

ADMINISTRATIVE PANEL DECISION

Skims Body, Inc. v. Web Commerce Communications Limited, Client Care Case No. D2023-4777

1. The Parties

The Complainant is Skims Body, Inc., United States of America (the “United States”), represented by Pearne & Gordon, LLP, United States.

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

2. The Domain Names and Registrar

The disputed domain names <skims-argentina.com>, <skims-australia.com>, <skimsbelgie.com>, <skims-belgium.com>, <skimsbelgium.com>, <skimsbrasil.com>, <skims-canada.com>, <skims-chile.com>, <skims-danmark.com>, <skims-deutschland.com>, <skims-dubai.com>, <skimsespana.com>, <skimsfactoryoutlet.com>, <skims-greece.com>, <skims-hungary.com>, <skimsindia.com>, <skims-ireland.com>, <skimsirelandsale.com>, <skims-italia.com>, <skimsitalia.com>, <skismalaysia.com>, <skims-mexico.com>, <skismexico.com>, <skims-norge.com>, <skims-nz.com>, <skims-philippines.com>, <skims-romania.com>, <skimssalestore.com>, <skimssaudi Arabia.com>, <skims-schweiz.com>, <skims-singapore.com>, <skims-suomi.com>, <skimsturkey.com>, <skims-turkiye.com>, <skims-uae.com>, <skims-uk.com>, and <skimsusa.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2023. On November 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 20, 2023, the 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 (Alibaba.com Singapore e-Commerce Private Limited) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 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 November 22, 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 December 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 8, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on January 11, 2024. 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, a United States based company, operates in the field of clothing and retail sales thereof.

The Complainant owns over 100 worldwide trademark registrations and applications for or including the mark SKIMS, such as the following:

- the United States trademark registration number 6754965 for the word SKIMS, filed on July 15, 2019, and registered on June 7, 2022, covering goods and services in International classes 18, 25 and 35; and
- the United States trademark registration number 6747497 for the word SKIMS (stylized), filed on August 26, 2019, and registered on May 31, 2022, covering goods and services in International classes 18, 25 and 35.

The Complainant owns and conducts business through the domain name <skims.com>.

According to the Registrar's verification, the Respondent is the owner of registration for the 37 disputed domain names at issue in this proceeding.

The disputed domain names were registered as follows:

- on April 25, 2023, were registered <skims-australia.com>, <skims-canada.com>, <skims-chile.com>, <skims-danmark.com>, <skimsfactoryoutlet.com>, <skims-greece.com>, <skimsindia.com>, <skims-ireland.com>, <skims-norge.com>, <skims-nz.com>, <skimssalestore.com>, <skims-schweiz.com>, <skims-suomi.com>, <skimsturkey.com>, <skims-uae.com>;
- on May 19, 2023, was registered <skims-italia.com>;
- on May 29, 2023, were registered <skimsbelgium.com>, <skismexico.com>, <skims-romania.com>, <skimssaudi Arabia.com>, <skimsitalia.com>;
- on May 31, 2023, was registered <skims-hungary.com>;
- on July 25, 2023, was registered <skims-belgium.com>;
- on July 30, 2023, were registered <skimsespana.com>, <skims-mexico.com>, <skims-singapore.com>, <skims-uk.com>, <skimsusa.com>;

- on July 31, 2023, were registered <skimsbelgie.com>, <skims-deutschland.com>; and
- on August 1, 2023, were registered <skims-argentina.com>, <skimsbrasil.com>, <skims-dubai.com>, <skimsirelandsale.com>, <skismalaysia.com>, <skims-philippines.com>, and <skims-turkiye.com>.

At the time of filing the Complaint and based on the record, 17 of the disputed domain names (namely <skims-canada.com>, <skims-chile.com>, <skimsfactoryoutlet.com>, <skimsindia.com>, <skims-ireland.com>, <skimssalestore.com>, <skims-suomi.com>, <skims-uae.com>, <skimsitalia.com>, <skims-uk.com>, <skimsusa.com>, <skims-argentina.com>, <skimsbrasil.com>, <skims-dubai.com>, <skimsirelandsale.com>, <skismalaysia.com>, <skims-philippines.com>) were directed to commercial websites displaying the Complainant's trademarks and official product images, where purported SKIMS products were advertised and offered for sale at discounted prices, copyright claims were presented and no disclaimer was provided.

20 of the disputed domain names (namely <skims-australia.com>, <skims-danmark.com>, <skims-greece.com>, <skims-norge.com>, <skims-nz.com>, <skims-schweiz.com>, <skimsturkey.com>, <skims-italia.com>, <skimsbelgium.com>, <skismexico.com>, <skims-romania.com>, <skimssaudiarabia.com>, <skims-hungary.com>, <skims-belgium.com>, <skimsespana.com>, <skims-mexico.com>, <skims-singapore.com>, <skimsbelgie.com>, <skims-deutschland.com>, and <skims-turkiye.com>) appear not to have been associated with active websites.

The Respondent has been found by UDRP panels to have engaged in abusive domain name registrations and it has been the subject of more than 150 cases under the Policy. See e.g. *Manduka LLC v. Bach Johanna, Beike Dieter, Brandt Uta, Wexler Mathias, Kalb Benjamin, and Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-3098](#); *Valentino S.p.A. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-2868](#); or *Jacquemus SAS v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-4751](#).

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 confusingly similar to its trademark as they incorporate the trademark SKIMS with additional geographical or descriptive terms, related to the Complainant's industry; that the Respondent has no rights or legitimate interests in the disputed domain names; and that the Respondent registered and is using the disputed domain names in bad faith to redirect Internet users to commercial websites, that have been organized to look like legitimate pages selling the Complainant's products, displaying, without authorization, products branded with SKIM trademark and reproducing the SKIM trademark on such websites.

Further, searching previous UDRP decisions, hundreds of results appear with the name of the Respondent, cases in which the Respondent has registered domain names of famous trademarks followed by a variety of geographical terms and/or generic words, thereby showing a pattern of bad faith.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (i) the disputed domain names are identical 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 the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. Each of the 37 disputed domain names at issue in this proceeding is registered by the same domain name holder.

This proceeding involves a substantial number of disputed domain names (i.e., 37) in two groups. The first group relates to the disputed domain names that have been associated with active websites. The second group is formed of the disputed domain names that have not been associated with active websites. The Respondent's conduct within each group is substantially identical. Given that substantial identity, there is no need for the Panel to address each of the disputed domain names separately. Rather the disputed domain names can be addressed by their respective groups as appropriate.

A. 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 names. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

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 mark is recognizable within the disputed domain names. Accordingly, each of the disputed domain names is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, -such as "Usa", "Romania", "Dubai", "India", etc. or "sale", "factory outlet" -, 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.

B. 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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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.

According to the evidence provided in the Complaint, the Respondent has used the disputed domain names listed in the first group in connection with websites promoting and offering for sale goods identical to those of the Complainant with significant price reductions, reproducing the Complainant's trademark and product images, without providing any disclaimer. Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

With respect to the second group of disputed domain names (i.e., not associated with an active website), the Respondent has not replied to establish any rights or legitimate interests.

Further, the composition of the disputed domain names which combine the Complainant's trademark with geographical terms and/or dictionary terms referring to the Complainant's products or otherwise, suggests an affiliation with the trademark owner. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

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

C. 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.

In the present case, the Panel notes that the disputed domain names were registered in bad faith, with knowledge of the Complainant and its trademark particularly because of their significant number, short timeframe of registration, and their composition. Furthermore, the use of some of the disputed domain names enforces such finding.

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.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain names in the first group incorporate the Complainant's trademark with additional geographical, or terms related to the Complainant's industry, and the websites operated under the disputed domain names display the Complainant's trademark, product images, claim copyright protection and have no disclaimer, indeed in this Panel's view, the Respondent has intended to attract Internet users accessing the websites corresponding to the disputed domain names who may be confused and believe that the websites are held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain.

At the time of filing the Complaint, the second group of disputed domain names direct towards inactive pages.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include:

(i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness of the Complainant’s trademark; the composition of the disputed domain names which include the Complainant’s trademark together with geographical or dictionary terms closely related to the Complainant’s activity; the Respondent’s failure to respond in the present proceedings; the implausibility of any good faith use to which the disputed domain names may be put, and finds that, in the circumstances of this case, the passive holding of the second group of disputed domain names does not prevent a finding of bad faith under the Policy.

Paragraph 4(b)(ii) of the Policy provides another circumstance of bad faith registration and use when the respondent registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. The Panel finds that registering for 37 disputed domain names incorporating the Complainant’s trademark, definitely constitutes a pattern of abusive conduct and registration of the disputed domain names in bad faith. Furthermore, the Respondent’s involvement in more than 150 UDRP disputes, as listed under Section 4 above, enforces such finding.

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, <skims-argentina.com>, <skims-australia.com>, <skimsbelgie.com>, <skims-belgium.com>, <skimsbelgium.com>, <skimsbrasil.com>, <skims-canada.com>, <skims-chile.com>, <skims-danmark.com>, <skims-deutschland.com>, <skims-dubai.com>, <skimsespana.com>, <skimsfactoryoutlet.com>, <skims-greece.com>, <skims-hungary.com>, <skimsindia.com>, <skims-ireland.com>, <skimsirelandsale.com>, <skims-italia.com>, <skimsitalia.com>, <skimsmalaysia.com>, <skims-mexico.com>, <skismexico.com>, <skims-norge.com>, <skims-nz.com>, <skims-philippines.com>, <skims-romania.com>, <skimssalestore.com>, <skimssaudiArabia.com>, <skims-schweiz.com>, <skims-singapore.com>, <skims-suomi.com>, <skimsturkey.com>, <skims-turkiye.com>, <skims-uae.com>, <skims-uk.com>, and <skimsusa.com>, be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: January 18, 2024