

ADMINISTRATIVE PANEL DECISION

The Society Model Management Inc. v. Brady King
Case No. D2024-0024

1. The Parties

The Complainant is The Society Model Management Inc., United States of America (“United States”), represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Brady King, United States, represented by OMNI Legal Group, United States.

2. The Domain Name and Registrar

The disputed domain name <thesocietyfashionweek.com> 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 January 4, 2024. On January 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 5, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 8, 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 January 10, 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 January 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 1, 2024. On January 30, 2024, the Respondent sent an email communication to the Center requesting a four day extension of the deadline to file its Response. In accordance with paragraph 5 (b) of the Rules, the Center notified the Parties of the extension, and the

Response due date was extended to February 5, 2024. The Response was filed with the Center on February 5, 2024. On February 15, 2024, the Complainant sent an unsolicited Supplemental Filing, and the Respondent did not comment on this submission.

The Center appointed Evan D. Brown, Reyes Campello Estebaranz, and Justin Hughes as panelists in this matter on February 21, 2024. The Panel finds that it was properly constituted. Each member of 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 talent management and modeling agency. It owns the mark THE SOCIETY and enjoys the benefits of registration of that mark in the United States (United States Reg. No. 4459660, registered on December 31, 2013), and its affiliate company Elite Licensing Company SAGL owns registrations for the mark in the United Kingdom and in the European Union (EUIPO Reg. No 015829278, registered on February 28, 2017, and UKIPO Reg. No. UK00915829278, registered on February 28, 2017). The Complainant asserts that it has marketed and sold its goods and services under its THE SOCIETY mark since 2011. The Complainant contends that it maintains a strong Internet presence, advertising its services through its primary domain name <thesocietymanagement.com>, registered since April 18, 2012.

The Whois information shows that the disputed domain name was registered on September 13, 2016, and resolves to a website where the Respondent's company promotes and sell tickets for its fashion shows. This website displays the brand THE BUREAU at its heading, but includes the THE SOCIETY mark within its content in several of its sections, and does not inform about its lack of relationship with the Complainant and/or its trademark. This website contains a section for models to submit their requests for providing model services in the organized fashion events. According to the evidence provided by the Complainant, the Respondent's website previously displayed THE SOCIETY mark at its heading.

On October 8, 2019, the Complainant sent a cease and desist letter to the Respondent and the Parties started a negotiation through the exchange of various emails, in one of which, on February 28, 2023, the Respondent agreed to rebrand its business, indicating, "[...] we are dropping the use of 'The Society' per your request. We are in the process of removing such instances of use. If at all possible, I request 45 days to ensure complete rebranding (April 15th, 2023)".

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.

The Complainant contends that it should prevail on the first element of the Policy because it holds registered trademarks for THE SOCIETY mark, satisfying the requirement of having trademark rights. The disputed domain name, which incorporates the Complainant's trademark along with terms closely related to its business, namely "fashion" and "week," results in confusing similarity. Additionally, according to the Complainant, the Respondent's use of the disputed domain name to offer services in direct competition with the Complainant, potentially even impersonating the Complainant, emphasizes the intent to leverage the confusing similarity for commercial gain.

As for the second element under the Policy, the Complainant asserts that (1) the Respondent is not sponsored by or affiliated with the Complainant in any way, (2) the Complainant has not given the Respondent permission to use the Complainant's trademarks in any manner, including in domain names, (3) the Respondent is not commonly known by the disputed domain name, (4) the Respondent is not making a

bona fide offering of goods or services or legitimate, noncommercial fair use of the disputed domain name, but instead is offering competing services using the Complainant's mark in a confusingly similar domain name, and (5) there is no legitimate reason for the Respondent to still use the disputed domain name, following the Respondent's rebranding.

And as for the third UDRP element, the Complainant asserts that the Respondent was aware of the Complainant's THE SOCIETY trademark, which has been in use since 2011, predating the Respondent's registration of the disputed domain name in 2016. The Complainant argues that the Respondent's registration of the disputed domain name, which fully incorporates the Complainant's trademark, together with use of the disputed domain name to set up a website for competing fashion services indicates a clear intention to mislead and profit from the Complainant's established reputation. This is further evidenced by the Respondent's actions at New York Fashion Week, where the Respondent is alleged to have prominently used the Complainant's trademark in a marketing campaign, making it implausible that the Respondent was unaware of the Complainant's brand at the time of the disputed domain name's registration. The continued use of the Complainant's trademark in the disputed domain name and website content, despite cease and desist communications from the Complainant and a partial rebranding attempt by the Respondent, along with the use of a privacy service to hide the Respondent's identity, further solidifies the claim of bad faith registration and use by the Respondent. The Respondent is currently using the disputed domain name to showcase its fashion show producing services, and previously used the disputed domain name to impersonate the Complainant.

B. Respondent

The Respondent objects to the Complainant's contentions under the first element of the Policy by stating that the facts of this dispute do not align with the cited holdings of past panels, as the Complainant is a talent management and modeling agency, not involved in producing fashion weeks, which is the Respondent's area of business concern. The Respondent argues that the term "fashion week" does not closely relate to the Complainant's business of scouting models for various fashion events, some of which are produced by the Respondent. Hence, despite the shared use of the word "Society" in the Parties' domain names and brands, the Respondent contends that there is no confusing similarity with the Complainant's trademarks.

As for the second Policy element, the Respondent contends that it provides a significant platform in the fashion industry, primarily supporting emerging designers, independent labels, and creative fashion innovators. Known for organizing and producing major fashion week events globally, including in New York, Paris, Dallas, and Los Angeles, the Respondent asserts that it has built a solid reputation. The platform not only showcases the latest collections of both established and emerging designers to a wide audience comprising press, buyers, stylists, and fashion enthusiasts but has also been engaged in this endeavor for nearly eight years without any prior disputes, until the Complainant recently filed this domain name dispute, aiming to leverage the Respondent's established brand and reputation.

The Respondent asserts that its events extend beyond mere runway shows, offering comprehensive fashion experiences that include networking events, workshops, and after-parties, thereby facilitating significant interactions among designers and industry professionals. This approach not only allows designers to present their work but also fosters potential collaborative opportunities and enhanced brand visibility. The Respondent's partnerships with a diverse range of designers serve to not only showcase creative talent but also integrate The Society Fashion Week's brand into various fashion narratives. Additionally, the Respondent had been using the disputed domain name and the SOCIETY FASHION WEEK mark in connection with its bona fide service offerings related to fashion event production long before the initiation of this dispute, which underscores the legitimacy of its operations and use of the disputed domain name.

Furthermore, in the Respondent's view, its substantial investment in the disputed domain name and corresponding branding efforts, both online and offline, reflect a genuine commitment to providing a bona fide offering of goods and services. The Respondent asserts that this is evidenced by significant investments in website development, marketing, and promotional activities, establishing a strong and

recognizable presence in the fashion industry. The widespread recognition of “Society Fashion Week” across various platforms and the inclusion in renowned publications underscore the Respondent’s established market presence and legitimate interest in the disputed domain name.

Concerning the third element of the Policy, the Respondent asserts that it has legitimate rights in the disputed domain name that are separate and distinguishable from the trademark rights of the Complainant. The Respondent claims that its business is entirely distinct and offers different services from the Complainant’s model management services. This differentiation is bolstered by the unique and established reputations of both parties in their respective fields, making the Respondent’s use of the disputed domain name reasonable and legitimate, thus not infringing on the Complainant’s trademark rights.

Additionally, the Respondent addresses the Complainant’s claim about the disputed domain being registered under an individual’s name, asserting that this does not negate its established brand identity as SOCIETY FASHION WEEK. The Respondent emphasizes its continuous use and promotion of this brand, further supported by business filings and the intention to use the disputed domain name for legitimate service offerings. The Respondent argues against any notions of bad faith in its registration and use of the disputed domain name, noting its independent development and promotion in the fashion industry, distinct from the Complainant’s operations. This, it argues, supports its claim for legitimate rights and interests in the disputed domain name, free from any intent to disrupt the Complainant’s business or to unfairly profit from its trademark.

In addition, the Respondent argues that the Complainant’s significant delay in filing the present Complaint has negatively impacted the Complainant’s ability to establish the required elements under the UDRP, particularly concerning the Respondent’s rights or legitimate interests and the alleged bad faith in registering and using the disputed domain name. This delay has permitted the Respondent to substantially invest in and develop a distinct brand and reputation in the fashion industry around the disputed domain name. The Respondent maintains that this investment and brand-building, conducted in good faith, should not be invalidated due to the Complainant’s inaction.

Furthermore, the Respondent asserts that there was no anticipation of confusion with the Complainant’s brand at the time of registering the disputed domain name, emphasizing its legitimate business use and absence of any intent to exploit the Complainant’s trademarks.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (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. The Panel finds that all three of these elements have been met in this case.

A. Preliminary issue: Complainant’s Unsolicited Supplemental Filing

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the Panel. See section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). In any event, though the Panel has reviewed the Complainant’s supplemental filing, it does not find the matters contained therein to affect its decision in this matter.

B. Identical or Confusingly Similar

This first element functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name. This element requires the Panel to consider two

issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the THE SOCIETY mark by providing evidence of its trademark registrations.

It is standard practice when comparing a disputed domain name to a complainant's trademarks, to not take the extension into account. See [WIPO Overview 3.0](#) at 1.11.1 ("The applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.").

The disputed domain name incorporates the THE SOCIETY mark in its entirety. This is sufficient for showing confusing similarity under the Policy. Although the presence of the additional words "fashion" and "week" may bear an assessment of the second and third elements, the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's THE SOCIETY mark. See [WIPO Overview 3.0](#) at section 1.8..

Accordingly, the Panel finds that the Complainant has satisfied this first element of the Policy.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

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. [WIPO Overview 3.0](#), section 2.1.

The Panel finds the Complainant's assertions under this element – described in Section 5.A. above, establish the Complainant's prima facie case. And nothing in the Respondent's arguments or otherwise in the record tips the balance in the Respondent's favor.

The Panel finds the disputed domain name implies a high risk of confusion. The disputed domain name incorporates THE SOCIETY mark, and, while additional words in a domain name can (in certain cases) reduce the likelihood of confusion, the phrase "fashion week" is closely connected to the commercial activities of the Complainant so, in that context, these words in the disputed domain name are more likely to increase, rather than reduce, the likelihood of confusion. See *Yellow Corporation v. MIC*, WIPO Case No. [D2003-0748](#) ("when a domain name is registered which is a well-known trademark in combination with another word, the nature of the other word will largely determine the confusing similarity"). Furthermore, see [WIPO Overview 3.0](#), section 2.5.1

Additionally, the Panel is not moved by the Respondent's assertions that the Respondent is operating outside the scope of the Complainant's business concern. The sorts of services that the Respondent provides are closely related, similar, and partially coincidental to those services that the Complainant provides, due to the specific section in the Respondent's website for casting models. The Panel does not share in the Respondent's contention that the Respondent's use of the disputed domain name and the mark SOCIETY FASHION WEEK – whether long before the initiation of this dispute as the Respondent asserts, or more recently – establishes a bona fide offering of services by the Respondent. The Complainant appears to

be well known in its respective market space, with trademark registrations in a number of jurisdictions around the world that predate the Respondent's adoption of its marks and the registration of the disputed domain name. The Panel finds it likely that the Respondent either knew about the Complainant when it decided to register the disputed domain name, or at least should have.

The Panel further notes that the Respondent's company Society Fashion Week, LLC was created on March 22, 2018, and, at the time of the registration of the disputed domain name (two years before the creation of this company) nothing in the record indicates the Respondent was commonly known by the terms "the society" or "society fashion week".

Moreover, the Complainant submitted meaningful evidence that the Respondent, at least for a time, used the Complainant's THE SOCIETY mark on the Respondent's website, indicating a possible intention to trade off of the goodwill the Complainant enjoys in its mark. This is not consistent with rights and legitimate interests residing in the Respondent.

Further, the Panel finds it curious that the Respondent seeks to retain the disputed domain name even after it has agreed to rebrand its service offerings, moving away from use of the word "society" in its brand identity. The Panel views the decision to rebrand as at least an implicit acknowledgement that the Respondent has no basis on which to claim rights or legitimate interests in any formative of the THE SOCIETY mark, and correspondingly, no rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

D. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt 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 a product or service on [the respondent's] website or location".

The Complainant's THE SOCIETY mark was put into use and registered a number of years prior to the registration of the disputed domain name and the record indicates that the Complainant and its mark are well known in the particular market space. The Panel finds that the Respondent knew or should have known about the Complainant when it registered the disputed domain name, and that the Respondent sought to trade off the goodwill of the Complainant's mark and deceive Internet users by operating the website at the disputed domain name. The Panel also perceives the evidence submitted by the Complainant that shows the presence of the Complainant's THE SOCIETY mark on the Respondent's website to demonstrate a bad faith targeting of the Complainant that runs afoul of the Policy.

Finding no explanation on the part of the Respondent that demonstrates good faith registration and use of the disputed domain name, the Panel determines that the Complainant has established this third element of the Policy.

Finally, the Panel wishes to clarify that any delay by the Complainant in filing the Complaint does not affect the outcome of the case. Panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits. See [WIPO Overview 3.0](#) at section 4.17. Furthermore, the Panel notes the Complainant tried to settle the case on an amicable basis, negotiated with the Respondent and gave him some time for rebranding before the filing of the Complaint.

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 <thesocietyfashionweek.com> be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Presiding Panelist

/Reyes Campello Estebarez/

Reyes Campello Estebarez

Panelist

/Justin Hughes /

Justin Hughes

Panelist

Date: March 18, 2024