

## ADMINISTRATIVE PANEL DECISION

Mycoskie, LLC v. Maurer Sabrina  
Case No. D2022-2099

### 1. The Parties

Complainant is Mycoskie, LLC, United States of America (“United States”), represented by SILKA AB, Sweden.

Respondent is Maurer Sabrina, Germany.

### 2. The Domain Name and Registrar

The disputed domain name is <tomsméxico.com> (<xn--tomsmxico-f4a.com><sup>1</sup>) which is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 9, 2022. On June 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 15, 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 those in the Complaint. The Center exchanged email communications with Complainant on July 1, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed a couple of amendments to the Complaint on July 1 and 3, 2022, respectively.<sup>2</sup>

The Center verified that the Complaint, together with the amendments to 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

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<sup>1</sup> <xn--tomsmxico-f4a.com> is the equivalent of and translates into <tomsméxico.com>. As regards the use of diacritics in domain names, ASCII characters, Punycode transliterations, and internationalized domain names, see, for instance, *Monografías.com S.A., Fernando Julián Negro v. Nick Lozikov / Moniker Privacy Services*, WIPO Case No. [D2008-0140](#); *The Coca-Cola Company v. Keren, Chen*, WIPO Case No. [D2008-1852](#); and *Dr. Ing. h.c. F. Porsche AG, v. Moniker Privacy Services / Sergey Korshunov*, WIPO Case No. [D2011-0100](#).

<sup>2</sup> The Whois report attached to the Complaint did not show the registrant's name and full contact information. The amendments to the Complaint added Respondent's name and contact details as per the information disclosed by the Registrar.

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 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 27, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 9, 2022.

The Center appointed Gerardo Saavedra as the sole panelist in this matter on August 15, 2022. This Panel finds that it was properly constituted. This 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, through its exclusive licensee TOMS Shoes, LLC, is engaged in the design and marketing of footwear, eyewear, coffee, apparel and handbags under Complainant’s TOMS marks.

Complainant has rights over the TOMS mark for which it holds, among others, International registration No. 887771, granted on May 12, 2006, in class 25; United States registration No. 3353902, granted on December 11, 2007, in class 25; Mexican registration No. 1260575, granted on January 16, 2012, in class 25; and European Union registration No. 012130563, granted on April 6, 2017, in classes 18 and 35.

Complainant also has rights over the TOMS and design mark for which it holds, among others, European Union registration No. 011555497, granted on June 21, 2013, in class 25; and Mexican registration No. 1401319, granted on September 27, 2013, in class 9.

Complainant is the registrant of the domain name <toms.com>, created on July 30, 1995.

The disputed domain name was registered on August 6, 2021. At the time the Complaint was filed, the website associated with the disputed domain name showed, among others, “Envío Gratuito a Partir De MXN2000”; Complainant’s TOMS and design mark cited above; “Hombre Mujer Niños”; “30 Días De Garantía De Devolución Entrega Rapida Toms Surprise Sale!”; “Toms Venice Collection Shop Now”; images of *alpargata*-type shoes followed by “The Alpargata Cupsole gives you the all-day comfort of our iconic shoe plus a custom cupsole built for extra flexibility and durability”; “Copyright © 2022 www.tomsméxico.com. Powered by Tienda Toms Mexico”.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant’s assertions may be summarized as follows.

Complainant and TOMS Shoes, LLC, were founded by Blake Mycoskie. TOMS Shoes, LLC, began its activities in 2006 when during a travel, Blake Mycoskie noticed that the people with shoes were all wearing a similar one..

Complainant is the owner of a number of trademark registrations worldwide consisting of TOMS. Complainant establishes its online presence under, *inter alia*, the domain name <toms.com>, which hosts a website that displays information about Complainant and its products.

The disputed domain name has been registered using Punycode (representation of Unicode with the limited ASCII character subset used for Internet hostnames), which is displayed as <tomsméxico.com>, that is, the TOMS mark together with the country name “méxico”. The disputed domain name is identical or confusingly

similar to Complainant's TOMS mark. It fully incorporates Complainant's TOMS mark, which is clearly recognizable in the disputed domain name. As set forth in several UDRP decisions, the use of Punycode does not prevent a finding of identity or confusing similarity.

Respondent has no rights or legitimate interests in the disputed domain name. Complainant has not authorized Respondent to use its TOMS mark for any reason or in any manner, and Complainant is not affiliated or otherwise connected with Respondent. There is no evidence that Respondent has been commonly known by the disputed domain name or the term "tomsméxico". The results of a Google search for "toms méxico" mostly refer to Complainant and its activities, and Complainant has found nothing to suggest that Respondent holds any trademark rights on the disputed domain name or on the term "tomsméxico".

The disputed domain name resolves to a website in English and Spanish languages, in which Complainant's TOMS mark is reproduced on top and as favicon, and where TOMS-branded shoes are purportedly offered for sale. Said website shows a copyright notice without mentioning the name of such website owner, and does not contain any information or disclaimer pointing out that its owner has no relationship with Complainant, misleading consumers into thinking that they are related. That is also the case in the "contact us", the "terms and conditions" and the "privacy notice" sections of said website. The composition and use of the disputed domain name reinforce the likelihood of confusion with Complainant, since consumers would assume that the disputed domain name is linked to one of Complainant's websites. Hence, the use of the disputed domain name cannot constitute fair use, as it effectively impersonates or suggests sponsorship or endorsement by Complainant.

Thus the disputed domain name seeks to capitalize the goodwill of Complainant's TOMS mark, misleading consumers into thinking that such website is operated by or affiliated with Complainant to carry out its activities in Mexico. Said use of the disputed domain name cannot be considered a *bona fide* use and it does not meet the cumulative requirements of the Oki Data test.

Respondent registered and is using the disputed domain name in bad faith.

Respondent had Complainant's mark and activities in mind when registering the disputed domain name, which amounts to bad faith registration. Complainant's TOMS mark was registered and has been in use well before the registration date of the disputed domain name and, given Complainant's numerous trademark registrations for the TOMS mark worldwide, it is not possible to conceive of a plausible situation in which Respondent would have been unaware of Complainant and its TOMS mark when the disputed domain name was registered. A simple search in an online trademark register or in the Google search engine would have informed Respondent on the existence of Complainant's rights in TOMS. The mere registration of a domain name that is identical or confusingly similar to a famous trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Complainant cannot conceive any possible use in which the use of the disputed domain name would not infringe its rights in TOMS. The disputed domain name resolves to a website which prominently displays Complainant's TOMS mark on top and as favicon, and that purportedly offers for sale TOMS-branded products, all that without identifying the name of the website owner in any section of said website. Respondent is using without permission Complainant's TOMS mark in order to intentionally attempt to attract for commercial gain Internet users to its website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of such website or goods or services offered on it, which amounts to registration and use in bad faith.

Respondent's use of the disputed domain name, diverting business from Complainant to Respondent, disrupts Complainant's business due to the customer relation issues it creates for Complainant.

Complainant requests that the disputed domain name be transferred to Complainant.

## B. Respondent

Respondent did not reply to Complainant's contentions.

## 6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

The lack of response from Respondent does not automatically result in a favorable decision for Complainant (see *Berlitz Investment Corp. v. Stefan Tinculescu*, WIPO Case No. [D2003-0465](#), and section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The burden for Complainant, under paragraph 4(a) of the Policy, is to show: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (ii) that 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.

### A. Identical or Confusingly Similar

It is undisputed that Complainant has rights over the TOMS and the TOMS and design marks.

Since the addition of a generic Top-Level Domain (*i.e.* ".com") in a domain name is technically required, it is well established that such element may be disregarded where assessing whether a domain name is identical or confusingly similar to a mark. The disputed domain name reflects the TOMS mark in its entirety, albeit followed by "m xico". It is clear to this Panel that the TOMS mark is recognizable in the disputed domain name and that the addition of such geographical term in the disputed domain name does not avoid its confusing similarity with said mark (see sections 1.7, 1.8 of the [WIPO Overview 3.0](#)).

Thus, this Panel finds that Complainant has satisfied paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

Complainant has alleged and Respondent has failed to deny that Respondent has no rights or legitimate interests in respect of the disputed domain name.

Complainant contends that it is not connected with Respondent, that Respondent is not commonly known by the disputed domain name, that Respondent holds no trademark rights on the disputed domain name, and that it has not authorized Respondent to use its TOMS mark.<sup>3</sup>

Complainant asserts that the website associated with the disputed domain name conveys the false impression that it is operated by or affiliated with Complainant. Complainant provided screenshots of such website, which on their face corroborate Complainant's assertion: the website associated with the disputed domain name shows the TOMS and design mark of Complainant and markets allegedly TOMS-branded shoes.<sup>4</sup> Further, it appears that said website does not show any disclaimer as regards Complainant thus

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<sup>3</sup> See *Casio Keisanki Kabushiki Kaisha (Casio Computer Co., Ltd.) v. Jongchan Kim*, WIPO Case No. [D2003-0400](#): "There is no evidence that the Complainant authorized the Respondent to register the disputed domain name or to use the CASIO trademark, with or without immaterial additions or variants. These circumstances are sufficient to constitute a *prima facie* showing by the Complainant of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent."

<sup>4</sup> See *Houghton Mifflin Co. v. The Weathermen, Inc.*, WIPO Case No. [D2001-0211](#): "Respondent used Complainant's mark, including its distinctive lettering style and a drawing of the Curious George character, as the large-font title of the page [...] As a result of the content of the page, a visitor to Respondent's site would be likely to believe that it was Complainant's official site. Such a confusing commercial use cannot be 'legitimate' under the Policy."

leading consumers to believe that it may be owned by, or at least somehow associated with, Complainant. All that demonstrates neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name.

This Panel considers that Complainant has established *prima facie* that Respondent has no rights or legitimate interests in the disputed domain name (see *Intocast AG v. Lee Daeyoon*, WIPO Case No. [D2000-1467](#), and section 2.1 of the [WIPO Overview 3.0](#)). In the case file there is no evidence of circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances, giving rise to rights or legitimate interests in the disputed domain name by Respondent.

Based on the aforesaid, this Panel concludes that paragraph 4(a)(ii) of the Policy is satisfied.

### **C. Registered and Used in Bad Faith**

The evidence in the file shows that Respondent deliberately targeted Complainant's TOMS marks.

Taking into consideration that the registration and use of Complainant's TOMS marks preceded the creation of the disputed domain name, and the content of the website linked to the disputed domain name (including the favicon showing the TOMS and design mark), this Panel is of the view that Respondent must have been aware of the existence of said marks and the goods marketed thereunder at the time it obtained the registration of the disputed domain name.

As set forth above, the website associated with the disputed domain name conveys the false impression that it is somewhat associated with Complainant, and there appears to be no disclaimer disassociating such website from Complainant. It seems to this Panel that in using the disputed domain name, Respondent has sought to create a likelihood of confusion with Complainant's marks as to the sponsorship, source, affiliation, or endorsement of said website, when in fact there is no such connection. All that is indicative of bad faith.

Thus the overall evidence shows that Respondent registered and used the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with Complainant's marks as to the source, sponsorship, affiliation or endorsement of such website.<sup>5</sup>

In this Panel's view, the lack of response is also indicative that Respondent lacks arguments and evidence to support its holding of the disputed domain name.

In light of the above, this Panel finds that Complainant has satisfied 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, this Panel orders that the disputed domain name <toms México.com> (<xn--tomsmxico-f4a.com>) be transferred to Complainant.

/Gerardo Saavedra/

**Gerardo Saavedra**

Sole Panelist

Date: August 29, 2022

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<sup>5</sup> See *Lilly ICOS LLC v. East Coast Webs, Sean Lowery*, WIPO Case No. [D2004-1101](#): "registration of a domain name in order to utilize another's well-known trademark by attracting Internet users to a website for commercial gain constitutes a form of bad faith."