

ADMINISTRATIVE PANEL DECISION

Madewell Inc. v. Qin Zhang
Case No. D2022-3204

1. The Parties

The Complainant is Madewell Inc., United States of America (“United States”), represented by Cowan, Liebowitz & Latman, PC, United States.

The Respondent is Qin Zhang, China.

2. The Domain Name and Registrar

The disputed domain name <themadewell.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 August 29, 2022. On August 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 1, 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 September 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 23, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on October 3, 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 subsidiary of United States multinational fashion business J. Crew Group LLC and an affiliate of J. Crew International, Inc. The Complainant's sales associated with the MADEWELL brand in 2018 exceeded USD 529 million. The Complainant holds a number of registrations for the mark MADEWELL including, for example, United States Trademark No. 0,968,685, registered in class 25 on September 18, 1973.

The Complainant owns the domain name <madewell.com>, where its e-commerce website is located.

The Disputed Domain Name <themadewell.com> was registered on May 6, 2022. The Disputed Domain Name resolves to a website impersonating the Complainant's official e-commerce website and offering the Complainant's products for sale.

5. Parties' Contentions

A. Complainant

The Complainant cites its trademark registrations for MADEWELL in various countries as *prima facie* evidence of ownership.

The Complainant submits that the trademark MADEWELL "has developed substantial public recognition and incalculable goodwill" and that its rights in that trademark predate the Respondent's registration of the Disputed Domain Name <themadewell.com>. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the MADEWELL trademark and that the similarity is not removed by the addition of the word "the".

The Complainant contends that the Respondent has no authorized rights or legitimate interests in respect of the Disputed Domain Name and that "the Respondent has no relationship whatsoever to the Complainant (and that) The Respondent has no rights or legitimate interests in the Domain Name because it is not using the Domain Name in connection with any *bona fide* offering of goods and services".

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 in view of the Respondent registering the Disputed Domain Name then using it to resolve to "the Respondent is using the Domain Name to direct traffic to the Respondent's Infringing Website, which features and prominently displays the Complainant's MADEWELL mark in addition to the Complainant's copyrighted material" which 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 MADEWELL. The mark MADEWELL was registered as a trademark in the United States on September 18, 1973 (No. 0,968,685). 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 URDP 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 MADEWELL trademark, the Panel observes that the Disputed Domain Name comprises: (a) the word “the”; (b) followed by an exact reproduction of the Complainant’s MADEWELL trademark; (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: “themadewell”.

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).

This Panel accepts that the addition of the word “the” does not preclude a finding of confusing similarity to the Complainant’s trademark (see, for example: *Telstra Corporation Limited v. Heydon Enterprises*, WIPO Case No. [D2000-1672](#) (“the addition of the definite article does not affect the basic concern about confusing similarity”)).

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 need 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 “the Respondent is using the Domain Name to engage in fraud by exploiting and infringing the Complainant’s trademarks and copyrights, and engaging in fraudulent and phishing activities, all in an apparent attempt to mislead consumers into thinking that the website and Domain Name are authorized by the Complainant, when in fact they are not”.

This Panel accepts that the Respondent is not an authorized reseller with a 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 *Oki 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 definite article “the” and the Complainant’s trademark. 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 (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 MADEWELL 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 disputed 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 MADEWELL 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 some 49 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 MADEWELL 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 MADEWELL and incorporated it in the Disputed Domain Name without the Complainant's consent or authorization, along with the word "the" 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 <themadewell.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: October 10, 2022