

ADMINISTRATIVE PANEL DECISION

Mr. Christmas, LLC v. Morgan Willis, Imogen Dale, Morgan Armstrong,
Brooke Turner, Yasmin Price
Case No. D2024-1030

1. The Parties

The Complainant is Mr. Christmas, LLC, United States of America (“United States”), represented by Venable LLP, United States.

The Respondents are Morgan Willis, Imogen Dale, Morgan Armstrong, Brooke Turner, and Yasmin Price, Germany.

2. The Domain Names and Registrar

The disputed domain names <mrchristmasargentina.com>, <mrchristmasaustralia.com>, <mrchristmasbrasil.com>, <mrchristmascanada.com>, <mrchristmaschile.com>, <mrchristmasdeutschland.com>, <mrchristmasitalia.com>, <mrchristmasjapan.com>, <mrchristmasmexico.com>, <mrchristmasportugal.com>, <mrchristmasspain.com>, and <mrchristmasuk.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 March 7, 2024. On March 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 11, 2024, 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 (Registrant Unknown) and contact information in the Complaint.

The Center sent an email communication to the Complainant on March 13, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, 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 and/or that all domain names are under common control. The Complainant filed an amendment to the Complaint on March 18, 2024.

The Center verified that the Complaint together with the amendment to the 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 Respondents of the Complaint, and the proceedings commenced on March 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on April 12, 2024.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on April 23, 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 is a multi-generational family-owned business dedicated to designing unique high-quality pieces. For over 90 years the Complainant has invested substantial resources into establishing its brand. The Complainant owns numerous trademark registrations for the MR. CHRISTMAS trademark, worldwide.

Among other trademark registrations, the Complainant’s trademark portfolio includes the following illustrative registrations:

- United States Trademark Registration No. 804,025 for MR. CHRISTMAS, registered on February 15, 1966, and designating such goods as “Christmas ornaments and decorations of the non-electrical type” in international class 28;
- United States Trademark Registration No. 2,204,701 for MR. CHRISTMAS, registered on November 24, 1998, and designating goods in international classes 11, 20, and 28.

The Complainant operates a website under the domain name <mrchristmas.com> featuring a wide variety of holiday décor for consumers to purchase.

The disputed domain names were all created on December 5, 2023, and resolve to the commercial websites of the similar design that features the MR. CHRISTMAS trademark and photographs of the Complainant’s products. The Respondents’ use of the MR. CHRISTMAS trademark (for example, its presentation on the page and the typeface used) and the overall look and feel of the websites closely resemble the Complainant’s use of the MR. CHRISTMAS trademark and the Complainant’s legitimate website.

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 the following.

Identical or Confusingly Similar

The Complainant contends that the disputed domain names and the MR. CHRISTMAS trademark are confusingly similar.

According to the Complainant's contentions, the disputed domain names are made of the complete incorporation of the Complainant's MR. CHRISTMAS trademark with the addition of a generic geographic indicator such as "Canada", "Australia", "Spain", "Mexico", "Japan", "Deutschland", "Italia", "Argentina", "Chile", "Brasil", "Portugal", and "UK" and with the addition of ".com".

According to the Complainant's contentions, the mere addition of a generic geographic indicator will not preclude the finding of confusing similarity.

No rights or legitimate Interests

The Respondents have no connection with the Complainant or any of its affiliates and have never sought or obtained any trademark registration for the MR. CHRISTMAS trademark. The Complainant does not carry out any activity for, nor have any business with, the Respondents.

The Complainant further contends that the Respondents are not commonly known by the disputed domain names.

The Complainant further asserts that the MR. CHRISTMAS trademark has no meaning other than as reference to the Complainant and the Complainant's goods and services.

The Complainant says that the disputed domain names are used by the Respondents in an attempt to pass itself off as the Complainant.

According to the Complainant's contentions, there is no evidence of noncommercial fair use with the disputed domain names. The Complainant further indicates that the disputed domain names offer for sale counterfeit MR. CHRISTMAS décor. The offering for sale of counterfeit goods supports a finding of bad faith.

Respectively, the Complainant submits that such use of the disputed domain names does not infer any legitimate right or interest over the disputed domain names.

Registered and used in bad faith

The Complainant submits that the Respondents registered and are using the disputed domain names in bad faith.

The Complainant submits that the Respondents registered the disputed domain names at a time when they knew or should have known of the value of the MR. CHRISTMAS trademark.

The Complainant contends that each of the disputed domain names was registered and is being used in bad faith. It claims that the use of the disputed domain names infringes its trademark rights. Further, it maintains that it is apparent from the content of the Respondents' websites that the Respondents are effectively pretending to be the Complainant, when they are not, and that this amounts to bad faith registration and use.

The offering for sale of counterfeit goods also supports a finding of bad faith.

Prior to the filing of the Complaint, the Complainant's representative instructed its private investigator to make a controlled buy from the website at the disputed domain name <mrchristmascanada.com>. The investigator attempted to make a purchase on the website on two separate occasions using two separate methods of payment. In both instances, the investigator's payments failed. Therefore, the Complainant believes that the disputed domain names direct to phishing websites with the aim to obtain personal information.

The Complainant alleges the Respondents' use of the disputed domain names to impersonate the Complainant's business and to perpetrate a phishing scheme directed against the Complainant's customers are strong indications of bad faith.

B. Respondents

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Considering that the Respondents did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following: (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondents have no rights or legitimate interests in respect of the disputed domain names; and (iii) the disputed domain names have been registered and are being used in bad faith.

Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

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.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards the consolidation of multiple Respondents and disputed domain names, it should first be noted that the Respondents share various common Whois contact information (e.g., the registrant information for all five Respondents lists "Bremen" three times followed by "DE", and all the Respondents are using the same email extension "@cxtmail.com"). Second, it should be recognized that all the disputed domain names have been registered through the same Registrar on the same date. Third, all the disputed domain names are composed of the Complainant's trademark together with a geographic indicator. Finally, all the disputed domain names resolve to commercial websites with the similar graphic user interface.

Therefore, it is reasonable to conclude that the disputed domain names are more likely than not subject to common control. [WIPO Overview 3.0](#), section 4.11.2. Further, the Respondents have not objected to the Complainant's request for consolidation.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as the “Respondent”) in a single proceeding.

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. [WIPO Overview 3.0](#), section 1.7.

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 entirety of the mark is reproduced within the disputed domain names. The Panel finds the MR. CHRISTMAS trademark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the MR. CHRISTMAS trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, such as “canada”, “australia”, “spain”, “mexico”, “japan”, “deutschland”, “italia”, “argentina”, “chile”, “brasil”, “portugal”, and “uk”, 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.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domain in this case. [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the MR. CHRISTMAS trademark in which the Complainant has rights.

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 available 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.

Based on the Complainant's contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its MR. CHRISTMAS trademark. The Complainant's trademark registrations for the MR. CHRISTMAS trademark predate the Respondent's registration of the disputed domain names.

Based on the case record, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain names, and there is no similarity or association between the names of the Respondent and the disputed domain names, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#)).

According to the Complainant's assertions, the disputed domain names are being used for the commercial websites through which the counterfeited goods under the Complainant's MR. CHRISTMAS trademark are sold, to which has not been rebutted by the Respondent.

Furthermore, based on investigation made by the Complainant prior to submission of the Complaint, the Complainant alleges that the Respondent has used the disputed domain names in an apparent phishing scheme in which the Respondent passed itself off as the Complainant and solicited sensitive information from Internet users. Panels find that the use of a domain name for illegal activity can never confer rights or legitimate interests on the Respondent. [WIPO Overview 3.0](#), section 2.13.1. In addition, the Panel notes the nature of the disputed domain name carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds that the Respondent's activity – as described by the Complainant and supported by the evidence – does not rise to a bona fide use of the disputed domain names, nor does it meet any of the other criteria set out in the Policy that could show the Respondent's rights or legitimate interests in the disputed domain names. Furthermore, the nature of the disputed domain names, composed of the Complainant's MR. CHRISTMAS trademark plus an additional geographic term, coupled together with the content at the websites found at the disputed domain names clearly illustrate the Respondent's attempt to effectively impersonate the Complainant or suggest the Complainant's sponsorship or endorsement of the disputed domain names, which cannot constitute fair use.

Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy by virtue of having made out an unrebutted prima facie case ([WIPO Overview 3.0](#), section 2.1).

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 Complainant's registration and use of the trademark significantly predates the creation dates of the disputed domain names. Before the Respondents created the disputed domain names, the Complainant's MR. CHRISTMAS trademark was already widely known and directly associated with the Complainant's activities. Panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Given the extensive prior use and fame of the Complainant's MR. CHRISTMAS trademark, in the Panel's view, the Respondents should have been aware of the Complainant's MR. CHRISTMAS trademark when registering the disputed domain names and ultimately, given the composition of the disputed domain names, the use of the Complainant's logo on the websites and sale of goods under the MR. CHRISTMAS

trademark, it is clear that the Respondent was aware of the Complainant and intentionally targeted the Complainant when registering the disputed domain names.

The websites at the disputed domain names have copied many elements from the Complainant's legitimate website including images, the Complainant's trademark and logo, and color scheme, which all contribute to a very similar overall look and feel, which could likely confuse visitors into believing that it is the official website of the Complainant.

In light of the nature of the disputed domain names, comprising the entirety of the Complainant's trademark, and the use of the disputed domain names by the Respondent for websites impersonating that of the Complainant, the Panel is in no doubt that the Respondent had the Complainant and its rights in the MR. CHRISTMAS trademark in mind when it registered the disputed domain names. In the absence of any response by the Respondent, the Panel has no reason to doubt that the Respondent has used its websites to mislead Internet users into believing that the websites at the disputed domain names are operated by or authorized by the Complainant and to deceive customers of the Complainant into disclosing personal information.

Accordingly, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's MR. CHRISTMAS trademark, amounting to registration and use of the disputed domain names in bad faith. Further, the Respondent has apparently sought to illegally collect personal and financial information from Internet users for possible phishing.

Panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit goods, phishing, impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third 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 names <mrchristmasargentina.com>, <mrchristmasaustralia.com>, <mrchristmasbrasil.com>, <mrchristmascanada.com>, <mrchristmaschile.com>, <mrchristmasdeutschland.com>, <mrchristmasitalia.com>, <mrchristmasjapan.com>, <mrchristmasmexico.com>, <mrchristmasportugal.com>, <mrchristmasspain.com>, and <mrchristmasuk.com> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: May 10, 2024