

ADMINISTRATIVE PANEL DECISION

Jomashop Inc v. M Humayon

Case No. D2023-4484

1. The Parties

The Complainant is Jomashop Inc, United States of America (“United States”), represented by Pryor Cashman, LLP, United States.

The Respondent is M Humayon, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <joma-watches.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2023. On October 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 30, 2023, 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 (Registration Private, Domains By Proxy, LLC (DomainByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 31, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on October 31, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on November 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 24, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on November 30, 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 owns and operates an online store, available at the domain name <jomashop.com>, specialized in the sale of watches, handbags, sunglasses, jewelry, beauty, fine writing instruments, apparel, shoes, and gift items.

The Complainant is the owner of the United States trademark registration Nos. 5410951 for JOMASHOP (word mark), filed on May 08, 2017, and registered on February 27, 2018, in international class 35; and 3682361 for JOMASHOP.COM (word mark), filed on October 13, 2008, and registered on September 15, 2009, in international class 35.

The Complainant's domain name <jomashop.com> was registered on December 1, 1999.

The disputed domain name <joma-watches.com> was registered on May 26, 2023, and is currently pointed to a webpage indicating: "Sorry, this store is currently unavailable". Based on the evidence submitted by the Complainant – which have not been challenged by the Respondent - prior to the present proceeding, the disputed domain name resolved to a website displaying a "Joma Watches" logo and purportedly offering branded watches for sale at discounted prices. According to such evidence, the only contact information provided of the website operator were an incomplete address based in Canada ("Mississauga, ON L5G4T8, Canada"), a Gmail email address and a telephone number.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the three elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the trademarks JOMASHOP and JOMASHOP.COM in which the Complainant has rights as it reproduces the "Joma" portion of the Complainant's trademark, with the mere addition of a hyphen, followed by the generic term "watches" and the generic Top-Level Domain ("gTLD") ".com".

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that i) the Respondent has never been authorized or licensed by the Complainant, ii) the Complainant does not have and never has had any type of business relationship with the Respondent, and iii) the Complainant has never consented to the Respondent's registration or use of the disputed domain name.

The Complainant underlines that its registration of the JOMASHOP mark long predate the registration of the disputed domain name and submits that considering the Respondent is not commonly known by the disputed domain name and is using the same to trade upon the Complainant's mark and goodwill, the Respondent cannot be considered to be using the disputed domain name for a *bona fide* offering of goods or services, nor for a legitimate noncommercial or fair use, since it purports to offer for sale watches, using a misleading "Joma Watches" logo, at suspiciously low, heavily discounted prices.

Moreover, the Complainant states that the Respondent set fake sales figures on the website and provided incomplete contact information and submits that the Respondent may have been engaging in the sale of counterfeit goods or may not have been selling any goods at all but was merely perpetuating a scam to collect credit card and other personal information from visitors.

Additionally, the Complainant highlights that the Respondent's website purported to be a retail website for authentic watches, which is identical to the retail services rendered at the Complainant's <jomashop.com> website, so consumers would have been likely led to believe that the Respondent's website was associated with or authorized by the Complainant, or was in fact the Complainant's website, when that was not the case.

With reference to the circumstances evidencing bad faith, the Complainant indicates that considering (i) the Complainant's rights long predate the Respondent's registration of the disputed domain name; (ii) the disputed domain name is confusingly similar to the Complainant's well-known trademarks JOMASHOP and JOMASHOP.COM; and (iii) the Respondent's website located at the disputed domain name purported to offer authentic watches for sale, which are identical services to the Complainant's services, it is highly unlikely that the Respondent was not aware of the Complainant at the time of registering the disputed domain name, nonetheless it chose to register and use the disputed domain name in bad faith as described above.

The Complainant claims that the Respondent is using the disputed domain name in bad faith, Respondent intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website as it used the dominant "Joma" portion of the Complainant's JOMASHOP mark and the word "watches" to create initial interest and confusion as to the ownership and/or sponsorship of the website to which the disputed domain name resolved.

The Complainant also asserts that each and every of the thousands of watch listing webpages on the Respondent's website, displayed a fabricated watch sales figure (e.g. "3 sold in last 25 hours"), which materially changed when visitors immediately reload the page (often to display a sales figure that was incongruous with the previously displayed sales figure), this being a fraudulent marketing tactic to make it appear to visitors that the website was selling multiple watches every day and was displaying legitimate sales figures, when it was not.

The Complainant also submits that the website to which the disputed domain name resolved was deemed "suspicious" by multiple third-party malware assessment websites, and that the Respondent may have potentially engaged in a fraudulent scheme that targeted Internet users intending to visit the Complainant's <jomashop.com> website and were looking to buy authentic watches, which would further proof of bad faith registration and use.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall 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." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

Indeed, the Complainant is the owner of a United States trademark registration for JOMASHOP.

The Panel finds the dominant portion of the Complainant's mark, consisting of the "joma" prefix, is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the term "watches" may bear on assessment of the second and third elements, the Panel finds the addition of such term, along with a hyphen, does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Therefore, based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's marks. Moreover, there is no element from which the Panel could infer a Respondent's rights and legitimate interests over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

As mentioned above, the disputed domain name is currently not pointed to an active website but prior to the present proceeding, it redirected to a website displaying a "Joma Watches" logo that purportedly offered multiple branded watches for sale. The lack of complete contact information of the website operator, the lack of any accurate or prominent disclaimer and the discounted prices at which the products were offered

supports the inference that the Respondent, as indicated by the Complainant, may have actually engaged in the sale of counterfeit goods or intended to obtain users' credit card data and personal information by pretending to offer genuine branded watches.

In view of the above-described use of the disputed domain name, the Panel finds that the Respondent has not used, and is not using, the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Moreover, Panels have held that the use of a domain name for illegal activity as applicable to this case: sale of counterfeit goods, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Therefore, based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel finds that, in light of i) the prior registration and use of the Complainant's trademark JOMASHOP in connection with the Complainant's retail services offered online via the website "www.jomashop.com", ii) the composition of the disputed domain name encompassing the same fanciful term "Joma" featured in the Complainant's trademark combined with a hyphen and an added term "watches" relevant to the Complainant's business, and iii) the use of the disputed domain name in connection with retail services like the ones provided by the Complainant and purportedly offered under the similar name "Joma Watches", the Respondent very likely registered the disputed domain name having the Complainant's trademark in mind and intended to target the Complainant and its trademarks at the time of registration of the disputed domain name.

The Panel also finds that, in view of the use of the disputed domain name to divert users to the website described above, the Respondent intentionally attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website and the goods offered therein, according to paragraph 4(b)(iv) of the Policy.

With regards to the current use of the disputed domain name, the Panel notes that it does not resolve to an active website.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel finds that, in view of the distinctiveness of the Complainant's trademark, in particular of its prefix "Joma", the composition of the disputed domain name and the prior use of the disputed domain name made by the Respondent, the absence of any attempt by the Respondent to refute Complainant's allegations, the current passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy in the circumstances of this proceeding.

Therefore, based on the available record, the Panel finds that the Complainant has established the third element 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 <joma-watches.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: December 14, 2023