

ADMINISTRATIVE PANEL DECISION

Skims Body, Inc. v. MARLON SCOTT

Case No. D2024-1940

1. The Parties

Complainant is Skims Body, Inc., United States of America (“United States”), represented by Tucker Ellis, LLP, United States.

Respondent is MARLON SCOTT, United States.

2. The Domain Name and Registrar

The disputed domain name <skimsretail.com> (hereinafter “Disputed Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 8, 2024. On May 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 10, 2024, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on May 15, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 15, 2024.

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 Respondent of the Complaint, and the proceedings commenced on May 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 11, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 13, 2024.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on June 19, 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 complaint alleges that Complainant conducts business through the domain <skims.com> and that it owns United States Trademark Registration No. 6,754,965 (registered September 10, 2019) for the trademark SKIMS in standard characters and No. 6,747,497 (registered on September 10, 2019) for the stylized version of the SKIMS mark. Complainant also alleges that it owns several applications pending in the United States Patent and Trademark Office and over 100 trademark registrations outside the United States for trademarks that include “skims” alone or in combination with other words or logos.

The trademark registrations relate to clothing, and undergarments in particular.

The Disputed Domain Name was registered September 14, 2023. Complainant submits copies of a screenshot of the webpage displayed in connection with the Disputed Domain Name (hereinafter “Disputed Webpage”). The Disputed Webpage displays links to “related searches” for “office supplies.” The website also includes a link to “Get This Domain,” which takes the user to a Go Daddy Domain Broker Service that states “We may be able to get the domain for you.”

Complainant has prevailed in at least three prior UDRP cases involving the SKIMS trademark. See *Skims Body, Inc. v. Web Commerce Communications Limited, Client Care*, WIPO Case No. [D2023-4777](#); *Skims Body, Inc. v. 帆 钱*, WIPO Case No. [D2023-0454](#); *Skims Body, Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-2745](#).

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, Complainant contends that “SKIMS is a coined term that has no common, descriptive, or dictionary meaning with respect to retail stores, clothing, and/or retail sales thereof is clear that Respondent is trying to capitalize on the reputation and goodwill inherent in Complainant’s mark.”

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

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 Complainant’s trademark and the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

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 and recognizable within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, “retail,” may bear on assessment of the second and third elements, the Panel finds the addition of this term does not prevent a finding of confusing similarity between the Disputed Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 Respondent may demonstrate rights or legitimate interests in a Disputed Domain Name.

Although the overall burden of proof in UDRP proceedings is on 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 Respondent. As such, where a complainant makes out a prima facie case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on Complainant). If Respondent fails to come forward with such relevant evidence, Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Disputed Domain Name. Respondent has not rebutted Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

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.

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.

The Panel finds that Complainant has proved by a preponderance of the evidence that Respondent registered the Disputed Domain Name in bad faith.

Complainant alleges that the Mark “it seems almost impossible that Respondent chose the subject domain name without reference to Complainant or Complainant’s trademark.”

In addition, Respondent’s addition of the term “retail” is evidence that Respondent knew that “skims” was used as a trademark for the sale of commercial products. Accordingly, The Panel finds that Respondent registered the Disputed Domain Name in bad faith.

Panels have found that the non-use of a domain name 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 Name does not prevent a finding of bad faith in the circumstances of this proceeding. [WIPO Overview 3.0](#), section 3.3. The Panel notes the distinctiveness of Complainant's trademark, and the composition of the Disputed Domain Name – which removes any doubt that Respondent was targeting Complainant, and finds that in the circumstances of this case the passive holding of the Disputed Domain Name does not prevent a finding of bad faith under the Policy.

The Panel finds that 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 Name <skimsretail.com> be transferred to Complainant.

/Lawrence K. Nodine/

Lawrence K. Nodine

Sole Panelist

Date: July 3, 2024