

ADMINISTRATIVE PANEL DECISION

Martha Stewart Living Omnimedia, LP v. mike simon
Case No. D2024-2436

1. The Parties

The Complainant is Martha Stewart Living Omnimedia, LP, United States of America (“United States” or “US”), represented by ESCA Legal, United States.

The Respondent is mike simon, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <marthastewart.shop> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 13, 2024. On June 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 14, 2024, 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 (PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 17, 2024, 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 July 17, 2024.

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 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 24, 2024.

The Center appointed Knud Wallberg as the sole panelist in this matter on July 31, 2024. 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 Martha Stewart Living Omnimedia, LP, who since its inception in 1997, has been a diversified media and merchandising company, spanning the publishing, Internet, broadcasting, and merchandising industries. The Complainant has garnered worldwide attention and enjoys a strong social media presence with a combined 6.3 million Instagram followers between associated accounts.

The Complainant is the owner of numerous trademark registrations consisting in whole or in part of the sign MARTHA STEWART including U.S. Trademark Registration No 6322478, registered on April 13, 2021 for goods in classes 6, 8, 16, 21, 24, 26, and 28; European Union Registration No. 017935491, registered on December 29, 2018, for goods in classes 6, 8, 16, 18, 20, and 21; and United Kingdom Registration No. UK00917935491, registered on December 29, 2018 also for goods in classes 6, 8, 16, 18, 20, and 21.

The Complainant is also the owner of several “MarthaStewart” domain names, including <marthastewart.com>, which hosts the Complainant’s official website.

The disputed domain name <marthastewart.shop>, was registered on April 9, 2024, and it resolves to an active website suggesting to be a sales platform of the Complainant’s MARTHA STEWART products.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that disputed domain name is identical to the Complainant’s MARTHA STEWART trademark since it merely reproduces it in its entirety, and since the generic Top Level Domain (gTLD) “.shop” shall to be disregarded in context of the UDPR.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not authorized the use of the MARTHA STEWART trademarks or any close variation thereof for the Respondent’s use with the disputed domain name, nor is the Respondent a licensee of the Complainant. Furthermore, the disputed domain name resolves to a website that contains content that suggests falsely that the website is the official sales platform of the Complainant’s MARTHA STEWART products or is affiliated or authorized by the Complainant, so the Respondent has not utilized the disputed domain name for any legitimate business purpose, such as including the creation and maintenance of a website in connection with a bona fide offering of goods or services.

The Complainant finally contends, that the disputed domain name was registered and is being used in bad faith. As mentioned, the disputed domain name resolves to a website that offers for sale counterfeit products and which has content that directly targets the Complainant’s trademarks by prominently displaying the MARTHA STEWART trademarks on these products. The website specifically makes sales of knives and sunglasses, both of which are popularly sold by the Complainant, bearing the MARTHASTEWART trademarks. Also, the intentional attempt to hide the Respondent’s contact information and the use of a proxy server to commercially exploit the Complainant’s goodwill, further supports a finding of registration in bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

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

- (i) that the disputed domain name registered by the respondent 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.

Paragraph 4(a) of the Policy states that the burden of proving that all these elements are present lies with the Complainant. At the same time, in accordance with paragraph 14(b) of the Rules, 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.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is identical to the Complainant's registered trademark MARTHA STEWART.

The disputed domain name thus comprises the Complainant's MARTHA STEWART trademark in its entirety and the gTLD ".shop" is a standard registration requirement and as such they are generally disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

The Panel finds that the conditions in paragraph 4(a)(i) of the Policy are therefore fulfilled in relation to the disputed domain name.

B. Rights or Legitimate Interests

It is clear from the facts of the case that the Complainant has not licensed or otherwise permitted the Respondent to use its trademark and given the circumstances of this case, the Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent has not produced, and there is no evidence of the types of circumstances set out in paragraph 4(c) of the Policy that might give rise to rights or legitimate interests in the disputed domain name on the part of the Respondent in these proceedings. The disputed domain name resolves to a website on which the Respondent purports to offer genuine MARTHA STEWART products. Not only is there a high risk of implied affiliation caused by the identical replication of the Complainant's MARTHA STEWART mark without modification in the construction of the disputed domain name, but this risk of association is reinforced by the use of the Complainant's mark in connection with products that purport to be offered on the website. The fact that the Respondent also purports to offer a few other products on the said website, does clearly not support a claim to rights or legitimate interests. See sections 2.5.1 and 2.5.3 of the [WIPO Overview 3.0](#).

The Panel recognizes that there may be some limited situations where the registration and use of domain names that specifically refer to and incorporate the trademark of another entity may serve legitimate purposes, cf. section 2.8.1 of the [WIPO Overview 3.0](#), but the requirements of the so called “Oki Data test” are clearly not met in this case.

Consequently, the Panel finds that the condition in paragraph 4(a)(ii) of the Policy is also fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the Complainant to prove both registration and use of the disputed domain name in bad faith. Paragraph 4(b) of the Policy provides examples of circumstances which shall be evidence of registration and use in bad faith:

(i) circumstances indicating that [the Respondent has] registered or has 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 [Respondent’s] documented out-of-pocket costs directly related to the domain name; or

(ii) [the Respondent have] 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 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 online 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.

Accordingly, for the Complainant to succeed, the Panel must be satisfied that the disputed domain name has been registered and is being used in bad faith.

Given the circumstances of the case, in particular the distinctiveness and well-established reputation of the Complainant’s trademark MARTHA STEWART, and the content of the Respondent’s website to which the disputed domain name redirects, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant’s mark. Further, the Panel finds that the Respondent could not have been unaware of the fact that the disputed domain name it chose could attract Internet users in a manner that is likely to create confusion for such users. Moreover, the mere registration of a domain name that is identical to a well-known trademark by an unaffiliated entity may by itself create presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name resolves to a website that purports to sell a number of the Complainant’s products, and which gives the impression of being an official website of the Complainant. Such use is clearly likely to disrupt the business of the Complainant and to create 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”, and this use thus constitutes bad faith use under the Policy.

Noting that the disputed domain name incorporates a well-known trademark, that the Respondent has failed to participate in these proceedings, that there appears to be no conceivable good faith use that could be made by the Respondent of the disputed domain name and considering all the facts and evidence, the Panel

finds that the requirements of paragraph 4(a)(iii) of the Policy are also fulfilled in this case.

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 <marthastewart.shop> be transferred to the Complainant.

/Knud Wallberg/

Knud Wallberg

Sole Panelist

Date: August 16, 2024