

ADMINISTRATIVE PANEL DECISION

Steven Madden, Ltd. v. Chen Changlan

Case No. D2023-0525

1. The Parties

The Complainant is Steven Madden, Ltd., United States of America (“United States”), represented by Ballard Spahr, LLP, United States.

The Respondent is Chen Changlan, China.

2. The Domain Name and Registrar

The disputed domain name <shoe-stevemadden.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 3, 2023. On February 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 7, 2023, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 8, 2023 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 in English on February 13, 2023.

On February 8, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On February 8, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on February 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 7, 2023.

The Center appointed Douglas Clark as the sole panelist in this matter on March 17, 2023. 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 an apparel company founded in 1990. The Complainant provides footwear, clothing, accessories and other goods sold under the mark STEVE MADDEN.

The Complainant owns several registrations for STEVE MADDEN in the United States, including the following:

Trade Mark	Registration Number	Registration Date	Class
STEVE MADDEN	2,012,115	October 29, 1996	25
STEVE MADDEN	4,511,533	April 8, 2014	25
STEVE MADDEN	4,518,492	April 22, 2014	35
	5,691,871	March 5, 2019	25
	2,693,085	March 4, 2003	25
	2,077,735	July 8, 1997	35

The Respondent is an individual based in China.

The disputed domain name <shoe-stevemadden.com> was registered on December 19, 2022. At the date of this Complaint, the disputed domain name resolved to a website displaying the Complainant's mark and purportedly offering the Complainant's footwear products for sale.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

- (a) The disputed domain name is confusingly similar to its trade mark. The disputed domain name wholly incorporates the Complainant's well-known STEVE MADDEN trade mark and preceded by the word "shoe". The generic Top-Level Domain ("gTLD") ".com" in the disputed domain name does not eliminate the overall notion that the designations are connected to the trade mark and the likelihood of confusion that the disputed domain name and the trade mark are associated;

- (b) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant in any way and the Complainant has never granted any authorisation or license to use the Complainant's trade mark. The Respondent is not commonly known by the disputed domain name, and has not made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The website under the disputed domain name purports to be an official Steve Madden store and collects information on customers such as credit card data; and
- (c) The disputed domain name was registered and is being used in bad faith. Based on the use of the disputed domain name, the Respondent registered and is using the disputed domain name to attract Internet users for commercial gain, creating a likelihood of confusion with the Complainant's trade mark.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue – Language of the Proceeding

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In this case, the language of the Registration Agreement for the disputed domain name is in Chinese. Based on the given evidence, there is no agreement between the Complainant and the Respondent regarding the language of the proceeding. The Respondent did not respond as to the language of the proceeding. The Complainant has filed its Complaint in English and has requested that English be the language for the proceeding under the following main grounds:

- a) the Complainant conducts all of its business activities in the English language;
- b) the Complainant has no familiarity with the Chinese language;
- c) the website under the disputed domain name is solely in English; and
- d) in order to proceed in Chinese, the Complainant would have had to retain specialised translation services that would cause an unnecessary burden to the Complainant and delay the proceeding.

In accordance with paragraph 11(a) of the Rules, the Panel hereby determines that the language of the proceeding shall be in English after considering the following circumstances:

- the Center has notified the Respondent in both English and Chinese regarding the language of the proceeding, and the commencement of the proceeding;
- the Respondent has not commented on the language of the proceeding;
- the website under the disputed domain name is in English; and

- an order for the translation of the Complaint will result in significant expenses for the Complainant and a delay in the proceeding.

Further, this Panel decided in *Zappos.com, Inc. v. Zufu aka Huahaotrade*, WIPO Case No. [D2008-1191](#), that a respondent's failure to respond to a preliminary determination by the Center as to the language of the proceeding "should, in general, be a strong factor to allow the Panel to decide to proceed in favour of the language of the Complaint".

6.2 Substantive Issues

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its action:

- (i) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights to;
- (ii) the 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.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name <shoe-stevemadden.com> is confusingly similar to the Complainant's trade mark. The disputed domain name incorporates the STEVE MADDEN trade mark in full preceded by the word "shoe", a hyphen and the gTLD ".com". The gTLD is generally disregarded when considering the first element as it is viewed as a standard registration requirement. (See section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").) The addition of the other term does not prevent a finding of confusing similarity. (See section 1.8 of the [WIPO Overview 3.0](#).)

The Panel notes that while the Complainant has stated in its Complaint that it holds registrations for STEVE MADDEN in many countries, it has only provided details of its registered trademarks in the United States. It did not rely on any registered trademarks in China where the Respondent is located. The ownership of a trademark is generally considered to be a threshold standing issue. The location of the trademark, its date of registration (or first use) and the goods and/or services for which it is registered, are all irrelevant for the purpose of finding rights in a trademark under the first element of the UDRP. These factors may however bear on a panel's further substantive determination under the second and third elements. (See section 1.1.2 of the [WIPO Overview 3.0](#)).

The Complainant has therefore satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Respondent has not asserted any rights or legitimate interests in relation to the disputed domain name.

Section 2.1 of the [WIPO Overview 3.0](#) provides:

"While 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 the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent. Accordingly, the Respondent has no rights or legitimate interests in regard to the disputed domain name.

The Panel notes that the disputed domain name resolves to a page that advertises STEVE MADDEN products. The Complainant in its Complaint did not make a specific allegation that these products were not genuine, although this was implied.

The Panel will therefore consider the matter on the basis the products being sold are genuine. UDRP panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales related to the genuine trademarked goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name if certain conditions are met. In *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), the panel in that case held that to be "*bona fide*" within the meaning of paragraph 4(c)(i) of the Policy, the offering should meet the following requirements:

- The Respondent must actually be offering the goods or services at issue;
- The Respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods;
- The site must accurately disclose the registrant's relationship with the trademark owners; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site; and
- The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

In this case the Respondent does not meet, at least, the third requirement set out above. The website under the disputed domain name does not accurately disclose its relationship with the Complainant, rather it gives the clear impression it is an official STEVE MADDEN website when, in fact, it is not.

Therefore, the Panel finds that the Complainant has made out a *prima facie* case, to which the Respondent has not rebutted.

Moreover, the nature of the disputed domain name is inherently misleading as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. (See section 2.5.1 of the [WIPO Overview 3.0](#)).

The second element of paragraph 4(a) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

Based on the given evidence, the disputed domain name was registered and is being used in bad faith.

The disputed domain name was registered long after the Complainant has registered the STEVE MADDEN trade mark and the use of the Complainant's STEVE MADDEN trade mark cannot be a coincidence. The STEVE MADDEN trade mark is used by the Complainant to conduct its business and the Complainant has used the trade mark for over 25 years. The addition of the word "shoe" in the disputed domain name and the website the disputed domain name resolves to shows that the Respondent is aware of the products the Complainant is selling. The Panel is satisfied that the Respondent was aware of the Complainant and its STEVE MADDEN trade mark when he or she registered the disputed domain name.

The Respondent has registered the disputed domain name to attract Internet users to the website for commercial gain in accordance with paragraph 4(b)(iv) of the Policy. The disputed domain name directs Internet users to an online retail website purportedly selling the Complainant's products. For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under paragraph 4(a) 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 <shoe-stevemadden.com> be transferred to the Complainant.

/Douglas Clark/

Douglas Clark

Sole Panelist

Date: March 31, 2023