

ADMINISTRATIVE PANEL DECISION

Leg Avenue, Inc. v. Feng Shu
Case No. D2022-4294

1. The Parties

The Complainant is Leg Avenue, Inc., United States of America (“United States”), represented by Nolan Heimann LLP, United States.

The Respondent is Feng Shu, China.

2. The Domain Name and Registrar

The disputed domain name <legavenuesale.com> (the “Disputed Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 11, 2022. On November 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 14, 2022, the Registrar transmitted by email to the Center its verification response confirming that the 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 the Respondent of the Complaint, and the proceedings commenced on November 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 7, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on December 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

The Complainant is a United States based fashion business with online operations that commenced in 1997 and currently include offering its products for sale directly and via United States based retailers Amazon.com, Target.com, and Walmart.com. The Complainant holds a number of registrations for the mark LEG AVENUE including, for example, United States Trademark Registration No. 4612675, registered in class 25 on September 30, 2014.

The Complainant registered the domain name <legavenue.com> in 1997, which it uses for its main e-commerce website.

The Disputed Domain Name <legavenuesale.com> was registered on August 3, 2022. The Disputed Domain Name resolves to a website impersonating the Complainant's official e-commerce website and offering products for sale that resemble those of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant cites its trademark registrations for LEG AVENUE, and variations of it, as *prima facie* evidence of ownership.

The Complainant submits that it has "extensively used in commerce since 1997" the trademark LEG AVENUE and submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the LEG AVENUE trademark and that the similarity is not removed by the addition of the word "sale".

The Complainant contends that the Respondent has no authorized rights or legitimate interests in respect of the Disputed Domain Name and that "the Complainant has owned the registered trademark "Leg Avenue" since 2007 and has used the mark in commerce since 1997." The Complainant also contends that "never granted a license, consented to, or otherwise authorized, the Respondent or anyone else associated with the LEGAVENUESALE.COM to use the Leg Avenue registered trademark."

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules. It submits that "every good that the Respondent's contends to sell at the LEGAVENUESALE.COM is a Leg Avenue branded good and the images use to advertise each good come directly from the Complainant's website" which, it submits, evidences registration and use of the Disputed Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

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

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark LEG AVENUE. The mark LEG AVENUE was registered as a trademark in the United States in fancy form on November 27, 2007 (No. 3343763). The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the LEG AVENUE trademark, the Panel observes that the Disputed Domain Name comprises: (a) an exact reproduction of the Complainant’s LEG AVENUE trademark; (b) followed by the word “sale”; and (c) followed by the generic Top-Level Domain (“gTLD”) “.com”.

It is well established that the gTLD used as technical part of a domain name may be disregarded (see section 1.11.1 of the [WIPO Overview 3.0](#)). The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: “legavenuesale”.

It is also well-established that 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 (see [WIPO Overview 3.0](#), section 1.7).

It has long been held by previous panels that the addition of the word “sale” to a trademark does not preclude a finding of confusing similarity to the Complainant’s trademark (see, for example: *Calvin Klein Inc. and Calvin Klein Trademark Trust v. Papikian Enterprises*, WIPO Case No. [D2001-1301](#)).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden of proof on the Complainant to establish the absence of the Respondent’s rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant needs only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it has not licensed, permitted, or authorized the Respondent to use the Complainant’s trademark or to sell its products and for those reasons, the Respondent is not making a *bona fide* offering of goods or services. The Complainant submits that “[i]t is evident that the Respondent is using Complainant’s Leg Avenue registered trademark to cause consumers to believe that it is affiliated with or an authorized seller of Complainant.”

This Panel accepts that the Respondent is not an authorized reseller with a right or legitimate interest in a domain name incorporating the Complainant’s mark, and there is no disclaimer on the website the Disputed Domain Name resolve to, therefore it cannot meet the tests set out in *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Nor, alternatively, is the Respondent commonly known by the Disputed Domain Name.

The composition of the Disputed Domain Name consists of the Complainant’s trademark and the word “sale”. In this Panel’s view, the conduct indicates an awareness of the Complainant and its mark and intent to take unfair advantage of such, which does not support a finding of any rights or legitimate interests but carry a risk of implied affiliation (see [WIPO Overview 3.0](#), section 2.5.1).

This Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it is engaging in an illegitimate commercial use of the Disputed Domain Name by suggesting some association with the Complainant and misleading consumers who are seeking out the Complainant's mark LEG AVENUE to opportunistically divert Internet traffic to its web page.

The Panel finds for the Complainant on the second element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy that a complainant must also demonstrate is that the domain name in question has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both.

The evidence that the Respondent has registered and used the Disputed Domain Name in bad faith is clear.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the content of the website it resolves to, the Panel is satisfied that the Respondent knew of the Complainant's trademark LEG AVENUE when it registered the Disputed Domain Name.

In addition, the gap of several years between registration of the Complainant's trademark and the Respondent's registration of the Disputed Domain Name, along with the composition of the Disputed Domain Name (containing an exact reproduction of the Complainant's well-known trademark) in the circumstances of this case is a further indicator of bad faith. (See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#)). In this case, the Complainant's rights in its trademark predate any rights that could possibly flow from the Respondent's registration by approximately 15 years.

On the issue of use, the uncontradicted evidence of record is that the Disputed Domain Name was used to resolve to a website bearing images, products, and artwork from the Complainant's genuine online store, and offering what appears to be the Complainant's goods for sale. In line with prior UDRP panel decisions, the Panel finds that this misconduct is an intentional attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (see [WIPO Overview 3.0](#), section 3.1.4).

This Panel finds that the Respondent has taken the Complainant's trademark LEG AVENUE and, along with the word "sale", incorporated it in the Disputed Domain Name without the Complainant's consent or authorization. The Panel finds that the Respondent did so for the purpose of capitalizing on the reputation of the trademark by diverting Internet users for commercial gain to its website which falls into the meaning of bad faith under paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the 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 Name, <legavenuesale.com>, be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: December 27, 2022