

ADMINISTRATIVE PANEL DECISION

PVH Corp., Tommy Hilfiger Licensing B.V. and Tommy Hilfiger Licensing LLC
v. c/o WHOISt trustee.com Limited, Registrant of tommytaiwan.com / hu yang
Case No. D2022-0054

1. The Parties

The Complainants are PVH Corp., United States of America (“United States”), Tommy Hilfiger Licensing B.V., Netherlands, and Tommy Hilfiger Licensing LLC, United States, represented by Winterfeldt IP Group PLLC, United States.

The Respondent is c/o WHOISt trustee.com Limited, Registrant of tommytaiwan.com, United Kingdom / hu yang, China.

2. The Domain Name and Registrar

The disputed domain name <tommytaiwan.com> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 6, 2022. On January 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 11, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 11, 2022, 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 amended Complaint on January 13, 2022.

The Center verified that the Complaint together with the amended 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 January 17, 2022. In accordance with the Rules, paragraph

5, the due date for Response was February 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 9, 2022.

The Center appointed Tuukka Airaksinen as the sole panelist in this matter on February 15, 2022. 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 PVH Corp is a parent company to the Complainants Tommy Hilfiger Licensing, B.V. and Tommy Hilfiger Licensing LLC (collectively "Tommy Hilfiger"). Tommy Hilfiger designs, sources, distributes, sells and markets fashion apparel, accessories and other products throughout the world under the trademark TOMMY HILFIGER and TOMMY.

In 2019, the Complainants' global revenue was approximately USD 9,2 billion and in 2020 the trademark TOMMY HILFIGER was ranked as the world's 75th most valuable brand with brand value at USD 1 billion.

The Complainants are the owners of the trademark TOMMY, registered *inter alia* as a United States trademark No 2475142 as of August 7, 2001.

The disputed domain name was registered on December 4, 2018. The disputed domain name resolves to a website selling counterfeit Complainants' goods and services using exact reproductions of the TOMMY trademark in connection with competing apparel and associated retail services.

5. Parties' Contentions

A. Complainant

The disputed domain name is confusingly similar to the Complainants' trademark TOMMY as it includes the same in its entirety combined with the geographic term "taiwan". This does not diminish similarity between the Complainants' trademark and the disputed domain name and actually increases likelihood of confusion.

The Respondent has no rights or legitimate interests to the disputed domain name. The Respondent is not associated with the Complainants and has never been authorized to use the Complainants' trademarks in any manner.

The disputed domain name is used to sell counterfeit merchandise bearing the Complainants' trademark. The disputed domain name resolves to a website offering goods directly competing with those of the Complainants and also bearing the Complainants' trademark.

B. Respondent

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

6. Discussion and Findings

In order to obtain the transfer of a domain name, a complainant must prove the three elements of paragraph 4(a) of the Policy, regardless of whether the respondent files a response to the complaint or not. The first element is that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. The second element a complainant must prove is that the respondent has no

rights or legitimate interests in respect of the domain name. The third element a complainant must establish is that the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires that the Complainant establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. Consequently, the Complainant must prove that it has rights to a trademark, and that the disputed domain name is identical or confusingly similar to this trademark.

According to section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test".

Furthermore, "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements". See section 1.8 of the [WIPO Overview 3.0](#).

The disputed domain name is confusingly similar to the Complainants' trademark as it includes the Complainants' trademark in its entirety and in an easily recognizable form combined with the geographical term "taiwan". This addition does not prevent a finding of confusing similarity between the Complainants' trademark and the disputed domain name.

This means that the disputed domain name is confusingly similar with the Complainants' trademark and hence the first element of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests to the disputed domain name.

It is widely accepted among UDRP panels that once a complainant has made a *prima facie* showing indicating the absence of the respondent's rights or legitimate interests in a disputed domain name the burden of production shifts to the respondent to come forward with evidence of such rights or legitimate interests. If the respondent fails to do so, the complainant is deemed to have satisfied the second element of the Policy. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#), and section 2.1 of the [WIPO Overview 3.0](#).

The Complainants have credibly submitted that the Respondent is neither affiliated with the Complainants in any way nor has it been authorized by the Complainants to use and register the disputed domain name, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain name and is not commonly known by the disputed domain name in accordance with paragraph 4(c)(ii) of the Policy.

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainants' trademark. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Complainants have made a *prima facie* case that has not been rebutted by the Respondent. Considering the Panel's findings below, the Panel finds that there are no other circumstances that provide the Respondent with any rights or legitimate interests in the disputed domain name. Therefore, the Panel finds that the second element of the Policy is fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy provides that the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent’s] documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business or competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] website or location or of a product or service on [the respondent’s] website or location.”

The Panel agrees with the Complainants, and previous UDRP panels, that the Complainants’ trademark is a well-known trademark within the fashion industry. It is therefore inconceivable that the Respondent would not have been aware of the Complainants’ trademark when registering the disputed domain name, especially considering the Respondent’s website offers counterfeit goods that bears the Complainants’ trademark.

It is therefore evident that the Respondent has registered the disputed domain name to intentionally attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainants’ mark as to the source, affiliation, or endorsement of the Respondent’s website.

Therefore, the Panel finds that the third element of the Policy is fulfilled.

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 <tommytaiwan.com> be transferred to the Complainants.

/Tuukka Airaksinen/

Tuukka Airaksinen

Sole Panelist

Date: March 1, 2022