

## **ADMINISTRATIVE PANEL DECISION**

**Matt Tolmach Productions, Inc., Matt Tolmach, The Matthew Tolmach and Allison Paige Goldberg Family Trust v. Matt Tolmach productions**  
Case No. D2023-2474

### **1. The Parties**

The Complainants are Matt Tolmach Productions, Inc., Matt Tolmach, The Matthew Tolmach and Allison Paige Goldberg Family Trust, United States of America (“United States”) (collectively, the “Complainants”), represented by Witzburg Ventures LLC, United States.

The Respondent is Matt Tolmach productions, Philippines.

### **2. The Domain Name and Registrar**

The disputed domain name <mattoolmachproductions.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 June 6, 2023. On June 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, the Registrar transmitted by email to the Center its verification response disclosing the 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 June 13, 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 amendment to the Complaint on June 16, 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 June 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 18, 2023.

The Center appointed Kiyoshi Tsuru as the sole panelist in this matter on July 24, 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 Complainants are Matt Tolmach (“Complainant Tolmach”), an individual in the business of film production, Matt Tolmach Productions, Inc. (“Complainant Tolmach Productions”), and The Matthew Tolmach and Allison Paige Goldberg Family Trust (“Complainant Trust”) (collectively, the “Complainants”).

The Complainant Tolmach Productions is a production company dedicated to entertainment services, namely, development, production, post-production, and distribution services of multimedia, entertainment content, film, motion pictures, television programs, multimedia programs, online non-downloadable audio and video programs, and audio and video recordings.

The Complainant Tolmach Productions claims to hold rights to the trademark MATT TOLMACH PRODUCTIONS. The Complainant Trust has filed the following pending trademark applications (collectively, the “TOLMACH Trademarks”):

Trademark	Application Serial Number	Jurisdiction	Filing date
MATT TOLMACH PRODUCTIONS	98000081	United States	May 17, 2023
MATT TOLMACH	98000101	United States	May 17, 2023

The disputed domain name was registered on June 28, 2022, and it currently resolves to an inactive website.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant contends the following:

That the Complainant Tolmach Productions is a leader in the film production and entertainment industries, which services are provided under the TOLMACH Trademarks throughout the United States and the world since at least September 1993.

That in 2008 the Complainant Tolmach was named co-president of production at Sony Pictures Entertainment, where he managed the Spider-Man franchise. That, when acting as co-president of Columbia Pictures, the Complainant Tolmach oversaw the production of world-famous films such as Talladega Nights: The Ballad of Ricky Bobby, starring Will Ferrell.

That the Complainant Tolmach also produced installments of the Spider-Man franchise including, The Amazing Spider-Man; Marvel Cinematic Universe Spider-Man films; and Sony’s Spider-Man Universe. That, along with the Spider-Man franchise, the Complainant Tolmach is also known for producing Rough Night, starring Scarlett Johansson and Zoë Kravitz, and the Jumanji sequels starring Dwayne Johnson and Kevin Hart.

That the Complainant Tolmach’s work has earned various recognitions such as the Variety 500 honor, which recognizes the 500 most influential and impactful executives and creatives in the media business, for every year since 2018.

That the Complainant Tolmach Productions has achieved public exposure through film distribution in movie theaters, streaming platforms, and online databases such as Internet Movie Database "IMDB", The Movie Database "TMDB"; as well as digital and print magazines such as Variety, Forbes, and The Hollywood Reporter.

### **1. Identical or Confusingly Similar**

That due to the tremendous sales success of the Complainants' business, the TOLMACH Trademarks have developed significant and substantial consumer recognition and goodwill.

That the TOLMACH Trademarks have become widely recognized by the public as identifying the Complainants and their high-quality services.

That the Complainants' long and extensive use of the TOLMACH trademarks in connection with global production services since 1993, demonstrates the Complainants' strong rights in the TOLMACH Trademarks.

That the disputed domain name incorporates the entirety of the Complainants' TOLMACH Trademarks, and as such is virtually identical and confusingly similar to the said trademarks under the Policy.

That the inclusion of the generic Top-Level Domain ("gTLD") ".com" is not significant in determining similarity.

### **2. Rights or Legitimate Interests**

That the Respondent's use of the disputed domain name is aimed at impersonating the Complainants, confusing the public as to the source of the Respondent's services, and at the very least suggesting a relationship with, approval by, or affiliation with the Complainants, which the Respondent does not have.

That the Respondent cannot be said to have legitimately chosen the disputed domain name for use in connection with its phishing emails.

That the Respondent has not used the disputed domain name for any legitimate business purpose, including the creation and maintenance of a website in connection with a *bona fide* offering of goods or services.

That the Respondent has never been commonly known by the disputed domain name or the TOLMACH Trademarks or any variation thereof; rather, that the only use of the disputed domain name that the Respondent has made has been to distribute phishing scam emails directly to third parties.

That there is no right to or legitimate interest in holding a domain name for purposes of sending fraudulent emails that impersonate the Complainants.

That the Respondent has not made, nor is presently making, any legitimate noncommercial use of the disputed domain name for any purposes.

### **3. Registered and Used in Bad Faith**

That the Respondent has appropriated the TOLMACH Trademarks to impersonate the Complainants and send scam phishing emails to defraud the public.

That previous panels have found that such impersonation constitutes bad faith, even when the relevant domain names are used only for sending emails.

### **B. Respondent**

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

## 6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainants are required to prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants 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.

Given the Respondent's failure to submit a formal response, the Panel may decide this proceeding based on the Complainants' undisputed factual allegations, in accordance with paragraphs 5(f), 14(a), and 15(a) of the Rules (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#)).

### A. Identical or Confusingly Similar

The Complainants have produced evidence showing that they hold applications for the TOLMACH Trademarks in the United States. Also, the Complainants have proven that they hold common law rights to the said TOLMACH trademarks, arising from the extensive commercial use thereof in the entertainment industry, in relation to films of worldwide renown (see section 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)").

The disputed domain name is confusingly similar to the trademark MATT TOLMACH PRODUCTIONS, as it entirely incorporates the said trademark. It is also confusingly similar to the trademark MATT TOLMACH, as it entirely incorporates it, with the addition of the term "productions" (see sections 1.7 and 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The addition of the generic gTLD ".com" to the disputed domain name constitutes a technical requirement of the Domain Name System ("DNS") and therefore may be disregarded under the first element confusing similarity test (see *CARACOLITO S SAS v. Nelson Brown, OXM.CO*, WIPO Case No. [D2020-0268](#); *SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*, WIPO Case No. [D2015-0565](#); and *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#)).

Therefore, the first element of the Policy has been met.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets forth the following examples as circumstances where a respondent may have rights or legitimate interests in a disputed domain name:

- (i) before any notice to the respondent of the dispute, the use by the respondent of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it did not acquire trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainants have asserted that there is no relationship between the Complainant and the Respondent, that they have not authorized the Respondent to use their trademarks in the disputed domain name, and that the Respondent has not been commonly known by the disputed domain name (see *Beyoncé Knowles v. Sonny Ahuja*, WIPO Case No. [D2010-1431](#) and *Six Continents Hotels, Inc. v. IQ Management Corporation*, WIPO Case No. [D2004-0272](#)). The Respondent did not contest these allegations.

The Complainants have submitted evidence showing that the Respondent has used the disputed domain name to impersonate the Complainants, by sending fraudulent emails from the address “[...]@matttolmachproductions.com” to different authors, telling them that their work is being considered for development as a TV series or a film, in order to try to obtain sensitive information and documentation from them.

The aforementioned behavior constitutes fraudulent conduct which cannot be deemed to have taken place in good faith (see *Instagram, LLC v. Temp Name Temp Last Name, Temp Organization*, WIPO Case No. [D2019-0249](#); *TRAVELGENIO, S.L. v. Rosabel Maduro*, WIPO Case No. [D2017-1392](#); *Olayan Investments Company Establishment v. Namesco Limited d/b/a Globaldomainprivacy.net / Jeffrey Nicholson*, WIPO Case No. [D2012-1303](#)). On the contrary, the acts of impersonation and phishing perpetrated by the Respondent are illegal, and thus cannot confer rights to or legitimate interests in the disputed domain name to the Respondent (see section 2.13.1 of the [WIPO Overview 3.0](#); see also: *Salesforce.com, inc. v. Registration Private, Domains By Proxy, LLC / Doug Todd*, WIPO Case No. [D2022-2152](#), “The Panel concludes that Respondent has no rights or legitimate interests in the disputed domain name. The evidence supports Complainant’s assertion that the disputed domain name is being used in connection with a phishing scheme. The use of a domain name in connection with illegal or fraudulent activity cannot establish rights or legitimate interests on a respondent.”).

The Respondent’s use of the disputed domain name shows that the said Respondent has targeted the Complainants. Therefore, the Respondent’s conduct cannot be considered as a legitimate, noncommercial, or fair use of the disputed domain name (see *Wachovia Corporation v. Peter Carrington*, WIPO Case No. [D2002-0775](#) and *Edmunds.com, Inc. v. Digi Real Estate Foundation* WIPO Case No. [D2006-1043](#)).

The case file contains no evidence demonstrating that the Respondent has used or has made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. On the contrary, the Complainants have proven that the disputed domain name resolves to an inactive website and that it has been used to send fraudulent emails to third parties.

Therefore, there is no evidence proving that the Respondent has used the disputed domain in connection with a *bona fide* offering of goods or services; rather, the Panel finds that the Respondent has attempted to capitalize on the reputation and goodwill of the Complainants and the TOLMACH Trademarks (see section 2.5.3 of the [WIPO Overview 3.0](#)).

In sum, the Complainants made a *prima facie* case that the Respondent lacks rights to or legitimate interests in the disputed domain name. The Respondent did not submit any evidence or arguments to challenge the Complainants’ assertions.

Therefore, the second element of the Policy has been fulfilled.

### **C. Registered and Used in Bad Faith**

Bad faith under the Policy is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark. According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that

complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the 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 domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location.

The fact that the Respondent chose to register the disputed domain name, which comprises the Complainants' TOLMACH Trademarks, and that it has associated the said trademarks to a fraudulent email scheme, suggests that the Respondent knew the Complainants, their trademarks, and their business when registering the disputed domain name. Therefore, the Panel finds that the Respondent has targeted the Complainants, which conduct constitutes opportunistic bad faith (see section 3.2.1 of the [WIPO Overview 3.0](#); see also *L'Oréal v. Contact Privacy Inc. Customer 0149511181 / Jerry Peter*, WIPO Case No. [D2018-1937](#); and *Gilead Sciences Ireland UC / Gilead Sciences, Inc. v. Domain Maybe For Sale c/o Dynadot*, WIPO Case No. [D2019-0980](#)).

As discussed previously, the disputed domain name currently resolves to an inactive website. However, the Complainants have submitted evidence showing that the Respondent has impersonated the Complainants, as part of a phishing scheme to obtain sensitive information and documentation from unsuspected authors, by sending fraudulent emails to them. This fraudulent conduct clearly constitutes bad faith use under the Policy (see section 3.1.4 of the [WIPO Overview 3.0](#); see also *National Westminster Bank plc v. Sites / Michael Vetter*, WIPO Case No. [D2013-0870](#); *Instagram, LLC v. Whois privacy protection service / Olga Sergeeva / Ivan Ivanov / Privacy Protect, LLC (privacy Protect.org)*, WIPO Case No. [D2020-0521](#); *Télévision Française 1 v. Kenechi Arene*, WIPO Case No. [D2019-1578](#): "Although there is no evidence in the case record indicating that the disputed domain name has resolved to an active website, it is clear that the Respondent has actively been using the disputed domain name to generate an email address to impersonate an employee of the Complainant in order to lure a third party to make a financial payment to the Respondent.").

According to the evidence submitted by the Complainants and not contested by the Respondent, the Respondent appears to have implemented a phishing scheme by sending fraudulent emails passing off as the Complainants, in an attempt to obtain sensitive information and documents from different authors. Therefore, the Respondent has attempted to impersonate the Complainant for commercial gain, which action constitutes bad faith under the Policy (see also *SwissCare Europe v. michael click, Active OutDoors LLC*, WIPO Case No. [D2022-1496](#): ("This Panel considers that, in appropriate circumstances, a failure to pass the impersonation test may properly lead to a finding of registration and use in bad faith because of the fact that, at its heart, such a domain name has been selected and used with the intention of unfairly deceiving Internet users, [...]"); *Philip Morris Products S.A. v. Domain Administrator, Registrant of iqosatismaganiz.com (apiname com) / Anl Girgin, Teknoloji Sarayi*, WIPO Case No. [D2019-0466](#); *Self-Portrait IP Limited v. Franklin Kelly*, WIPO Case No. [D2019-0283](#); and *Friedman and Soliman Enterprises, LLC v. Gary Selesko, M&B Relocation and Referral, LLC*, WIPO Case No. [D2016-0800](#)). These facts constitute bad faith under paragraph 4(b)(iv) of the Policy (see section 3.1.4 of the [WIPO Overview 3.0](#) "the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith.").

The abovementioned facts show that not only did the Respondent register the disputed domain name in bad faith, but also that the Respondent has used the disputed domain name in bad faith (see *BHP Billiton Innovation Pty Ltd. v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#), “The findings above would be sufficient for the Panel to find bad faith use and registration, but the Panel further concludes that the use of an email address associated with the disputed domain name, to send a phishing email for the purposes of dishonest activity is in itself evidence that the disputed domain name was registered and is being used in bad faith.”).

Based on the available record, the Panel finds the third element of the Policy has been established.

## **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, <mattoilmachproductions.com> be transferred to the Complainants.

*/Kiyoshi Tsuru/*

**Kiyoshi Tsuru**

Sole Panelist

Date: August 7, 2023