

ADMINISTRATIVE PANEL DECISION

YZ Productions, Inc. v. zengyi xu, SOUFEEL JEWELRY LIMITED
Case No. D2022-2302

1. The Parties

The Complainant is YZ Productions, Inc., United States of America (“United States”), represented by AESTHETIC LEGAL, United States.

The Respondent is zengyi xu, SOUFEEL JEWELRY LIMITED, China.

2. The Domain Name and Registrar

The disputed domain name <rebeccazamolomerc.shop> (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 24, 2022. On June 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 28, 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 29, 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 amendment to the Complaint on July 1, 2022.

The Center verified that the Complaint together with the amendment to 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 July 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 3, 2022.

The Center appointed Willem J. H. Leppink as the sole panelist in this matter on August 11, 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 following facts are undisputed.

The Complainant, based in Encino, California, United States, is a multimedia production company that designs, creates and distributes multimedia content. The Complainant's content is uploaded on the platforms of, amongst others, YouTube and TikTok. Some of the Complainant's most popular channels and most viewed videos feature Rebecca Zamolo modeling and displaying her own Rebecca Zamolo branded clothing. The Complainant also owns and operates an online e-commerce site selling clothing, stickers and cosmetics

The Complainant is *inter alia* the owner of the United States trademark, REBECCA ZAMOLO (word mark), with registration no. 6090463 and with a registration date of December 5, 2019, for goods and services in classes 3, 16, 25 and 41 (hereinafter also referred to as "Trademark").

The Domain Name was registered on April 7, 2022. The website to which the Domain Name resolves ("Website"), offers all kinds of merchandise, such as hoodies, t-shirts, posters, and wall clocks, for sale, whilst using and referring to the Trademark.

5. Parties' Contentions

A. Complainant

The Complainant contends the following:

The Domain Name is identical or at least confusingly similar to the Trademark. More specifically, the Domain Name encompasses the Trademark in its entirety and only adds the descriptive term "merch". Therefore, the Trademark is sufficiently recognizable within the Domain Name. Moreover, the use of a different domain name extension like ".shop" instead of ".com", which the Complainant uses for its own domain name <rebeccazamolo.com>, cannot lead to a different conclusion other than that the Domain Name is identical or confusingly similar to the Trademark.

The Respondent has no rights or legitimate interests in regard to the Domain Name. The Respondent is not commonly known by the Domain Name and is not affiliated with the Complainant in any way. Whereas, the Respondent has not secured a license from the Complainant to use the Trademark. Nor has the Respondent obtained any other authorization from the Complainant. Furthermore, the Respondent uses the Website to offer merchandize that clearly makes use of the Trademark. The Respondent is, thus, intentionally diverting users to its own Website that offers goods that are in direct competition with those of the Complainant. Such use cannot constitute a *bona fide* offering of goods and services.

Additionally, the Domain Name was registered and is being used in bad faith. The circumstances indicate that Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Website, by creating a likelihood of confusion with the Trademark as to the source, sponsorship, affiliation, or endorsement of the Website. The Respondent is using the Domain Name, to direct Internet users to the Website, on which the Respondent offers and advertises goods identical in nature to those offered by the Complainant.

It is moreover clear that the Respondent registered the Domain Name with the Trademark in mind in light of the obvious link between the Complainant and the goods advertised on Website. The Website also features pictures of content creator Rebecca Zamolo. Therefore, the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of the Complainant.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements:

(i) the Domain Name is identical or confusingly similar to a trademark 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.

A. Identical or Confusingly Similar

The Complainant has sufficiently proven to have rights in the Trademark.

The Domain Name is comprised of the REBECCA ZAMOLO Trademark in its entirety, to which the Respondent solely added the term "merch". The Panel, therefore, finds that the Domain Name is confusingly similar to the relevant Trademark.

As set out in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, the addition of other terms, such as "merch" (short for merchandising), would not prevent a finding that a domain name is confusingly similar to the relevant trademark for purposes of the first element.

The use of the Top Level Domain ("TLD") ".shop" does not lead to any other conclusion. In accordance with section 1.11 of the [WIPO Overview 3.0](#), the TLD is in principle disregarded under the first element.

Hence, the Panel is satisfied that the first element of the Policy is met.

B. Rights or Legitimate Interests

The Complainant in its Complaint and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name.

The Panel could not find any evidence by referring to the types of evidence set forth in paragraph 4(c) of the Policy from which the Panel might conclude that the Respondent has rights or legitimate interests in the Domain Name, such as:

(i) use or preparation to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods and services prior to notice of the dispute; or

(ii) being commonly known by the Domain Name (as an individual, business or other organization) even if the Respondent has not acquired any trademark or service mark rights; or

(iii) making legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or tarnish the trademark or service mark at issue.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent in order to demonstrate that it has rights or legitimate interests in the Domain Name. However, the Respondent has not presented evidence of any such rights or legitimate interests it may have in regard to the Domain Name, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

In more detail, the Complainant has asserted that the Respondent cannot be commonly known by the Domain Name. In addition to this, the Respondent has not been licensed or otherwise permitted by the Complainant to use the Trademark.

The Respondent has also not put forward any evidence that would support the claim that the Respondent has used or made preparations to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods and services.

To the contrary, the Respondent uses the Website to offer products for sale identifying these products as Rebecca Zamolo products and thus using the Trademark. In addition, the Trademark is used all over the website. There is no mention of any party being responsible as operator of the Website, except for a copyright notice “© 2022, rebeccazamolomerc.shop”. Moreover, the Website mentions “We are Official Rebecca Zamolo Merch Apparel & Collectibles”.

Certainly lacking a Response, the Panel finds that the Website creates the impression of being an official website affiliated to the Complainant. The Website can even be regarded as an impersonation of the Complainant. In accordance with [WIPO Overview 3.0](#), section 2.5.1 the use of the Domain Name cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant.

The Complainant has not alleged that the products offered for sale on the Website are genuine or counterfeit. Nonetheless, even if the products are not counterfeit and the Respondent considered itself to be a reseller or distributor of the Complainant’s products, the Respondent has not satisfied all of the requirements set forth in the so-called “Oki Data test”. Whereas, the Website does not accurately and prominently disclose the Respondent’s relationship with the Complainant.

Hence, the Respondent’s use cannot be considered a legitimate noncommercial or fair use of the Domain Name either.

The Panel, therefore, finds that the second element has been satisfied.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent has registered and used the Domain Name in bad faith and refers to its considerations under section 6.B. above.

In light of the evidence filed by the Complainant, the Panel finds that the Complainant’s Trademark and activities are well-known. The Respondent has not rebutted that the Complainant’s YouTube channel, that features Rebecca Zamolo, has roughly 12.6 million subscribers and the videos that are uploaded on the YouTube channel enjoy many (monthly) views.

It is beyond any doubt that the Respondent clearly had the Complainant in mind when registering and using the Domain Name as the Website offers for sale products that clearly relate to the influencer Rebecca Zamolo, as also images of her are being used.

As such, the Respondent has registered and is using the Domain Name to intentionally attract Internet users for commercial gain to its website by creating a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation or endorsement of the Website or the products that are being offered for sale on the Website.

Finally, although the lack of a formal or substantive response by the Respondent as such cannot by itself lead to the conclusion that there is registration and use in bad faith, the cumulative circumstances as outlined in the Decision are sufficient for the Panel to find that the registration and use of the Domain Name by the Respondent is in bad faith.

In light of the above circumstances, the Panel is satisfied that the third element of the Policy is met and that the Domain Name has been registered and 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 <rebeccazamolomerc.h.shop> be transferred to the Complainant.

/Willem J. H. Leppink/

Willem J. H. Leppink

Sole Panelist

Date: August 16, 2022