputed domain name on August 29, 2022, more than 23 years later. The Complainant 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 trademark.

The disputed domain name was registered and is being used in bad faith. The Respondent is listing for sale various items that are identical to those sold by the Complainant for prices that are a fraction of the actual cost of the real items – costs that are impossible to be genuine. The entire website features what appear to be genuine products of the Complainant – using actual photographs from the Complainant's website of the products – for prices that are entirely irrational and unrealistic. The Respondent also uses, without consent, the name, image and likeness of Jonathan Adler, an individual, on its infringing website, confirming the Respondent's bad faith and tortious intent as a pirate and copier. The Respondent is intentionally attempting to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and its products and services. There has already been one documented instance of confusion where a third-party user believed that the Respondent's site belonged to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the “[WIPO Overview 3.0](#)”) the applicable generic Top-Level Domain (“gTLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards gTLD “.com” for the purposes of the confusing similarity test.

According to section 1.7 of the [WIPO Overview 3.0](#) in cases where a domain name incorporates the entirety of a trademark the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. The Panel finds that in the present case the disputed domain name incorporates the entirety of the Complainant’s trademark.

According to 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 (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The Panel finds that the addition of “fr” and hyphen to the disputed domain name does not prevent finding it confusingly similar to the Complainant’s trademark.

Considering the above the Panel finds the disputed domain name is confusingly similar to the Complainant’s trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence does not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The disputed domain name redirects Internet users to a website with a logo similar to the Complainant’s and designed similarly to the Complainant’s website to make the Internet users believe that they actually access the Complainant’s website. Past UDRP panels confirmed that such actions prove the registrant has no rights or legitimate interests in a disputed domain name (see *Daniel C. Marino, Jr. v. Video Images Productions, et al.*, WIPO Case No. [D2000-0598](#); *Houghton Mifflin Co. v. Weatherman, Inc.*, WIPO Case No. [D2001-0211](#)).

According to section 2.8.1 of the [WIPO Overview 3.0](#) resellers, distributors using a domain name containing a complainant’s trademark to undertake sales related to the complainant’s goods may be making a *bona fide* offering of goods and thus have a legitimate interest in such domain name. Outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the “*Oki Data Test*”), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods at issue;
- (ii) the respondent must use the site to sell only the trademarked goods;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with trademark holder; and

- (iv) the respondent must not try to “corner the market” in domain names reflecting trademark.

The Panel finds that the Respondent failed to satisfy at least the third above requirement and did not in any way disclose its actual relationship with the Complainant, and thus failed to pass the *Oki Data* Test. The Respondent’s use of the disputed domain name misleads consumers into thinking that the website is operated by or affiliated with the Complainant. As such, the Respondent’s use of the disputed domain name cannot be considered *bona fide*.

Moreover, the Panel finds that the disputed domain name is inherently misleading (see section 2.5.1 of the [WIPO Overview 3.0](#)).

Considering the above the Panel finds the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent’s use of the disputed domain name to purport to sell the Complainant’s products shows that at the time of the registration of the disputed domain name the Respondent clearly knew and targeted Complainant’s prior registered and famous trademark, which in the circumstances of this case confirms the bad faith (see, e.g., *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

According to paragraph 4(b) of the Policy the following circumstance, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: 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. In this case, the disputed domain name was resolving to a website featuring the Complainant’s trademark and falsely pretended to be the Complainant’s official website to intentionally attract Internet users by creating likelihood of confusion with the Complainant’s trademark as to the source of the website and its products. The Panel finds the above confirms the disputed domain name was registered and used in bad faith.

Considering the above the Panel finds the disputed domain name was registered and is being used in bad faith. Therefore, 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, <fr-jonathanadler.com>, be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: June 25, 2023