

ADMINISTRATIVE PANEL DECISION

Skinny Tan Pty Ltd v. Theresa W Chavez

Case No. D2024-2591

1. The Parties

Complainant is Skinny Tan Pty Ltd, Australia, represented by Ashfords LLP, United Kingdom.

Respondent is Theresa W Chavez, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <skinnytan.shop> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 25, 2024. On June 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 26, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to Complainant on July 1, 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 July 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 July 16, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was August 5, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 12, 2024.

The Center appointed Stephanie G. Hartung, Steven A. Maier and Marina Perraki as panelists in this matter on September 11, 2024. The Panel finds that it was properly constituted. Each member of 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

Complainant is a company organized under the laws of Australia that is active in the skincare and tanning products industry.

Complainant has provided evidence that it is the registered owner of several trademarks relating to its company name and brand SKINNY TAN, including, but not limited to, the following:

- word mark SKINNY TAN, United States Patent and Trademark Office (USPTO), registration number: 5488651, registration date: June 12, 2018, status: active;
- word Mark SKINNY TAN, European Union Intellectual Property Office (EUIPO), registration number: 1155361, registration date: February 4, 2013, status: active.

Moreover, Complainant has evidenced its ownership since April 11, 2012 of the domain name <skinnytan.co.uk>, which resolves to Complainant's main website at "www.skinnytan.co.uk" through which Complainant promotes and offers its skincare and tanning products internationally.

Respondent, according to the disclosed Whois information for the disputed domain name, is located in the United States. The disputed domain name was registered on March 3, 2024. By the time of the rendering of this decision, the website under the disputed domain name has been suspended at the request of Complainant. The latter, however, has demonstrated that, at some point before the filing of the Complaint, the disputed domain name resolved to a website at "www.skinnytan.shop", which was set up as a "look-alike" website, copying substantial parts (including copyright protected product images) of Complainant's official website and displaying Complainant's SKINNY TAN trademark and official logo, thereby purporting to offer Complainant's skincare and tanning products, although with no authorization to do so. Moreover, Complainant has shown to have undertaken several trap purchases through Respondent's website under the disputed domain name, all of which failed.

Complainant requests that the disputed domain name be transferred to Complainant.

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 its SKINNY TAN trademark was originally pitched in 2012 on the well-known TV program Dragon's Den, and that it has developed ever since into a global brand offering high-performance skincare and tanning products with over 20,000 five-star reviews and millions of global customers.

Complainant submits that the disputed domain name is identical to Complainant's SKINNY TAN trademark, as it incorporates the entirety of the latter, simply adding the Top-Level Domain ("TLD") ".shop". Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Respondent has not been given any permission to use Complainant's SKINNY TAN trademark, and it is neither sponsored by nor affiliated with Complainant in any way, (2) the website to which the disputed domain name resolved at some point before the filing of the Complaint was designed to look like it might be owned by and/or operated and/or authorized and/or otherwise economically connected to Complainant, thereby displaying Complainant's SKINNY TAN trademark as well as copyright protected images lifted directly from Complainant's website, and, thus, enhancing the legitimate appearance of such website in order to misrepresent that Respondent had been authorized by Complainant to operate that

website, and (3) Respondent was not offering an official and authorized sale of products via its website, but rather attempted to make unauthorized sales of goods (counterfeit or otherwise), or to operate a scam website trying to obtain money, card details and other financial or personal data from Complainant's potential customers. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) Respondent has not been given any permission to use Complainant's SKINNY TAN trademark, and it is neither sponsored by nor affiliated with Complainant in any way, (2) the website to which the disputed domain name resolved at some point before the filing of the Complaint displayed images that infringe the copyright of Complainant as they were direct copies of images from Complainant's official website, and (3) the various Terms & Conditions and Privacy policies displayed on that website failed to identify the entity behind the disputed domain name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

A. Identical or Confusingly Similar

First, it is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for identity/confusing similarity involves a reasoned, but relatively straightforward comparison between Complainant's SKINNY TAN 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 its SKINNY TAN trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Moreover, the disputed domain name incorporates the SKINNY TAN trademark entirely and exclusively, with no alterations or additions whatsoever. Accordingly, the disputed domain name is identical to Complainant's SKINNY TAN trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Finally, given that the applicable TLD as such is usually disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1), the inclusion of the generic TLD ".shop" in the disputed domain name does not alter the finding of identity in the case at hand.

The Panel, therefore, holds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Second, 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 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 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.

In particular, Respondent has neither been granted a license nor has it been otherwise authorized by Complainant to use its SKINNY TAN trademark, either as a domain name or in any other way. Also, there is no reason to believe that Respondent’s name somehow corresponds with the disputed domain name, and Respondent does not appear to have any trademark rights associated with the term “skinny tan” on its own. Finally, the disputed domain name resolved at some point in the past to a website at “www.skinnytanshop.com”, which was set up as a “look-a-like” website, copying substantial parts (including copyright protected images) of Complainant’s official website and displaying Complainant’s SKINNY TAN trademark and official logo, thereby purporting to offer Complainant’s skincare and tanning products with no authorization to do so; moreover, several trap purchases undertaken by Complainant through Respondent’s website under the disputed domain name all failed, which corroborates the fraudulent nature of Respondent’s website. Such use of the disputed domain name, therefore, neither qualifies as bona fide nor as legitimate noncommercial or fair within the meaning of paragraph 4(c) of the Policy, not even so under the so-called Oki Data principles which would indeed have required Respondent e.g. to accurately and prominently disclose on such website the non-existent relationship between Respondent and Complainant as the SKINNY TAN trademark holder, which Respondent apparently did not as the various Terms & Conditions and Privacy policies displayed on that website undisputedly failed to identify the entity behind the disputed domain name. In this context, panels have also long held that the use of a domain name for illegal activity (here: Complainant’s impersonation/passing-off) can never confer rights or legitimate interests on a respondent: [WIPO Overview 3.0](#), section 2.13.1.

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

C. Registered and Used in Bad Faith

Third, 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 circumstances of this case leave no doubt that Respondent was fully aware of Complainant’s business in the skincare and tanning products industry and its rights in the SKINNY TAN trademark when registering the disputed domain name and that the latter clearly is directed thereto. Moreover, using the disputed domain name to run a website set up as a “look-alike” website, by e.g. copying substantial parts (including copyright protected images) of Complainant’s official website and displaying Complainant’s SKINNY TAN trademark and official logo, thereby purporting to offer Complainant’s skincare and tanning products with no authorization to do so and, thus, inducing Internet users into some apparently illegal online business, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with Complainant’s SKINNY TAN trademark as to the source, sponsorship, affiliation or endorsement of Respondent’s website. Such circumstances are evidence of registration and use of the disputed domain names in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. In this context, panels have also long held that the use of a domain name for illegal activity (here: Complainant’s impersonation/passing-off) constitutes bad faith: [WIPO Overview 3.0](#), section 3.4.

Finally, it also carries weight in the eyes of the Panel that Respondent obviously provided false or incomplete contact information (e.g. a bad address) in the Whois register for the disputed domain name. This fact at least throws a light on Respondent's behavior which supports the Panel's bad faith finding.

The Panel, therefore, holds 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, <skinnytan.shop>, be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Presiding Panelist

/Steven A. Maier/

Steven A. Maier

Panelist

/Marina Perraki/

Marina Perraki

Panelist

Date: September 19, 2024