



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

#### **Jones Apparel Group, Inc. v. Robin Sousa**

**Case No. D2001-1308**

#### **1. The Parties**

The Complainant is Jones Apparel Group, Inc., a corporation of the State of Pennsylvania, 1411 Broadway, New York, New York 10018, USA.

The Respondent is Ms. Robin Sousa, 338 Sylvan Avenue, Waterbury, Connecticut 06706, USA.

#### **2. The Domain Name and Registrar**

The Contested Domain Name is <evanpicone.com>.

The Registrar is Network Solutions, Inc. (NSI), 505 Huntmar Drive, Herndon, Virginia 20170, USA.

#### **3. Procedural History**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved on October 24, 1999 and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999 and by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 ("Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in e-mail form on October 26, 2001 and in hard-copy form with Annexes A-I on October 30, 2001 along with the appropriate payment.

The Complainant's attorney, stated that he separately served, on October 26, 2001 and by Express mail, a copy of the Complaint together with a copy of the cover sheet, on the Respondent, and by courier on the Registrar, NSI.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on November 2, 2001, the Center requested confirmation from NSI of information set forth in the Complaint relative to the contested domain name; specifically, contact and registrant information for that domain name, as well as whether NSI received a copy of the Complaint from the Complainant. The Center also requested NSI to specify: (a) whether the ICANN Policy applies to the contested domain name, (b) the current status of that domain name, (c) the language of the registration agreement, and (d) whether, through the registration agreement, the registrant has submitted to the jurisdiction at the location of the principal office of the Registrar for court adjudication of disputes concerning or arising from use of the contested domain name.

On November 9, 2001, NSI provided its response to the Center through which NSI provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that NSI is the registrar of that name, stated that the Policy is in effect (through Network Solutions' version 5.0 registration agreement) for the domain name, stated that the language of the registration agreement is English, and stated that the domain name was then in an "active" status.

On November 12, 2001, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, both in e-mail and via courier in hard-copy form to the Respondent (with the latter method forwarding a copy of all the annexes as well). On the same day, the Center also sent a copy of the Complaint to the Respondent by facsimile. The Complaint, and its accompanying documents, and all subsequent communications associated therewith were provided in the preferred manner and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on November 12, 2001 under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and succeeding correspondence between the Center and NSI, in detail, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20-calendar day period, expiring on December 2, 2001 to file its response with the Center and serve a copy of the response on the Complainant.

As of December 2, 2001, the Center had not received any response to the Complaint from the Respondent; hence, the Center, in an e-mail letter dated December 3, 2001 notified the Complainant and Respondent of the default of the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, on December 5, 2001, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a sole panelist for this dispute. On the next day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an e-mail letter

dated December 7, 2001, notified the parties of the appointment of Mr. Michaelson as the sole panelist.

Based on deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before December 21, 2001.

The language of this proceeding is English.

#### **4. Factual Background**

A copy of the WHOIS registration record for the contested domain name appears in Annex A to the Complaint. As indicated on this record, the Respondent registered this name with NSI on May 17, 1999. When this name is entered into a browser as an address of an Internet site, the address resolves to a page that simply states "under construction".

##### **A. The "EVAN-PICONE" marks**

The Complainant owns numerous United States and counterpart foreign trademark registrations for the mark "EVAN-PICONE" (as well as similar marks containing the words "EVAN-PICONE" or "PICONE" as formatives) on which this dispute is based (collectively the "EVAN-PICONE" marks). The Complainant has provided, in Annex C to the Complaint, copies of the registration certificates for some of these marks both in the US and overseas, of which the following four registered United States registered trademarks are illustrative.

1) EVAN-PICONE (block letters)

US registration 854,224; registered August 6, 1968 (renewed as of August 6, 1988)

This trademark was registered for use in connection with: "Skirts, suits, slacks, shorts, blouses, dresses, coats for women and misses" all in international class 25. This mark claims first use and first use in inter-state commerce of September 1, 1949.

2) EVAN-PICONE (block letters)

US registration 1,339,047; registered June 4, 1985

This trademark was registered for use in connection with: "Eyeglass frames" in international class 9. This mark claims first use and first use in inter-state commerce of September 24, 1984.

3) EVAN-PICONE (block letters)

US registration 1,668,985; registered December 17, 1991

This trademark was registered for use in connection with: "Luggage, handbags, purses, attache cases, briefcases, business and credit card cases, passport cases, wallets, school bags, totebags, all purpose sport tote bags, duffel bags, beach bags, travelling trunks and valises, cosmetic bags sold empty, briefcase-type portfolios, umbrellas, key fobs and key cases" all in international class 18. This mark claims first use and first use in inter-state commerce of July 25, 1991.

4) EVAN-PICONE (block letters)

US registration 2,062,265; registered May 13, 1997

This trademark was registered, for use in connection with: "Clothing, namely men's top coats, overcoats and raincoats" all in international class 25. This mark claims first use and first use in inter-state commerce of December 31, 1994.

**B. The Complainant**

The Complainant, Jones Apparel Group, was founded in 1970 and has, for many years, been engaged in the national and international manufacture, production and distribution of a wide variety of high quality women's clothing, including women's career and casual sportswear, suits and dresses. The Complainant's offerings can be broken down into five categories: (i) sportswear; (ii) suits and dresses; (iii) shoes; (iv) fashion accessories; and (v) jewelry. For nearly thirty years, the Complainant has manufactured, promoted and distributed its merchandise under and in connection with the group name "JONES APPAREL GROUP" as well as a variety of its individually branded, well-known names and marks, including its "JONES NEW YORK" label, as well as "EVAN-PICONE", "NINE WEST", "RENA ROWAN", "TODD OLDHAM", "EASY SPIRIT" and "ENZO ANGIOLINI". The Complainant also manufactures, promotes and distributes merchandise under licenses from such names as "LAUREN BY RALPH LAUREN", "RALPH BY RALPH LAUREN", "POLO JEANS" and "TOMMY HILFINGER". The Complainant currently has 32 separate licensing agreements under which independent licensees sell products under the Complainant's own mark, "JONES APPAREL", in accordance with designs furnished to and approved by the Complainant for sale in the United States and Canada. Current licenses cover men's tailored clothing and overcoats, women's intimate apparel, women's rainwear, outerwear, leather outerwear and woolen coats, footwear, handbags, belts, scarves, women's swimwear, umbrellas, eyewear, fine jewelry, costume jewelry, hair accessories, cosmetic travel accessories, luggage and watches.

The Complainant experienced considerable growth throughout the 1980s, and became a publicly listed company on the New York Stock Exchange in May of 1991 (symbol "JNY"). This growth continued unabated into the 1990s. By 1996, the Complainant realized US \$1 billion in worldwide sales on an annual basis. By the end of 1998, the Complainant had grown from its original space in the States of Pennsylvania and New York to include warehouses and offices in Canada and Mexico, and in the States of New Jersey, Tennessee, Delaware, North Carolina and Virginia. All told, the Complainant now employs in excess of 17,000 people worldwide and has achieved annual sales in excess of US \$ 4.1 billion. Through its various labels, including "EVAN-PICONE", the Complainant in year 2000 has achieved sales in excess of US \$ 940 million in the shoe market, in excess of US \$1 billion in retail apparel and in excess of US \$ 2.1 billion in wholesale apparel. Total advertising expenditures for the year 2000 for the Complainant's various labels exceeded US \$ 3,000,000. As a result of its growth, market penetration and advertising expenditures, the Complainant and its various marks, including the "EVAN-PICONE" marks, have become widely and instantly recognized by the consuming public and have come to be associated by the consuming public with excellent clothing and fashion accessories.

**C. The Complainant's Use of the "EVAN-PICONE" Name and Marks**

In 1993, the Complainant acquired all right, title and interest in and to the "EVAN-PICONE" name when the Complainant purchased the "EVAN-PICONE" brand

from Crystal Brands.

The woman's sportswear label had been established in 1949 by Joseph Picone and Charles Evans, hence forming "Evan-Picone". Evan-Picone essentially created the concept of career dressing for the large number of women entering the work force during the 1970s and 1980s. Under the Complainant's direction, sales for the "EVAN-PICONE" brand have risen from US \$ 20 million in 1992 to in excess of US \$ 100 million each year since 1994. Today, through direct sale or license, the "EVAN-PICONE" name appears on a wide range of apparel and related merchandise including but not limited to dresses, skirts, shirts, pants, evening dresses, coats, lingerie, suits, shorts, slacks, blouses, vests, jackets, eyeglasses, sunglasses, scarves, shoes, stockings, leather goods, handbags and jewelry.

The Complainant has expended US \$ 220,000 on an annual basis towards advertising and promoting its "EVAN-PICONE" marks. The Complainant has provided, in Annex D to the Complaint, samples of its advertising copy, for the "EVAN-PICONE" brand, which have appeared in such publications as Vogue, House Beautiful, Marie Claire and the New York Times. Furthermore, in Annex E to the Complaint, the Complainant has provided a copy of its promotional pieces, bearing the mark "EVAN-PICONE", which appears in Complainant's most recent Annual Report. The "EVAN-PICONE" brand is sold in a variety of retail and department stores throughout the United States, including such large stores as Robinsons-May, Lord & Taylor and Filene's. The Complainant has also provided in Annex F to the Complaint, a partial listing, obtained from the Complainant's website <www.jny.com>, of stores currently selling the "EVAN-PICONE" brand of merchandise. Through this site, customers can obtain a partial listing of the retail establishments that sell "EVAN-PICONE" branded products in each state of the US.

The Complainant promotes its "EVAN-PICONE" brand through its <www.jny.com> website. A copy of the first page of this site, which provides consumers with general information regarding the Complainant and its various labels, appears in Annex G to the Complaint. The website currently receives approximately 200,000 hits per year.

In addition to its own advertising, the Complainant benefits from a substantial volume of unsolicited press coverage. Illustrative copies of such coverage, in which the "EVAN-PICONE" name is prominently displayed, appear in Annex H to the Complaint. Further, the Complainant's "EVAN-PICONE" marks appear in quite a number of third-party web sites. Searches for the mark "EVAN-PICONE" on such widely used search engines as MSN, Alta Vista and Google revealed thousands of hits pertaining to the Complainant and on web sites based in various countries and appearing in languages including Spanish, Italian and Chinese, as well as English. Annex I to the Complaint provides a sample list of web sites that reference the Complainant's "EVAN-PICONE" marks and which were found through these search engines.

Hence, the "EVAN-PICONE" marks are well-known both in the U.S. and abroad.

#### **D. The Complainant's Awareness of the Respondent and the Contested Domain Name**

During June 1999, the Complainant first learned that Respondent had registered the contested domain name with NSI. Though the Complainant repeatedly attempted to contact the Respondent by mail and by telephone throughout 2000 and 2001, all such attempts were unsuccessful.

## **5. Parties' Contentions**

### **A. Complainant**

#### **i. Similarity**

The Complainant takes the position that the contested domain name is identical, but for the inclusion of a hyphen in the mark, and hence confusingly similar to its registered "EVAN-PICONE" marks, so as to ostensibly and likely confuse Internet users as to source, sponsorship, affiliation or endorsement between the Respondent's web site and the Complainant; hence, satisfying the confusing similarity requirement in paragraph 4(a)(i) of the Policy.

#### **ii. Legitimacy**

The Complainant contends that the Respondent has no rights or legitimate interests in the contested domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Complainant contends that its "EVAN-PICONE" name and marks, is so distinctive and that consumers worldwide associate the "EVAN-PICONE" name and marks with the Complainant, that there can be no legitimate reason the Respondent has chosen to register it as a domain name. Rather, the Complainant contends that the Respondent has clearly attempted to trade off of the renown of the Complainant's "EVAN-PICONE" name and marks. Thus, the Complainant concludes there can be no inference that Respondent has any claim to a right or legitimate interest in the contested domain name.

#### **iii. Bad Faith**

The Complainant contends that the Respondent has registered and is now using the contested domain name in bad faith.

Inasmuch as the Respondent's web site to which the contested domain name resolves merely returns a page stating "under construction", and apparently since no evidence has been submitted to indicate that the Respondent has ever had an active web site resolvable through this name since she registered it on May 17, 1999, the Complainant contends that the Respondent's conduct since that date amounts to passive holding. The Complainant states various ICANN decisions support the view that passive holding can be evidence of bad faith, citing to: *Casa Cor Promoções e Comercial Ltda vs Nelson Abras* WIPO Case No D2001-0628 and *Telstra Corporation Limited v. Nuclear Marshmallows* WIPO Case No D2000-0003.

Furthermore, the Complainant contends that the Respondent's registration of the contested domain name has prevented the Complainant from utilizing its mark "EVAN-PICONE" as its domain name, hence forcing the Complainant to utilize <jny.com> instead.

Therefore, the Complainant concludes that the Respondent's conduct in registering and passively using the contested domain name constitute bad faith registration and use under paragraph 4(a)(iii) of the Policy.

## **B. Respondent**

The Respondent has not filed any substantive response to the allegations raised in the Complaint.

## **6. Discussion and Findings**

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations. In that regard and apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings.

### **i. Similarity**

The differences between that domain name and the registered marks are simply the concatenation of the generic top level domain (gTLD) ".com" and the deletion of a hyphen from the mark "EVAN-PICONE".

These differences are so de minimus and immaterial as to be utterly inadequate to preclude any confusion from occurring. Hence, for all practical purposes, the domain name in question is identical to the Complainant's mark "EVAN-PICONE". See, e.g., *Ticketmaster Corporation vs. DiscoverNet, Inc.* D2001-0252 (WIPO April 9, 2001), *NetWizards, Inc. v. Spectrum Enterprises* D2000-1768 (WIPO April 4, 2001), *MSNBC Cable, LLC v. Tsys.com* D2000-1204 (WIPO December 8, 2000), *Wine.com, Inc. v. Zvieli Fisher* D2000-0614 (WIPO September 11, 2000) and *Lana Marks, Ltd., Inc. v. SYP Web* D2000-0304 (WIPO June 23, 2000). Furthermore, this Panel is in full accord with a prior panel decision, *Ticketmaster Corporation v. Dmitri Prem*, D2000-1550 (WIPO January 16, 2001), which held that a gTLD is to be ignored in assessing similarity to a mark. See, also, *Universal City Studios, Inc. v. David Burns and Adam-12 Dot Com* D2001-0784 (WIPO October 1, 2001) and *Teradyne, Inc. v. 4Tel Technology*, D2000-0026 (WIPO May 9, 2000) where hyphens added to the registered marks to form contested domain names were simply ignored by the respective panels.

Such confusion would undoubtedly cause Internet users intent on accessing what each believes to be the Complainant's website but who instead reach the Respondent's website, (even though that site is still "under construction" and not operative) to think that an affiliation of some sort exists between the Complainant and the Respondent, when, in fact, no such relationship exists at all. See, e.g., *Dollar Financial Group, Inc. v. VQM NET* FA 96101 (Nat. Arb. Forum January 25, 2000); *eBay Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.* D2000-1463 (WIPO January 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales, Corp.* FA 95856 (Nat. Arb. Forum December 18, 2000) and *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.* AF-0145 (eResolution May 3, 2000).

Therefore, the Panel finds that the contested domain name <evanpicone.com> sufficiently resembles the Complainant's registered marks as to cause confusion; hence, the Complainant has shown sufficient similarity between its marks and the contested domain name under paragraph 4(a)(i) of the Policy.

## **ii. Illegitimacy**

Based on its federal trademark registration, the Complainant has acquired exclusive rights to use its "EVAN-PICONE" marks. Furthermore, by virtue of the registration of these marks, the US Patent and Trademark Office has implicitly recognized that each such mark has acquired appropriate secondary meaning in the marketplace.

The Respondent has yet to provide any basis that would legitimize any claim it has to the contested domain name. In fact, it is extremely unlikely that the Respondent can even make such a claim.

The simple reason is that the contested domain name includes the Complainant's mark "EVAN-PICONE" under which the Complainant (or its predecessors in interest) marks and distributes its goods and has been doing so for over 50 years. The Complainant has apparently never authorized the Respondent to utilize any of its marks, nor does the Complainant have any relationship or association whatsoever with the Respondent. Hence, any use to which the Respondent were to put of any of the "EVAN-PICONE" marks in connection with the goods listed in any of the Complainant's registrations would directly violate the exclusive trademark rights now residing in the Complainant. Consequently, inasmuch as the Respondent is not now and has never been commonly known by the mark "EVAN-PICONE", the Respondent is in direct contravention of paragraph 4(c)(ii) of the Policy. See, e.g., *America Online, Inc. v. Curtis Woods* D2001-0555 (WIPO June 13, 2001), *MSNBC Cable, LLC v. Tsysys.com* cited *infra*, and *Cabletron Systems, Inc. v. DSL Enterprises* D2000-0571 (WIPO August 18, 2000).

Furthermore, since the date on which the Respondent registered the contested domain name, i.e. May 17, 1999 -- some 2 1/2 years ago, she has passively held it. In that regard, there is no evidence whatsoever in the record before this Panel that, prior to receiving notice of this dispute, the Respondent, in connection with a bona fide offering of goods or services, was either actually using the contested domain name with an existing website or making demonstrable preparations to use that name with such a site.

In light of the above findings, the Panel is not persuaded that the Respondent has any or, based on current facts provided to the Panel, is likely to acquire any legitimate interests in the contested domain name, whether on a commercial or non-commercial basis under either paragraph 4(c)(i) or 4(c)(iii) of the Policy.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the contested domain name within paragraph 4(a)(ii) of the Policy.

## **iii. Bad Faith**

The Panel firmly believes that the Respondent's actions constitute bad faith registration and use of the contested domain name.

Specifically, since the date on which the Respondent registered the contested domain name some 2 1/2 years ago to the date of the Complaint (October 26, 2001), the Respondent has not used that name as an address of an operative web site.

Various panels have ordered transfer of a domain name after an extended period of non-use by its registrant, typically referred to as "passive holding". In each instance, non-use was coupled with a complainant having valid trademark rights commencing prior to the date on which the offending domain name was registered coupled with the registrant having actual or imputed knowledge of those rights -- as is the case here. See,

e.g., *Spence-Chapin Services to Families and Children v. Stanley Wynman* FA100492 (Nat. Arb. Forum December 10, 2001), *America Online, Inc. v. Curtis Woods* D2001-0555 (WIPO June 13, 2001), *America.com Inc. et al v PSS InterNet Services, Inc.* FA 96784 (Nat. Arb. Forum April 19, 2001), *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications* D2001-0210 (WIPO April 16, 2001), *The Chip Merchant Inc. v. Blue Star Electronics d/b/a Memory World* D2000-0474 (WIPO August 21, 2000), *Chernow Communications, Inc. v. Jonathan D Kimball* D2000-0119 (WIPO May 18, 2000) and *Mary-Lynn Mondich and American Vintage Wine Biscuits, Inc v. Shane Brown, d/b/a Big Daddy's Antiques*, D2000-0004 (WIPO February 16, 2000); as well as *Northwest Racing Associates Limited Partnership v. Quantu Marketing* FA 95506 (Nat. Arb. Forum October 6, 2000), *Can't Stop Productions, Inc. v. Kevin Lussie* FA 94966 (Nat. Arb. Forum July 27, 2000), *Liberty Public Limited Company v. Thomas Guarrera* FA 95103 (Nat. Arb. Forum August 17, 2000), *V & S Vin & Spirit Aktiebolag v. Gunnar Hedenlans Peev* FA 95078 (Nat. Arb. Forum August 9, 2000), *Leland Stanford Junior University v. Zedlar Transcription & Translation* FA94970 (Nat. Arb. Forum July 11, 2000), *Georgia Gulf Corporation v. The Ross Group* D2000-0218 (WIPO June 14, 2000), *Sanrio Company, Ltd. and Sanrio, Inc. v. DLI* D2000-0159 (WIPO April 20, 2000), *America Online, Inc. v. Avrasya Yayincilik Danismanlik Ltd.* FA 93679 (Nat. Arb. Forum March 16, 2000) and *Telstra Corporation Limited v. Nuclear Marshmallows* cited *infra*. In each instance, such passive holding was seen as sufficient evidence of bad faith use and registration under the general provisions of paragraph 4(b) of the Policy. The Panel sees no plausible reason to divert from that view, with the passive holding here evidencing bad faith registration and use by the Respondent.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations to establish a *prima facie* case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## 7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel now grants the relief sought by the Complainant.

The contested domain name, specifically <evanpicone.com>, is ordered transferred to the Complainant.

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Peter L. Michaelson, Esq.  
Sole Panelist

Dated: December 21, 2001