

ADMINISTRATIVE PANEL DECISION

Tommy Bahama Group, Inc. v. zhang ping ping
Case No. D2023-3033

1. The Parties

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

The Respondent is zhang ping ping, China.

2. The Domain Name and Registrar

The disputed domain name <tommybahamaonsale.com> is registered with Bizcn.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 14, 2023. On July 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 19, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. On the same day, the Center sent an email communication to the Complainant 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 in English on July 21, 2023.

On July 19, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On July 21, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 25, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on September 13, 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 markets island-inspired apparel and related accessories including footwear, swimwear, sunglasses, eyewear, watches, wallets, bedding, sporting goods, fragrances, personal care products, and home furnishings. It presently operates 136 TOMMY BAHAMA retail stores throughout the United States (including 10 outlet stores) and has, through various arrangements, 22 TOMMY BAHAMA stores in other countries. Its products are also sold through third parties. It operates 21 TOMMY BAHAMA restaurant-retail locations in the United States. "Tommy Bahama" is a name but does not identify a particular living individual. The Complainant presently holds multiple trademark registrations in multiple jurisdictions, including the following:

- United States trademark registration number 1802812 for TOMMY BAHAMA, registered on November 2, 1993 with a claim of first use in commerce on March 1, 1993, specifying goods in class 25, including men's, women's, boys', and girls' clothing;
- Chinese trademark registration number 1219615 for TOMMY BAHAMA, registered on October 28, 1998, specifying goods in class 32, including beer; and
- Chinese trademark registration number 1733366 for TOMMY BAHAMA, registered on September 28, 2010, specifying goods in class 25, including clothing.

The above trademark registrations remain current. The Complainant has also registered the domain name <tommybahama.com> that it uses in connection with a website that prominently displays the TOMMY BAHAMA mark and provides information about the Complainant and its clothing for men and women.

The Respondent is an individual based in China.

The disputed domain name was registered on May 31, 2023. It resolves to a default index.html or home page displaying a message titled "Congratulations, the site is created successfully".

5. Parties' Contentions

A. Complainant

The disputed domain name is confusingly similar to the Complainant's TOMMY BAHAMA mark. The only difference between the TOMMY BAHAMA mark and the disputed domain name is the addition of the phrase "on sale".

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent cannot use the disputed domain name with any *bona fide* offering and cannot be commonly known as "TommyBahamaOnSale," given that the Complainant has extensive and exclusive rights in the TOMMY BAHAMA mark and has not authorized the Respondent to use that mark. The disputed domain name is not in use at all, which is sufficient to demonstrate that the Respondent does not have rights or legitimate interests in it. Instead, it appears likely that the Respondent intends to use the disputed domain name for her own commercial gain by diverting members of the public to her website.

The disputed domain name was registered and is being used in bad faith. Registration of a domain name that includes the TOMMY BAHAMA mark in its entirety is evidence of bad faith registration. The

Complainant's TOMMY BAHAMA mark is well-known. The Respondent is not authorized to use the TOMMY BAHAMA mark but has nonetheless registered the disputed domain name, likely with the intent to divert the Complainant's customers for the Respondent's own financial gain.

B. Respondent

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

6. Discussion and Findings

6.1. Language of the Proceeding

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". The Registrar confirmed that the Registration Agreement for the disputed domain name is in Chinese.

The Complainant requests that the language of the proceeding be English. Its main arguments are that the disputed domain name is registered in Latin characters, not Chinese script, and consists entirely of English language words; there is no indication that the Respondent is necessarily more fluent in Chinese than English; and the Complainant is unable to communicate in Chinese without a great deal of additional expense and delay due to the need for translation.

Paragraphs 10(b) and (c) of the Rules require the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); and *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. Ltd.*, WIPO Case No. [D2008-0293](#).

The Panel observes that in this proceeding the Complaint and amended Complaint were filed in English. Despite the Center having sent the written notice of the Complaint and an email regarding the language of the proceeding in both Chinese and English, the Respondent has not commented on the issue of language nor expressed any interest in otherwise participating in this proceeding. Therefore, the Panel considers that requiring the Complainant to translate the Complaint would create an undue burden and delay, whereas accepting it as filed without translation will not cause unfairness to either Party.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English. The Panel would have accepted a Response in Chinese, but none was filed.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove the following elements:

- (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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Based on the evidence presented, the Panel finds that the Complainant has rights in the TOMMY BAHAMA mark.

The disputed domain name wholly incorporates the TOMMY BAHAMA mark as its initial element. It adds the words “on sale”. However, this addition does not prevent a finding of confusing similarity because the TOMMY BAHAMA mark remains clearly recognizable within the disputed domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8.

The only other element in the disputed domain name is a generic Top-Level Domain (“gTLD”) extension (“.com”). As a standard requirement of domain name registration, a gTLD extension may be disregarded in the comparison between the disputed domain name and the Complainant’s mark. See [WIPO Overview 3.0](#), section 1.11.1.

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to [the respondent] of the dispute, [the respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] 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 [the respondent has] acquired no trademark or service mark rights; or
- (iii) [the respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As regards the first and third circumstances set out above, the disputed domain name resolves to a default homepage for a website that has yet to be constructed. There is no evidence of demonstrable preparations to construct a website. The Complainant submits that it has not authorized the Respondent to use its TOMMY BAHAMA mark. In the Panel’s view, these circumstances indicate that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, nor is she making a legitimate noncommercial or fair use of the disputed domain name that would generate rights or legitimate interests for the purposes of the Policy.

As regards the second circumstance set out above, the Respondent is identified in the Registrar’s Whois database as “zhang ping ping”, not the disputed domain name. There is no evidence that the Respondent has been commonly known by the disputed domain name.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because she did not respond to the Complaint.

Therefore, based on the record of this proceeding, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances shall be evidence of the registration and use of a domain name in bad faith but these circumstances are not exhaustive.

The disputed domain name was registered in 2023, years after the registration of the Complainant's TOMMY BAHAMA trademark, including in China, where the Respondent is based. The disputed domain name wholly incorporates the TOMMY BAHAMA mark, which is a distinctive name, not a dictionary word or common phrase. The Complainant has made extensive use of its mark in connection with its clothing, accessories, and other products, including online. This all gives the Panel reason to find that the Respondent had the TOMMY BAHAMA mark in mind when she registered the disputed domain name.

The disputed domain name is used to resolve to a default homepage. Although the website to which the disputed domain name resolves is yet to be constructed, this does not preclude a finding of use in bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), regarding passive use. In the present dispute, the disputed domain name wholly incorporates the TOMMY BAHAMA trademark, followed by the words "on sale" and a gTLD extension. The Complainant has acquired a considerable reputation in its TOMMY BAHAMA mark through long-standing and extensive use in connection with its clothing, accessories, and other products, including online. The Respondent is not authorized by the Complainant to use its mark and she provides no explanation of any intended good faith use of the disputed domain name. In view of all these circumstances, the Panel considers it more likely than not that the Respondent is using the disputed domain name in bad faith.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in 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 <tommybahamaonsale.com> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: September 25, 2023