

## ADMINISTRATIVE PANEL DECISION

TBL Licensing LLC v. Lisa Viney

Case No. D2022-4722

### 1. The Parties

Complainant is TBL Licensing LLC, United States of America, represented by SILKA AB, Sweden.

Respondent is Lisa Viney, United States of America.<sup>1</sup>

### 2. The Domain Name and Registrar

The disputed domain name <smartwool.llc> is registered with NameCheap, Inc. (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 8, 2022. On December 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 9, 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 the named Respondent, Privacy Service Provided by Withheld for Privacy ehf, and contact information in the Complaint. The Center sent an email communication to Complainant on December 12, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on December 12, 2022.

The Center verified that the Complaint together with the amendment 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 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 December 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 2, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on January 3, 2023.

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<sup>1</sup> The originally-named privacy service has been removed from the caption pursuant to the evolving privacy environment (post-GDPR) and further to section 4.4.5 of the [WIPO Overview 3.0](#).

The Center appointed Michael A. Albert as the sole panelist in this matter on January 19, 2023. 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 domain name <smartwool.com> was registered in 1996.

The Smartwool company was started in Steamboat Springs, Colorado, in 1994. It was sold to Timberland Group in 2005. In 2011, Timberland was acquired by the VF Corporation, which owns various other brands including The North Face, Jansport, Altra, Timberland, and Icebreaker. Smartwool remains one of VF Corporation's main brands.

Complainant is the owner of a number of trademark registrations which consist of or include the term "smartwool", such as the following:

1. United States Patent and Trademark Office No. 4619419, registered on October 15, 2014, in international class 35.
2. International Trademark Registration No. 1283645, registered on December 4, 2014, in international class 25.

The disputed domain name <smartwool.llc> (hereinafter, the "Disputed Domain Name") was created on November 28, 2022. Pursuant to the evidence in the Complaint, the Disputed Domain Name has been used in connection with a fraudulent email scheme impersonating the Complainant.

#### **5. Parties' Contentions**

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

Complainant contends that the Disputed Domain Name is confusingly similar to its SMARTWOOL mark.

Respondent has no rights or legitimate interests in the Disputed Domain Name. Complainant has not authorized Respondent to use its SMARTWOOL mark for any reason or in any manner, including in or as part of the Domain name. Likewise, Complainant is not affiliated or otherwise connected with Respondent.

Respondent registered and is using the Disputed Domain Name in bad faith.

##### **B. Respondent**

Respondent did not reply to Complainant's contentions.

#### **6. Discussion and Findings**

##### **A. Identical or Confusingly Similar**

The Disputed Domain Name incorporates Complainant's SMARTWOOL trademark in its entirety, with only the addition of the generic Top-Level Domain ("gTLD") "llc." Complainant's trademark is clearly recognizable in the Disputed Domain Name.

The addition of gTLDs is commonly viewed as a standard registration requirement, and as such is generally disregarded under the first element of the confusing similarity test (section 1.11 of [WIPO Overview 3.0](#)). See

also *Accenture Global Services Limited v. Contact Privacy Inc. Customer 1246518020 / Name Redacted*, WIPO Case No. [D2020-0520](#) (“The gTLD ‘.llc’ need not be taken into account in the assessment of confusing similarity.”)

## **B. Rights or Legitimate Interests**

Complainant has not authorized Respondent to use its SMARTWOOL mark for any reason or in any manner, including in or as part of the Disputed Domain Name. Likewise, Complainant is not affiliated or otherwise connected with Respondent. Complainant has found no evidence that Respondent is commonly known by the Disputed Domain Name.

The Disputed Domain Name does not resolve to an active website. Complainant states, and has provided some evidence suggesting, that the Disputed Domain Name has been used to impersonate one of Complainant’s employees who works in the credit department requesting payment status for invoices. The email was sent from “[...]@smartwool.llc”. The use of a domain name for illegal activity such as phishing cannot confer rights or legitimate interests on a respondent (see section 2.13.1 of [WIPO Overview 3.0](#)). See also *Screening Eagle Technologies AG v. James Rich, Company Limited*, WIPO Case No. [D2020-2057](#). (“Prior UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent; see [WIPO Overview 3.0](#), section 2.13.”)

Finally, taking into consideration that the Disputed Domain Name reproduces Complainant’s SMARTWOOL mark in full with only the addition of the gTLD “.llc.”, the Disputed Domain Name carries a high risk of implied affiliation with Complainant and cannot constitute fair use.

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

Complainant’s well-known SMARTWOOL mark has been registered and in use well before the registration date of the Disputed Domain Name. The Disputed Domain Name is identical to Complainant’s SMARTWOOL mark and domain name <smartwool.com>, under which Complainant operates its online presence. A simple search in an online trademark register or in the Google search engine would have informed Respondent of the existence of Complainant’s rights in SMARTWOOL. Further, the Disputed Domain Name has been used to impersonate one of Complainant’s employees. It is accordingly not plausible that Respondent would have been unaware of Complainant and its SMARTWOOL mark when the Disputed Domain Name was registered.

Since the Disputed Domain Name appears to have been used to impersonate one of Complainant’s employees, there is little doubt that Respondent knew of Complainant and registered the Domain Name in bad faith, in order to attract, for commercial gain, Internet users to its website or other online location by creating a likelihood of confusion with Complainant’s SMARTWOOL mark. See section 3.4 of [WIPO Overview 3.0](#) (“Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. ... Many such cases involve the respondent’s use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant’s actual or prospective customers.”)

## **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, <smartwool.llc>, be transferred to Complainant.

*/Michael A. Albert/*

**Michael A. Albert**

Sole Panelist

Date: February 2, 2023