

ADMINISTRATIVE PANEL DECISION

Mycoskie, LLC v. Client Care, Web Commerce Communications Limited
Case No. D2022-2020

1. The Parties

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

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <tenistoms.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 3, 2022. On June 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 7, 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 June 8, 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 amendment to the Complaint on June 9, 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 the Respondent of the Complaint, and the proceedings commenced on June 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 1, 2022.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on July 14, 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 Mycoskie, LLC is the owner of the TOMS trademark, which is used in commerce by its exclusive licensee TOMS Shoes, LLC in order to design and market shoes, eyewear, coffee, apparel and handbags. The Complainant and TOMS Shoes, LLC were founded by Blake Mycoskie, and the two companies have their principal place of business in Los Angeles, California, United States.

The TOMS trademark was registered in several jurisdictions around the world including United States, European Union, Mexico, Australia, Singapore and Malaysia, including the United States trademark registration No. 3353902 registered on December 11, 2007.

The disputed domain name was registered on June 21, 2021 and is currently inactive. However, according to evidence submitted by the Complainant, it resolved to a website offering the Complainant's products.

5. Parties' Contentions

A. Complainant

The Complainant stated that the disputed domain name incorporates the Complainant's TOMS trademark, with the addition of the term "tenis". Therefore, it is evident that the Complainant's trademark is clearly recognizable in the disputed domain name. In addition the Complainant states that the word "tenis" means "tennis" or "tennis shoes" in Portuguese and Spanish which are goods related to those offered by the Complainant.

The Complainant stated that the Respondent Web Commerce Communications Limited is not known by the name TOMS, nor has Web Commerce Communications Limited received any approval to register the disputed domain name.

The Complainant stated that the disputed domain name seems to be inactive. However, the Complainant notes that the access of the website is blocked, at least, from the United States and Sweden. Thanks to the screenshots taken from a VPN system it can be seen how the disputed domain name resolves to a website in Spanish language, in which the Complainant's TOMS mark is reproduced on top and where TOMS-branded shoes are purportedly offered for sale.

The Complainant also stated that the website to which the disputed domain name resolves: (i) allegedly offers TOMS-branded products for sale. See the below comparison, (ii) includes the copyright notice "tenistoms" and the text "Toms Mexico", without mentioning the name of the Website owner, (iii) the website does not contain any note, information or disclaimer pointing out that the owner of the Website actually has no relationship with the Complainant, misleading consumers into thinking that they are related.

Taking the above into consideration, and bearing in mind that the disputed domain name incorporates the Complainant's TOMS trademark in full, and the fact that the term "Toms" is commonly associated with the Complainant and its activities, there is no doubt that the disputed domain name seeks to capitalize the goodwill of the Complainant's TOMS mark, misleading consumers into thinking that the website is operated by or affiliated with the Complainant. Therefore, this use of the disputed domain name cannot be considered a *bona fide* use.

The Complainant's TOMS mark has been registered and in use well before the registration date of the disputed domain name. Given the Complainant's numerous trademark registrations for the TOMS mark

worldwide (including in Malaysia, where the Respondent appears to be located according to the Whois information), and the fact that Internet users commonly associate the terms “tenistoms” and “toms” with the Complainant and its activities, it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant and the Complainant’s TOMS mark when the disputed domain name was registered.

In addition the Complainant stated that the Respondent has also been involved in numerous UDRP decisions (see for instance: *C. & J. Clark International Ltd v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0813](#), *ABG Juicy Couture, LLC v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-1096](#), *Spyder Active Sports, Inc. v. Web Commerce Communications Limited*, WIPO Case No. [D2022-0659](#), *Alpargatas S.A., Alpargatas Europe, S.L.U v. Sabrina Diederich / Web Commerce Communications Limited*, WIPO Case No. [D2022-0942](#)). According to the Complainant, these cases show that the Respondent is a “serial cybersquatter” which further supports registration and use of bad faith of the disputed domain name.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must prove that:

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

A. Identical or Confusingly Similar

The Complainant has submitted registration certificates demonstrating that it has trademark rights in the TOMS trademark.

The disputed domain name wholly incorporates that trademark, with the addition of the term “tenis”, which does not prevent the Complainant’s trademark from being recognizable within the disputed domain name.

The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

In the view of the Panel, the Complainant’s submissions set out above give rise to a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and so the burden of production has effectively been shifted to the Respondent. However, the Respondent has failed to file any response in this proceeding and has not submitted any explanation for its registration and use of the disputed domain name, or evidence of rights or legitimate interests on its part in the disputed domain name, whether in the circumstances contemplated by paragraph 4(c) of the Policy or otherwise.

Noting the composition of the disputed domain name, the Panel also finds that the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the WIPO Overview of WIPO

Panel Views on Selected UDRP Questions, Third Edition "[WIPO Overview 3.0](#)".

The Panel therefore finds that the Respondent has not rebutted the Complainant's *prima facie* case, and that the Complainant has established the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant must prove both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Complainant's allegations with regard to the Respondent's registration and use of the disputed domain name in bad faith has been considered by the Panel. These allegations have not been contested by the Respondent because of its default.

The Respondent has registered a domain name that reproduces in its entirety the TOMS trademark with the addition of the term "tenis" which is used in Spanish and Portuguese languages to designate sport shoes, a product linked to the Complainant. In view of this, the Panel understands that this is evidence of bad faith registration.

In addition, the disputed domain name resolved to a website in Spanish language, in which the Complainant's TOMS mark were reproduced on top and where TOMS-branded shoes were purportedly offered for sale. Thus in view of this the Panel is of the view that the Respondent has registered the disputed domain name to attract Internet users to the website for commercial gain in accordance with paragraph 4(b)(iv) of the Policy.

The current non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding.

Finally, the Panel notes that the Respondent was also a party to several UDRP cases, some of them involving trademark related to shoes (see *Puma SE v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-1806](#); *Gabor Shoes AG v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-1541](#) and *Alpargatas S.A., Alpargatas Europe, S.L.U v. Sabrina Diederich / Web Commerce Communications Limited*, WIPO Case No. [D2022-0942](#)). This is further evidence of bad faith.

For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under paragraph 4(a) 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 <tenistoms.com> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: July 28, 2022