

## **ADMINISTRATIVE PANEL DECISION**

Tommy Bahama Group, Inc. v. yan ping ping  
Case No. D2023-3276

### **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 yan ping ping, China.

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

The disputed domain name <tommybahamawelfare.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 30, 2023. On July 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 2, 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. The Center sent an email communication to the Complainant on August 2, 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 in English on August 6, 2023.

On August 2, 2023, the Center sent an email communication to all Parties in Chinese and English regarding the language of the proceeding. On August 7, 2023, the Complainant confirmed the 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 in Chinese and English of the Complaint, and the proceedings commenced on August 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 5, 2023.

The Center appointed Sok Ling MOI as the sole panelist in this matter on September 19, 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 in the fashion wear business, and has used the TOMMY BAHAMA mark in connection with its apparel and accessories as early as 1993. Over the years, the Complainant has expanded the TOMMY BAHAMA line of products to a range of lifestyle accessories, fragrances, personal care products as well as home furnishings. The Complainant has enjoyed substantial sales under the TOMMY BAHAMA mark, and boasted a net sales of USD 880 million in fiscal year 2022.

The Complainant presently operates 136 Tommy Bahama retail stores for its apparel, accessories and home furnishings products throughout the United States, and has 22 international Tommy Bahama retail stores in Australia, Canada, the United Arab Emirates, and Japan. The Complainant operates its official website at the domain name <tommybahama.com>, featuring its Tommy Bahama apparel and accessories, retail store and restaurant locations, customer service and product care information.

The Complainant owns a large portfolio of trade mark registrations for its TOMMY BAHAMA mark, in several jurisdictions around the world, the earliest being registered in the United States on November 2, 1993, including the following:

Jurisdiction	Mark	Class	Registration No.	Registration Date
United States	TOMMY BAHAMA	25	1802812	November 2, 1993
United States	TOMMY BAHAMA	42	2284151	October 5, 1999
United States	TOMMY BAHAMA	35	2492771	September 25, 2001
United States	TOMMY BAHAMA	24	2704749	April 8, 2003
United States	TOMMY BAHAMA	3	3075649	April 4, 2006
China	TOMMY BAHAMA	25	9049899	March 21, 2012
China	TOMMY BAHAMA	25	1733366	September 28, 2010
China	TOMMY BAHAMA	35	9400325	May 14, 2012
China	TOMMY BAHAMA	24	9400333	August 14, 2014
China	TOMMY BAHAMA	3	9400341	November 21, 2015

The disputed domain name was registered on June 23, 2023. According to the evidence submitted by the Complainant, the disputed domain name did not resolve to any active website but was passively held.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its trade mark.

The Complainant contends that as the Complainant has not licensed or otherwise authorized the Respondent to use its trade mark, and the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant contends that the disputed domain name has been registered and is being used to create confusion and mislead Internet users into believing that the Respondent's website is in some way connected with or endorsed by the Complainant. The Complainant therefore contends that the Respondent has registered and is using the disputed domain name in bad faith.

For all of the above reasons, the Complainant requests for the transfer of the disputed domain name to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Procedural Issue - Language of the Proceeding**

Pursuant to paragraph 11(a) of the Rules, 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.

Paragraphs 10(b) and (c) of the Rules require the Panel to ensure that the proceeding takes place with due expedition and that the Parties are treated equitably and given a fair opportunity to present their respective cases.

The language of the Registration Agreement for the disputed domain name is Chinese. From the evidence on record, no agreement appears to have been entered into between the Complainant and the Respondent regarding the language issue. The Complainant filed its Complaint in English and has requested that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Panel finds evidence in the present proceeding to suggest that the Respondent may have knowledge of English. In particular, the Panel notes that:

- . (a) the disputed domain name is registered in Latin characters, rather than Chinese scripts; and
- . (b) the disputed domain name consists of the English word "welfare".
- .

Additionally, the Panel notes that:

- . (a) the Center has notified the Respondent of the language of the proceeding and commencement of the proceeding in both Chinese and English;
- . (b) the Respondent has been given the opportunity to present his or her case in this proceeding and to respond to the issue of the language of the proceeding;
- . (c) the Center has informed the Respondent that it would accept a Response in either English or Chinese; and
- . (d) the Respondent did not comment on the language of the proceeding or file a Response.

Considering the above circumstances, the Panel finds that the choice of English as the language of the present proceeding is fair to all Parties and is not prejudicial to any of the Parties in their ability to articulate the arguments for this case. The Panel has taken into consideration the fact that to require the Complaint to be translated into Chinese would, in the circumstances of this case, cause an unnecessary cost burden to the Complainant and would unnecessarily delay the proceeding.

In view of all the above, the Panel determines under paragraph 11(a) of the Rules that it shall accept the Complaint as filed in English, that English shall be the language of the proceeding, and that the decision will be rendered in English.

## **6.2. Substantive Issue - Three Elements**

Paragraph 4(a) of the Policy directs that the complainant must prove each of the following three elements to obtain an order for the disputed domain name to be cancelled or transferred:

- (i) the disputed domain name registered by the respondent is identical or confusingly similar to a trade mark or service 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.

On the basis of the evidence introduced by the Complainant, the Panel concludes as follows:

### **A. Identical or Confusingly Similar**

The Panel accepts that the Complainant has trade mark rights in TOMMY BAHAMA by virtue of use and registration.

The disputed domain name incorporates the Complainant's trade mark in its entirety. The addition of the word "welfare" does not prevent a finding of confusingly similarity between the disputed domain name and the Complainant's trade mark. The addition of the generic Top-Level Domain ("gTLD") ".com" is a standard registration requirement and is generally disregarded in the confusing similarity assessment.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark.

Accordingly, the Complainant has satisfied the requirements of the first element under paragraph 4(a) of the Policy.

### **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the complainant bears the burden of establishing that the respondent lacks rights or legitimate interests in the disputed domain name. However, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii), the burden of production shifts to the respondent to establish its rights or legitimate interests in the disputed domain name by demonstrating any of the following, without limitation, under paragraph 4(c) of the Policy:

- (i) before any notice to it 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 has been commonly known by the disputed domain name, even if it has acquired no trade mark 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 trade mark or service mark at issue.

The Respondent appears to be an individual by the name “yan ping ping”, which does not bear any resemblance to the term “tommy bahama”. There is no evidence suggesting that the Respondent is commonly known by the disputed domain name or that it has any rights in the term “tommy bahama” or in the disputed domain name. The Complainant has confirmed that the Respondent is not in any way related to or affiliated with the Complainant or otherwise authorized or licensed to use the TOMMY BAHAMA trade mark or to seek registration of any domain name incorporating the trade mark.

According to the evidence submitted by the Complainant, the disputed domain name does not resolve to any active website but is passively held. There is no evidence to suggest that the Respondent has made any preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use purpose.

The Panel is therefore satisfied that the Complainant has made out a *prima facie* case showing that the Respondent lacks rights or legitimate interests in the disputed domain name. The burden of production thus shifts to the Respondent to establish his or her rights or legitimate interests in the disputed domain name. Since the Respondent has failed to respond, the *prima facie* case has not been rebutted.

Consequently, the Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

Accordingly, the Complainant has satisfied the requirements of the second element under paragraph 4(a) of the Policy.

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

Paragraph 4(b) of the Policy sets out four circumstances which, without limitation, shall be evidence of the registration and use of a disputed domain name in bad faith, namely:

- (i) circumstances indicating that the respondent has registered or acquired the disputed 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 trade mark or service mark or to a competitor of the complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent has registered the disputed domain name in order to prevent the owner of the trade mark 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s web site or location or of a product or service on the respondent’s web site or location.

The Panel notes that, as of the date of this decision, the disputed domain name does not resolve to any active website. Nevertheless, the consensus view of previous UDRP panels is that passive holding in itself does not preclude a finding of bad faith. UDRP panels must examine all the circumstances of the case to determine whether a respondent is acting in bad faith. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 3.3.

The Panel accepts that the Complainant's TOMMY BAHAMA trade mark is a distinctive and well-known mark as a result of extensive use and advertising over the past three decades. It is unlikely that the Respondent was unaware of the Complainant at the point of registering the disputed domain name. Registration of a domain name that incorporates a complainant's distinctive and well-known trade mark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

The Respondent has not denied the Complainant's allegations of bad faith. In view of the above finding that the Respondent does not have rights or legitimate interests in the disputed domain name, and taking into account all the circumstances, particularly the fame and reputation of the Complainant's trade mark and the implausibility of any good faith use the disputed domain name may be put, the Panel concludes that the Respondent has registered and used the disputed domain name in bad faith.

Accordingly, the Complainant has satisfied the requirements of 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 <tommybahamawelfare.com> be transferred to the Complainant.

*/Sok Ling MOI/*

**Sok Ling MOI**

Sole Panelist

Date: October 22, 2023