

ADMINISTRATIVE PANEL DECISION

Mycoskie, LLC v. Web Commerce Communications Limited, Client Care
Case No. D2023-2428

1. The Parties

The Complainant is Mycoskie, LLC, United States of America (“United States”), represented by SILKA AB, Sweden.

The Respondent is Web Commerce Communications Limited, Client Care, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <tomsuae.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 5, 2023. On June 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 7, 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 (not disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 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 July 7, 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 July 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 3, 2023.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on August 8, 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 Mycoskie, LLC, a Los Angeles based company founded by the entrepreneur Blake Mycoskie and incorporated in May 2005.

Mycoskie, LLC is the owner of the trademark TOMS which has been used since 2006, especially for selling and distributing shoes. This trademark derives from Blake Mycoskie's humanitarian initiative entitled "Shoes for Tomorrow Project", later shortened to "TOMS". Today, TOMS trademarks are used in commerce to design and market not only footwear but eyewear, coffee, apparel and handbags. The Complainant sells products online, in particular under the domain name <toms.com>.

The Complainant has rights over a number of trademark registrations consisting in TOMS such as international registration No. 887771, registered on May 12, 2006, in class 25 and United States registration No. 3353902, registered on December 11, 2007, in class 25.

The disputed domain name <tomsuae.com> was registered on June 11, 2022. It was used until recently to resolve to a website which offered for sale shoes under the trademark TOMS at discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant's arguments in support of its Complaint can be summarized as follows:

First, the Complainant claims that the trademark TOMS trademark is clearly recognizable in the disputed domain name <tomsuae.com> which incorporates TOMS trademark in full. The addition of the country code "uae" for the United Arab Emirates does not preclude a finding of confusing similarity.

Second, the Complainant contends that it has not authorized the Respondent, Web Commerce Communications Limited, to use the trademark TOMS for any reason or in any manner. Moreover, it has found no evidence that the Respondent holds trademark rights on the term "tomsuae" and nothing suggests that the Respondent is commonly known by this term.

Third, the Complainant states that its trademark TOMS has been registered and used well before the registration of the disputed domain name on June 11, 2022. The Complainant has consolidated worldwide rights over the trademark TOMS (including in Malaysia, where the Respondent appears to be located, according to the Whois information). And insofar as Internet users commonly associate the term "toms" with the Complainant and its activities, it is not possible to conceive a plausible situation in which the Respondent would have been unaware of the Complainant and its rights when the disputed domain name was registered. A simple search online, on the Google search engine or on a trademark search engine, would have informed the Respondent on the existence of the Complainant's rights on TOMS.

In addition, the Complainant points out, by producing screenshots, that (i) the website to which the disputed domain name originally redirected, reproduced its trademark TOMS and offered TOMS-branded products for sale.

However, (ii) the website did not contain any note, information or disclaimer pointing out that the owner of the website had no relationship with the Complainant, thereby misleading consumers into believing that the website was operated by or affiliated with the Complainant, and (iii) the website included the copyright notice “Copyright 2023 Toms Dubai Mall” without mentioning the name of the real owner of the website.

Therefore, the use of the disputed domain name cannot be considered a *bona fide* use and it does not meet the cumulative requirements of the Oki Data test. According to the Complainant, there is no doubt that the Respondent registered the disputed domain name in order to capitalize the goodwill of the trademark TOMS and to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion.

In addition, the Complainant states that the Respondent has been involved in numerous UDRP Decisions (+100). See for instance: *No Ordinary Designer Label Limited t/a Ted Baker v. Web Commerce Communications Limited*, WIPO Case No. [D2023-1678](#), *Reebok International Limited v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-0518](#), *Puma SE v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-0285](#), *S.A.S Jean Cassegrain v. REDACTED FOR PRIVACY; William Henry; Connie West; Thomas Cole; Mikayla Krefft; Leonora Pimentel; Ernestine Peterson; Jansson Lindgren; Guy Corral; Julius Bergman; Web Commerce Communications Limited, Client Care*, WIPO Case No. [D2023-0022](#), *Prada S.A. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4776](#), *Mycoskie, LLC v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-2020](#); *C. & J. Clark International Ltd v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0813](#), *ABG Juicy Couture, LLC v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-1096](#), *Spyder Active Sports, Inc. v. Web Commerce Communications Limited*, WIPO Case No. [D2022-0659](#), *Alpargatas S.A., Alparagas Europe, S.L.U v. Sabrina Diederich / Web Commerce Communications Limited*, [WIPO Case No. D2022-0942](#). According to the Complainant, these precedents show that the Respondent is a “notorious cybersquatter” which confirms bad faith in the registration and use of the disputed domain name.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

For the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of the probabilities that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith

A. Identical or Confusingly Similar

The Complainant, under the first requirement of paragraph 4(a) of the Policy, needs to establish that the disputed domain name is confusingly similar to a trademark or a service mark in which it has rights. This is primarily a standing requirement.

The Complainant owns trademark rights over the sign TOMS that have been used for many years. The trademark TOMS is fully reproduced in the disputed domain name <tomsuae.com>, and the addition of the term “uae” does not prevent the Complainant’s trademark from being recognizable within the disputed domain name. See [section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition \(“WIPO Overview 3.0”\)](#): “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. The nature of such additional term(s) may however bear on assessment of the second and third elements”.

The disputed domain name is therefore confusingly similar to the Complainant’s trademarks.

The Complainant is deemed to have satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the Respondent carries the burden of production of evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Respondent is not affiliated with the Complainant, has not received any authorization or license from the Complainant and there is no evidence that the Respondent is commonly known by the disputed domain name which implies that the Respondent has no rights or legitimate interests in the disputed domain name. Besides, the operation by the Respondent of a website that impersonates of the Complainant does not qualify as a *bona fide* use.

Besides, the disputed domain name, given its composition, carries a risk of implied affiliation with the Complainant. See [section 2.5.1 of the WIPO Overview 3.0](#).

While the burden of proof was on its side, the Respondent has failed to file any response in this proceeding and has not submitted any explanation for its registration and use of the disputed domain name, or evidence of rights or legitimate interests on its part in the disputed domain name, whether in the circumstances contemplated by paragraph 4(c) of the Policy or otherwise.

The Panel therefore finds that the Complainant has established that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

In order to prevail under the third element of paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate that the disputed domain names have been registered and are being used in bad faith.

Paragraph 4(b) of the Policy lists a number of circumstances which, without limitation, are deemed to be evidence of the registration and use of a domain name in bad faith. These are:

- (i) circumstances indicating that [a respondent has] registered or acquired a disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of [the respondent’s] documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) [the respondent has] registered the disputed domain name in order to prevent the complainant from reflecting the complainant’s trademark or service mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or
- (iii) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or

endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location.

Firstly, the disputed domain name registered by the Respondent reproduces in its entirety the trademark TOMS trademark with the addition of the initials "uae", which stand for "United Arab Emirates". The association of the Complainant's trademark to a geographical name shows that the Respondent had the Complainant's trademark in mind when it configured the disputed domain name. This configuration is likely to create the belief among consumers that the disputed domain name provides access to a website of the Complainant which is expressly dedicated to clients based in the United Arab Emirates.

This bad faith registration is confirmed by the use made subsequently of the disputed domain name: it used to resolve to a website in English language, which reproduced the trademark TOMS on all its pages and on which TOMS-branded products appeared to be on sale. Such use is made to attract Internet users to the website for commercial gain in accordance with paragraph 4(b)(iv) of the Policy. Possibly, the Respondent operated a phishing scheme through the infringement of the Complainant's trademark.

Finally, the Panel notes that the Respondent is a "serial" cybersquatter and has previously been found to have registered and used domain names in bad faith numerous times and having lost hundreds of UDRP cases in circumstances where the modus operandi exhibited in this case was identical or highly similar. This case appears to be a continuation of this pattern.

The Complainant has satisfied 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 <tomsuae.com> be transferred to the Complainant.

/Benjamin Fontaine/

Benjamin Fontaine

Sole Panelist

Date: August 22, 2023