

ADMINISTRATIVE PANEL DECISION

Tomboy Exchange, Inc. v. dong0 Bong
Case No. D2022-4576

1. The Parties

The Complainant is Tomboy Exchange, Inc., United States of America (“United States”), represented by DLA Piper US LLP, United States.

The Respondent is dong0 Bong, China.

2. The Domain Name and Registrar

The disputed domain name <tomboyxus.com> (the “Disputed Domain Name”) 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 December 1, 2022. On December 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 2, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 December 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 28, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on January 3, 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 United States headquartered clothing business that has been trading online since at least 2014. The Complainant holds registrations in a number of countries for the mark TOMBOYX including, for example, United States Trademark No. 5021246, registered in classes 18, 25, and 35 on August 16, 2016.

The Complainant owns the domain name <tomboyx.com>, where its e-commerce website is located.

The Disputed Domain Name <tomboyxus.com> was registered on August 6, 2022. The Disputed Domain Name resolves to a website impersonating the Complainant's official e-commerce website and offering the Complainant's products for sale.

5. Parties' Contentions

A. Complainant

The Complainant cites its trademark registrations for TOMBOYX in various countries, including China, as *prima facie* evidence of ownership.

The Complainant submits that its rights in the trademark TOMBOYX predate the Respondent's registration of the Disputed Domain Name <tomboyxus.com>. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the TOMBOYX trademark and that the similarity is not removed by the addition of the letters "us".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it allegedly has been used in a phishing scheme involving an error message on the website that the Disputed Domain Name resolves to, followed by a telephone call seeking card payment details.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules. It submits that the Respondent registered the Disputed Domain Name which resolved to a website that "currently does not sell any products but, upon information and belief, appears to be the front for a phishing scam" which evidences registration and use of the Disputed Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark TOMBOYX. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected URDP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the TOMBOYX trademark, the Panel observes that the Disputed Domain Name comprises: (a) an exact reproduction of the Complainant’s TOMBOYX trademark; (b) followed by the letters “us”; (c) followed by the generic Top-Level Domain (“gTLD”) “.com”.

It is well established that the gTLD used as technical part of a domain name may be disregarded. The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: “tomboyxus” (see section 1.11.1 of the [WIPO Overview 3.0](#)).

It is also well established that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

This Panel accepts that the addition of the letters “us” does not preclude a finding of confusing similarity to the Complainant’s trademark (see, for example: *Lilly ICOS LLC v. 2thetop Marketing*, WIPO Case No. [D2005-0559](#), and [WIPO Overview 3.0](#), section 1.8).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden of proof on the Complainant to establish the absence of the Respondent’s rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it has not licensed, permitted or authorized the Respondent to use the Complainant’s trademark or to sell its products and for those reasons, the Respondent is not making a *bona fide* offering of goods or services. The Complainant submits that “When users attempt to make a purchase on the tomboyxus.com domain, they receive an error message stating ‘Unfortunately your order cannot be processed as the originating bank/merchant has declined your transaction.’ Or ‘Sorry, payment is failure, please try another card!’ Less than an hour later users receive a phone call from a bank stating that a temporary restriction has been placed on the card. However, the call is not from the user’s actual bank but, upon information and belief, is from the Registrant phishing for personal information”.

The composition of the Disputed Domain Name consists of the Complainant’s trademark and the letters “us”. In this Panel’s view, the conduct indicates an awareness of the Complainant and its mark and intent to take unfair advantage of such, which does not support a finding of any rights or legitimate interests (see [WIPO Overview 3.0](#), section 2.5.1).

The use of a domain name for illegal activity such as impersonation, passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. This Panel also accepts that the Respondent is not an authorized reseller with a legitimate interest in a domain name incorporating the Complainant’s mark,

and there is no disclaimer on the website the Disputed Domain Name resolve to, therefore it cannot meet the tests set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Nor, alternatively, is the Respondent commonly known by the Disputed Domain Name.

Therefore, this Panel is satisfied that the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. In the absence of a response, this Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Panel finds for the Complainant on the second element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy that a complainant must also demonstrate is that the disputed domain name in question has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both.

The evidence that the Respondent has registered and used the Disputed Domain Name in bad faith is overwhelming.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the content of the website it resolves to, the Panel is satisfied that the Respondent knew of the Complainant's trademark TOMBOYX when it registered the Disputed Domain Name.

On the issue of use, the uncontradicted evidence of record is that the Disputed Domain Name was used to resolve to a website bearing images, products, and artwork from the Complainant's online store, and offering what appears to be TOMBOYX goods for sale.

The Complainant's evidence is that the Disputed Domain Name has been used in attempted phishing by using the Disputed Domain Name to attempt to impersonate the Complainant to seek to fraudulently obtain payments, albeit by a rather convoluted method. In line with prior UDRP panel decisions, the Panel finds that the use of a domain name for *per se* illegitimate activity such as phishing supports a finding of bad faith (see [WIPO Overview 3.0](#), section 3.1.4).

This Panel also views the provision of false contact information underlying the privacy or proxy service as an additional and separate indication of bad faith, since the Written Notice seems to be undelivered to the postal address provided by the Respondent to the Registrar (see [WIPO Overview 3.0](#), section 3.6).

This Panel finds that the Respondent has taken the Complainant's trademark TOMBOYX and incorporated it in the Disputed Domain Name without the Complainant's consent or authorization, along with the letters "us" for the purpose of capitalizing on the reputation of the trademark by diverting Internet users for commercial gain to its website which falls into the meaning of bad faith under paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 <tomboyxus.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: January 17, 2023