

DISPUTE RESOLUTION SERVICE

D00018025

Decision of Independent Expert

Stitch Fix, Inc.

and

Mr Yang HongJuan

1. The Parties:

Complainant:

Stitch Fix, Inc.
One Montgomery Street, Suite 1200
San Francisco
CA 94104
USA

Respondent:

Mr Yang HongJuan
No.4 ZhuLin Road,Futian District
Shenzhen
518000
China

2. The Domain Name(s):

stitchfix.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, which need be disclosed as might be of such a

nature as to call into question my independence in the eyes of one or both of the parties.

- 29 September 2016 Dispute received
- 3 October 2016 Notification of complaint sent to parties
- 24 October 2016 Response received
- 24 October 2016 Notification of response sent to parties
- 1 November 2016 Reply received
- 1 November 2016 Notification of reply sent to parties
- 1 November 2016 Mediator appointed
- 8 November 2016 Mediation failed
- 18 November 2016 Expert decision payment received

4. Factual Background

The Nominet records show that the Domain Name was registered on 1 March 2013.

Based on the parties' submissions (see section 5 below) and a review of the materials annexed to the Complaint, I set out below are the main facts which I have accepted as being true in reaching a decision in this case:

- (a) The Complainant is the owner of an EU trade mark registration for STITCH FIX, dating from 2012.
- (b) The Complainant's company name is Stitch Fix, Inc. It carries on its fashion-related business under the trading name of Stitch Fix and uses the website www.stitchfix.com.
- (c) The Domain Name resolves to a website where links are displayed for the goods and services of third parties, which include women's clothing and fashion stylist services.
- (d) The Respondent has had three DRS decisions against it since 2013.

5. Parties' Contentions

Complaint

The Complainant's submissions are set out below:

The Complainant has rights in respect of a name and mark which is identical or similar to the Domain Name:

- (1) The Complaint is based on the Complainant's company name, trade name, domain name (www.stitchfix.com) and trade mark (with protection in the United Kingdom by virtue of European Union trade mark registration no. 010832483 STITCH FIX). The Complainant's trade mark registration covers, amongst other services, "on-line retail store services featuring

clothing; retail store services featuring clothing” in class 35 and “personal shopping services” in class 45.

- (2) The element stitchfix within the disputed Domain is contained within the Complainant’s trade mark STITCH FIX and domain name www.stitchfix.com. Therefore it is identical to the Complainant’s STITCH FIX trade mark and domain name. The domain name www.stitchfix.com is the Complainant’s official site from where they conduct their on-line business.

The Domain Name, in the hands of the Respondent, is an abusive registration:

- (1) The Respondent knew of, and sought to capitalise on, the fame and value of the Complainant’s trade mark, at the time the Domain Name was registered for the purpose of selling, renting or otherwise transferring the Domain Name to the Complainant or one of their competitors. There is the possibility that the Respondent could seek to sell the Domain Name at issue, if possible, to the highest bidder and this is evidenced by the use of “*The domain stitchfix.co.uk may be for sale. Click here to inquire about this domain*” on the Respondent’s website. Clicking on this link launches the web page <http://www.stitchfix.co.uk/listing> where it is stated that “*The owner of Stitchfix.co.uk has chosen to receive offer inquiries regarding this domain name. Note that the owner may disregard your inquiry if your offer does not meet his or her expectations*” and the internet user is invited to submit an offer.
- (2) The links currently displayed on the website of the Domain Name take the user to offerings of third parties and in many circumstances the links relate to women’s clothing (e.g. “John Lewis” and “La Redoute”) and fashion stylist services (e.g. “Style Doctors” and “Personal Wardrobe Stylist”). These goods/services are identical to and overlapping with the Complainant’s core commercial interests, namely on-line retail store services featuring clothes and personal shopping/personal stylist services.
- (3) The Complainant’s prospective customers will assume that the website found at the Domain Name is connected to or authorized by the Complainant, for example thinking that the live website is the Complainant’s UK website or operation. The Complainant has no control over what is offered to prospective customers. This must inevitably interfere with the business of the Complainant by diverting business or tarnishing its reputation.
- (4) The Complainant has rights in the STITCH FIX trade mark and so the Respondent's registration of the Domain Name is primarily as a blocking registration against a mark in which the Complainant has rights. For example, the Domain Name has been registered with the intention to intercept the internet traffic for the Complainant.
- (5) The registration of the Domain Name by the Respondent blocks the Complainant’s legitimate registration of the Domain Name.

- (6) The Respondent includes STITCH FIX in the Domain Name in which the Complainant has exclusive rights. Inevitably this will at least lead to initial interest confusion amongst consumers, regardless of the content of the website.
- (7) All of the above means that the inevitable assumption of consumers is that there is a formal association with, or connection to, the Complainant, at least initially.
- (8) The consumers of the Complainant's services will understandably believe that it is the Domain Name of the Complainant given that it is identical to their core domain name www.stitchfix.com and trade mark STITCH FIX and the links currently shown on the Web site which are in the same commercial area as the Complainant i.e. on- line retail store services featuring clothes and personal shopping/personal stylist services.
- (9) Persons mistaking the Domain Name for the Complainant's domain name will be deceived into assuming there is a link to the Complainant's business, with a correspondingly detrimental effect on the reputation and integrity of the Complainant's business within the general definition of an abusive registration, especially as the links on the site have no connection with the Complainant. Further, the Respondent's activities:
 - (a) risk misleading Complainant's customers to the Complainant's detriment;
 - (b) risk diverting business from Complainant; and
 - (c) will take unfair advantage of and will be detrimental to the reputation and distinctive character of the Complainant's trade mark.
- (10) In view of the Complainant's reputation and goodwill symbolised by their STITCH FIX trade mark and the absence of any denial thereof, and the manner of use of clothing, fashion and stylist related links on the site in question, it can be inferred the Respondent must have been aware of the Complainant's rights when the Domain Name was registered and intended to exploit that reputation unfairly/detrimentally to his own ends. There is no other reasonable explanation for the Respondent's acts.
- (11) The Respondent has had at least three DRS decisions against it since 2013, namely:
 - (a) D00012473 in relation to the domain name baupost.co.uk;
 - (b) D00012682 in relation to the domain name lyxor.co.uk; and
 - (c) D00014289 in relation to the domain name lytro.co.uk.

The time frame of these decisions is consistent with the registration of the Domain Name on 1 March 2013 and shows a pattern of abusive

registrations by the Respondent. The domain names previously registered by the Respondent all related to large companies including Lytro, Inc. and The Baupost Group LLC.

Response

The Respondent's submissions are set out below:

- (1) The Respondent registered the Domain Name in 2013 for one project, which has not yet started, so it parked the Domain Name temporarily. The Respondent has a detailed plan to use the Domain Name in the near future.
- (2) The word Stitchfix is an original word created by the Respondent. It is not a generic term. The Respondent does not have a trade mark for the word but, according to general domain names principles, it should be first come, first served.
- (3) The Respondent's plan is to set up a site about medical apparatus. It is not related to the Complainant. Before the Respondent registered the Domain Name, the Respondent knew nothing about the Complainant.
- (4) The Complainant does not have rights in the name. First, the Respondent registered the Domain Name in 2013. Though the Complainant has a registered trade mark for "Stitchfix" in trade mark classes 35 and 45, this does not mean it can prevent other people using the word legitimately and reasonably for other goods and services. The Respondent is a start-up business related to medical apparatus, and has nothing to do with the Complainant.
- (5) The Complainant has not provided any evidence showing that it did any of the following before the Respondent registered the Domain Name: register a company in the UK; carry out any commercial activities in the UK; carry out any advertising or promotion in the UK.
- (6) The Complainant has not provided any evidence showing that the word "Stitchfix" is commonly associated with the Complainant, and recognized by the public in the UK, before the Respondent registered the Domain Name.
- (7) The Respondent registered the Domain Name in good faith. The Respondent's good faith use of the Domain Name will not confuse the public in the UK.
- (8) The Complainant is guilty of reverse domain name hijacking. The Complainant only has the domain name Stitchfix.com, which cannot give it the automatic right to Stitchfix.co.uk. Secondly, the Complainant is a company, whilst the Respondent is an individual. This is a case of bullying.

Reply

The Complainant's submissions in reply are set out below:

- (1) By the Respondent's own admission, it has not used the domain name www.stitchfix.co.uk and there has been no evidence provided that the Respondent has made preparations to use this domain name in connection with a genuine offering of goods or services. Additionally, no evidence has been produced to show that the Respondent is commonly known by this name.
- (2) The Respondent alleges that the Complainant has no rights in this mark. This is self-evidently incorrect. As included in the Complaint, the Complainant owns EU trade mark registration no. 10832483 STITCH FIX dating from 24 April 2012 which predates the registration of the domain name of 1 March 2013.
- (3) The Respondent alleges it was not aware of the Complainant and submits that:
 - (a) the Claimant has not registered a company in the UK prior to 1 March 2013;
 - (b) the Claimant has had no commercial activities in the UK prior to 1 March 2013;
 - (c) the Claimant has not conducted any advertising or promotion in the UK prior to 1 March 2013;
 - (d) STITCH FIX is not commonly associated with the Complainant or recognised by the public in the UK prior to 1 March 2013.

All of these allegations and submissions are irrelevant. As detailed in the Complaint, the Domain Name is an abusive registration in the hands of the Respondent because (a) the Complainant has evidenced earlier rights in a sign or trade mark which is identical or similar to the domain name and (b) the webpage associated with the domain name displays web links to offerings of third parties in the same/similar commercial space to the Complainant along with an invitation for "offer inquiries". The domain name is also part of an abusive pattern of domain name registrations.

- (4) The Respondent claims it was preparing to "do it sooner" which is interpreted to mean that it intended to register the trade mark prior to the Complainant. However, no evidence to that effect has been submitted.
- (5) The Respondent alleges reverse domain name hijacking. This is a serious allegation made without any evidence. It is submitted that the Respondent has not filed any evidence because there is none to submit and this allegation is therefore denied. The Complainant is the legitimate owner of the STITCH FIX trade mark. As has been shown, the domain name www.stitchfix.co.uk is identical or similar to a sign or trade mark in which

the Complainant has earlier rights and is an abusive registration. The Complainant is therefore justified to use the DRS and does so in good faith.

6. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- (i) it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

The Complainant is the owner of an EU trade mark registration for STITCH FIX, which dates from 2012. Accordingly the Complainant owns legal rights in the STITCH FIX name.

Disregarding the generic .co.uk suffix, the Domain Name is identical to the name in which the Complainant has Rights.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the Policy defines an "Abusive Registration" as:

"A Domain Name which either:

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- (ii) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The factors under paragraph 3a on which the Complainant relies in this case are as follows:

"i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

A. for the purposes of selling, renting or otherwise transferring the Domain

Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well-known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern"

I will deal first with the factor under paragraph 3aCii. The Domain Name consists solely of "stitchfix" (disregarding the generic *.co.uk* suffix), with no additional differentiating element(s). When a domain name is identical to the name or mark of a complainant, without any adornment, barring exceptional circumstances this is almost inevitably going to lead to people being confused into believing that the domain name is owned or authorised by the complainant. I find that this is the case here. In reality the website at www.stitchfix.co.uk is not operated or authorised by the Complainant. In fact, website contains links to third party fashion-related goods and services which are not connected in any way with the Complainant.

Even if people arrive at the www.stitchfix.co.uk website and realise reasonably quickly that the website is not operated or authorised by the Complainant, there will still have been, and is likely to be in the future, what is known as "initial interest" confusion caused by the complete identity of the Domain Name to the name of the Complainant, i.e. people initially arriving at the website expecting it to be the Complainant's.

Secondly, the Respondent claims to have come up with the StitchFix name independently, and to intend to use the name for a medical apparatus business. However, it has not provided any evidence of the latter. Taking into account that the name StitchFix is a relatively unusual one, it is inherently unlikely that someone would create it independently and later than the Complainant. I find that the Respondent did not do so independently but in the knowledge of the Complainant's business. In light of this finding, and the offer for sale of the Domain Name on the Respondent's website, it is a reasonable inference that the Respondent's motive was to sell it to the Complainant (or a competitor) for more than Respondent's out of pocket expenses; and I find that this is the case.

Based on the three previous decisions against the Respondent, I also find that the Respondent has been engaged in a pattern of abusive registrations.

Taking everything into account, I do not believe that the Respondent had any bona fide reason for registering the Domain Name. The most likely reason was that it planned to bring about a situation where the Complainant would purchase the Domain Name for a significant sum. From this it must follow that the Respondent intended to gain an unfair advantage by his registration of the Domain Name, and that such registration took unfair advantage of the Complainant's Rights.

Conversely, the Respondent's registration and use of the Domain Name is unfairly detrimental to the Complainant's Rights for reasonably obvious reasons. The content of the www.stitchfix.co.uk website diverts and/or distracts people who are looking for the Complainant.

In light of the above, it is clear that the Respondent's registration and use of the Domain Name has taken unfair advantage of and been unfairly detrimental to the Complainant's Rights, and that the Domain Name is therefore an Abusive Registration.

7. Decision

Having found that the Complainant has Rights in respect of a name which is identical to the Domain Name, and that the Domain Name is an Abusive Registration, the Expert directs that the Domain Name *stitchfix.co.uk* be transferred to the Complainant.

Signed:
Jason Rawkins

Dated: 15 December 2016