

## **ADMINISTRATIVE PANEL DECISION**

**Mallet. Footwear Limited v. Domain Protection Services, Inc. / Ajeio Qudeim**  
Case No. D2022-1904

### **1. The Parties**

Complainant is Mallet. Footwear Limited, United Kingdom, represented by Murgitroyd & Company, United Kingdom.

Respondent is Domain Protection Services, Inc., United States of America (“United States”) / Ajeio Qudeim, Hong Kong, China.

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

The Disputed Domain Names <londonmallet.com> and <malletshoe.com> are registered with Name.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 26, 2022. On May 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On May 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on May 30, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. The Center sent an email communication to Complainant on May 30, 2022 requesting a clarification regarding the identity of the Complainant. Complainant filed a first amended Complaint on May 30, 2022. Complainant filed a second amended Complaint on June 1, 2022.

The Center verified that the Complaint together with the amended Complaints 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 June 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 27, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 28, 2022.

The Center appointed Richard W. Page as the sole panelist in this matter on July 1, 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 is a highly regarded, London-based, premium footwear and fashion label which designs, develops, sells, and markets footwear and clothing. Complainant has traded under the name MALLET LONDON since, at least as early as 2015. Since this date, the MALLET LONDON Mark has been used continuously in relation to footwear and clothing. The products of the Complainant are available throughout the United Kingdom from leading fashion retailers including Harrods, Selfridges, Flannels, Tessuti, and Choice.

Complainant operates an e-commerce website at “www.mallet.com”. Along with the website, Complainant has had a presence on social media since 2015. Complainant has in excess of 160,000 followers on Instagram. It has used the Twitter handle “@MALLET\_LONDON” since May 2015, the Facebook handle “@malletlondon” since June 2015 and Instagram since June 2015. Complainant is the owner of the following trademark registrations:

United Kingdom trademark registration No. UK00801467442 Mallet London in Class 25, registered on October 25, 2019;

United Kingdom trademark registration No. UK00003640464 MALLET in Class 25, registered on November 5, 2021; and

International trademark registration No. 1467442 Mallet London in Class 25, registered on January 24, 2019, which designated the European Union, Turkey, and the United States of America.

The Complainant’s trademarks are referred to herein as the “MALLET LONDON Mark”.

The Disputed Domain Names were registered on April 23, 2022 and are used to offer for sale training shoes, footwear and clothing for sale including apparently the products of the Complainant, along with products of other brands.

#### **5. Parties’ Contentions**

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

Complainant contends that the Disputed Domain Names are confusingly similar to the MALLET LONDON Mark pursuant to paragraph 4(a)(i) of the Policy.

Complainant further contends that the Disputed Domain Names consist of “londonmallet” and “malletshoe”. Complainant further contends that incorporating the MALLET LONDON Mark in the Disputed Domain Names creates confusingly similarity to the MALLET LONDON Mark. Complainant further contends that one Disputed Domain Name consist of the MALLET LONDON Mark with the order of the words reversed. The other Disputed Domain Name consists of the distinctive and dominant element of the MALLET LONDON Mark – “mallet” plus the word “shoe” which describes part of the goods sold by Complainant. The addition of the generic Top-Level Domain (“gTLD”) “.com” is a standard registration requirement and does not negate the confusing similarity between the Disputed Domain Names and the MALLET LONDON Mark.

Complainant further contends that Respondent’s websites to which the Disputed Domain Names resolve are offering for sale training shoes, footwear, and clothing including the products of Complainant.

Complainant has no business, or other, relationship with Respondent. Complainant has not consented to the registration of the Disputed Domain Names nor their subsequent use by Respondent. Complainant has not sold product to Respondent which would allow Respondent to sell the products which it is offering on its website.

Complainant submits that to the best of its knowledge, Respondent is not commonly known by the Disputed Domain Names.

Complainant further submits that Respondent is not making legitimate or noncommercial or fair use of the Disputed Domain Names. It is clear that Respondent is using the Disputed Domain Names, as well as signs similar to the registered MALLEET LONDON Mark, with the intent of misleading consumers and/or harming the reputation enjoyed by Complainant. Respondent can have no legitimate justification for holding or using the Disputed Domain Names.

Complainant alleges that the Disputed Domain Names were registered and are being used in bad faith.

Firstly, due to the reputation that Complainant enjoys in the MALLEET LONDON Mark, under which it operates a highly regarded, London-based premium footwear and fashion label. Complainant further alleges that the Disputed Domain Names were registered, and are being used, in bad faith and that Respondent was fully aware of Complainant and the MALLEET LONDON Mark.

Secondly, by virtue of the longstanding and widespread use of the MALLEET LONDON Mark, Internet users would believe that the website at the Disputed Domain Names were operated by Complainant or in association with Complainant.

Thirdly, the use of Disputed Domain Names amounts to a misrepresentation to consumers of an association with Complainant and its goodwill in the MALLEET LONDON Mark and constitutes an infringement.

Fourthly, Complainant further alleges that Respondent is offering for sale the products of the Complainant, to which it does not have access. The Disputed Domain Names are offering for sale products from other well-known brands such as DKNY, Kenzo, Moschino and Stella McCartney. Complainant asserts that if Respondent is offering its products for sale, without any stock, it is likely that it does not have any stock of other brands. This will cause harm to the business and brand of Complainant particularly if Respondent accepts orders and payments which it cannot fulfil. This will lead to disruption of the business of Complainant under the MALLEET LONDON Mark. Consumers will believe that the website at the Disputed Domain Names are in some way connected with, associated with or related to the activities of Complainant under the MALLEET LONDON Mark. Complainant submits that the Disputed Domain Names have been registered and are being used in such a way as to create an unauthorized association with Complainant for Respondent's commercial gain.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable."

Even though Respondent has failed to file a Response or to contest Complainant's assertions, the Panel will review the evidence proffered by Complainant to verify that the essential elements of the claims are met. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following:

- i) that the Disputed Domain Names registered by Respondent are identical or confusingly similar to the MALLET LONDON Mark in which Complainant has rights; and,
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and,
- iii) that the Disputed Domain Names have been registered and are being used in bad faith.

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

Section 1.2.1 of the [WIPO Overview 3.0](#) states that registration is *prima facie* evidence of Complainant having enforceable rights in the MALLET LONDON Mark.

Complainant has contended that it has numerous registrations of the MALLET LONDON Mark, which Respondent has not contested.

Therefore, the Panel finds that for purposes of this proceeding Complainant has enforceable trademark rights in the MALLET LONDON Mark.

Section 1.7 of the [WIPO Overview 3.0](#) says that inclusion of the entire trademark in a domain name will be considered confusingly similar. Also, Section 1.8 of the [WIPO Overview 3.0](#) instructs that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) does not prevent a finding of confusing similarity. Also, Section 1.11.1 of the [WIPO Overview 3.0](#) instructs that gTLDs such as (.com) may be disregarded for purposes of assessing confusing similarity.

Complainant contends that the Disputed Domain Names consist of “londonmallet” and “malletshoe” and that incorporating the MALLET LONDON Mark in the Disputed Domain Names creates confusingly similarity to the MALLET LONDON Mark.

The Panel finds that one Disputed Domain Name consist of the MALLET LONDON Mark with the order of the words reversed. The Panel finds that the other Disputed Domain Name consists of the distinctive and dominant element of the MALLET LONDON Mark – “mallet” plus the word “shoe” which describes part of the goods sold by Complainant. The addition of the gTLD “.com” is a standard registration requirement and does not negate the confusing similarity between the Disputed Domain Names and the MALLET LONDON Mark.

Therefore, the Panel finds that Complainant has met the requirements of paragraph 4(a)(i) of the Policy.

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

Complainant contends that Respondent has no rights or legitimate interests in the Disputed Domain Names pursuant to paragraph 4(a)(ii) of the Policy.

Section 2.1 of the [WIPO Overview 3.0](#) states that once Complainant makes a *prima facie* case in respect of the lack of rights or legitimate interests of Respondent, Respondent carries the burden of demonstrating he has rights or legitimate interests in the Disputed Domain Names. Where Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Names:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Disputed Domain Names or a name corresponding to the Disputed Domain Names in connection with a *bona fide* offering of goods or services; or

(ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Disputed Domain Names, even if you have acquired no trademark or service mark rights; or

(iii) you [Respondent] are making a legitimate noncommercial or fair use of the Disputed Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the MALLET LONDON Mark.

Complainant submits that it has no business, or other, relationship with Respondent. Complainant has not consented to the registration of the Disputed Domain Names nor their subsequent use by Respondent.

Complainant further submits that, to the best of its knowledge, Respondent is not commonly known by the Disputed Domain Names.

Complainant further submits that Respondent is not making *bona fide*, legitimate or noncommercial or fair use of the Disputed Domain Names. Complainant further submits that Respondent is using the Disputed Domain Names, as well as signs similar to the registered MALLET LONDON Mark, with the intent of misleading consumers and/or harming the reputation enjoyed by Complainant. Respondent has no legitimate justification for holding or using the Disputed Domain Names.

The Panel finds that Complainant has made a *prima facie* showing, which has not been refuted by Respondent.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

Complainant contends that Respondent registered and is using the Disputed Domain Names in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of the Disputed Domain Names:

(i) circumstances indicating that you [Respondent] have registered or you have acquired the Disputed Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Names registrations to Complainant who is the owner of the MALLET LONDON Mark or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Names; or

(ii) you [Respondent] have registered the Disputed Domain Names in order to prevent the owner of the MALLET LONDON Mark from reflecting the MALLET LONDON Mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you [Respondent] have registered the Disputed Domain Names primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Disputed Domain Names, you [Respondent] 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 MALLET LONDON Mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product on your website or location.

The four criteria set forth in paragraph 4(b) of the Policy are nonexclusive. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In addition to these criteria, other *Telstra* factors alone or in combination can support a finding of bad faith.

Section 3.2.2 of the [WIPO Overview 3.0](#) states that in circumstances where Complainant's Mark is widely known and Respondent cannot credibly claim to have been unaware of the mark, panels have been prepared to infer that Respondent knew, or have found that Respondent should have known, that its registration would be identical or confusingly similar to Complainant's Mark.

The Panel finds that, by virtue of the longstanding and widespread use of the MALLET LONDON Mark and Respondents commercial activities, Respondent has violated paragraph 4(b)(iv) of the Policy and had actual knowledge of Complainant's rights in the MALLET LONDON Mark when he registered the Disputed Domain Names, using them in bad faith.

The Panel finds that Complainant has satisfied the requirements of 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 Names, <londonmallet.com> and <malletshoe.com> be transferred to Complainant.

*/Richard W. Page/*

**Richard W. Page**

Sole Panelist

Date: July 15, 2022