

ADMINISTRATIVE PANEL DECISION

Telfar LLC. v. Teresa Vicencio
Case No. D2023-0992

1. The Parties

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

The Respondent is Teresa Vicencio, United States.

2. The Domain Name and Registrar

The disputed domain name <telfarbagg.net> (the “Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 6, 2023. On March 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 7, 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 (unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 7, 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 amendment to the Complaint on March 8, 2023.

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 March 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 4, 2023.

The Center appointed Ellen B Shankman as the sole panelist in this matter on April 14, 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 company that manufactures and sells purses and bags.

The date of the Domain Name registration is April 9, 2022.

The trademark TELFAR serves as key brand of the Complainant and is protected as a registered trademark. The Complainant provided evidence of trademark registration for the mark TELFAR, United States Trademark Registration No. 5895525 (registered on October 29, 2019, in International Class 18), that predates the date of the Domain Name registration for a variety of bags. The Complainant claims that it has spent a considerable amount of time and money protecting its intellectual property rights, and has used the mark in commerce since as early as January 2019.

The Complainant provided some evidence that the Domain Name at one point resolved to a website containing images belonging to the Complainant and selling counterfeit bags, and at the time of the filing of the Complaint the website was deactivated. The Panel conducted an independent inquiry to confirm that the Domain Name currently resolves to a parking page.

5. Parties' Contentions

A. Complainant

The Complainant designs, manufactures and commercializes bags and clothes under the trademark TELFAR, a registered trademark in the United States and abroad. The Complainant actively promotes its TELFAR trademark through its official website linked to the domain name <telfar.net>. The Respondent uses the Domain Name, which was registered subsequent to the Complainant's registered trademark, without the Complainant's written or verbal authorization, to sell counterfeit goods under the Complainant's TELFAR trademark. The Domain Name is identical or confusingly similar, just adding "bagg" to the Complainant's trademark.

The Complaint alleges that the Respondent has no rights or legitimate interests in respect of the Domain Name. This is supported by the fact that: (i) the Respondent is not commonly known by the Domain Name; (ii) the Respondent has not acquired trademark or service mark rights; (iii) the Respondent has not been authorized by the Complainant to use its well-known mark; (iv) no actual or contemplated *bona fide* or legitimate use of the Domain Name can be claimed since the Respondent is not licensed or permitted by the Complainant to use its mark; and (v) the Domain Name was being used to host a website copying the TELFAR trademark and copyright protected content that can be found on the Complainant's website <telfar.net> and running an online store selling counterfeit goods based on the Complainant's products.

The Complainant further alleges that the Domain Name is registered and being used in bad faith. At the time of the registration the Respondent must have known of the Complainant and its trademarks. The Respondent has used the overall "look and feel" of the Complainant's website by copying the Complainant's trademark and copyright protected images. This is clearly an act of impersonating the official "TELFAR" website. Further, the Respondent's website is used to sell counterfeit goods based on the Complainant's products. The Respondent is therefore using the Domain Name to intentionally attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship or endorsement of the website. The Respondent's registration of the Domain Name

also prevents the Complainant from reflecting its trademark in the corresponding domain name, and this affects the Complainant's business.

Finally, the Complainant alleges that the Respondent's bad faith registration and use of the Domain Name is further evidenced by the fact that false contact information is provided in the website. Under the "Contact Us" heading, the Respondent lists the address of a small single-family home located in a residential area of Middletown Connecticut.

To summarize the Complaint, the Complainant is the owner of registration for the trademark TELFAR, in respect of bags. The Domain Name is confusingly similar to the trademark owned by the Complainant. By registering the Domain Name that comprises the Complainant's TELFAR trademark in its entirety, with the mere addition of the term "bagg" the Respondent has created a domain name that is confusingly similar to the Complainant's trademark. As such, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. Therefore, the Domain Name could be considered virtually identical and/or confusingly similar to the Complainant's trademark. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Domain Name was registered and is being used in bad faith. The current error page use of the Domain Name does not present a finding of registration and use in bad faith. Thus, the Respondent's registration and use of the Domain Name constitutes bad faith registration and use under the Policy, and the Complainant requests transfer of the Domain Name.

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) the Domain Name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the Domain Name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint. Since the Respondent did not respond to this Complaint, the supported facts regarding the use and reputation of the Complainant's mark taken from the Complaint are generally accepted as true in the circumstances of this case.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has satisfactorily proven that it has registered trademark rights for TELFAR.

Further, the Panel finds that the Domain Name integrates the Complainant's mark TELFAR in its entirety with the addition of the arguably descriptive element "bagg", and that the Domain Name is confusingly similar to the Complainant's trademark. Further, the Panel finds that the mere addition of the term "bagg" to the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the

Complainant's trademark. See *Pfizer Inc. v. Asia Ventures, Inc.*, WIPO Case No. [D2005-0256](#). See also *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. [D2001-0110](#).

Accordingly, the Panel finds that the Complainant has satisfied the first requirement that the Domain Name is identical or confusingly similar to the Complainant's registered trademark, under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy in turn identifies three non-exclusive means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often-impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the consensus view is that paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in the disputed domain name, once the complainant has made a *prima facie* showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Domain Name and that it is not related to or affiliated in any way with the Complainant, nor has the Complainant authorized the Respondent to use its trademarks, and is not using the Domain Name for a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Domain Name. In fact, the Domain Name resolves to an inactive page does not change this.

Based on the available record, the Panel finds that the Complainant has established a *prima facie* case, which was not refuted by the Respondent, and that the Respondent lacks rights or legitimate interests in the Domain Name.

Therefore, the Complainant has satisfied the second requirement that the Respondent has no rights or legitimate interests in the Domain Name, under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel agrees with the Complainant that when considering the balance of probabilities, it is more likely than not that the Respondent had actual or constructive knowledge of the TELFAR trademark and that registration of the Domain Name would be identical or confusingly similar to the Complainant's trademark. Based on the evidence provided, the Panel finds that it is implausible that there could be any legitimate use of this Domain Name. In light of and on balance of the facts set forth within this Complaint, the Panel finds that it is more likely than not that the Respondent knew of and targeted the Complainant's trademark. The Panel agrees with the Complainant's contention that indeed, the Respondent's purpose in registering the Domain Name was probably to capitalize on the reputation of the Complainant's trademarks.

By registering the Domain Name that comprises the Complainant's TELFAR trademark in its entirety, with the mere addition of the descriptive term "bag" misspelled, and with evidence of the prior appropriated photos of the Complainant's products, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. In light of the facts set forth within this Complaint, the Panel finds that it is "not possible to conceive of a plausible situation in which the Respondent would have been unaware of" the Complainant's brand at the time the Domain Name was registered. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) (February 18, 2000). Further, "it defies common sense to believe that the Respondent coincidentally selected the precise domain without any knowledge of the Complainant and its trademarks." See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#) (December 10, 2007).

Furthermore, the lack of current active use of the Domain Name does not prevent a finding of bad faith in the circumstances of this case. See [WIPO Overview 3.0](#), section 3.3. In that regard, the reputation of the

Complainant's trademarks, the choice of additional term in the Domain Name, the evidence of the earlier appropriated photos, the failure of the Respondent to provide any evidence of actual or contemplated good faith use, and the implausibility of any good faith use to which the Domain Name could be put, support a finding of bad faith.

In light of the above, the Panel finds that the Complainant has satisfied the third requirement that the Respondent has registered and is using the Domain Name in bad faith, under 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 Domain Name, <telfarbagg.net> be transferred to the Complainant.

/Ellen B Shankman/

Ellen B Shankman

Sole Panelist

Date: April 28, 2023