

ADMINISTRATIVE PANEL DECISION

Skims Body, Inc. v. 杨彦鹏 (yangyanpeng)
Case No. D2024-1941

1. The Parties

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

The Respondent is 杨彦鹏 (yangyanpeng), China.

2. The Domain Names and Registrar

The disputed domain names <skimsoutlet.com> and <skimsstores.com> are registered with DNSPod, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed in English 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 names. On May 16, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 20, 2024 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 May 20, 2024.

On May 20, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On May 20, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 English and Chinese of the Complaint, and the proceedings commenced on May 28, 2024. In accordance with the

Rules, paragraph 5, the due date for Response was June 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 18, 2024.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on June 20, 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 the owner of the SKIMS trademarks, which are used by the Complainant in connection with clothing and retail sales of clothing.

The Complainant provides evidence that it owns a portfolio of trademark registrations for the SKIMS mark, including, but not limited to the following marks: the United States trademark registration number 6754965 for the word SKIMS, registered on June 7, 2022, covering goods and services in classes 18, 25, and 35; and the United States trademark registration number 6747497 for the word SKIMS (stylized), registered on May 31, 2022, covering goods and services in classes 18, 25, and 35. The Complainant also has a domain name portfolio with domain names incorporating the SKIMS mark, including its main domain name <skims.com>.

The disputed domain names were registered by the Respondent on the following dates: for <skimsoutlet.com> on April 7, 2024 and for <skimsstores.com> on March 16, 2024. The disputed domain names directed to virtually identical websites in English, including the sign "puhuo001" at the top, and purported to sell various clothing items and related goods for very low prices. However, according to a blog post published on March 7, 2024 on the website "www.malwaretips.com", this store (also hosted on various other domain names) constituted a fraudulent online store operating under the name "Puhuo001", and also according to the blog post, when a customer places an order with the online store, they will receive counterfeit or inferior goods or nothing at all. However, the Panel notes that on the date of this Decision, the disputed domain name <skimsoutlet.com> directs to an error 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 that it is the owner of a number of registered trademarks for SKIMS and that it has a strong reputation for the products under this trademark. The Complainant asserts that the disputed domain names are confusingly similar to the abovementioned trademarks since they incorporate such trademarks fully. The Complainant contends that the Respondent is not licensed by or affiliated with the Complainant in any way. The Complainant also argues that the goal of the websites linked to the disputed domain names is to trick customers into placing orders and sending money and/or sensitive personal information to the Respondent. The Complainant essentially alleges that the abovementioned facts mean that the Respondent has no rights or legitimate interests in the disputed domain names, which, it argues, were registered and are being used in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain names is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the disputed domain names consist of the Complainant's trademark, SKIMS, plus the English words "outlet" and "stores"; the fact that the webpages linked to the disputed domain names are in English and that the currency for the products advertised on the webpages hosted at the disputed domain names is the U.S. dollar, so that the Respondent seems to have knowledge of the English language and so that English as the language of this proceeding will not prejudice the Respondent.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

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.

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 entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are 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, respectively "outlet", and "stores" may bear on the 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 disputed domain names.

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 domain names 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.

Moreover, upon review of the facts and evidence, the Panel notes that the Respondent has not provided any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services. Instead, upon review of the facts and the evidence submitted in this proceeding, the Panel notes that the disputed domain names directed to active websites which showed a clear intent on the part of the Respondent to either misleadingly sell third party products of unclear origin to unsuspecting Internet users, or even to commit fraud or theft of personal information or phishing. Given the abovementioned elements, the Panel concludes that the Respondent’s use does not constitute a bona fide offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain names.

However, the Panel notes that on the date of this Decision, the disputed domain name <skimsoutlet.com> directs to an error webpage. In this regard, the Panel finds that holding a domain name passively, without making any use of it, also does not confer any rights or legitimate interests in that disputed domain name on the Respondent in the circumstances of this case (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#); and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (Jun Cui)*, WIPO Case No. [D2021-1685](#)).

Finally, the Panel also finds that the nature of the disputed domain names, being confusingly similar to the Complainant’s trademarks and consisting of such marks combined with additional descriptive words suggesting online stores for products branded with such marks, such as “stores” and “outlet”, carries a risk of implied affiliation and cannot constitute fair use, as it effectively impersonates the Complainant and its products or suggests sponsorship or endorsement by the Complainant (see [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.

Given the intensive use and distinctiveness of the Complainant’s prior registered trademarks, the Panel finds that the subsequent registration of the disputed domain names, which are confusingly similar to such marks, clearly and consciously targeted the Complainant’s prior registered trademarks (the Panel notes that panels have recognized the Complainant’s rights in these trademarks in earlier decisions applying the Policy, such as *Skims Body, Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-2745](#)). The Panel therefore deducts from the Respondent’s efforts to target the Complainant’s prior trademarks that the Respondent knew or should have known of the existence of the Complainant’s trademarks at the time of registering the disputed domain names, which has demonstrated that the Respondent registered the disputed domain names in bad faith.

As to use of the disputed domain names in bad faith, the Complainant provides evidence that the disputed domain names directed to active websites which showed a clear intent on the part of the Respondent to either misleadingly sell third party products of unclear origin to unsuspecting Internet users, or even to commit fraud or theft of personal information or phishing. The Panel concludes from these facts that the Respondent was intentionally attracting Internet users for commercial gain to such websites, by creating consumer confusion between the websites associated with the disputed domain names and the Complainant's trademarks. This constitutes direct evidence of the Respondent's bad faith under paragraph 4(b)(iv) of the Policy. The Panel therefore finds that it has been demonstrated that the Respondent has used, and is using the disputed domain names in bad faith.

However, the Panel notes that on the date of this Decision, the disputed domain name <skimsoutlet.com> directs to an error webpage. 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 this disputed domain name 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 and reputation of the Complainant's trademarks, the composition of the disputed domain name <skimsoutlet.com>, and the prior misleading and other unlawful use, and also considers the unlikelihood of any future good faith use of the disputed domain name <skimsoutlet.com> by the Respondent considering the composition of the disputed domain name makes it clear that the Complainant's mark is being targeted and finds that in the circumstances of this case the passive holding of the disputed domain name <skimsoutlet.com> does not prevent a finding of 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 <skimsoutlet.com> and <skimsstores.com> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: June 30, 2024