

ADMINISTRATIVE PANEL DECISION

Fashion Nova, LLC v. Domains By Proxy, LLC / mahesh hadiya, ecomrce
Case No. D2022-2014

1. The Parties

The Complainant is Fashion Nova, LLC, United States of America (“United States”), represented by Ferdinand IP, LLC, United States.

The Respondent is Domains By Proxy, LLC, United States / mahesh hadiya, ecomrce, India.

2. The Domain Name and Registrar

The disputed domain name <fashionnovaa.club> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 2, 2022. On June 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 9, 2022, 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 June 12, 2022.

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 June 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 12, 2022.

The Center appointed Vincent Denoyelle as the sole panelist in this matter on July 22, 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

Given that no Response was filed, the following facts are based on the submissions in the Complaint and the Annexes to the Complaint.

The Complainant is a fashion retail company primarily operating online.

The Complainant is the owner of several trade marks for FASHION NOVA including the following:

- USPTO Trade Mark FASHION NOVA Registration No. 4785854 in International Class 25, registered on August 4, 2015 ; and
- International Trade Mark FASHION NOVA Registration No. 1377383 in International Class 25, registered on October 24, 2017.

The Complainant is also the owner of several domain names reflecting its trade mark including <fashionnova.com>.

The Domain Name was registered on March 3, 2022. The Domain Name resolves to a website purporting to offer for sale women fashion clothing.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the FASHION NOVA trade mark in which the Complainant has rights as the Domain Name only differs from the FASHION NOVA trade mark by the addition of one character following the exact trade mark of the Complainant. The Complainant also asserts that the addition of the generic Top-Level Domain ("gTLD") ".club" could enhance confusion.

The Complainant asserts that the Respondent cannot claim it is commonly known by a name that includes "fashion nova" and therefore cannot possibly assert a defense based on fair use of the name. The Complainant adds that neither the Complainant, nor anyone acting on its behalf, has ever authorized the Respondent to use the FASHION NOVA trade mark in connection with the sale or promotion of any goods or services. Finally, the Complainant argues that the Domain Name is merely used in an attempt by the Respondent to pass itself off as the Complainant as the associated website reproduces the FASHION NOVA trade mark of the Complainant and purports to offer for sale women fashion clothing.

The Complainant contends that the Respondent registered the Domain Name in order to intentionally attempt to attract users to its website for commercial gain, by creating a likelihood of confusion with the FASHION NOVA trade mark as to the source, sponsorship, affiliation, and/or endorsement of the website accessible at the Domain Name.

B. Respondent

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

6. Discussion and Findings

In order to prevail the Complainant must substantiate that the three elements of paragraph 4(a) of the Policy have been met, namely:

(i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

In the case of default by a party, as is the case here, paragraph 14(b) of the Rules makes it clear that if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

In the absence of a Response from the Respondent whereby the Respondent did not object to any of the contentions from the Complainant, the Panel will have to base its decision on the basis of the Complaint and supporting Annexes.

A. Identical or Confusingly Similar

In light of the evidence provided by the Complainant, the Panel is satisfied that the Complainant has substantiated that it holds valid trade mark rights in FASHION NOVA.

The second point that has to be considered is whether the Domain Name is identical or confusingly similar to the trade mark FASHION NOVA in which the Complainant has rights.

At the second level, the Domain Name consists of the term “fashionnovaa”. The Panel finds that upon carrying out a side-by-side comparison of the Domain Name and the textual components of the trade mark FASHION NOVA, the Domain Name is confusingly similar to the Complainant’s trade mark. The only difference is the addition of the letter “a” at the end of the Complainant’s trade mark. The Panel finds that this one character difference between the trade mark FASHION NOVA and the Domain Name does not dispel the confusing similarity between the Complainant’s trade mark and the Domain Name.

Then there is the addition of the gTLD “.club”. As is widely accepted, the addition of a gTLD such as “.club” is merely a technical registration requirement and as such is typically disregarded under the first element confusing similarity test.

Thus, the Panel finds that the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out relevant circumstances that could demonstrate that a respondent has rights or legitimate interests in a domain name, namely:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent’s] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to [the respondent] of the dispute, [the 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) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trademark or service mark rights; or

(iii) [the 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 trade mark or service mark at issue.”

Numerous previous panels have found under the UDRP that once a complainant makes a *prima facie* showing that the respondent does not have rights or legitimate interests in a domain name, the burden of production shifts to the respondent to rebut the showing by providing evidence of its rights or legitimate interests in the domain name.

Having reviewed the Complainant’s assertions and evidence, the Panel is satisfied that the Complainant has made a *prima facie* showing that the Respondent does not have rights or legitimate interests in the Domain Name.

The Complainant has stated that it has not authorized the Respondent to make any use of its trade mark. There is no evidence that the Respondent is commonly known by the Domain Name especially given that the Respondent chose not to respond.

The Domain Name is currently used to direct to a website that purports to sell products competing with the Complainant’s products. This use of the Domain Name cannot be seen as a legitimate noncommercial or fair use of the Domain Name nor can it be seen as a *bona fide* offering of goods or services. The Panel is satisfied that the Respondent is using the Domain Name to exploit the goodwill of the Complainant’s trade mark, with an intent for commercial gain and to misleadingly divert consumers.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a number of relevant non-exhaustive circumstances, which can be deemed to constitute evidence of registration and use of a domain name in bad faith, namely:

(i) circumstances indicating that [the respondent has] registered or acquired [a disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark 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 trade mark 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 [the respondent’s] website 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 [the respondent’s] website or location or of a product or service on [the respondent’s] website or location.

Given the circumstances described in the Complaint and the documentary evidence provided by the Complainant, the Panel finds that the Domain Name was registered in bad faith.

The Domain Name is confusingly similar to the trade mark FASHION NOVA of the Complainant and this cannot be a coincidence.

The Complainant has substantiated that the trade mark FASHION NOVA is registered in many jurisdictions and has acquired significant visibility on the Internet including on social media. The Respondent has registered the Domain Name in order to create a website purporting to sell products of the type the Complainant sells. In light of this, the Panel finds it inconceivable that the Respondent would not have been well aware of the Complainant and its trade mark at the time of registration of the Domain Name. The Panel finds that when registering the Domain Name, the Respondent had the Complainant's trade mark in mind and targeted it specifically.

Thus, the Panel finds that the Domain Name was registered in bad faith.

As for use of the Domain Name in bad faith, given the circumstances described in the Complaint, the documentary evidence provided by the Complainant and the brief verification carried out by the Panel of the website associated with the Domain Name, the Panel is satisfied that the Domain Name is being used in bad faith.

The Domain Name is being used to direct to a website purporting to sell products of the type the Complainant sells and reproducing the Complainant's FASHION NOVA trade mark, including as part of the website's copyright notice. The Panel thus considers that by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of a product on the Respondent's website.

The fact that the Respondent chose not to object to the Complainant's assertions can only reinforce the Panel's view that the Domain Name is being used in bad faith.

Thus, the Panel finds that the Domain Name is being used in 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 Domain Name <fashionnovaa.club> be transferred to the Complainant.

/Vincent Denoyelle/

Vincent Denoyelle

Sole Panelist

Date: August 8, 2022