

ADMINISTRATIVE PANEL DECISION

Thom Browne, Inc. v. Client Care, Web Commerce Communications Limited Case No. D2023-4592

1. The Parties

The Complainant is Thom Browne, Inc., United States of America (“US”), represented by Strategic IP Information Pte Ltd., Singapore.

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

2. The Domain Names and Registrar

The disputed domain names <thombrownecanada.com>, <thombrownechile.com>, <thombrownecolombia.com>, <thombrownefrance.com>, <thombrowneindia.com>, <thombrowneitaly.com>, <thombrownekuwait.com>, <thombrownephilippines.com>, <thombrownesingapore.com>, <thombrownesouthafrica.com>, <thombrowneuk.com>, and <thombrowneus.com> (each a “Disputed Domain Name” and together the “Disputed Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).¹

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 6, 2023. On November 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On November 7, 2023, the First Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. On November 8, 2023, the Second Registrar transmitted by email to the

¹ The Complaint filed on November 6, 2023, included the disputed domain names listed in Section 2 above and the additional domain name <thombrowneespaña.com> [<xn--thombrowneespañ-cr-b.com>] (the “additional domain name”). The additional domain name was registered with the Registrar, PSI-USA, Inc. dba Domain Robot. The additional domain name was not included in the amended Complaint submitted to the Center on November 20, 2023. Accordingly, on January 8, 2024, the Panel issued Administrative Procedural Order No. 1 seeking clarification as to whether the additional domain name still formed part of the Amended Complaint. On January 10, 2024, the Complainant confirmed that the additional domain name did not form part of the amended Complaint. Therefore, the Panel hereby terminates the proceeding as it relates to the additional domain name and instructs the Registrar to remove the LOCK on the additional domain name. Hereinafter, references to the disputed domain names will solely reference those in Section 2 above.

Center its verification response disclosing registrant and contact information for the Disputed Domain Names 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 November 15, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar(s), requesting the Complainant to either file separate complaint(s) for the Disputed Domain Names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity.

The Complainant filed an amended Complaint on November 20, 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 November 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 14, 2023.

The Center appointed Nick J. Gardner as the sole panelist in this matter on December 26, 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 a US apparel and fashion company specializing in tailored clothing, which has expanded to include ready-to-wear, footwear, accessories, and fragrances all marketed under the brand name “Thom Browne”. The brand is currently offered in over 300 leading department stores and specialty boutique doors across 40 countries and through 68 retail stores, flagships, and shop-in-shops in key cities such as New York, London, Milan, Tokyo, Hong Kong, Beijing, Shanghai and Seoul. The Complainant has received numerous awards for its products and is widely recognised in fashion circles. The Complainant owns various trademark registrations for the words “Thom Browne” – see for example US registration No. 3950216 registered on April 26, 2011. These trademarks are referred to as the “THOM BROWNE trademark” in this decision. The Complainant also owns the domain name <thombrowne.com> which is linked to its principal website promoting its business. It also has a widespread presence on social media using the term “thombrowne”.

The Disputed Domain Names were all registered in or around August 2023 and all resolve to websites (the “Respondent’s Websites) which are substantially similar and which purport to be websites operated by the Complainant and which each offer for sale products which purport to be those of the Complainant offered at a discounted price.

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 content of the Respondent's Websites shows the choice of the Disputed Domain Names was not coincidental but was part of a deliberate scheme to attract traffic and sales by purporting to be genuine websites operated by the Complainant.

B. Respondent

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

6. Discussion and Findings

Preliminary Matters

The Panel notes that no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent's failure to file any Response. While the Respondent's failure to file a Response does not automatically result in a decision in favour of the Complainant, the Panel may draw appropriate inferences from the Respondent's default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel in respect of each Disputed Domain Name:

- (i) the Disputed Domain Name is identical with or confusingly similar to a trademark 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;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has rights in the THOM BROWNE trademark. The Panel finds each of the Disputed Domain Names is confusingly similar to this trademark. They each comprise the THOM BROWNE trademark combined with a geographic term. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.. [WIPO Overview 3.0](#), section 1.7.

As stated in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.8, "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements". Accordingly, each of the Disputed Domain Names, containing the THOM BROWNE mark in its entirety, are confusingly similar to the Complainant's trademark regardless of the added terms.

Accordingly, the Panel finds that the Disputed Domain Names are each confusingly similar to the Complainant's trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Names or to use the THOM BROWNE trademark. The Complainant has prior rights in the THOM BROWNE trademark which precede the Respondent's acquisition of the Disputed Domain Names. The Complainant has therefore established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Names and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Names (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the Disputed Domain Names. The Disputed Domain Names have been used for the Respondent's Websites that impersonated the Complainant via their construction and content, both reflecting the Complainant's THOM BROWN trademark in its entirety and the content failing to disclaim any relationship despite allegedly offering the Complainant's good for sale, thereby exacerbating the misleading nature of the Disputed Domain Names. Accordingly, the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Names and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

In the present circumstances the fact that the Disputed Domain Names were linked to the Respondent's Websites which impersonated the Complainant's own website lead the Panel to conclude the registration and use were in bad faith.

The Panel concludes that the Respondent chose to register a series of names comprising the Complainant's trademark combined with geographic terms in order to facilitate a scheme where the Respondent's Websites impersonated that of the Complainant and allegedly offered for sale products which purported to be those of the Complainant at a discount.

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (i) circumstances indicating that you have registered or you have acquired the 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 trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.

In the present circumstances the Panel agrees with the Complainant that factor (iv) applies as the Respondent was seeking to achieve commercial gain by impersonating the Complainant. Factor (ii) also applies given the Respondent registered multiple domain names consisting of the Complainant's trademark. The Panel also notes that the Respondent has not filed a Response and hence has not availed itself of the opportunity to present any case of good faith that it might have. The Panel infers that none exists.

Accordingly, the Panel finds that the Disputed Domain Names have each been registered and are being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 <<thombrownecanada.com>, <thombrownechile.com>, <thombrownecolombia.com>, <thombrownefrance.com>, <thombrowneindia.com>, <thombrowneitaly.com>, <thombrownekuwait.com>, <thombrownephilippines.com>, <thombrownesingapore.com>, <thombrownesouthafrica.com>, <thombrowneuk.com>, and <thombrowneus.com> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: January 17, 2024