

ADMINISTRATIVE PANEL DECISION

S. TOUS, S.L. v. Client Care, Web Commerce Communications Limited
Case No. D2024-2120

1. The Parties

The Complainant is S. TOUS, S.L., Spain, represented by Baylos 5.0 Legal Advisors, S.L., Spain.

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

2. The Domain Names and Registrar

The disputed domain names <tous-argentina.com>, <tous-australia.com>, <touschile.com>, <tous-colombia.com>, <tous-greece.com>, <toushungary.com>, <tous-ireland.com>, <tousisrael.com>, <tous-italia.com>, <tousitalia.com>, <tousjewelryfrance.com>, <tous-mexico.com>, <tous-nz.com>, <tousoutletportugal.com>, <tousoutletusa.com>, <touspolska.com>, <toususashop.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 May 23, 2024. On May 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 24, 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 (UNKNOWN) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 24, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaints 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 amended Complaint on May 28, 2024, requesting to partially withdraw the Complaint and only proceed with the disputed domain names registered with the Respondent.

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 May 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 21, 2024.

The Center appointed Tommaso La Scala as the sole panelist in this matter on June 25, 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 well-known Spanish company located in Barcelona, which manufactures and sells jewelry and fashion accessories since 1920.

The Complainant runs over 700 stores in 54 Countries worldwide and owns many trademarks around the world, including the followings covering Malaysia (where the Respondent is located):

- Malaysia trademark no. 3007805MY, TOUS, registered on February 7, 2006
- Malaysia trademark no. 3007806MY, TOUS, registered on February 17, 2006
- Malaysia trademark no. 3007807MY, TOUS, registered on July 18, 2006
- Malaysia trademark no. 3007808MY, TOUS, registered on July 5, 2006
- European Union trademark no. 018706106, TOUS, registered on December 6, 2022

The Complainant is also the owner of several domain names including the designation trademark TOUS, such as the domain name <tous.com>.

The disputed domain names were registered between December 2023 and January 2024, and they resolve to inactive websites.

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.

The Complainant affirms that the disputed domain names are identical or highly confusingly similar to the Complainant's TOUS trademark, as they reproduce it in its entirety, with the mere addition of geographical and/or descriptive terms (e.g., "Israel", "outlet", "jewelry", "France", etc.).

The Complainant submits that the Respondent is neither a licensee of the Complainant nor is it affiliated with the Complainant in any way. The Complainant says that it has not authorized the Respondent to make any use of its TOUS trademark. Lastly, the Complainant says that there is no evidence to suggest that the Respondent is commonly known by the disputed domain names, as intended under paragraph 4(c)(ii) of the Policy.

Furthermore, the Complainant asserts that the Respondent registered and used the disputed domain names in bad faith, as - taking into account the worldwide fame of the Complainant's TOUS mark - there is no chance of the disputed domain names having been registered by the Respondent by simple coincidence. Furthermore, whilst the disputed domain names resolve to inactive webpages, under the doctrine of passive holding the Respondent's bad faith remains unchanged.

The Complainant requests that the disputed domain names be transferred from the Respondent to the Complainant.

B. Respondent

The Respondent did not reply to the 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 the 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.

Based on the available record, the Panel finds the Complainant has shown rights in respect of its TOUS trademark for the purposes of the Policy; see the [WIPO Overview 3.0](#), section 1.2.1.

As a technical requirement of registration, the generic Top-Level Domain ("gTLD"), that is ".com" in the case of the disputed domain names, is usually disregarded when assessing confusing similarity. see the [WIPO Overview 3.0](#), section 1.11.1.

The Complainant's TOUS mark is reproduced in its entirety within the disputed domain names and is clearly recognizable in them. In these circumstances, the addition of geographic and/or descriptive words (e.g., "Israel", "outlet", "jewelry", "shop", "France", etc.) does not prevent a finding of confusing similarity between the disputed domain names and the Complainant's mark for the purposes of the Policy, see the [WIPO Overview 3.0](#), section 1.8.

For the above reasons, based on the available record, the Panel finds that 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.

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 finds that the Respondent had the TOUS trademark in mind while registering the disputed domain names, as they exactly reproduce the trademark TOUS, with one of the disputed domain names also including the term “jewelry” (the Complainant’s area of business). Accordingly, the Panel finds the Respondent registered the disputed domain names with the Complainant in mind.

Moreover, the Respondent has not offered an explanation for registering several domain names incorporating the TOUS trademark with the addition of geographical /descriptive terms such as “jewelry”, unless there was an intention to create a likelihood of confusion between the disputed domain names and the TOUS trademark from which the Respondent would likely benefit. Therefore, the Panel finds the passive holding of the disputed domain names does not prevent a finding bad faith.

For the above reasons, based on the available record, the Panel finds that 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 <tous-argentina.com>, <tous-australia.com>, <touschile.com>, <tous-colombia.com>, <tous-greece.com>, <toushungary.com>, <tous-ireland.com>, <tousisrael.com>, <tous-italia.com>, <tousitalia.com>, <tousjewelryfrance.com>, <tous-mexico.com>, <tous-nz.com>, <tousoutletportugal.com>, <tousoutletusa.com>, <touspolska.com>, and<toususashop.com> be transferred to the Complainant.

/Tommaso La Scala/

Tommaso La Scala

Sole Panelist

Date: July 5, 2024