

ADMINISTRATIVE PANEL DECISION

AS IP Brands LLC v. Blue, Blue Face
Case No. D2022-2442

1. The Parties

Complainant is AS IP Brands LLC, United States of America (“United States”), represented by Kelley Drye & Warren, LLP, United States.

Respondent is Blue, Blue Face, United States.

2. The Domain Name and Registrar

The disputed domain name <theashleystewartshop.com> 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 5, 2022. On July 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 7, 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 12, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 14, 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 July 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 9, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 12, 2022.

The Center appointed Clark W. Lackert as the sole panelist in this matter on August 24, 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 promotes and sells a wide array of high-quality and size-inclusive apparel, such as shirts, dresses, skirts, blouses, sweaters, graphic t-shirts, short-sleeved and long-sleeved shirts, swimwear, underwear, lingerie, and related goods and services, including without limitation, jewelry, hair accessories, handbags, hats, eyewear, belts, scarves, tights, socks, footwear, other accessories, and retail store and online retail store service using its ASHLEY STEWART trademark and service mark. Since at least as early as 1991, Complainant has continuously used the trademark and service mark ASHLEY STEWART, used alone or with other words and/or designs, in connection with the promotion and sale of its goods and services. Since at least as early as 2005, Complainant has adopted and used the following variations of Complainant's ASHLEY STEWART trademark combining the ASHLEY STEWART trademark with a design comprised of the letters "A" and "S": (the "Horizontal AS Logo") and (the "Vertical AS Logo") (collectively all of the above-referenced marks "ASHLEY STEWART Marks").

Complainant is the exclusive owner of all rights, title, and interest in and to the ASHLEY STEWART Marks, which are the subject of trademark registrations around the world, including valid and subsisting United States trademark registrations for ASHLEY STEWART (Reg. Nos. 2,046,868, registered March 25, 1997, and 3,076,982, registered on April 4, 2006), European Union trade Mark registrations for ASHLEY STEWART (Reg. Nos. 014975676, registered on June 10, 2016, and 014976492, registered on May 30, 2022), and United Kingdom registration for ASHLEY STEWART (Reg. Nos. UK00914975676, registered on June 10, 2016, and UK00914976492, registered on May 30, 2016), as well as other registrations for the ASHLEY STEWART Marks in the United States, European Union, and worldwide.

Complainant's ASHLEY STEWART Marks have been featured prominently in connection with the promotion and sale of Complainant's goods and services related marketing and promotional materials for decades. Complainant has expended significant time and money in promoting its goods and services in connection with the ASHLEY STEWART Marks, and has generated millions of USD in revenue as a result of its sales of its goods and services. ASHLEY STEWART brand products have an active presence on the Internet, including at the domain name <ashleystewart.com>, which resolves to Complainant's retail website devoted to the promotion and sale of products from Complainant around the world.

The disputed domain name was registered on November 21, 2021. The disputed domain name resolves to a website that allegedly offers the Complainant's trademarked goods.

5. Parties' Contentions

A. Complainant

The disputed domain name is nearly identical and confusingly similar to Complainant's registered trademarks for its ASHLEY STEWART Marks in which Complainant has exclusive rights and has used for many years in connection with the promotion and sale of clothing, apparel, accessories, and jewelry, the offering of retail store services featuring such products, and related goods and services. The addition of non-distinctive terms such as "the" and "shop" to the trademark does not add any distinguishing character to the disputed domain name to avoid confusing similarity.

Respondent has no rights or legitimate interest in the disputed domain name. The disputed domain name is not the trade name or company name of Respondent, Respondent is not commonly known by that name, is not a licensee of Complainant, and is not otherwise authorized to use Complainant's ASHLEY STEWART

Marks. By registering the disputed domain name, which contains the entirety of Complainant's well-known ASHLEY STEWART trademark and is confusingly similar to Complainant's ASHLEY STEWART Marks, Respondent's sole intention was clearly to benefit financially from, and/or unlawfully trade upon, the renown associated with Complainant's trademarks.

The disputed domain name was registered and is being maintained in bad faith. The ASHLEY STEWART Marks are well-known by virtue of the excellence of Complainant's goods and services, and its long-standing use, extensive promotion, advertising and unsolicited publicity relating to its ASHLEY STEWART Marks and related goods and services. Complainant has established a valuable reputation and has achieved enormous goodwill of immeasurable value in the ASHLEY STEWART Marks. The disputed domain name currently resolves to an imposter website that is confusingly similar to Complainant's website and purports to promote and offer goods that are the same or related to the goods and services offered under the ASHLEY STEWART Marks, without Complainant's authorization or consent. The website at the disputed domain name also copies proprietary copyrighted content from Complainant's website, including without limitation product and model photographs featured on Complainant's website located at "www.ashleystewart.com", all without authorization or consent from Complainant. Upon information and belief, the products being promoted for sale at the website of the disputed domain name are either counterfeit or otherwise unauthorized by Complainant. On June 30, 2022, counsel for Complainant filed a Notification of Infringement pursuant to the United States Digital Millennium Copyright Act (the "DMCA Takedown Notice") with Respondent's hosting provider, Istanbuldc Veri Merkezi Ltd Sti ("IVMLS"), regarding Respondent's unauthorized use of Complainant's intellectual property, including the ASHLEY STEWART Marks and copyrighted content from Complainant's marketing videos, on the website at the disputed domain name. To date, counsel for Complainant has not received a response from IVMLS.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

The Panelist has reviewed the Complaint, all supporting evidence, and the proceeding history as set forth in the record. The Panelist notes that no response has been filed in this proceeding, and that the record supports a decision in Complainant's favor.

A. Identical or Confusingly Similar

By virtue of the registrations listed in section 4 above, the Panel finds that Complainant has established trademark rights in the ASHLEY STEWART Marks.

It is well established that the addition of terms, such as "the" or "shop", to a domain name does not prevent confusing similarity where the trademark remains recognizable. See, e.g., *ASOS PLC et al. v. Liu Bing*, WIPO Case No. [D2022-0604](#) (transferring the domain name <missselfridgeshop.com> because "the term 'shop' is merely a descriptive term and thus does not prevent a finding of confusing similarity" with Complainant's MISS SELFRIDGE trademark); *Skorpio Ltd. v. Li Huaiqing*, WIPO Case No. [D2022-0538](#) (transferring the domain name <therickowenshop.com> because "The addition of the terms 'the' and 'shop' does not therefore prevent the disputed domain name from being confusingly similar to the Complainant's trademark (RICK OWENS)"); *AMI Paris v. Grifitse*, WIPO Case No. [D2022-0362](#) (finding the domain name <amiclothingfr.shop> confusingly similar to Complainant's AMI trademark for a French clothing company because the "addition of the word 'clothing'... does nothing material to detract from the fact that the dominant feature of Complainant's mark is clearly recognizable in the domain name"), and many others. The disputed domain name incorporates Complainant's ASHLEY STEWART Marks in its entirety, coupled with the terms "the" and "shop", and therefore is confusingly similar to Complainant's ASHLEY STEWART Marks.

The Panelist finds that the requirements of paragraph 4(a)(i) of the Policy have been satisfied.

B. Rights or Legitimate Interests

Respondent has defaulted and therefore introduced no evidence of rights or legitimate interests.

Given the prior use and promotion by Complainant of its ASHLEY STEWART Marks for many years before the disputed domain name was registered, and the fact that the disputed domain name resolves to an imposter website that copies Complainant's proprietary copyrighted content from its legitimate website, there is no doubt that Respondent's use of the disputed domain name was not a *bona fide offering* of goods or services, and that it did so for illegitimate purposes. See, e.g., *Royal Bank of Scotland v. Milner*, WIPO Case No. [D2012-1724](#) (finding Respondent had no rights or legitimate interests in the disputed domain name <online-rbs.com> where it consisted of a well-known mark and registrant had no plausible connection to Complainant); *Kylie Jenner, Inc. v. Kappel*, WIPO Case No. [D2021-2082](#) (finding Respondent lacked rights or legitimate interests in <kyliecosmetics.shop> where Respondent used the domain name "for the purpose of deriving unfair monetary advantage by confusing Internet users and leading them to believe that the site to which the disputed domain name relates is an official site of the Complainant"); *Karen Millen Fashions Ltd. v. Belle Kerry*, WIPO Case No. [D2012-0436](#) (concerning the domain name <karenmillenonline-australia.com> explaining that sales of counterfeit goods are "powerful evidence that Respondent lacks rights or a legitimate interest in the use of the domain name because there can be no legitimate interest in the sale of counterfeit goods"), and various other related decisions.

While UDRP panels have recognized that resellers, distributors, or service providers using a domain name containing a complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide offering* of goods and services, the criterion established in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), provide the necessary guidance in determining such fair use. Here, the disputed domain name contains the entirety of Complainant's trademark between the terms "the" and "shop", giving the false impression that the website is an authorized source for Complainant's goods. Moreover, the risk of implied affiliation is exacerbated given the impersonating nature of the content found at the disputed domain name, which neither disclaims the lack of relation to Complainant and also falsely cites copyright to content that has been copied from Complainant's genuine website. Irrespective of whether the nature of the goods are counterfeit, the nature and use of the disputed domain name do not amount to a *bona fide offering* nor establish Respondent's rights or legitimate interests in the disputed domain name.

The Panelist finds that the requirements of paragraph 4(a)(ii) of the Policy have been satisfied.

C. Registered and Used in Bad Faith

The disputed domain name was used and registered in bad faith for a number of reasons. Given the extensive and long-standing use and promotion of Complainant's ASHLEY STEWART Marks since as early as 1991, and the fact that the disputed domain name resolves to an imposter site which purports to offer goods and services identical or confusingly similar to the goods and services offered in connection with Complainant's ASHLEY STEWART Marks, Respondent was undoubtedly aware of Complainant's rights in the ASHLEY STEWART Marks at the time the disputed domain name was registered on November 21, 2021. See, e.g., *Elite Licensing Co. v. PrivacyProtect.org*, WIPO Case No. [D2010-1441](#) (regarding <elite-model.com>, the panel found bad faith use and registration because the domain name "totally reproduce[d] Complainants' well-known trademarks" and it was "highly unlikely that the Respondent would have been unaware of the Complainants' pre-existing rights in their trademarks when registering the disputed domain name"). Respondent has attempted to attract visitors to Respondent's website by creating a likelihood of confusion with Complainant's ASHLEY STEWART Marks as to the source, sponsorship, affiliation, or endorsement of the disputed domain name for its own commercial gain, by copying the look and feel on Complainant's website in addition to its copyrighted content. Bad faith can be found when the attendant website copies the legitimate website. See, e.g., *Anchor Drilling Fluids USA, Inc. v. anchordf, anchor drills*, WIPO Case No. [D2012-0385](#) (regarding <anchordf.com>, the panel found evidence of

registration and use in bad faith where the disputed domain name “was used for a website which was plainly intended to mimic the Complainant’s genuine website”); Finally, the sale of counterfeit goods by the Respondent is itself evidence of bad faith. See, e.g., *Karen Millen Fashions Limited v. Belle Kerry*, WIPO Case No. [D2012-0436](#) (concerning <karenmillenonline-australia.com>, the panel found that “Respondent’s conduct in registering the disputed domain name and offering for sale counterfeit branded merchandise via Respondent’s website, all without authorization, approval, or license of Complainant, amounts to bad faith registration and use under paragraph 4(b)(iv) of the Policy”); *Richemont Int’l S.A. v. Admin Domain, Domain Admin*, WIPO Case No. [D2012-0032](#) (concerning <cartierjewelrystore.com> and related domain names, the panel found bad faith use and registration where respondent used the disputed domain name “in relation to the sale via the Internet of counterfeit goods, or goods from competing luxury goods businesses”).

The Panelist finds that the requirements of paragraph 4(a)(iii) of the Policy have been satisfied.

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 <theashleystewartshop.com> be transferred to Complainant.

Clark W. Lackert

Clark W. Lackert

Sole Panelist

Date: September 5, 2022