

## **ADMINISTRATIVE PANEL DECISION**

Fossil Group, Inc. v. Client Care, Web Commerce Communications Limited /  
Norma Sauter

Case No. D2022-2824

### **1. The Parties**

The Complainant is Fossil Group, Inc., United States of America (“United States”), represented by Marq Vision Inc., Republic of Korea.

The Respondents are Client Care, Web Commerce Communications Limited, Malaysia / Norma Sauter, United States.

### **2. The Domain Names and Registrars**

The disputed domain names <fossilphilippines.com> and <fossilphilippines.com> are registered with Alibaba.com Singapore E-Commerce Private Limited; the disputed domain name <fossilphilippines.top> is registered with NameSilo, LLC. (Collectively the “Registrars”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 27, 2022. On August 2, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names <fossilphilippines.com> and <fossilphilippines.top>. On August 2 and 3, 2022, the Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the disputed domain names which differed from the named Respondents and contact information in the Complaint. The Center sent an email communication to the Complainant on August 9, 2022, providing the registrant and contact information for the multiple underlying registrants disclosed by the Registrar, and inviting the Complainant to either amend the Complaint, adding the Registrar-disclosed registrants as formal Respondents and provide relevant arguments or evidence demonstrating that all named Respondents are, in fact, the same entity and/or that all domain names are under common control or indicate which disputed domain names would have no longer been included in the current Complaint. The Complainant filed amendments to the Complaint on August 10 and 18, 2022.

On August 18, 2022, the Complainant requested for <fossilphilippines.com> to be added to the proceedings. On August 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <fossilphilippines.com>. On August 22, 2022, the Registrar transmitted by email to the Center its verification response. The Center sent an email communication to the

Complainant on August 22, 2022, providing the registrant and contact information for <fossilphilippines.com> disclosed by the Registrar, and inviting the Complainant to either amend the Complaint adding the Registrar-disclosed registrant as the formal Respondent and provide relevant arguments or evidence demonstrating that all the named Respondents are, in fact, the same entity and/or that all domain names are under common control or indicate which disputed domain names would have no longer been included in the current Complaint. The Complainant filed an Amended Complaint on August 24, 2022, and an amendment to the Complaint August 25, 2022.

The Center verified that the Complaint together with the amendments to the Complaint and 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 August 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 16, 2022.

The Center appointed Luca Barbero as the sole panelist in this matter on September 21, 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 designs, manufactures and commercializes watches and bags under the trademark FOSSIL.

The Complainant is the owner of the following trademark registrations for FOSSIL, as per trademark certificates submitted as annex to the Complaint:

- United States Trademark registration No. 2599215 for FOSSIL (word mark), filed on January 18, 2001, and registered on July 23, 2002, in international class 14;
- United States Trademark registration No. 1582547 for FOSSIL (word mark), filed on August 23, 1988, and registered on February 13, 1990, in international class 18;
- Philippines trademark registration No. 505176, for FOSSIL (word mark), filed on October 10, 2016, and registered on October 4, 2018, in classes 9, 14, and 18;
- Malaysia trademark registration No. 2016068645 for FOSSIL (figurative mark), and registered on October 10, 2016, in international class 14;
- Malaysia trademark registration No. 2016068636, for FOSSIL (figurative mark), registered on October 10, 2016, in international class 18.

The Complainant is also the owner of the domain name <fossil.com>, registered on June 3, 1995, and used by the Complainant to promote and sell its products under the trademark FOSSIL.

The disputed domain names <fossilphilippines.com> registered on April 27, 2022, <fossilphilippines.com>, registered on July 18, 2022, and <fossilphilippines.top>, registered on July 18, 2022, as per annexes in the Complaint, are pointed to websites where the Complainant's trademark and images of FOSSIL products are published and purported FOSSIL products are advertised and offered for sale.

## 5. Parties' Contentions

### A. Complainant

The Complainant contends that disputed domain names are confusingly similar to the trademark FOSSIL in which the Complainant has rights.

The Complainant also states that the Respondents have no rights or legitimate interests in respect of the disputed domain names since:

- (i) the Respondents are not commonly known by the disputed domain names;
- (ii) the Respondents have not acquired trademark or service mark rights in the FOSSIL mark;
- (iii) the Respondents have not been authorized by the Complainant to use its well-known trademark FOSSIL;
- (iv) no actual or contemplated *bona fide* or legitimate use of the disputed domain names can be claimed since the Respondents are not licensed or permitted by the Complainant to use its trademark;
- (v) the disputed domain names are used to host a website copying the FOSSIL trademark and copyright protected content that can be found on the Complainant's website "www.fossil.com" and an online store selling allegedly counterfeit goods based on the Complainant's products.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondents must have been well aware of the Complainant and its trademark at the time of registering the disputed domain names, since they used the overall "look and feel" of the Complainant's website by copying the Complainant's trademark and copyright protected images.

The Complainant emphasizes that the Respondents' websites are used to sell allegedly counterfeit goods based on the Complainant's products and concludes that the Respondents are therefore using the disputed domain names to intentionally attract, for commercial gain, Internet users to their websites, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship or endorsement of such websites.

The Complainant underlines that the Respondents' registration of the disputed domain names also prevents the Complainant from reflecting its trademark in corresponding domain names, consequently affecting the Complainant's business.

### B. Respondents

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

## 6. Discussion and Findings

### 6.1. Consolidation of multiple Respondents

Paragraph 10(e) of the Rules provides that a panel shall decide a request by a party to consolidate multiple domain name disputes in accordance with the Policy and the Rules.

As stated in section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario. Panels have considered a range of factors, typically present

in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s)."

The Complainant asserted that the disputed domain names, although registered by different named registrants, are under common control since:

- i) the content and layout of the websites to which the disputed domain names resolve, including but not limited to their main page, product offer page, privacy notice, return policy and shipping info, are identical;
- ii) the naming pattern of the domain names is identical, combining the Complainant's trademark FOSSIL with the geographical term "philippines" (although misspelled in the disputed domain name <fossilphilippines.com>);
- iii) the IP address of the domain names is identical; and
- iv) for a brief period of time, the landing page for the domain name <fossilphilippines.com> was <fossilphilippines.top> (though no record of this last statement was supplied as evidence).

The Panel finds that the elements highlighted by the Complainants and referenced above sufficiently demonstrate a common control of the disputed domain names by the Respondents.

Indeed, the disputed domain names all incorporate the Complainants' trademark with the mere addition of the geographical term "philippines", or misspellings thereof, and have been pointed to almost identical websites promoting the sale of purported FOSSIL products. The Panel also notes that two of the disputed domain names <fossilphilippines.com> and <fossilphilippines.top>, were registered on the same day and that the disputed domain names <fossilphilippines.com> and <fossilphilippines.com> are registered in the name of the same registrant.

In view of the above, the Panel concludes that the consolidation of the multiple domain names is appropriate in this case and is consistent with the Policy and Rules as well as with prior relevant UDRP decisions in this area. See *i.a.* other prior decisions in which UDRP panels deemed appropriate to consolidate multiple domain names in circumstances similar to the ones of the present case, *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#); *Société des Produits Nestlé S.A. v. Super Privacy Service LTD c/o Dynadot / Glova Karl, Grosorow, Nitsch Weiser, Thels Thdss, Binhuang Lin and Minyu Lin*, WIPO Case No. [D2021-3475](#); *Guccio Gucci S.p.A., v. 詹金荣 (Zhan Jinrong); 何祥 (He Xiang); 张明荣 (Zhang Mingrong); 蓝罗程 (Lan Luocheng); 张航 (Zhang Hang); Philipp Schumacher, Hardware Solutions Canada (HSC) Inc.; Mathieu Laroussi, Gucciowner; Tok Pi; Eiki Stone village; Dominique Lacroix; Daniel Liao; Chengwei Hong, Guccidubai; Jingjia Ji, Gucci; Ba Dan Wang; Hua Wang; Huaiwei Zhang; Ke Ke Zhou; Manami Murakami; Peter Green; Sara Lee; SDFDS DSFS; Siciyuan Luo; Wang Zhang; \u6d25\u5609\u5c71 \u5f18\u6a39 [津嘉山 弘树]*, WIPO Case No. [D2020-3211](#); and *Société des Produits Nestlé S.A. v. Domain Admin, Whois Privacy Corp., and WhoisSecure, WhoisSecure / Sylvester Galphin*, WIPO Case No. [D2021-1322](#)).

Therefore, the Panel will now proceed to a decision on the merits of the case.

## 6.2. Substantive Issues

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

### A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark FOSSIL based on the trademark registrations cited under section 4 above and the excerpt of the trademark registration details submitted as annex 8 to the Complaint.

As highlighted in section 1.7 of the [WIPO Overview 3.0](#), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain names.

Moreover, where the relevant trademark is recognizable within the disputed domain names, the addition of other terms (whether descriptive or otherwise) would not prevent a finding of confusing similarity under the first element (sections 1.8 of the [WIPO Overview 3.0](#)).

In the case at hand, the Complainant’s trademark FOSSIL is entirely reproduced in the disputed domain names, with the mere addition of the term “philippines” in two disputed domain names and an obvious misspelling of the word “philippines” in the <fossilphilippines.com> disputed domain name – where the last “i” was deliberately substituted by a “l” – and the generic Top-Level Domains “.com” and “.top”, which are commonly disregarded under the first element confusing similarity test (section 1.11 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain names are confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

The Complainant must show that the Respondents have no rights or legitimate interests in respect of the disputed domain names. The Respondents may establish a right or legitimate interest in the disputed domain names by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- “(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

In the case at hand, the Complainant has made a *prima facie* case and the Respondent, by not filing any response, have failed to raise any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondents and the Complainant. The Respondents are not licensees of the Complainant, nor have the Respondents otherwise obtained an authorization to use the Complainant’s trademark.

Moreover, there is no indication before the Panel that the Respondents are commonly known by the disputed domain names, have made preparations to use the disputed domain names in connection with a *bona fide* offering of goods or services, or that they intend to make a legitimate, noncommercial or fair use of the disputed domain names.

As mentioned above, the disputed domain names have been pointed to websites publishing the Complainant’s trademark and images taken from the Complainant’s website and promoting the sale of purported FOSSIL products. The Panel also notes that the Respondents have not provided disclaimers on their websites to inform users of their lack of affiliation with the Complainant. The Respondents have thus failed to meet the cumulative requirements set forth in the leading case *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), <okidataparts.com> and referred to in section 2.8.1 of the [WIPO Overview 3.0](#) for a reseller to claim use of a domain name encompassing a third-party trademark in connection with a *bona fide* offering of goods and services.<sup>1</sup> Particularly, the Respondents have failed to accurately and prominently disclose their absence of relationship with the trademark holder.

Moreover, the contents of the Respondents’ websites appear to be designed to reinforce the impression that the websites are operated by the Complainant or one of its affiliated entities with the Complainant’s consent. In this context, the composition of the disputed domain names, combining the Complainant’s well-known trademark FOSSIL with a geographical term, or barely perceptible misspelling thereof, creates a risk of implied affiliation. As stated in section 2.5.1 of the [WIPO Overview 3.0](#), “Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner”.

Therefore, the Panel finds that the Complainant has proven that the Respondents have no rights or legitimate interests in the disputed domain names according to paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain names were registered and are being used by the Respondents in bad faith.

As to the bad faith at the time of the registration, the Panel notes that, in light of the prior registration and use of the trademark FOSSIL in connection with the Complainant’s products, also online on the Complainant’s website “www.fossil.com”, and considering the Respondents’ direction of the disputed domain names to

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<sup>1</sup> According to section 2.8.1. of the [WIPO Overview 3.0](#), “Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the “Okidata test”, the following cumulative requirements will be applied in the specific conditions of a UDRP case: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark”.

websites displaying the trademark FOSSIL and images of the Complainant's products, the Respondents clearly registered the disputed domain names with the Complainant's trademark in mind.

The Panel also finds that, by pointing the disputed domain names to websites publishing the Complainant's trademark and images taken from the Complainant's website and offering for sale purported FOSSIL products without accurately and prominently disclose their (lack of) relationship with the trademark owner, the Respondents have intentionally attempted to attract Internet users to their websites for commercial gain, by causing a likelihood of confusion with the trademark FOSSIL as to the source, sponsorship, affiliation or endorsement of their websites and the products promoted therein according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainant has also proven that the Respondents registered and are using the disputed domain names in bad faith according to 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 names, <fossilphilippines.com>, <fossilphilippines.top>, and <fossilphilippines.com>, be transferred to the Complainant.

*/Luca Barbero/*

**Luca Barbero**

Sole Panelist

Date: October 6, 2022