

ADMINISTRATIVE PANEL DECISION

S. Tous, S.L. v. Zhang Fei, na
Case No. D2024-2176

1. The Parties

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

The Respondent is Zhang Fei, na, China.

2. The Domain Names and Registrar

The disputed domain names <tousbelgie.com>, <touscanadashop.com>, <tousdenmark.com>, <tousegypteg.com>, <tousksa.com>, <tousnl.com>, <tousoutletonline.com>, <tousportugal.com>, <tousturkiye.com>, <tousuae.com>, and <toususaoutlet.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 28, 2024. On May 31, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 3, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 Respondent of the Complaint, and the proceedings commenced on June 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 25, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 26, 2024.

The Center appointed Assen Alexiev as the sole panelist in this matter on July 9, 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 jewelry, accessories and fashion retailer founded in 1920 in Spain. It has over 700 stores in 54 countries around the world in cities such as New York, United States of America, Mexico City, Mexico, and Tokyo, Japan.

The Complainant is the owner of the following trademark registrations for TOUS (the “TOUS trademark”):

- the International trademark TOUS with registration No. 682707, registered on October 13, 1997 for goods in International Class 14 in multiple jurisdictions, including China, where the Respondent is located;
- the European Union trademark TOUS with registration No. 000011882, registered on August 14, 1998 for goods and services in International Classes 6, 14 and 35;
- the International trademark TOUS with registration No. 737052, registered on July 6, 2000 for goods in International Classes 3, 9, 18 and 25 in multiple jurisdictions, including China, where the Respondent is located; and
- the European Union trademark TOUS with registration No. 001450600, registered on February 7, 2001 for goods in International Classes 3, 9 and 18.

The Complainant is also the owner of the domain name <tous.com> registered on August 4, 1997, which resolves to its official website.

The details about the dates of registration of the disputed domain names and their use are the following:

Disputed domain name	Date of registration	Use at the time of filing of the Complaint	Current use
<tousbelgie.com>	December 9, 2023	inactive	inactive
<tousegypteg.com>	December 9, 2023	inactive	inactive
<tousuae.com>	December 9, 2023	inactive	inactive
<tousnl.com>	December 9, 2023	inactive	inactive
<tousksa.com>	December 9, 2023	inactive	inactive
<tousdenmark.com>	December 10, 2023	inactive	inactive
<touscanadashop.com>	January 5, 2024	resolved to a website that copied the design of the Complainant's website and offered products under the TOUS trademark	inactive
<toususaoutlet.com>	January 5, 2024	inactive	inactive
<tousportugal.com>	January 5, 2024	resolved to a website that copied the design of the Complainant's website and offered products under the TOUS trademark	inactive
<tousturkiye.com>	January 5, 2024	resolved to a website that copied the design of the Complainant's website and offered products under the TOUS trademark	inactive
<tousoutletonline.com>	January 5, 2024	inactive	inactive

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 states that the disputed domain names are confusingly similar to its TOUS trademark, because they all include it in combination with geographic terms or dictionary words. According to the Complainant, this may lead consumers to believe that the disputed domain names are used by the Complainant in each of the countries, whose names are included in the disputed domain names.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain names, because the Complainant has not authorized it to use the TOUS trademark and the Respondent does not use them for a bona fide purpose and does not carry out a legitimate noncommercial use of them, but intentionally creates confusion in Internet users, making them believe that the disputed domain names belong to the Complainant or are connected to it.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. According to it, the registration of the disputed domain names is an attempt by the Respondent to gain an unfair benefit from the Complainant's reputation.

The Complainant notes that three of the disputed domain names (<touscanadashop.com>, <tousportugal.com>, and <tousturkiye.com>) resolve to websites that copy the website of the Complainant, using the TOUS trademark and marketing goods identical to those of the Complainant, while the other disputed domain names (<tousbelgie.com>, <tousdenmark.com>, <tousegypteg.com>, <tousksa.com>, <tousnl.com>, <tousoutletonline.com>, <tousuae.com>, and <toususaoutlet.com>) are inactive.

According to the Complainant, the similarity between the websites at the disputed domain names <touscanadashop.com>, <tousportugal.com>, and <tousturkiye.com> is not a coincidence, but shows the Respondent's intention to take unfair advantage of the reputation achieved by the Complainant in the jewelry and fashion sector. The Complainant concludes that using these disputed domain names, the Respondent intentionally attempts to attract for commercial gain, Internet users to the websites at these disputed domain names by producing a likelihood of confusion with the Complainant's TOUS trademark as to the source, sponsorship, affiliation, or endorsement of the websites at the disputed domain names or of the products on the websites at the disputed domain names.

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.

The Complainant has shown rights in respect of the TOUS trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

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

Although the addition of other terms (here, “Belgie” – a simplified spelling of “België”, the Dutch name of Belgium, “Canada”, “Denmark”, “Egypt”, “EG” - the ISO 3166-1 alpha-2 code of Egypt, “KSA” – the abbreviation for the “Kingdom of Saudi Arabia”, “NL” – the abbreviation for “The Netherlands (Kingdom of the)”, “outlet”, “online”, “Portugal”, “Turkiye” – a simplified spelling of “Türkiye”, “UAE” – the abbreviation for the “United Arab Emirates”, and “USA” – the abbreviation for the “United States of America”) 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 TOUS trademark 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 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.

As noted in section 2.5.1 of the [WIPO Overview 3.0](#), where a domain name consists of a trademark plus an additional term (at the second- or top-level), 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. Certain geographic terms (e.g., <trademark-usa.com>, or <trademark.nyc>), or terms with an “inherent Internet connotation” (e.g., <e-trademark.com>, <buy-trademark.com>, or <trademark.online>) are seen as tending to suggest sponsorship or endorsement by the trademark owner. All of the disputed domain names fall in this category.

The evidence submitted by the Complainant shows that the disputed domain names <touscanadashop.com>, <tousportugal.com>, and <tousturkiye.com> have been used for websites that appeared as localized versions of the Complainant’s official website for Canada, Portugal, and Türkiye, as they completely copied its design, prominently featured the TOUS trademark and purportedly offered goods under the same trademark, without any mention that these websites were not affiliated to the Complainant. The use of these disputed domain names cannot be regarded as being in compliance with the Oki Data requirements (see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), and section 2.8 of the [WIPO Overview 3.0](#)), as the Respondent did not accurately and prominently disclose its lack of relationship with the Complainant, who is the holder of the TOUS trademark. Therefore, there is no basis for a finding that the Respondent has rights or legitimate interests in the disputed domain names <touscanadashop.com>, <tousportugal.com>, and <tousturkiye.com>.

In view of the above and the fact that the Respondent has failed to provide any plausible explanation why it has registered the other eight disputed domain names (<tousbelgie.com>, <tousdenmark.com>, <tousegypteg.com>, <tousksa.com>, <tousnl.com>, <tousoutletonline.com>, <tousuae.com>, and <toususaoutlet.com>) and how it intends to use them, the Panel accepts as more likely than not that the Respondent has targeted the Complainant with their registration as part of the same attempt to receive commercial gain or advantage. Such conduct cannot give rise to rights or legitimate interests in the disputed domain names.

Also, the Respondent, having registered within less than a month 11 domain names that follow the same naming pattern with the “.com” generic Top-Level Domain (“gTLD”) and are all confusingly similar to the TOUS trademark, appears to have tried to “corner the market” in domain names that reflect the same trademark.

The Panel therefore finds that 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.

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 within a short period of time the Respondent registered all of the disputed domain names, and this happened 25 years after the Complainant first registered its TOUS trademark, including in China, where the Respondent is located. All of them follow a practically identical naming pattern combining the TOUS trademark with geographic terms or dictionary words, which make them appear as the online locations of the Complainant for the respective territories. This suggests that all disputed domain names are part of the same plan.

Three of the disputed domain names (<touscanadashop.com>, <tousportugal.com>, and <tousturkiye.com>) have resolved to identical websites that copied the design of the Complainant’s official website, prominently featured the TOUS trademark and purportedly offered goods branded with it using images from the Complainant’s website, without disclosing the lack of relationship with the Complainant. This supports a finding that the Respondent is well aware of the Complainant’s TOUS trademark and its business, and that it has registered these three disputed domain names and activated the associated websites targeting the TOUS trademark in an intentional attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the TOUS trademark as to the affiliation of the disputed domain names and of the associated websites.

In the lack of any allegation and evidence to the contrary, it also seems justified to accept that the Respondent’s intent in registering the other eight disputed domain names (<tousbelgie.com>, <tousdenmark.com>, <tousegypteg.com>, <tousksa.com>, <tousnl.com>, <tousoutletonline.com>, <tousuae.com>, and <toususaoutlet.com>) must have been the same, although they have not been activated at the time of filing the Complaint, and that the Respondent has engaged in a pattern of bad faith registration and use of domain names targeting the Complainant. In light of this, and taking into account the established precedent under the Policy that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see [WIPO Overview 3.0](#), section 3.3), the Panel finds that in the circumstances of this case the passive holding of eight of the disputed domain names does not prevent a finding of bad faith under the Policy.

The Panel therefore 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 <tousbelgie.com>, <touscanadashop.com>, <tousdenmark.com>, <tousegypteg.com>, <tousksa.com>, <tousnl.com>, <tousoutletonline.com>, <tousportugal.com>, <tousturkiye.com>, <tousuae.com>, and <toususaoutlet.com> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: July 22, 2024