

## **ADMINISTRATIVE PANEL DECISION**

Mel Bernie and Company, Inc. v. Clay Foy  
Case No. D2023-4578

### **1. The Parties**

Complainant is Mel Bernie and Company, Inc., United States of America (“United States”), represented by Stubbs Alderton & Markiles, LLP, United States.

Respondent is Clay Foy, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <192s.shop> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 3, 2023. On November 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 6, 2023, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing 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 November 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 5, 2023. Respondent did not reply to Complainant’s contentions. Accordingly, the Center notified the Notification of Respondent Default on December 8, 2023.

The Center appointed Lorelei Ritchie as the sole panelist in this matter on December 18, 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**

Complainant is a company based in the United States. For decades prior to the registrations of the disputed domain name, Complainant has offered fashion jewelry under the mark 1928. Complainant owns numerous registrations for the 1928 mark. These include, among others, United States Registration No. 1210421 (registered September 28, 1982). In addition, Complainant owns the registration for the domain name <1928.com>, which Complainant uses to connect with consumers, and to provide information about goods and services offered under its 1928 mark.

The disputed domain name was registered on June 15, 2023. Respondent has used the URL associated with the disputed domain name to resolve to a website that appears to mimic an official website of Complainant, offering jewelry goods at a discounted price under the trademark 1928. Complainant has not authorized any activities by Respondent, nor any use of its trademarks thereby.

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

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

Complainant contends that the (i) disputed domain name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the disputed domain name; and (iii) Respondent registered and is using the disputed domain name in bad faith.

In particular, Complainant contends that Respondent has incorporated in full its 1928 mark, with an intentional misspelling, and with the generic top-level domain ".shop".

Complainant asserts that Respondent has no rights or legitimate interests in the domain name registration or use of the disputed domain name.

Complainant contends that Respondent has acted in bad faith in setting up a website meant to impersonate Complainant and to confuse consumers as to the source of ownership of the disputed domain name. Complainant thus asserts that Respondent has used Complainant's mark for Respondent's own commercial gain.

##### **B. Respondent**

Respondent did not reply to Complainant's contentions.

#### **6. Discussion and Findings**

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

This Panel must first determine whether the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy. The Panel finds that it is.

The disputed domain name is confusingly similar to Complainant's 1928 mark, with a clear and obvious misspelling, the final digit "8" from Complainant's mark is intentionally left out, and a letter "s" is added in its place. This indicates a practice commonly known as "typosquatting," where a domain name registrant deliberately registers common misspellings of a well-known mark in order to divert consumer traffic. Other UDRP panels have routinely found typosquatted domain names like these to be "confusingly similar" for purposes of a finding under the UDRP. See *Edmonds.com, Inc. v. Yingkun Guo*, WIPO Case No. [D2006-0694](#) (<edunds.com>); *Disney Enterprises, Inc. v. John Zuccarini, Cupcake City and Cupcake Patrol*, WIPO Case No. [D2001-0489](#) (<disneychanel.com>, <disneywolrd.com>, <walddisney.com>). See also *Credit Karma, Inc. v. Domain Admin, Whols Privacy Corp.*, WIPO Case No. [D2017-0194](#) (<credidkarma.com>). The disputed domain name is registered with the generic top-level domain ".shop". Typically a top-level domain name may be disregarded for purposes of considering this first element. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), Paragraph 1.11.

The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

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

The Policy provides some guidance to respondents on how to demonstrate rights or legitimate interests in the domain name at issue in a UDRP dispute. For example, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name. These examples include: (i) use of the domain name "in connection with a *bona fide* offering of goods or services;" (ii) demonstration that Respondent has been "commonly known by the domain name;" or (iii) "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."

Respondent did not submit a reply to Complainant's contentions, and Respondent did not allege or otherwise provide any information that would support a finding that Respondent has rights or legitimate interest in the disputed domain name. Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent's lack of rights or legitimate interest in the disputed domain name, which Respondent has not rebutted.

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

There are several ways that a complainant can demonstrate that a domain name was registered and used in bad faith. For example, paragraph 4(b)(iv) of the Policy states that bad faith can be shown where "by using the domain name [respondent has] intentionally attempted to attract, for commercial gain, Internet users to [respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or of a product or service on [the] web site or location."

As noted in Section 4 of this Panel's decision, Respondent has used the URL associated with the disputed domain name to resolve to a website that appears to mimic an official website of Complainant, offering jewelry goods at a discounted price under the trademark 1928. Respondent is thus trading on the goodwill of Complainant's trademarks to attract Internet users, presumably for Respondent's own commercial gain. See also *Krispy Kreme Doughnut Corporation, HDN Development Corporation*, WIPO Case No. [D2022-2376](#) (transferring <krispykremefranchising.com>).

The Panel finds that Respondent registered and used the disputed domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy.

## **7. Decision**

For all 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 <192s.shop> be transferred to Complainant.

*/Lorelei Ritchie/*

**Lorelei Ritchie**

Sole Panelist

Dated: January 1, 2024