

ADMINISTRATIVE PANEL DECISION

Tommy Bahama Group, Inc. v. Manlidy, GNN
Case No. D2023-0885

1. The Parties

The Complainant is Tommy Bahama Group, Inc., United States of America, represented by Kilpatrick Townsend & Stockton LLP, United States of America (“US”).

The Respondent is Manlidy, GNN, Singapore.

2. The Domain Name and Registrar

The disputed domain name <newtommybahama.com> (the “Domain Name”) is registered with OwnRegistrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 28, 2023. On February 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 1, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (OwnRegistrar, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 2, 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 amended Complaint on March 3, 2023.

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 March 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 4, 2023.

The Center appointed Jonas Gulliksson as the sole panelist in this matter on April 18, 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 engaged in the business of selling apparel and related accessories such as watches, wallets, eyewear, fragrances, personal care products, and home furnishings. The Complainant is the proprietor of trademark and service mark registrations for TOMMY BAHAMA in several countries, including the following registrations:

- US trademark registration No. 6274029, registered February 16, 2021;
- US trademark registration No. 2462870, registered June 19, 2001;
- US service mark registration No. 2492771, registered September 25, 2001;
- Canadian trademark registration No. TMA936216, registered April 27, 2016;
- European Union Trade Mark registration No. 2416642, registered February 23, 2005;
- Chinese trademark registration No. 53057353, registered June 14, 2022; and
- Singaporean trademark registration No. T1116890E, registered July 4, 2013.

Further, the Complainant is the holder of the website <tommybahama.com>.

The Domain Name was registered February 7, 2023. At the time of filing the Complaint, the Domain Name resolved to an online store displaying the Complainant's product images and purportedly offering products for sale at discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant asserts, substantially, the following:

The Complainant holds trademark and service rights in TOMMY BAHAMA and acquired such rights well prior to the date the Domain Name was registered by the Respondent. The Domain Name is identical to a trademark and service mark in which the Complainant has rights.

The Respondent has no rights or legitimate interests in respect of the Domain Name. There is no relationship between the Complainant and the Respondent giving rise to any license, permission, or other right by which the Respondent could own or use a domain name incorporating the TOMMY BAHAMA mark. The Respondent cannot establish that it is commonly known by the Domain Name, as there is no indication that the Respondent has conducted any legitimate business under the Domain Name. The Respondent clearly does not have a legitimate interest in the use of the Complainant's TOMMY BAHAMA mark in the Domain Name, especially without the addition of any distinguishing material. The Respondent is using the Domain Name to impersonate the Complainant by operating a website that falsely claims to be an online store of the Complainant and uses the Complainant's TOMMY BAHAMA mark prominently on the home page and throughout the site, uses numerous of the Complainant's copyrighted images, copies the look and feel of the Complainant's "tommybahama.com" website, and purports to offer genuine products from the Complainant at deeply discounted prices. It appears that the Respondent is offering counterfeit products on the aforementioned website, alternatively, to the extent the Respondent is not actually selling the Complainant's products, it appears that the Respondent is conducting a fraudulent scam to take payment without providing a product and/or a phishing scheme to obtain consumers' personal information.

The Respondent registered and is using the Domain Name in bad faith. The Respondent was aware of the Complainant's TOMMY BAHAMA mark at the time the Domain Name was registered. The Respondent's

bad faith is evidenced by the fact that it is using the website to which the Domain Name resolves to either offer counterfeit goods, or, to conduct a scam to perpetrate fraud on consumers and/or to harvest their personal information. Additionally, at least nine UDRP decisions have been issued against the Respondent, which is another indication of bad faith.

B. Respondent

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

6. Discussion and Findings

The burden for the Complainant under paragraph 4(a) of the Policy is to prove:

- (i) that the Domain Name 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 Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established that it holds trademark and service mark rights in relation to TOMMY BAHAMA.

The Domain Name incorporates the Complainant's TOMMY BAHAMA mark in its entirety, with the addition of the word "new" in the beginning of the Domain Name, the deletion of spacing between "tommy" and "bahama" and the addition of the generic Top-Level Domain ("gTLD") ".com". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, 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. In this case, the addition of "new" and the exclusion of spacing between "tommy" and "bahama" does not prevent a finding of confusing similarity between the Domain Name and the Complainant's TOMMY BAHAMA mark. Further, it is well established that gTLDs, typically are disregarded in the assessment of confusing similarity, see [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that that the Domain Name is confusingly similar to a trademark and service mark in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must first make out a *prima facie* case showing that the respondent lacks rights or legitimate interests in respect of a disputed domain name and then the burden, in effect, shifts to the respondent to come forward with evidence of its rights or legitimate interests, if the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see [WIPO Overview 3.0](#), section 2.1).

Considering the evidence presented in the case, and the Complainant's un rebutted contentions that the Respondent has no rights or legitimate interests in the Domain Name, the Panel finds that the Complainant has made out an undisputed *prima facie* case.

In addition, the Panel finds that the Domain Name carries a risk of implied affiliation with the Complainant ([WIPO Overview 3.0](#), section 2.5.1).

Considering the above, the Panel finds that the Complainant has established that the Respondent lacks rights or legitimate interests in the Domain Name, in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As mentioned above, the Domain Name incorporates the Complainant's TOMMY BAHAMA mark. Further, the Complainant's rights to the TOMMY BAHAMA mark were obtained well before the Respondent's registration of the Domain Name.

The Complainant has not authorized the Respondent to use its TOMMY BAHAMA mark. The content of the website to which the Domain Name resolves (the "Domain Name Website") clearly reflects the Respondent's awareness of and intent to target the Complainant. The content of the Domain Name Website indicates that the Respondent intentionally has tried to attract, for commercial gain, Internet users to the Domain Name Website by creating a likelihood of confusion with the Complainant's TOMMY BAHAMA mark as to the source, sponsorship, affiliation, or endorsement of the Domain Name Website and the products supposedly offered on such website. In addition, it has been established that the Respondent has a history of bad faith domain name registrations.

Considering the above the Panel finds that the Domain Name was registered and is being used in bad faith.

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 Domain Name <newtommybahama.com> be transferred to the Complainant.

/Jonas Gulliksson/

Jonas Gulliksson

Sole Panelist

Date: May 2, 2023