

ADMINISTRATIVE PANEL DECISION

Toteme AB v. Dongmei Zhao

Case No. D2023-0651

1. The Parties

The Complainant is Toteme AB, Sweden, represented by Kanter Advokatbyrå, Sweden.

The Respondent is Dongmei Zhao, China.

2. The Domain Name and Registrar

The disputed domain name <totemeoutlet.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 13, 2023. On February 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 15, 2023, the Registrar transmitted by email to the Center its verification response and contact information in the Complaint. The Center verified that 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 the Respondent of the Complaint, and the proceedings commenced on March 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 4, 2023.

The Center appointed Christopher J. Pibus as the sole panelist in this matter on April 17, 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 Complainant is a Swedish company, founded in 2014, that designs and distributes high fashion products around the world. It offers online shopping and also operates retail stores in Stockholm, New York, and Shanghai.

The Complainant owns a portfolio of TOTEME-formative trademarks which are protected in more than fifty countries for fashion products including clothing, shoes, bags and accessories, and for retail store services.

Examples of its registrations for the word mark TOTEME include:

United States of America trademark No. 4730273, registered May 5, 2015;
European Union Trademark No. 018042127, registered July 20, 2019; and
China Trademark No. 39973640 registered September 7, 2020.

The disputed domain name was registered on April 29, 2022, and resolves to a commercial website in relation to fashion goods at discounted prices, displaying the Complainant's trademark.

5. Parties' Contentions

A. Complainant

The Complainant submits that it is the owner of well-established rights in the trademark TOTEME based on use and registration in the European Union and other countries where it carries on business. The disputed domain name is confusingly similar to the Complainant's registered trademark, as it contains the Complainant's trademark as a whole with the addition of the word "outlet" which does not diminish the likelihood of confusion.

With respect to the absence of rights or legitimate interests, the Complainant submits that the Respondent has engaged in a scheme to deceive users who access his website, which has been designed to have the look and feel of the Complainant's retail website, under the name "Cheap Toteme Store". The Complainant asserts that the Respondent has never been authorized to engage in this conduct or to adopt a confusingly similar domain name. It further submits that the Respondent is not making a *bona fide* offering of services but rather is using the disputed domain name to divert unknowing users who are deceived by the associated website. The Complainant submits that it has put forward clear *prima facie* evidence of the absence of rights or legitimate interests.

With respect to bad faith, the Complainant relies on evidence of the Respondent's impersonation scheme and its look-alike website, to establish abusive registration and use of the disputed domain name. Based on this misconduct, the Complainant submits that there is sufficient evidence to support a finding of bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, the Complainant must establish each of the following elements:

- (i) The disputed domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interest 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

The Complainant clearly holds relevant ownership rights in the trademark TOTEME, as demonstrated by the registered trademarks enumerated in paragraph 4, which were registered before the Respondent took any steps to acquire and use the disputed domain name.

The test for confusing similarity is described as a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name” in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s registered trademark. The disputed domain name includes the entirety of the distinctive TOTEME mark with the addition of the descriptive term “outlet”. This variation does not prevent a finding of confusing similarity under the first element. The Complainant’s trademark is clearly recognizable within the disputed domain name ([WIPO Overview 3.0](#), section 1.8).

Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Although the Policy places on the complainant the burden of proof to establish the absence of rights or legitimate interests, the practice now recognizes that it is often sufficient for a complainant to make out a *prima facie* case, which then shifts the burden to the respondent to bring forward evidence to demonstrate the relevant rights or interests. Where the respondent fails to produce such evidence, the complainant will be deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1).

In this proceeding, the Complainant has provided detailed evidence of the Respondent’s misconduct in misappropriating the Complainant’s trademark and creating an online store (associated with the disputed domain name) which copies content from the Complainant’s website, all of which is in furtherance of a scheme to deceive users. The documentary evidence shows misappropriation of product images and the Complainant’s distinctive geometric logo in the Respondent’s so-called “Cheap Toteme Store”, although the products are not genuine goods originating with the Complainant. The totality of the evidence clearly establishes a *prima facie* case of the absence of rights or legitimate interests on the part of the Respondent. Illegal conduct of this nature is highly probative in connection with this issue. “Panels have categorically held that the use of a domain name for illegal activity (e.g., [...] impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.” ([WIPO Overview 3.0](#), section 2.13.1.) In addition, the Panel finds that the nature of the disputed domain name together with the associated website carry a risk of implied affiliation with the Complainant.

In the absence of any response from the Respondent, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the disputed domain name constitutes an abusive registration which was registered and is being used in bad faith in order to take advantage of the significance of TOTEME as a well known trademark. The Respondent clearly set out to target the Complainant and to deceive Internet users into believing that its website, associated with the confusingly similar disputed domain name, was in fact a website of the Complainant. The Respondent’s website was cunningly adapted so it had the appearance of a legitimate virtual shop for the TOTEME line of products, including the replication of the Complainant’s distinctive logo in multiple places as well as the reproduced product images, when in fact the goods did not originate with the Complainant. However, the Respondent’s bad faith goes beyond the unauthorized reproduction by pricing items at absurdly low levels, more than 80% less than the purported regular price, thereby inflicting economic harm targeted at the Complainant’s market. Other indicia of bad faith include the use of a false business address for the so-called “Cheap Toteme Store” in San Antonio, Texas, which the Complainant identifies as a false address used in numerous other fraudulent enterprises. This same address was also used for a similar bad faith scheme in association with the domain name <toteme-outlet.com>, which was the subject of a recent decision in favour of the Complainant in *Toteme AB v. Xiuorong Ma*, WIPO Case No. [D2022-3631](#). [WIPO Overview 3.0](#), section 3.4 recognizes this type of use of deceptive impersonation websites as probative evidence of bad faith (see *Magna International Inc. v. Stefan Polisky*, WIPO Case No. [D2021-0875](#)).

Accordingly the Panel finds that the Respondent has intentionally attempted to attract for commercial gain Internet users to his website by creating a likelihood of confusion with the Complainant's TOTEME mark, as to the source, sponsorship, affiliation or endorsement of the website and products offered on it, under paragraph 4(b)(iv) of the Policy.

The 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, the Panel orders that the disputed domain name, <totemeoutlet.com>, be transferred to the Complainant.

/Christopher J. Pibus/

Christopher J. Pibus

Sole Panelist

Date: April 28, 2023