

ADMINISTRATIVE PANEL DECISION

River Light V, L.P. and Tory Burch LLC v. Tyronn Mccoy
Case No. D2023-1084

1. The Parties

The Complainants are River Light V, L.P. (the “first Complainant”), United States of America (“United States”), and Tory Burch LLC (the “second Complainant”), United States, represented by Dorf & Nelson LLP, United States.

The Respondent is Tyronn Mccoy, United States.

2. The Domain Name and Registrar

The disputed domain name <mailtoryburch.com> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 13, 2023. On March 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 14, 2023, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainants on March 14, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on March 14, 2023, and an amendment to the Complaint on March 20, 2023.

The Center verified that the Complaint together with the amended Complaint and 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 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 11, 2023.

The Center appointed Angela Fox as the sole panelist in this matter on May 1, 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 second Complainant Tory Burch LLC was founded in 2004 in New York City and is an American-based global luxury fashion brand. Ms. Tory Burch is a fashion designer whose collections include ready-to-wear, handbags, footwear, accessories, jewelry, home, and beauty. These fashion lines have since at least 2004 been offered under the name and trademark TORY BURCH in the United States and in other countries around the world.

The first Complainant River Light V, L.P. is the proprietor of United States trademark registrations for TORY BURCH, details of which were annexed to the Complaint, covering goods such as clothing, jewelry, eyewear, bags, watches, homeware and retail services, dating from as early as 2005. These include among others:

- United States Trademark Registration No. 3386532 for TORY BURCH for retail clothing stores, registered on February 19, 2008;
- United States Trademark Registration No. 3428373 for TORY BURCH for clothing, registered on May 13, 2008;
- United States Trademark Registration No. 3428374 for TORY BURCH for cosmetic bags and handbags, registered on May 13, 2008; and
- United States Trademark Registration No. 3428816 for TORY BURCH for jewelry, registered on May 13, 2008.

Tory Burch's website, "www.toryburch.com", was launched in 2004. Her annual global sales revenues are said to be in excess of USD 1 billion, with hundreds of millions of dollars invested in marketing and advertising globally each year. The TORY BURCH brand is frequently covered by fashion blogs, magazines, newspapers, and talk shows, and was endorsed by Oprah Winfrey on her talk show in 2005. Since then, Tory Burch has appeared on a number of other television shows including Project Runway, Martha Stewart Presents, Good Morning America, and CBS This Morning. The TORY BURCH brand has more than 2,100,000 likes on Facebook, and Ms. Tory Burch has more than 2,000,000 followers on Instagram and more than 380,000 followers on Twitter globally. TORY BURCH-branded products have been seen to be worn by celebrities including Blake Lively, Oprah Winfrey, Jennifer Lopez, Rashida Jones, Jessica Alba, Hilary Swank, Sarah Jessica Parker, Reese Witherspoon, Pippa Middleton, and Anne Hathaway.

Ms. Tory Burch has received many awards and accolades, including: (i) the 2008 Accessories Designer of the Year award from the Council of Fashion Designers of America; (ii) the 2007 Accessory Brand Launch of the Year award from the Accessories Counsel of Excellence; and (iii) the 2005 Rising Star Award for Best New Retail Concept from Fashion Group International. She was also included on Vanity Fair's New Establishment List in 2013 and was named one of Crain's Most Powerful Women in New York in 2013 and 2014, one of Forbes' Most Powerful Women in the World in 2010, 2013, and 2014 as well as Glamour Women of the Year in 2019. In addition, she published her first book "Tory Burch in Color" in 2014, which was on the coveted New York Times Best Sellers list.

The disputed domain name was registered on February 27, 2023, and is inactive.

5. Parties' Contentions

A. Complainants

The Complainants refer to other WIPO cases in which the Administrative Panel has ordered the transfer of domain names to the Complainant River Light V, L.P, namely *River Light V, L.P., Tory Burch LLC v. Domain Admin, Privacy Protect, LLC/Domain Admin, Domain Privacy Guard Sociedad Anónima Ltd.*, WIPO Case No. [D2019-2188](#); *River Light V, L.P. River Light V, L.P., Tory Burch LLC v. Kung Chen Chang*, WIPO Case No. [D2018-0046](#).

The Complainants submit that the disputed domain name is confusingly similar to the TORY BURCH trademark, in which the first Complainant has registered rights. The Complainants note that the disputed domain name contains the whole of the TORY BURCH trademark and only the non-distinctive, generic word "mail".

The Complainants further submit that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has never been known by the disputed domain name, nor is he making a legitimate noncommercial or fair use of it. The disputed domain name does not in fact link to any active website. The Complainants submit that a respondent can have no legitimate interests in a domain name that is passively held.

Finally, the Complainants contend that the disputed domain name was registered and used in bad faith. The Complainants submit that prior decisions have found that the parking of a domain name with no intent to use it is evidence of bad faith. The Complainants contend that bad faith may be inferred from the fact that there is no landing page for the disputed domain name. The Complainants also contend that when a domain name at issue wholly incorporates a famous trademark, a panel may infer bad faith. They argue that the TORY BURCH Mark is famous around the world, and thus, the Respondent's incorporation of it into the disputed domain name implies bad faith. Finally, the Complainants argue that the Respondent's use of a privacy service to shield his identity, when considered in combination with the foregoing factors, is also evidence of bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions. No exceptional circumstances explaining the default have been put forward. Therefore, in accordance with paragraphs 14(a) and (b) of the Rules, the Panel will decide the Complaint and shall draw such inferences as it considers appropriate from the Respondent's default.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the panel finds that:

- (i) the disputed domain name 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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

All three elements must be present before a complainant can succeed in an administrative proceeding under the Policy.

A. Identical or Confusingly Similar

The Complainants have proved that the first Complainant has registered trademark rights in TORY BURCH. The disputed domain name includes TORY BURCH trademark in its entirety, preceded only by the additional word “mail” and followed by the domain name suffix “.com”. As noted in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“the [WIPO Overview 3.0](#)”), at section 1.8, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity. Further, as noted in the [WIPO Overview 3.0](#), at section 1.11.1, the top-level domain suffix is a standard registration requirement and as such is disregarded under the first element confusing similarity test.

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

B. Rights or Legitimate Interests

The burden of proving absence of rights or legitimate interests in a domain name falls on complainants, but panels have long recognized that the information needed to prove such rights or legitimate interests is normally in the possession of respondents.

In order to avoid requiring complainants to prove a negative, which will often be impossible, UDRP panels have typically accepted that once a complainant has established a *prima facie* case that a respondent lacks rights or legitimate interests, the respondent carries the burden of providing evidence that it does indeed have such rights or interests (see, *inter alia*, *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#)). In the present case, the Complainant has put forward a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. There is nothing on the record in this case to indicate that the Respondent might have any rights or legitimate interests in it, nor has the Respondent attempted to make out a case that it has. The Complainant has not authorized the Respondent to use the disputed domain name, nor is there any evidence that the Respondent has ever been commonly known by it. Moreover, the combination of the term “mail” plus the well-known TORY BURCH brand creates an inference that the disputed domain name would be associated with the Complainants (see [WIPO Overview 3.0](#) at section 2.5.1).

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

As the Complainants submit, the non-use of a domain name can constitute a form of bad faith use under the doctrine of passive holding (see [WIPO Overview 3.0](#), section 3.3). However, as indicated therein, panelists must look at the totality of the circumstances in each case. Under the Overview, “factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

In this case, the Complainants rely principally on the fame of the TORY BURCH trademark and its wholesale incorporation within the disputed domain name; the absence of a website landing page linked to the disputed domain name; and the Respondent’s use of a privacy shield to cloak his identity.

Taken on their own, the lack of a website landing page and the Respondent’s use of a privacy shield are not in and of themselves always indicative of bad faith, but here given the global fame of the TORY BURCH trademark and its wholesale incorporation in the disputed domain name in connection with the term “mail”, and the absence of any explanation from the Respondent for why it registered the disputed domain name create an inference of bad faith.

The decisions referred to by the Complainants in support of their contention are not necessarily supportive of the Complainant's position as argued. In *Swarovski Aktiengesellschaft v. Hugel/ Carol Carol*, WIPO Case No. [D2014-0406](#), the domain name was in use for a website offering for sale purported Swarovski products, such as "Swarovski Necklaces", "Swarovski Pendants", "Swarovski Earrings". In contrast, in the present case there is no use of the disputed domain name at all.

Similarly, the two cases referred to above show that the Complainants are a target for cybersquatters, even though in those cases the domain names either resolved to a website offering women's clothing and advertising the domain name for sale, or re-directed Internet users to a website of a major fashion competitor of Tory Burch LLC.

The Panel accepts that the TORY BURCH brand is well-known in fashion circles and has gained a high consumer profile, such that it is difficult to envisage a plausible good faith use for the disputed domain name. The Respondent is based in the United States, where the TORY BURCH trademark has been especially well publicized, but despite the Complaint having been notified to it, the Respondent has made no effort to explain its registration and use of the disputed domain name nor to rebut any of the allegations against him.

On balance, the Panel finds that the doctrine of passing holding applies in this case, and that the disputed domain name was registered and has been 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 disputed domain name, <mailtoryburch.com>, be transferred to the Complainant.

/Angela Fox/

Angela Fox

Sole Panelist

Date: May 22, 2023