

ADMINISTRATIVE PANEL DECISION

Lane Bryant Ipco LLC v. Blue Face
Case No. D2022-2682

1. The Parties

Complainant is Lane Bryant Ipco LLC, United States of America (“U.S.”), represented by Fross Zelnick Lehrman & Zissu, P.C., U.S.

Respondent is Blue Face, U.S.

2. The Domain Name and Registrar

The disputed domain name <lanebryantonlineshop.com> (the “Disputed Domain Name”) is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 21, 2022. On July 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 25, 2022, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on July 26, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 29, 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 Respondent of the Complaint, and the proceedings commenced on August 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 21, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on August 22, 2022.

The Center appointed Douglas M. Isenberg as the sole panelist in this matter on August 26, 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 states that it is a "a retail entity focused on plus size women's fashions and accessories"; that it "currently operates more than 500 LANE BRYANT and LANE BRYANT OUTLET stores"; and that it "also offers its products for sale through its website, 'www.lanebryant.com', which has averaged more than 8 million visitors per month to date in 2022."

Complainant states, and provides documentation in support thereof, that it is the registrant of "a large number of" registrations for the mark LANE BRYANT around the world, including U.S. Reg. No. 1,363,867 for LANE BRYANT (first used in commerce 1911; registered October 1, 1985) for use in connection with "retail women's clothing store services." These registrations are referred to herein as the "LANE BRYANT Trademark."

The Disputed Domain Name was created on September 20, 2021, and according to the evidence submitted with the Complaint, is being used in connection with a website that Complainant describes as one that "closely mimics Complainant's own <https://www.lanebryant.com/> website." Screenshots of Respondent's website provided by Complainant show images of size fashion" items for sale, and Complainant states that "[a]ll of the product listings on the website associated with the Domain Name use images exclusively copied from Complainant's own website."

5. Parties' Contentions

A. Complainant

Complainant contends, in relevant part, as follows:

- The Disputed Domain Name is confusingly similar to the LANE BRYANT Trademark because, *inter alia*, the Disputed Domain Name "incorporates Complainant's LANE BRYANT mark in its entirety" and "the addition of descriptive terms – such as the terms 'online' and 'shop' – does not alleviate any confusion between the Domain Name and Complainant's registered LANE BRYANT trademark."
- Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, *inter alia*, "Respondent's website unquestionably trades on the fame of the LANE BRYANT mark and as such could not constitute a *bona fide* use"; "there is no relationship between Complainant and Respondent that would give rise to any license, permission, or authorization by which Respondent could own or use the Domain Name or operate a website that mimics Complainant's own website"; and "even if the goods being sold at Respondent's website are genuine LANE BRYANT merchandise (and there is no evidence that this is the case), Respondent's use of the Domain Name would still not be *bona fide*" because "for a reseller 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 the Respondent's relationship with the trademark owner."

- The Disputed Domain Name was registered and is being used in bad faith because, *inter alia*, “[s]ince Respondent has no connection with Complainant and has never been authorized by Complainant to use or register the Domain Name, the very fact that Respondent has registered the Domain Name establishes opportunistic bad faith use and registration”; “[g]iven the fame of Complainant’s LANE BRYANT mark and the fact that the website associated with the Domain Name is passing itself off as a website of Complainant’s, consumers are likely to believe, mistakenly, that the Domain Name is related to or associated with Complainant”; “Respondent is a serial cybersquatter, having lost at least nine previous UDRP disputes”; and “the Domain Name is being used in connection with a website that mimics Complainant’s own and further use Complainant’s own product images without authorization.”

B. Respondent

Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

Pursuant to the Policy, Complainant is required to prove the presence of each of the following three elements to obtain the relief it has requested: (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 has been registered and is being used in bad faith. Policy, paragraph 4(a).

A. Identical or Confusingly Similar

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the LANE BRYANT Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the LANE BRYANT Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (*i.e.*, “lanebryantonlineshop”) because “[t]he applicable Top-Level Domain (‘TLD’) 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”. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.11.1.

As set forth in section 1.7 of [WIPO Overview 3.0](#): “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.” Further, as set forth in section 1.8 of [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.”

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

B. Rights or Legitimate Interests

Complainant has argued that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, *inter alia*, “Respondent’s website unquestionably trades on the fame of the LANE BRYANT mark and as such could not constitute a *bona fide* use”; “there is no relationship between Complainant and Respondent that would give rise to any license, permission, or authorization by which Respondent could own or use the Domain Name or operate a website that mimics Complainant’s own website”; and “even if the goods being sold at Respondent’s website are genuine LANE BRYANT merchandise (and there is no evidence that this is the case), Respondent’s use of the Domain Name would still not be *bona fide*” because “for a reseller 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 the Respondent's relationship with the trademark owner".

[WIPO Overview 3.0](#), section 2.1, states: "[w]hile the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its *prima facie* case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in the Policy: (i) circumstances indicating that the registrant has registered or acquired the 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 trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's 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 registrant's website or location or of a product or service on the registrant's website or location. Policy, paragraph 4(b).

As set forth in section 3.1.4 of [WIPO Overview 3.0](#): "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith". Here, given that the LANE BRYANT Trademark has been used for more than a century and is protected by numerous registrations worldwide, it is apparent that the LANE BRYANT Trademark is famous or widely known.

In addition, as numerous decisions under the Policy have made clear, creating a website that appears to be a website for a complainant, as Respondent has done in the instant case, is "likely fraudulent" and "indicates an intent to deceive or, at a minimum, act in bad faith with the intent for commercial gain". *DocuSign, Inc. v. Traffic CPMiPV, Maria Carter*, WIPO Case No. [D2010-0344](#). See also, e.g., *Emu (Aus) Pty Ltd. and Emu Ridge Holdings Pty Ltd. v. Antonia Deinert*, WIPO Case No. [D2010-1390](#) ("a reasonable person who visited the Respondent's website was likely to be misled in relation to the source, sponsorship, affiliation, or endorsement of the website and the products purportedly made available for online sale on the website").

Finally, as Complainant has noted, Respondent has lost multiple previous decisions under the Policy. As a result, the Panel agrees that Respondent has engaged in a "pattern" of conduct establishing bad faith under paragraph 4(b)(ii) of the Policy.

Accordingly, the Panel finds that Complainant has proven the third element 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, <lanebryantonlineshop.com>, be transferred to the Complainant.

/Douglas M. Isenberg/

Douglas M. Isenberg

Sole Panelist

Date: September 8, 2022