

ADMINISTRATIVE PANEL DECISION

Skims Body, Inc. v. Client Care, Web Commerce Communications Limited Case No. D2023-2745

1. The Parties

The Complainant is Skims Body, Inc., United States of America (“United States”), represented by Pearne & Gordon, LLP, United States.

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

2. The Domain Name and Registrar

The disputed domain name <skimsuksale.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 27, 2023. On June 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 29, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 30, 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 July 12, 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 July 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 22, 2023.

The Center appointed Douglas Clark as the sole panelist in this matter on August 29, 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 the owner of the SKIMS trade mark which is used by the Complainant in connection with clothing and retail sales of clothing. The Complainant owns several trade mark registrations for SKIMS in the United States, including the following:

Trade Mark	Registration Number	Registration Date	Class
SKIMS (stylised)	6,747,497	May 31, 2022	18, 25, 35
SKIMS	6,754,965	June 7, 2022	18, 25, 35

The Complainant also stated in its complaint that it had over 100 trademarks globally that comprise or include the term SKIMS, either by itself, in conjunction with other words, in foreign characters, or with a logo, including in the United Kingdom (“UK”) but did not produce registration certificates for these marks. The Panel confirmed by its own search that the mark SKIMS has been registered by the Complainant in the UK under No. UK00003615657 in classes, 3, 18, 25, and 35. The mark claimed priority from a European Union registration filed in 2019 and registered in 2021. No registration for SKIMS was found in Malaysia. (See section 4.8, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) for the Panel’s power to conduct such searches.)

The disputed domain name was registered on April 25, 2023. At the date of this Complaint, the disputed domain name resolves to a website showing the Complainant’s mark and offering clothing products for sale. All prices for the products are showing in GBP.

5. Parties’ Contentions

A. Complainant

The Complainant contends that:

- (a) The disputed domain name is confusingly similar to its trade mark. The disputed domain name wholly incorporates the Complainant’s SKIMS trade mark. Addition of the term “uksale” and the generic Top-Level Domain (“gTLD”) “.com” in the disputed domain name does not eliminate the confusing similarity between the disputed domain name and the trade mark;
- (b) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant in any way and the Complainant has never granted any authorisation or license to use the Complainant’s trade mark. The Respondent has not made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. In fact the use made by the disputed domain name implies an affiliation with the Complainant which is not good faith; and
- (c) The disputed domain name was registered and is being used in bad faith. Based on the use of the disputed domain name and a website that looks like the Complainant’s website, the Respondent registered and is using the disputed domain name to attract Internet users for commercial gain, creating a likelihood of confusion with the Complainant’s trade mark.

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

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its action:

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

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark. The disputed domain name incorporates the SKIMS trade mark in full with the abbreviation for the United Kingdom "uk", the word "sale", and followed by the gTLD ".com". The addition of these terms does not preclude a finding of confusing similarity. The gTLD is generally disregarded when considering the first element. (See section 11.1, [WIPO Overview 3.0](#)).

The Panel notes that the Complainant did not rely on any registered trademarks in Malaysia where the Respondent is located. The ownership of a trademark is generally considered to be a threshold standing issue. The location of the trademark, its date of registration (or first use), and the goods and/or services for which it is registered, are all irrelevant for the purpose of finding rights in a trademark under the first element of the UDRP. These factors may however bear on a panel's further substantive determination under the second and third elements. (See section 1.1.2 of [WIPO Overview 3.0](#)).

In this case, the Complainant does have a registration for SKIMS in the United Kingdom in Class 25. The website under the disputed domain name appears to be targeted at the United Kingdom.

The Complainant has therefore satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Respondent has not asserted any rights or legitimate interests in relation to the disputed domain name.

Section 2.1 of the [WIPO Overview 3.0](#) provides:

"While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent. Accordingly, the Respondent has no rights or legitimate interests in regard to the disputed domain name.

The Panel also notes that the disputed domain name resolves to a page that prominently displays the Complainant's trade mark and advertises SKIMS products. In principle, it is not objectionable to resell or promote for resale genuine trademarked goods by reference to the mark. Further, as long as certain conditions are met, a seller can make use of a trade mark in a domain name to sell genuine products. In *Oki Data Americas, Inc. v. ASD, Inc.* WIPO Case No. [D2001-0903](#), the panel held that to be "bona fide" within the meaning of paragraph 4(c)(i) of the policy, the offering should meet the following requirements:

- The Respondent must actually be offering the goods or services at issue;
- The Respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods;
- The site must accurately disclose the registrant's relationship with the trademark owners; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site; and
- The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

In this case the Respondent does not meet, at least, the third requirement set out above. The website under the disputed domain name does not accurately disclose its relationship with the Complainant.

The second element of paragraph 4(a) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

Based on the given evidence, the disputed domain name was registered and is being used in bad faith.

The disputed domain name was registered after the Complainant has registered the SKIMS trade mark and the use of the Complainant's SKIMS trade mark cannot be a coincidence. The SKIMS trade mark is used by the Complainant to conduct its business and the presence of the Complainant's SKIMS trade mark in the website the disputed domain name resolves to shows that the Respondent is aware of the products the Complainant is selling. The Panel is satisfied that the Respondent was aware of the Complainant and its SKIMS trade mark when he or she registered the disputed domain name.

The Respondent has registered the disputed domain name to attract Internet users to the website for commercial gain in accordance with paragraph 4(b)(iv) of the Policy. The disputed domain name directs Internet users to an online retail website offering the Complainant's products for sale. For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under paragraph 4(a) 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, <skimsuksale.com>, be transferred to the Complainant.

/Douglas Clark/

Douglas Clark

Sole Panelist

Date: September 7, 2023