

## ADMINISTRATIVE PANEL DECISION

Simon Property Group, L.P. v. Magno Torreja / Organization Name Redacted  
Case No. D2023-2944

### 1. The Parties

Complainant is Simon Property Group, L.P., United States of America (“United States”), represented by CSC Digital Brand Services Group AB, Sweden.

Respondent is Magno Torreja / Organization Name Redacted<sup>1</sup>, United States, represented by Dmitriy Chyrkin, Esq, Ukraine.

### 2. The Domain Name and Registrar

The disputed domain name <nypremiumoutlet.com> is registered with Tucows Inc. (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 10, 2023. On July 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 0163105756) and contact information in the Complaint. The Center sent an email communication to Complainant on July 12, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 17, 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

---

<sup>1</sup> The Respondent appears to have used the organization name of the Complainant when registering the disputed domain name. In light of Complainant’s request to redact, and the potential identity theft, the Panel has redacted the Respondent’s organization name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the organization name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

The Center received a further communication from Complainant, requesting a name redaction on July 21, 2023, and a supplemental filing from Complainant on July 26, 2023.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on July 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 7, 2023. The Response was filed with the Center on July 26, 2023. The Center also received a further supplemental filing from Respondent on July 31, 2023.

The Center appointed Georges Nahitchevansky as the sole panelist in this matter on August 14, 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**

Complainant, Simon Property Group, L.P., is an American real estate trust that invests in shopping malls, outlet centers and community / lifestyle centers. Amongst Complainant’s many activities, Complainant owns and operates a number of outlet centers in the United States and internationally that use or incorporate the name and mark PREMIUM OUTLETS. These include, by way of example and of relevance to this proceeding, “Woodbury Common Premium Outlets” in the State of New York. Complainant owns several trademark registrations in the United States for PREMIUM OUTLETS in connections with its services (i) as a word mark (Registration No. 2619883, which issued to registration on September 17, 2002), and (ii) in combination with other words, such as S SIMON PREMIUM OUTLETS (Registration No. 5241781, registered on July 11, 2017), SHOP PREMIUM OUTLETS (Registration No. 5955766, registered on January 7, 2020) and WOODBURY COMMON PREMIUM OUTLETS (Registration No. 3532840, registered on November 18, 2008) or a logo, such as S SIMON PREMIUM OUTLETS (Registration No. 5241781, registered on July 1, 2017). All of these registrations predate the registration of the disputed domain name and in all of these registrations Complainant has expressly disclaimed the word “outlets.”

Complainant also owns a registration for a stylized version of PREMIUM OUTLETS in the Philippines (Registration No. 4-2015-4371) that issued to registration on April 21, 2019, and likewise disclaims the word “outlets.”

Lastly, Complainant owns and uses the domain name <premiumoutlets.com> for a website concerning Complainant, its properties, outlet centers and services.

Respondent is an individual with a company that is based in New York State in a town less than fifteen miles from Complainant’s Woodbury Common Premium Outlets. Respondent registered the disputed domain name on November 16, 2021 and has used such for an e-commerce website targeted to consumers in the Philippines that offers for sale and delivery in the Philippines shoes, clothing, accessories and bags that have been purchased by Respondent from outlet stores in New York. Respondent’s website originally made numerous references to Complainant’s Woodbury Common Premium Outlets and that the products being offered for sale on Respondent’s website had originated from the Woodbury Common Premium Outlets. These included such statements as “[s]hopping at our online store is like shopping at Woodbury Common Premium Outlets without having to come to New York.” These statements no longer appear on Respondent’s website at the disputed domain name and have been replaced with statements that the products being offered for sale are “sourced from New York outlet stores.”

Respondent filed a trademark application in the United States for NEW YORK PREMIUM OUTLET (Serial No. 97329268) on March 24, 2022, claiming a date of first use on March 20, 2022. On February 12, 2023 Respondent’s application was refused registration by the United States Patent and Trademark Office

("USPTO") on various grounds including likelihood of confusion with some of Complainant's trademark registrations that include PREMIUM OUTLETS. Respondent then moved its application for NEW YORK PREMIUM OUTLET to the Supplemental Register. Respondent's application is still pending and is currently suspended.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant maintains that it has rights in the mark and name PREMIUM OUTLETS by virtue of its continuous use of that name and mark since 1985 in connection with its outlet and lifestyle centers, its trademark registrations for PREMIUM OUTLETS alone and with other words, and through its use of the domain name <premiumoutlets.com> for Complainant's website since 1996.

Complainant asserts that the disputed domain name is confusingly similar to Complainant's PREMIUM OUTLETS mark as it includes a singular version of the mark with the word "outlet" instead of "outlets," along with the non-distinctive geographic abbreviation "NY" for New York, which relates expressly to Complainant's Woodbury Common Premium Outlets located in New York.

Complainant contends that Respondent does not have rights or legitimate interests in the disputed domain name as Respondent (i) is not affiliated or connected to Complainant, (ii) has no permission to use Complainant's trademarks, (iii) cannot be considered as having rights in the disputed domain name by virtue of a business state registration for its company name, obtained after Complainant secured trademark rights in PREMIUM OUTLETS, (iv) and is essentially creating without permission the impression that the disputed domain name and associated website are "authorized by, connected to or affiliated with Complainant's PREMIUM OUTLETS / WOODBURY COMMON PREMIUM OUTLETS brand."

Lastly, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith as the disputed domain name is confusingly similar to Complainant's PREMIUM OUTLETS mark that has been used since 1985. Complainant further argues that since Respondent has been purchasing goods at Complainant's Woodbury Commons Premium Outlets, it was well aware of Complainant's rights in PREMIUM OUTLETS and registered the disputed domain name to pass itself off and its website as connected to Complainant. In that regard, Complainant notes that Respondent makes numerous statements and references to Complainant's Woodbury Common Premium Outlets on its website to give the false impression that Respondent is somehow associated with Complainant, when, in fact, there is no such connection.

### **B. Respondent**

Respondent rejects Complainant's contentions.

Respondent argues that it is a New York registered company serving customers in the Philippines and that the disputed domain name is based on its company name.

Respondent questions Complainant's ownership and rights in the PREMIUM OUTLETS mark. In particular, Respondent notes that Complainant has disclaimed the word "outlets" in all of its registrations and that, as such, "for purposes of this dispute, only 'Premium' can be claimed as a protected word." In that regard, Respondent maintains that since "premium" is a generic term, Complainant does not have sufficient trademark rights for purposes of the first element. Complainant also asserts that the words "premium outlets" have a generic meaning and that a Google search of such returns numerous descriptive uses of "premium outlets" and that a trademark search on WIPO's Global Brand Database returns 270 applications for marks containing "premium outlets."

Respondent contends that it has not registered or used the disputed domain name in bad faith since “common words and descriptive terms are legitimately subject to registration as domain names on a “first-come, first-served” basis. Respondent then argues that as it has a legitimate interest in the disputed domain name, it cannot be seen as having use or registered the disputed domain name in bad faith. Respondent also argues that none of the factors under paragraph 4(b) of the policy are present in this case.

Lastly, Respondent argues that the doctrine of laches should be considered here as the disputed domain name was registered in November 2021 and Complainant waited until July 2023 to take action.

### **C. The Parties Supplemental Filings**

On July 27, 2023, Complainant submitted a brief supplemental filing noting that the USPTO had refused Respondent’s trademark application for NEW YORK PREMIUM OUTLET on the grounds of confusion with Complainant’s registrations and that Respondent’s application is currently suspended. Complainant provided the USPTO records in that regard.

Respondent, in turn, submitted a brief supplemental filing in which Respondent maintains it is appealing the USPTO rejection of its application and notes that the USPTO allowed Respondent to amend its application for NEW YORK PREMIUM OUTLET to the Supplemental Register and found that the word “outlet” is generic. Respondent also notes that some of Complainant’s claimed marks were initially rejected by the USPTO because on the grounds that the wording “premium outlets” is descriptive. Respondent likewise provides USPTO records in support of these points.

The Panel, having reviewed the brief and limited supplemental submissions of the parties accepts these as they provide further information regarding the parties’ respective registrations and application.

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) 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. Preliminary Issue: Respondent’s Claim of Laches**

Respondent asserts that because Respondent registered the disputed domain name in November 2021, Complainant is barred under the doctrine of laches from initiating a complaint against the disputed domain name. While the doctrine of laches is a common law equitable defense that seeks to prevent a party from ambushing someone else by failing to make a legal claim in a timely manner, the Policy contains no limitation period for making a claim, and a delay by a complainant in bringing a complaint does not provide a defense per se under the Policy. As such, UDRP panels who have considered the issue have declined to specifically adopt concepts such as laches in the UDRP. See Section 4.17 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)) and cases cited therein. Here, even in the absence of an explanation from Complainant, the Panel does not draw a negative inference from the mere delay in the filing of the Complaint.

That being said, the Panel considers that a delay would be relevant to its decision if there was some firm indication that Complainant had, explicitly or implicitly, consented to Respondent’s use of its trademark in the disputed domain name. It is notable that Respondent has provided no evidence that Complainant was or when Complainant became aware of Respondent’s registration and use of the disputed domain name for its

website selling products sourced from Complainant's Woodbury Commons Premium Outlets to consumers in the Philippines, and there is no indication of any correspondence between Complainant and/or any representative of Complainant with Respondent to suggest or imply that Complainant may have approved of or condoned Respondent's use of a variation of the PREMIUM OUTLETS mark in the disputed domain name. Without some material evidence, beyond conjecture, to indicate that Complainant approved of or condoned Respondent's use of the PREMIUM OUTLETS mark in the disputed domain name, the Panel is not prepared to consider a bar on the grounds of laches against Complainant's claims concerning the disputed domain name.

## **B. Identical or Confusingly Similar**

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. Section 1.2.1. of the [WIPO Overview 3.0](#). Complainant has provided evidence that it owns trademark registrations for PREMIUM OUTLETS alone and in combinations with other words, such as WOODBURY COMMON PREMIUM OUTLETS, and that such issued to registration years before Respondent registered the dispute domain name. Complainant has also provided evidence that it owns and uses PREMIUM OUTLETS in connection with its outlet and lifestyle centers both in the United States and internationally.

With Complainant's rights the PREMIUM OUTLETS mark established, the remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the generic Top-Level Domain, such as ".com") is identical or confusingly similar with Complainant's mark. See *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#). The threshold for satisfying this first element is low and panels generally have found that fully incorporating the identical mark or close variant thereof in a disputed domain name is sufficient to meet this standing requirement.

In the instant proceeding, the disputed domain name is confusingly similar to Complainant's PREMIUM OUTLETS mark as it incorporates PREMIUM OUTLETS, albeit in a singular form, in its entirety at the tail of the disputed domain name. The addition of the geographic abbreviation "NY" (for New York) does not distinguish the disputed domain name from Complainant's PREMIUM OUTLETS mark as that mark is clearly and prominently visible in the disputed domain name. The Panel therefore finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its rights in the PREMIUM OUTLETS mark and in showing that the disputed domain name is confusingly similar to that trademark.

## **C. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the complainant must make at least a *prima facie* showing that the respondent possesses no rights or legitimate interests in a disputed domain name. *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once the complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

The evidence submitted in this proceeding shows that Respondent has used the disputed domain name for a website targeted to consumers in the Philippines that offers for sale and delivery in the Philippines shoes, clothing, accessories and bags that have been purchased by Respondent from outlet stores in New York. There is no evidence or indication that Respondent has sold any products other than genuine products sourced through outlet stores in New York or that there have been any consumer complainants regarding the products sold by Respondent through the website at the disputed domain name. Thus, on its face it would appear that Respondent, while an unauthorized reseller of various products sourced through outlet stores located in New York, and in all likelihood Woodbury Common Premium Outlets (given Respondent's prior statements on its website), could have a legitimate interest in the disputed domain name under the "Ok! Data test" adopted by numerous UDRP Panels. See *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); see also [WIPO Overview 3.0](#) at section 2.8.

However, while reselling legitimately sourced genuine products could be seen as being a legitimate interest or use, Respondent here has taken the extra step of registering a domain name that on its face suggests a connection to Complainant, or which likely could be seen as a domain name connected to Complainant in New York. Respondent argues against such contention by urging that it has a legitimate interest in the disputed domain name because Complainant's rights in PREMIUM OUTLETS are questionable given that the word "outlets" was disclaimed by Complainant and the word "premium" is a common word.

Such contention reveals a misunderstanding of disclaimer practice, at least in the United States, as the word "outlets" is disclaimed "apart from the mark as shown." What this means is that a mark needs to be considered as a whole and not narrowly dissected as Respondent seeks to do. A disclaimer of a portion of a trademark does not remove the disclaimed portion completely from the trademark. See, e.g., *In re Nat'l Data Corp.*, 753 F.2d 1056, 1059, (Fed. Cir. 1985). A trademark with a disclaimed portion must still be regarded as a whole when evaluating that trademark's similarity to other trademarks. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, (Fed. Cir. 1984).

To be sure, the disclaimer of "outlets" impacts on the claimed strength of Complainant's PREMIUM OUTLETS mark, particularly as Complainant cannot claim exclusive rights in the word "outlet" or "outlets." But the analysis in the first instance should be centered on the use of "PREMIUM OUTLETS" as a whole – including the voluntarily disclaimed word "outlets" – when considering its similarity to the disputed domain name. Here, there is no question that Complainant enjoys rights in PREMIUM OUTLETS and that Respondent has incorporated a confusingly similar variant of such mark with the geographic term "NY" in the disputed domain name.<sup>2</sup>

Perhaps implicitly recognizing that there is indeed a similarity between Complainant's PREMIUM OUTLETS mark and the disputed domain name, Respondent also argues that "premium outlets" has a "generic" meaning, as shown through Google searches that show use of "premium outlets" in a descriptive sense, and on account of a search by Respondent of WIPO's Global Brand Database revealing many marks with the words "premium outlets." Notably, Respondent has not provided any results from its claimed Google search. A quick search by the Panel for "premium outlets," however, revealed a number of pages of references to Complainant and its PREMIUM OUTLETS brand. As for Respondent's WIPO trademark search, the pages provided are only for selected portions of the search, include numerous expired or terminated ("ended") trademarks in various countries, and some registered marks primarily in Chile that use "premium outlet." What is missing in Respondent's submission is evidence of use of "premium outlet" or "premium outlets" as trademarks by third parties in the United States or the Philippines, the two countries of relevance in this proceeding and where the parties are based and operating.

But there is more. Although Respondent attempts to discount Complainant's trademark rights, Respondent has itself attempted to register the mark NEW YORK PREMIUM OUTLET. Respondent has likewise disclaimed the word "outlet," but obviously claims rights in the whole mark that includes the disclaimed portion. Indeed, after Respondent faced a refusal to register the NEW YORK PREMIUM OUTLET mark for the USPTO, Respondent amended its application to place it on the Supplemental Register. While such placement on the Supplemental Register is an admission that the Respondent's claimed mark is not inherently distinctive, that amendment to the Supplemental Register does not eliminate the fact that Respondent is trying to claim trademark rights in NEW YORK PREMIUM OUTLET or that the USPTO continues to refuse registration of Respondent's applied for mark on the basis, in part, on Complainant's

---

<sup>2</sup> Respondent also argues that as Complainant's SIMON PREMIUM OUTLETS and other PREMIUM OUTLETS marks were initially rejected by the USPTO on the grounds that "premium outlets" was descriptive, Complainant has no rights in such marks. While it is true that Complainant received an office action in 2014 regarding its SIMON PREMIUM OUTLETS marks requiring a disclaimer of "premium outlets," Respondent ignores that Complainant overcame that refusal on the basis of establishing acquired distinctiveness in PREMIUM OUTLETS on account of over five years of continuous use of PREMIUM OUTLETS. Respondent provides little to no evidence suggesting that Complainant's PREMIUM OUTLETS mark no longer has any distinctiveness. Indeed, the fact that Respondent did not include the results from its claimed Google search, suggests in and of itself that a search, as conducted by the Panel, immediately returns results for Complainant's use of PREMIUM OUTLETS as a trademark owned and used by Complainant.

PREMIUM OUTLETS mark. Thus what is before the Panel is an attempt by Respondent to use PREMIUM OUTLETS for essentially closely related services or to suggest a connection to Complainant.

That this is the case is confirmed by Respondent's own website. The original version made numerous references to Complainant's Woodbury Common Premium Outlets, some of which could be seen as suggesting a connection between Respondent and Complainant's Woodbury Common Premium Outlets or an online retail website operated or authorized by Complainant for the sale of goods in the Philippines, a country in which Complainant has rights in the PREMIUM OUTLETS mark. Notably, none of the pages within Respondent's website have ever specified that Respondent does not have any affiliation with or connection to Complainant. Moreover, the use of "NY" for New York in the disputed domain name seems also meant to foster an association between Respondent and Complainant, given that Complainant's Woodbury Common Premium Outlets in New York enjoys a reputation not only in the United States, but internationally.

Such actions by Respondent, in their totality, appear to have been designed to suggest that Respondent's website at the disputed domain name is affiliated with, connected to or authorized by Complainant, when such is not the case. Thus while Respondent may have a legitimate basis for reselling legitimately sourced clothing, accessories or other products sourced from outlets in the United States for sale in the Philippines, it is not legitimate for Respondent to use the disputed domain name that is based on Complainant's PREMIUM OUTLETS mark in order to attract consumers to Respondent's website and/or to suggest some form of connection, sponsorship or endorsement by Complainant for purposes of selling products – even if they are genuine products. Respondent is not connected to Complainant and taking measures to misleadingly imply an affiliation with Complainant is not a legitimate or fair use even under the "Oki Data Test." [WIPO Overview 3.0](#) at sections 2.5.1 and 2.8.2.

It should also be noted that Respondent's registration of the company name "NEW YORK PREMIUM OUTLET" in New York State does not render Respondent's actions as legitimate. Knowingly adopting a company name based on or incorporating the prior mark of another to offer similar or closely related services is not legitimate and can never justify an attempt to take advantage of another's mark for one's own profit.

Given that Complainant has established with sufficient evidence that it owns rights in the PREMIUM OUTLETS mark, and given Respondent's above noted actions, the Panel concludes that Respondent does not have a right or legitimate interest in the disputed domain name and that none of the circumstances of paragraph 4(c) of the Policy are evident in this case.

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

In the present case, Respondent has registered the disputed domain name that fully incorporates a singular version of Complainant's PREMIUM OUTLETS mark with the geographic term "NY," which stands for New York. Given that Complainant uses its PREMIUM OUTLETS for a number of its shopping malls and outlets around the world and promotes such through its website at <premiumoutlets.com>, the disputed domain name is likely to be viewed by consumers as linked to Complainant and/or to a website that is authorized by Complainant. This is particularly so given that Respondent, as noted above, has used references on its website that suggest a connection to Complainant's Woodbury Common Premium Outlets mall in New York State. It is again worth noting that Respondent has included no disclaimer on its website. The lack of any such disclaimer along with the references to Complainant's outlet in New York undermines any claim by Respondent that it took reasonable steps to avoid passing itself off as related to Complainant. Simply put, Respondent's actions make it more likely than not that Respondent opportunistically registered and used the disputed domain name, which is based on Complainant's PREMIUM OUTLETS mark, to intentionally and misleadingly attract Internet users to Respondent's website, or to legitimize Respondent's website, for Respondent's own profit. See [WIPO Overview 3.0](#), Section 3.1.4 (and cases cited therein).

Accordingly, the Panel finds that Complainant succeeds under this element 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, <nypremiumoutlet.com>, be transferred to Complainant.

*/Georges Nahitchevansky/*

**Georges Nahitchevansky**

Sole Panelist

Date: August 28, 2023