

ADMINISTRATIVE PANEL DECISION

David Yurman IP LLC v. Sofia Mazurowski

Case No. D2022-1708

1. The Parties

Complainant is David Yurman IP LLC, United States of America (“United States”), represented by Fross Zelnick Lehrman & Zissu, P.C., United States.

Respondent is Sofia Mazurowski, United States.

2. The Domain Name and Registrar

The disputed domain name <davidyurmannecklace.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 May 10, 2022. On May 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 11, 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 May 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 7, 2022.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on June 15, 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

Complainant David Yurman IP LLC (“Complainant” or “Yurman”) is a leading maker of luxury jewelry products. Founded in 1980 by David Yurman and his wife, Sybil Yurman, Complainant has developed global name-recognition and a reputation for making premier luxury jewelry. For decades, Complainant has continuously maintained its DAVID YURMAN brand and trademark through extensive use and protection. Complainant’s brand, trade name, and other intellectual property are the result of significant investment.

Complainant currently operates 33 DAVID YURMAN boutiques in the United States, and another 11 around the world. Complainant’s DAVID YURMAN branded products are also sold through a number of retail partners, including Bloomindale’s, Neiman Marcus, and Nordstrom. In addition to its physical retail locations, Complainant sells products through its ecommerce website.

Complainant owns several trademark registrations for the DAVID YURMAN mark (the “Mark”) in multiple jurisdictions, with sample registration details as follows:

- DAVID YURMAN, United States Trademark Reg. No. 1,725,487, registered on October 20, 1992;
- DAVID YURMAN, United States Trademark Reg. No. 2,014,167, registered on November 5, 1996;
- DAVID YURMAN, United States Trademark Reg. No. 2,460,107, registered on June 12, 2001.

Complainant has continuously used the DAVID YURMAN mark in connection with jewelry for over 40 years. Complainant also owns and operates the <davidyurman.com> domain name, which it has continuously used in commerce since 1998. The disputed domain name was registered on January 18, 2018. Currently, <davidyurmannecklace.com> resolves to a webpage that is being used in connection with the promotion and sale of jewelry items. The website itself does not sell any products, and, instead, contains links to eBay listings purporting to sell DAVID YURMAN jewelry pieces.

5. Parties’ Contentions

A. Complainant

According to Complainant, the disputed domain name is identical or confusingly similar to Complainant’s DAVID YURMAN trademark in which Complainant has rights as demonstrated through its cited registrations. The Mark was adopted and has been continuously used since at least as early as 1971 in connection with making luxury jewelry. Complainant maintains its online presence through its website hosted at its domain name <davidyurman.com>.

Complainant argues that the disputed domain name fully incorporates the Mark. Complainant also argues that the addition of the descriptive or generic word “necklace” at the end of the Mark is clearly not sufficient to avoid a likelihood of confusion with Complainant’s prior rights. Complainant argues that, due to the complete reproduction of Complainant’s company name and prior well known trademarks, Internet users will obviously and wrongly think that the disputed domain name belongs to Complainant or has been registered in its name. Complainant argues that a likelihood of confusion is therefore undeniable and is reinforced by the high degree of recognition enjoyed by Complainant in relation to a wide range of luxury jewelry products, including necklaces.

Complainant asserts that Respondent lacks any rights or legitimate interests in the disputed domain name. According to Complainant, Respondent does not have any trademark rights to the Mark. Complainant alleges that Respondent is using the disputed domain name to divert Internet traffic for profit from click-through revenue generated as part of eBay’s Partner Network. Complainant also asserts that it has not granted Respondent, by license or otherwise, permission to use the Mark in any way. Complainant argues that the disputed domain name was registered by Respondent without Complainant’s consent.

Complainant argues that Respondent both registered and is using the disputed domain name in bad faith. According to Complainant, Respondent registered and used the disputed domain name intentionally in an attempt to attract Internet users to its website for financial gain by creating a likelihood of confusion with Complainant's trademark. Complainant argues that Respondent intends to attract Internet users and consumers looking for legitimate David Yurman goods and/or authorized partners to Respondent's own webpage for Respondent's illicit commercial gain. Complainant argues that Respondent could not have been unaware of the existence of Complainant's famous trademarks and company name when registering the disputed domain name. Complainant argues that the mere fact that Respondent has registered the disputed domain name which incorporates the famous DAVID YURMAN mark belonging to a famous luxury jewelry brand is alone sufficient to give rise to an inference of bad faith. Complainant argues that, although Respondent's website appears to be a resale site, it is in fact not that at all, but is instead a pass-through site linking to products for sale on eBay. Additionally, Complainant argues that some of the links are to sales of products that are not even DAVID YURMAN branded products – Complainant argues that, in accordance with previous Panel decisions and WIPO Overview section 2.3, for a re-seller to make a *bona fide* use of a trademarked term in a domain name, Respondent must *inter alia*: (1) sell only the trademarked goods or services; and (2) accurately disclose Respondent's relationship with the trademark owner. Complainant argues that Respondent has failed to follow both of these requirements. Complainant argues that such actions clearly show the domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Under paragraphs 5(f) and 14(a) of the Rules, the effect of a default by a respondent is that, in the absence of exceptional circumstances, the panel shall proceed to a decision on the basis of the complaint.

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A respondent's default does not by itself satisfy a complainant's burden of proof and is not necessarily an admission that the complainant's allegations are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Thus, even though Respondent has failed to address Complainant's contentions, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence that it owns multiple trademark registrations for the DAVID YURMAN trademark as referenced above. Therefore, Complainant has established that it has rights in the Mark.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain ("TLD") in which the domain name is registered) is identical or

confusingly similar to Complainant's mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. 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. *Id.*

Here, the disputed domain name incorporates the entirety of the Mark, adding only the word "necklace" to the end, which does not prevent a finding of confusing similarity. A side-by-side comparison of the Mark and the disputed domain name reveals that the Mark is easily identifiable within the disputed domain name.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to its DAVID YURMAN mark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.1. Once Complainant makes such a *prima facie* showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainant. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainant will have sustained its burden under the second element of the UDRP.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the disputed domain name:

- (i) before any notice of the dispute, Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business or other organization) has been commonly known by the disputed 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 disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has failed to come forward with any evidence showing rights or legitimate interests. Respondent has not submitted any arguments or evidence to rebut Complainant's contention that Respondent is not an assignee or licensee of Complainant and that Respondent has no other business relationship with Complainant. Complainant has contended that Respondent is not commonly known by the disputed domain name and that there is no evidence that Respondent has established trademark rights in the disputed domain name. Again, Respondent has not provided any evidence or arguments to demonstrate that it has such rights.

Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. Paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location.

Here, Respondent's actions align with 4(b)(iv) of the Policy. The disputed domain name contains the entirety of the DAVID YURMAN mark, with the addition of the word "necklace" to the end. Due to the well-known nature of Complainant's brand, evidenced by its numerous trademark registrations for DAVID YURMAN, as well as global brand recognition provided by Complainant through its unsolicited media coverage and online presence, along with the unauthorized use of the Mark in the disputed domain name, Respondent was undoubtedly aware of Complainant and the Mark when it registered the disputed domain name. Respondent's use of the Mark in the disputed domain name in connection with Respondent's pass-through site, and failure to follow requirements for resale of goods, clearly evidences bad faith on the part of Respondent in the registration and use of the disputed domain name.

This Panel therefore finds that Respondent acted in bad faith by its registration and use of the disputed domain name, intentionally creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's website with the purpose of attracting Internet users for commercial gain as per paragraph 4(b)(iv) 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, <davidyurmannecklace.com>, be transferred to Complainant.

/Brian J. Winterfeldt/

Brian J. Winterfeldt

Sole Panelist

Date: June 29, 2022