

ADMINISTRATIVE PANEL DECISION

Tommy Bahama Group, Inc. v. Jerry Anderson; Rizwan Rasing; dsge heww;
bao lu; men ma; ba xuan
Case No. D2023-2759

1. The Parties

The Complainant is Tommy Bahama Group, Inc., United States of America (the “U.S.”), represented by Kilpatrick Townsend & Stockton LLP, U.S.

The Respondents are Jerry Anderson, U.S.; Rizwan Rasing, U.S.; dsge heww, China; bao lu, China; men ma, China; ba xuan, China.

2. The Domain Names and Registrars

The disputed domain names <tommybahamaoutlets.shop>, <tommybahamasale.shop>, and <tommybahamaus.shop> are registered with NameSilo, LLC.

The disputed domain name <tommybahamavip.shop> is registered with Dynadot, LLC.

The disputed domain names <tommybahamasale.store>, <tommybahamavip.store>, and <tommyonline.store> are registered with Name.com, Inc.

NameSilo, LLC, Dynadot, LLC, and Name.com, Inc. are collectively the “Registrars”.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 28, 2023. On June 29, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On June 29, and July 3, 2023, the Registrars transmitted by email to the Center their verification responses respectively disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Unidentified Registrant(s)) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 4, 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 7, 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 Respondents 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 Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on August 8, 2023.

The Center appointed Taras Kyslyy as the sole panelist in this matter on August 18, 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

Since at least as early as 1993, the Complainant has continuously and exclusively used the TOMMY BAHAMA mark in connection with its upscale island-inspired apparel and related accessories. The Complainant operates 136 retail stores in the US and 22 retail stores in other countries, having USD 800,000,000 net sales in 2022. The Complainant has spent tens of millions of dollars promoting and marketing its goods and services.

The Complainant owns numerous registrations for its TOMMY BAHAMA trademark in various jurisdictions, including for instance Chinese trademark registration No. 9400332, registered on November 14, 2015, and U.S. trademark registration No. 1802812, registered on November 2, 1993.

The Complainant also operates a heavily trafficked, interactive website at the domain name <tommybahama.com>.

The disputed domain names were registered as follows:

<tommybahamaoutlets.shop> on May 27, 2023 by the Respondent Rizwan Rasing,
<tommybahamasale.shop> on May 20, 2023 by the Respondent bao lu,
<tommybahamasale.store> on May 20, 2023 by the Respondent ba xuan,
<tommybahamaus.shop> on May 16, 2023 by the Respondent dsge heww,
<tommybahamavip.shop> on May 26, 2023 by the Respondent Jerry Anderson,
<tommybahamavip.store> on May 21, 2023 by the Respondent dsge heww,
<tommyonline.store> on May 18, 2023 by the Respondent men ma.

The disputed domain names resolved to identical websites, mocking design of the Complainant’s website, prominently featuring the Complainant’s mark, and purportedly offering for sale the Complainant’s products. At the time of the decision the disputed domain names do not resolve to any active websites.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant’s trademark. All but one of the disputed domain names incorporate the Complainant’s trademark in its entirety. The only difference between the Complainant’s trademark and the disputed domain

names is the addition of a generic and descriptive term “online,” “sale,” “vip,” “us,” or “outlets,” which does little to dispel the confusing similarity. As to the disputed domain name <tommyonline.store>, the “tommy” in the disputed domain name is clearly a reference to the TOMMY BAHAMA mark, given that the website at the disputed domain name displayed the TOMMY BAHAMA mark.

Also, the Complainant contends that the Respondents have no rights or legitimate interests in the disputed domain names. There is no relationship between the Complainant and the Respondents giving rise to any license, permission, or other right by which the Respondents could own or use any domain name incorporating the Complainant’s trademark. The Respondents cannot establish that they are commonly known by any of the disputed domain names, as there is no indication that the Respondents have conducted any legitimate business under the name “tommybahamaoutlets”, “tommyonline”, “tommybahamasale”, “tommybahamavip”, or “tommybahamaus”. The Respondents are not making any legitimate noncommercial or fair use of the disputed domain names. By operating the websites using the Complainant’s trademark (which is prominently displayed on the home pages and throughout the sites) and using the Complainant’s copyrighted photographs to purportedly offer for sale the Complainant’s products to intentionally impersonate the Complainant.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. The Respondents have registered and are using the disputed domain names in bad faith for commercial gain and to benefit from the goodwill and fame associated with the Complainant’s trademark. This is established by the fact that the disputed domain names purposefully incorporate the Complainant’s well-known trademark and were registered long after this trademark became well known to consumers. The Respondents have not made any legitimate or *bona fide* use of the disputed domain names. Instead, the Respondents have used the disputed domain names for personal commercial gain – leveraging the notoriety of the Complainant’s trademark to attract users to the Respondents’ websites. The Respondents were aware of the Complainant’s trademark, given the Respondents’ use of the trademark on the websites at the disputed domain names and the offering of the purported Complainant’s products through the websites.

B. Respondents

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

6. Discussion and Findings

A. Consolidation of Multiple Respondents

The Complainant requested the Panel to hear the present dispute brought against six Respondents as a consolidated Complaint.

Paragraph 10(e) of the Rules states that a “[p]anel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules”. Paragraph 10(c) of the Rules provides, in relevant part, that “the [p]anel shall ensure that the administrative proceeding takes place with due expedition”.

Section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) summarizes the consensus view of UDRP panels on the consolidation of multiple respondents, in part, as follows: “Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.”

The Complainant asserts, among other things, that the Respondents should be treated as one Respondent in this proceeding, as the Respondents appear to be the same person controlling the websites at the disputed domain name. This is confirmed by the facts that (i) seven nearly identical disputed domain names

were registered within 11 days of each other, using false or inaccurate contact information; (ii) the disputed domain names have been hosted at the same IP address; and (iii) the disputed domain names have been resolved to identical websites. The Panel accepts these arguments in favor of consolidation. The Panel further notes that the Respondents have not made any objection to the Complainant's consolidation request.

Considering the above, the Panel finds that the disputed domain names are subject to common control, and grants the Complainant's request to consolidate the Respondents into one proceeding. Hereafter, the Panel will refer to the Respondents as "the Respondent".

B. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain names <tommybahamaoutlets.shop>, <tommybahamasale.shop>, <tommybahamasale.store>, <tommybahamaus.shop>, <tommybahamavip.shop> and <tommybahamavip.store>. Accordingly, these disputed domain names are identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Regarding the disputed domain name <tommyonline.store>, it resolved to a website, which prominently featured the Complainant's mark. Therefore, the Panel finds that the content of the website associated with this disputed domain name confirms that it is confusingly similar to the Complainant's mark for the purposes of the Policy because the Respondent seeks to target the mark through this disputed domain name. [WIPO Overview 3.0](#), section 1.15.

While the addition of other terms "online," "sale", "vip", "us", and "outlets" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence

demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The available evidence do not confirm that the Respondent is commonly known by the disputed domain names, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree with the use of its prior registered trademarks by the Respondent (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

The disputed domain names used to redirect Internet users to identical websites with a design similar to the Complainant's website, prominently featuring the Complainant's mark, and purportedly offering for sale the Complainant's products, which would make Internet users believe that they actually accessed the Complainant's website. According to section 2.8.1 of the [WIPO Overview 3.0](#) resellers, distributors using a domain name containing a complainant's trademark to undertake sales related to the complainant's goods may be making a *bona fide* offering of goods and thus have a right or legitimate interest in such domain name. Outlined in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the "Okidata Test"), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods at issue;
- (ii) the respondent must use the site to sell only the trademarked goods;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names reflecting the trademark.

The Panel finds that the Respondent failed to satisfy at least the above third requirement and did not in any way disclose its actual relationship with the Complainant, and thus failed to pass the *Okidata Test*. The Respondent's use of the disputed domain names misleads consumers into thinking that the websites are operated by or affiliated with the Complainant. As such, the Respondent's use of the disputed domain names cannot be considered *bona fide*.

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

D. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent's use of the disputed domain names to purport to sell the Complainant's products shows that at the time of the registration of the disputed domain names the Respondent clearly knew and targeted the Complainant's prior registered and famous trademark, which confirms the bad faith (see, e.g., *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

According to section 3.1.4 of the [WIPO Overview 3.0](#) the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is convinced that the Complainant's trademark is well established through long and widespread use and the Complainant has acquired a significant reputation and level of

goodwill in its trademark both in the U.S. and internationally. Thus, the Panel finds that the disputed domain names confusingly similar to the Complainant's trademark was registered in bad faith.

According to paragraph 4(b) of the Policy the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location. In this case, the disputed domain names were resolving to identical websites prominently featuring the Complainant's trademark to intentionally attract Internet users to the Respondent's websites, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the websites and their products. The Panel finds the above confirms the disputed domain names were registered and are being used in bad faith.

Although at the time of this decision the disputed domain names resolve to inactive webpages, their previous bad faith use and lack of explanation of possible good faith use from the Respondent makes any good faith use of the disputed domain names implausible. Thus, the current passive holding of the disputed domain names does not prevent a finding of bad faith (see section 3.3 of the [WIPO Overview 3.0](#)).

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 names <tommybahamaoutlets.shop>, <tommybahamasale.shop>, <tommybahamasale.store>, <tommybahamaus.shop>, <tommybahamavip.shop>, <tommybahamavip.store>, and <tommyonline.store> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: September 1, 2023