

Decision for dispute CAC-UDRP-105810

Case number	CAC-UDRP-105810
Time of filing	2023-10-26 11:34:41
Domain names	<p>salestommyhilfiger.com, tommyhilfigerchiletiendas.com, tommychile.com, tommyhilfigerenmexico.com, tommyhilfigercanadaonline.com, tommyhilfigerparis.com, tommyhilfiger-ireland.com, tommyhilfigerpolskaoutlet.com, tommyhilfigercanada.com, tommyhilfiger-gr.com, tommyhilfigeroutletscanada.com, tommyhilfigerturkiyeonline.com, tommyhilfiger-italia.com, tommyhilfigeroutlethungary.com, tommyhilfigersfinland.com, tommyhilfigeroutletaustria.com, tommyhilfigerphilippine.com, tommyhilfigercanadaca.com, tommyhilfigeronlinestores.com, tommyhilfigerfinland.com, tommyhilfigers-gr.com, tommyhilfigerstoreph.com, tommyhilfigeraustraliaonline.com, tommyhilfigersalenz.com, tommyhilfigergrandindonesia.com, tommyjeanssingapore.com, tommyhilfigerthailand.com, tommyhilfigerfactoryoutlet.com, tommyhilfigeruaedubai.com, tommyhilfigerukwebsite.com, tommyhilfigerisrael.com, tommyhilfigerpuertorico.com, tommy-hilfiger-ksa.com, tommy-hilfiger-thailand.com, tommyhilfigerperth.com, tommy-hilfiger-ireland.com, tommyhilfiger-uruguay.com, tommyhilfigermonterrey.com, storetommyhilfiger.com, tommyjeansperu.com, tommyhilfigeril.com, tommyhilfigeroutletfrance.com, tommyhilfigerit.com, tommyhilfigerzurich.com, tommyhilfigersuisse.com, tommyhilfigerptonline.com, tommyhilfigerlojas.com, tommyhilfigermedellin.com, tiendastommyhilfigercostarica.com, tommyhilfigerhelsinki.com, tommyhilfigeraltopalermo.com, tommyhilfigergreek.com, tommyhilfigercl.com, tommyhilfigerhr.com, tommyhilfigeruaeonline.com, tommyhilfigeregyp.com, tommyhilfigerksa.com, tiendastommyhilfigermadrid.com, tommyhilfigeramsterdam.com, tommyhilfigerwinkels.com, tommyhilfigerstoreberlin.com, tommyhilfigerwien.com, tommyhilfiger-sk.com, tommyhilfigernloutlet.com, tommyjeansgreece.com, tommyhilfiger-pt.com, tommyhilfigerbarcelona.com, tommychileoutlet.com, tommyhilfigerdk.com, tommyhilfigelromania.com, tommyhilfigelturkiye.com, tommyhilfigeroutletberlin.com, tommy-hilfiger-schweiz.com, codepromotommyhilfiger.com, tommy-hilfiger-italia.com, tommyhilfigereshop.com, tommyoutletaustria.com, tommyhilfigersi.com, tommyhilfigersrbijaonline.com, tommyhilfigerucuz.com, tommyhilfigerdubai.com, tommyhilfigergreeceeshop.com, tommyhilfigerquito.com</p>

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Tommy Hilfiger Licensing B.V.
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Complainant representative

Organization	Coöperatie SNB-REACT U.A.
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Defendants

respondents

Organization	Client Care (Web Commerce Communications Limited)
Name	Monika Lehmann
Name	Ulrike Hueber
Name	Sonya Hawkins
Name	Rick Harrington
Name	Giovanni Gutierrez
Name	Heather Hnatiuk
Name	Santy Ardini
Name	Michele Myskow
Name	Wendy Truong
Name	Leopold Palad
Name	Karan Mehta
Name	Leonie Holzman
Name	Jonas Glockner
Name	Luca Kunze
Name	Monika Freud
Name	Annett Neudorf
Name	Max Frey
Name	Patrick Keller
Name	Stephanie Frueh
Name	Jens Bosch
Name	Stefan Schweizer
Name	Chidi Chima
Name	Alexandre Daneau
Name	Abishek Gopal
Name	Susan Embrose
Name	Annicka Hatch
Name	Tyler Russell
Name	Cheryl Solomon
Name	Mei Chen
Name	Jessica Andregg

Name	Danny Nunez
Name	Rania Sabty
Name	Colleen Kirkham
Name	Ralph Foerst
Name	Euisik Gong
Organization	Joseph Graham (Joseph Graham)

OTHER LEGAL PROCEEDINGS

The Panel while conducting its limited independent research discovered that some of the disputed domain names on the date of this decision resolve to a web page that contains information about legal proceedings in the US and the following message:

"Plaintiffs have charged Defendants with violations of United States federal and state laws prohibiting trademark infringement and counterfeiting".

It therefore possible that there is a legal proceeding in the US in respect of some of the disputed domain names.

Under par. 18 (a) of the UDRP Rules the Panel in the event of any legal proceedings initiated prior to or during an administrative proceeding has a discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.

The Panel decides to proceed to a decision as it finds that any possible pending legal proceeding does not affect its own analysis of this case.

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

In this proceeding the Complainant relies on the various trademark registrations "TOMMY HILFIGER", "TOMMY", "HILFIGER" and "TOMMY JEANS" including the following valid registrations:

- Benelux trademark registration No. 587912 "TOMMY HILFIGER" (word), registered on December 01, 1996;
- EU trademark registration No. 000131706 "TOMMY HILFIGER" (word), registered on October 16, 1998;
- UK trademark registration No. UK00900131706 "TOMMY HILFIGER" (word), registered on October 16, 1998;
- International Trademark registration under the Madrid System No.1270616 "TOMMY HILFIGER" (word), registered on July 29, 2015, protected *inter alia* in the following jurisdictions: Algeria, Armenia, Azerbaijan, Egypt, Georgia, Iceland, Iran, Japan, Mongolia, Norway, Philippines, Korea, Turkey, Ukraine and Singapore;
- EU trademark registration No. 018093680 "TOMMY" (word), registered on December 21, 2019;
- UK trademark registration No. UK00002292693 "TOMMY" (word), registered on July 29, 2005;
- International Trademark registration under the Madrid System No. 1170031 "HILFIGER" (word), registered on November 7, 2012, protected in Russia, Norway and Switzerland;
- EU trademark registration No. 10451383 "HILFIGER" (word), registered on May 2, 2012;
- UK trademark registration No. UK00001300553 "HILFIGER" (word), registered on May 12, 1989;
- EU trademark registration No. 001233923 "TOMMY JEANS" (word), registered on October 31, 2005;
- International Trademark registration under the Madrid System No.1393619 "TOMMY JEANS" (word), registered on August 28, 2017, protected *inter alia* in Albania, Australia, Bahrain, Egypt, Iceland, Montenegro, Morocco, Israel, Korea, Serbia, Switzerland and Ukraine;
- UK trademark registration No. UK00801225683 "TOMMY HILFIGER" (word + flag picture), registered on October 06, 2015;
- EU trademark registration No. 1225683 "TOMMY HILFIGER" (word + flag picture), registered on May 16, 2014;
- International Trademark registration under the Madrid System No. 1243929 "TOMMY HILFIGER" (word + flag picture), registered on April 28, 2014, protected in China and Japan;
- EU trademark registration No. 000131631 "TOMMY HILFIGER" (word + flag picture), registered on October 16, 1998.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Consolidation: The Complainant requests to consolidate this dispute in respect of all 84 disputed domain names since, in its opinion, the disputed domain names are owned or under the effective control of a single person or entity, or a group of individuals acting in concert.

THE DISPUTED DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant states that it is a leading global corporation that designs, sources, distributes, sells, and markets fashion apparel, accessories, and other goods throughout the world, among others, under the trademarks “TOMMY HILFIGER”, “TOMMY”, “TOMMY JEANS” and “HILFIGER” and it started its operations in 1985.

The Complainant claims its “TOMMY HILFIGER” brand was ranked as the world’s 75th most valuable brand with brand value at USD 1 billion according to the ranking in the “Most Valuable Fashion Brands” 2020 (<https://fashionunited.com/i/most-valuable-fashion-brands>).

The Complainant refers to its various trademarks, including the marks provided above, that include “TOMMY HILFIGER”, “TOMMY”, “TOMMY JEANS” and “HILFIGER”.

The Complainant refers to previous UDRP decisions where its trademarks were considered “well-known”.

The Complainant contends that the disputed domain names are confusingly similar to its trademarks since all of them incorporate one of Complainant’s well-known “TOMMY HILFIGER”, “TOMMY” or “HILFIGER” trademark(s) in their entirety and additional elements do not affect confusing similarity. The additional elements in the disputed domain names are either geographical terms (including acronyms or short terms), e.g. Uruguay, Suisse, UK, Srbija, SI (short for “Slovenia”), etc. or generic (descriptive) elements such as “outlet” and “store” and they do not affect confusing similarity. The Complainant cites some previous UDRP decisions on confusing similarity.

Thus, the Complainant contends the disputed domain names are confusingly similar to the Complainant’s trademarks.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

The Complainant asserts that it has no relationship whatsoever with the Respondent and has never licensed or otherwise authorized the Respondent to use the well-known “TOMMY HILFIGER”, “TOMMY” and “HILFIGER” trademarks on the websites or in the disputed domain names. The Complainant has exclusive trademark rights which predate the registration of the disputed domain names.

The Respondent cannot demonstrate any legitimate offering of goods or services under the trademarks. All 84 (eighty-four) disputed domain names were registered between November of 2021 and June of 2023.

The Respondent cannot demonstrate any legitimate offering of goods or services in this case. In the absence of a license or permission from the Complainant, no actual or contemplated bona fide or legitimate use of the disputed domain names can reasonably be claimed.

There is no credible evidence that the Respondent is commonly known by the disputed domain names.

The Complainant alleges that the Respondent is not making any noncommercial or fair use of the disputed domain names in the circumstances of this dispute.

In particular, the Complainant claims that the disputed domain names have been and are being used to offer multiple goods for sale. Since the use made of the websites by the disputed domain names to offer goods for sale to consumers is clearly commercial, it cannot be considered a legitimate non-commercial or fair use.

The Complainant notes that a Respondent’s use of a domain name will not be considered “Fair” if it falsely suggests affiliation with the trademark owner and this is the case in the present dispute.

The Respondent registered 84 disputed domain names that incorporate Complainant’s Trademark(s) in its entirety, with the addition of a geographical term or a generic word that is related to Complainant’s business. The Respondent has registered and used the disputed domain names for the purpose of passing itself off as being (connected with) the Complainant by prominently featuring one of Complainant’s Trademarks at the top of every page, on each of its substantially identical websites in connection with the sale of clothing.

Confusion is heightened by the prominent use of Complainant’s Trademarks on every page of the 84 disputed domain names, thereby suggesting a commercial relation with the Complainant where none exists.

The Respondent also displays similar text messages such as the ones displayed at the top of Complainant’s own website.

Furthermore, the Respondent placed a false and misleading copyright notice in the footer of all disputed domain names, claiming it owns copyrights in the content/products offered on the websites (for example: “Copyright © 2023 tommyoutletaustalia Powered By tommyoutletaustalia.com”).

The Complainant also alleges that the Respondent fails to comply with the “Oki Data Test” criteria and par. 2.8.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), namely “accurately and prominently disclose the registrant’s relationship with the trademark holder”.

While some of the disputed domain names are inactive at the time of filing this Complaint, the Complainant has made a prima facie case that the currently inactive domain names have not been used in a manner which confers any rights or legitimate interests on the

Respondent. The disputed domain names were used to impersonate the Complainant and impersonation does not create rights or legitimate interest.

THE DISPUTED DOMAIN NAMES WERE REGISTERED AND BEING USED IN BAD FAITH

The Complainant's submissions on the bad faith element of the Policy can be summarized as follows:

1. The Respondent has engaged in a pattern of conduct where it has registered domain names in order to prevent the owner of the trademark or service mark from reflecting the mark in corresponding domain names. Registering 84 domain names that incorporate the Complainant's trademark constitutes a pattern of conduct directed against the Complainant, stopping it from reflecting its trademark in the disputed domain names. The Complainant claims that the Respondent is known as a serial cybersquatter and appeared in numerous previous UDRP disputed, including no less than 40 CAC disputes.
2. By using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site or of a product or service on its web site. The Complainant claims that its marks are well-known citing previous UDRP decisions. The disputed domain names have all been registered between November of 2021 and June of 2023. According to the Complainant, it is not feasible that the Respondent could ignore the Complainant's reputation and business when it registered the disputed domain names.
3. The Respondent has registered 84 domain names which incorporate Complainant's well-known trademarks, merely adding generic and/or geographical terms. The prominent use of Complainant's Trademark(s) in the disputed domain names and on the content of the corresponding websites clearly creates a likelihood of confusion for Internet users who visit Respondent's domain names. The similarity of the products offered on the websites, demonstrates that the Respondent was seeking to cause confusion. The false impression is increased by the incorporation of the Complainant's Trademark(s) in the 84 disputed domain names, the similar goods (apparel) being offered, and the unauthorized featuring of the Complainant's trademarks, most notably the "TOMMY HILFIGER" and the "Tommy Hilfiger flag logo", in a prominent manner on the websites related to the disputed domain names. A number of disputed domain names have become inactive during the course of this proceeding. However, the Complainant has provided evidence that the disputed domain names have been registered and used in bad faith, namely, to impersonate the Complainant. Moreover, non-use of a domain name, especially one which incorporates an extremely famous trademark such as those of Complainant, does not prevent a finding of bad faith under the passive holding doctrine.
4. The content of any website to which the disputed domain names direct: the Respondent has sought to impersonate and pass itself off as Complainant or one of its local outlets and a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the disputed domain names;
5. Use of the privacy services in the circumstances of this case also indicates bad faith of the Respondent.

Therefore, the Complainant claims the disputed domain names were registered and being used in bad faith.

PARTIES CONTENTIONS

The Complainant's contentions are summarized in the Factual Background section above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

Preliminary Issues

I. Consolidation and identity of Respondent - “Web Commerce Communications Limited”

The Complainant requests consolidation of all the disputed domain names into a single dispute. The Complainant asserts that 22 (twenty-two) of the disputed domain names are registered by a single registrant identified as “Web Commerce Communications Limited” and all the disputed domain names (including the remaining 62 domain names) are owned or under the effective control of a single person or entity, or a group of individuals acting in concert.

The Complainant’s arguments in favor of consolidation can be summarized as follows:

- All 84 disputed domain names share the same Registrar – “ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED”;
- All 84 disputed domain names use a similar naming pattern, namely the entirety of Complainant’s trademark, accompanied by a geographical term and/or a generic term, sometimes divided by a dash;
- The websites by the disputed domain names share a similar fake copyright notice at the bottom;
- The websites by the disputed domain names use a similar template;
- Two of the named registrants share the same email address;
- For all the disputed domains except one (tommyhilfigerthailand.com), the Respondent made the exact same mistake in the WHOIS data: only providing an identical town name two or three times, instead of any real address (e.g. street name and house number);
- The Complainant also cites some previous UDRP CAC decisions on the consolidation issue that support Complainant’s position.

The Panel first notes that under par. 3 (c) of the UDRP Rules, the complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. Consolidation is also addressed in WIPO Overview 3.0, section 4.11, which states that “panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario”.

The Panel considered the Complainant’s arguments in favor of consolidation, the evidence provided as well as facts of this dispute, and also its limited research conducted under par. 10 (a) of the Rules and its authority under par. 10 (e) of the Rules, decided to accept the consolidation request based on the following:

- All 84 disputed domain names are registered through the same Registrar;
- All 84 disputed domain names share a similar composition, e.g. Complainant’s mark with the addition of a geographical or descriptive/generic term;
- They all share a similar pattern of use, namely for websites with nearly identical content, including pictures and logos of the Complainant, nearly identical copyright notices at the bottom and they all seem to offer Complainant’s goods for sale;
- Most of the contact details of the registrant share a similar pattern, as noted by the Complainant, e.g. providing identical town name two or three times;
- At least one of the named registrants – Joseph Graham, was previously involved in numerous UDRP proceedings along with “Web Commerce Communications Limited”, where they were named as co-respondents and it appears he is associated with “Web Commerce Communications Limited” (see e.g. **WIPO Case No. D2023-3558**, **WIPO Case No. D2023-3806** and **CAC Case No. 105616** where one of the named respondents was identified as “Joseph Graham (Web Commerce Communications Limited)”);
- Totality of the circumstances of this dispute indicate that all the named registrants are either different aliases of the same person/entity or they are commonly controlled. As noted by the Panel in **CAC case No. 105776**, where one of the named respondents was involved (“Web Commerce Communications Limited”): “*all of the disputed domain names are equally registered with “Alibaba.Com Singapore E-Commerce Private Limited”, which is, in the panel’s experience, not too common a registrar for domain holders from Italy and France... it is more likely than not for the Panel, taking into account all the circumstances of the specific case, that all of the disputed domain names are under common control*”. This Panel notes that “Web Commerce Communications Limited” was involved in numerous previous UDRP consolidated cases and never questioned consolidation (see e.g. **CAC Case No. 105792**, **CAC Case No. 105776** and **CAC Case No. 105616**) and
- Last, but not least, neither of the identified respondents filed a response and questioned consolidation or otherwise indicated that he or she is not related to the other identified respondents.

Based on the above the Panel finds that all disputed domain names are more likely than not under common control and consolidation is fair and equitable to both parties, taking into account evidence available and facts of the case, Panel's own limited research and previous UDRP decisions in similar circumstances, including decisions involving the same Respondent (s).

Therefore, the Panel accepts the consolidation request of the Complainant and will refer to all named respondents in the complaint as "Respondent".

Identity of Respondent - Web Commerce Communications Limited

The Complainant emphasized that the largest subset in terms of identical registrant data, namely 22 domains, are registered by the same Registrant: "Web Commerce Communications Limited", doing business as "Webnic.cc".

Webnic.cc is, however, simply a reseller of the Registrar's domain name registration services. Since it operates as a reseller and conduit reselling Registrar's services, the Registrar should have provided the details of the underlying registrants. It failed to do so, therefore, the Complainant claims that the Registrar is potentially in violation of the Temporary Specification for gTLD Registration Data, Appendix E 1.1 (<https://www.icann.org/resources/pages/gtld-registration-data-specs-en>).

The Panel notes that there may be indeed potential non-compliance by the Registrar with the Temporary Specification for gTLD Registration Data, Appendix E 1.1 that states, inter alia, the following: "The Registrar MUST provide the UDRP provider with the full Registration Data for each of the specified domain names, upon the UDRP provider notifying the Registrar of the existence of a complaint...", if the Registrar failed to disclose actual registrant(s) and instead provided details of a proxy/privacy service.

In any case, the Panel here agrees to treat "Web Commerce Communications Limited" as registrant and respondent since there is no other information and this name was disclosed by the Registrar. The same respondent previously appeared in numerous UDRP disputes (e.g. in over 40 CAC disputes) and was treated as respondent by previous UDRP panels.

II. Language

The registration agreement for all 84 disputed domain names is in English. The Complainant asserts that in case the Respondent requests another language, English still shall be the language of this proceedings based on a number of factors, including the following: a) the disputed domain names are all formed by words in the Latin script and not in Chinese characters; b) all of the disputed domain names include the English-language trademark(s), c) all of the disputed domain names are in the international .com gTLD and most of the websites are or were in the English language and d) requiring the Complainant to translate the Complaint into another language would create an undue burden and delay.

The Respondent did not respond and did not question the language of this proceeding. Therefore, English shall be the language of this proceeding.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar

The Complainant provides evidence of its numerous registrations for "TOMMY HILFIGER", "TOMMY", "HILFIGER" and "TOMMY JEANS" marks listed above (both word and word + device) that are protected in various jurisdictions across the globe. As confirmed by WIPO Overview 3.0: *"where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case"* (see 1.2.1).

The disputed domain names fully incorporate the Complainant's trademarks with the addition of the geographical or generic/descriptive terms.

As stated in WIPO Overview 3.0: *"in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing"* and *"where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element"* (see 1.7 and 1.8).

In the present case, the Complainant's word trademarks identified above (word elements of the Complainant's marks) are clearly recognizable within all 84 disputed domain names and the additional terms do not change overall perception of the disputed domain names and do not affect confusing similarity under the UDRP.

The <.com> gTLD shall be disregarded under the confusing similarity test as it does nothing to eliminate confusion.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

- (i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and
- (ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see **“Julian Barnes v. Old Barn Studios”, WIPO Case No. D2001-0121; “Belupo d.d. v. WACHEM d.o.o.”, WIPO Case No. D2004-0110.**

The disputed domain names were registered between November of 2021 and June of 2023. The disputed domain names are (or were) used for websites that contained Complainant’s goods images, logos and made an appearance of being online shops where goods under Complainant’s trademarks were available.

Some of the disputed domain names are no longer used for active websites, whereas some other disputed domain names are still used for hosting Complainant-related content as described above.

Some of the disputed domain names now redirect to the same webpage that informs about alleged legal proceedings under US law with the following message: **“Plaintiffs have charged Defendants with violations of United States federal and state laws prohibiting trademark infringement and counterfeiting”**.

The Complainant has made a prima facie case of Respondent’s lack of rights or legitimate interests in respect of all disputed domain names.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Rules and **CAC Case No. 101284**: *“A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant”*.

The Respondent is not known by the disputed domain names and has no connection to the Complainant’s business, the disputed domain names or any name(s) corresponding to the disputed domain names. The Complainant has not granted any license or authorization to use its trademarks to the Respondent and the Complainant is not doing any business with the Respondent.

The Respondent seems to be offering (was offering) for sale Complainant’s goods via the websites by the disputed domain names. Therefore, hypothetically the Respondent could be considered as an unauthorized reseller of Complainant’s goods and unauthorized resellers/distributors may under certain circumstances have a legitimate interest under the “Oki Data Test” criteria as outlined in **“Oki Data Americas, Inc. v. ASD, Inc.”, WIPO Case No. D2001-0903** and 2.8.1 of WIPO Overview 3.0.

The Respondent in this dispute, however, fails to comply with the “Oki Data” requirements, namely it fails to *“accurately and prominently disclose the registrant’s relationship with the trademark holder”*, moreover, it appears that the Respondent actually tried to increase confusion with the Complainant by using copyright notices and Complainant’s logos, and the Respondent cornered *“the market in domain names that reflect the trademark”* by registering 84 disputed domain names that contain the Complainant’s mark.

Besides, as reflected in WIPO Overview 3.0 *“a respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner”* (see 2.5), and the Panel finds that this applies to the present dispute since the disputed domain names all incorporate the Complainant’s marks with the addition of terms that may actually indicate some kind of affiliation or endorsement by the Complainant.

The use of the disputed domain names by the Respondent and the very choice of the disputed domain names indicate an intent to create an implied affiliation and impersonate the Complainant.

Impersonation is not fair and as such does not create any rights or legitimate interests.

There is no other evidence that may indicate any rights or legitimate interest of the Respondent in the present dispute.

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark (see par. 3.1 of the WIPO Overview 3.0). Targeting is important in establishing bad faith under the UDRP.

As noted by Gerald M. Levine in his treatise, the leading authority on the subject of UDRP and domain name disputes: *“knowledge and targeting are prerequisites to finding bad faith registration” and “knowledge of a complainant’s mark, if not directly evident or denied, can be inferred or rebutted from website’s content, strength of the mark and respective timing of a mark’s use in commerce and registration of the domain name”* (see **“Domain Name Arbitration”**, Gerald M. Levine, “Legal Corner Press”, Second Edition, 2019, page 235).

The Panel finds that the Complainant established that the disputed domain names were registered and are being used in bad faith based on the following:

1. The nature of the disputed domain names that incorporate various Complainant's trademarks with the addition of geographical or descriptive/generic terms and the timing of the registration of the disputed domain names, many years after the Complainant obtained protection for its trademarks and started using its trademarks. The nature of the disputed domain names indicates that the Respondent was aware of the Complainant and its trademarks when it registered the disputed domain names.
2. The strength of the Complainant's trademarks, in particular its "TOMMY HILFIGER" mark. The Complainant's marks were previously recognized as "well-known" and "notorious" (see e.g. **CAC Case No. 104505**: *"The Panel agrees and infers, **due to the notoriety of the Complainant's marks** and the manner of use of the disputed domain names that the Respondent had actual knowledge of the Complainant's rights in the Complainant's marks at the time of registering the disputed domain names..."* and **CAC Case No. 105327**: *"The Complainant has demonstrated that it owns registered trade mark rights for TOMMY and has operated under the TOMMY or TOMMY HILFIGER marks since approximately 1985 and is extremely well known worldwide..."*).
3. The nature of use of the disputed domain name and the content of the website by the disputed domain names related to the Complainant and its trademarks and impersonating the Complainant. While some of the disputed domain names are not actively used on the date of this decision, the Complainant provided evidence that they were previously used for hosting Complainant's related content and contained Complainant's logos and pictures of Complainant's goods. Some of the disputed domain names are still used for the websites that look like Complainant's online shops. The nature of use and content of the websites clearly demonstrate targeting. As noted by another UDRP Panel in **CAC Case No. 105792** that involved multiple domain names used for impersonation and offering complainant's goods: *"In the Panel's view, it is obvious that at the time the Respondent registered the different disputed domain names it must have had the Complainant's trademark in mind, and the Respondent started using the disputed domain names to offer purportedly counterfeit products with misappropriation of the Complainant's images and target customers of the Complainant's products upon registration of the disputed domain names"*.
4. A clear absence of rights or legitimate interests as discussed above under the second element analysis coupled with no credible explanation for the Respondent's choice of the domain names and the fact of registration of 84 domain names that incorporate Complainant's distinctive trademarks. The Respondent failed to respond and provide explanations for its choice of the disputed domain names confusingly similar with the Complainant's trademarks.
5. By registering 84 disputed domain names the Respondent engaged in a pattern of conduct preventing the Complainant "from reflecting its mark in corresponding domain names". As provided in WIPO Overview 3.0 establishing a pattern of conduct *"requires more than one, but as few as two instances of abusive domain name registration. This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, **even where directed at the same brand owner**"* (see 3.1.2 and see **CAC Case No. 104505** involving the same Complainant where the Panel noted: *"The Panel finds that the fact of registering 60 domain names that incorporate the Complainant's trademarks represents a pattern of bad faith conduct directed against the Complainant..."*).

Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (ii) and par. 4 b (iv) of the UDRP since the Respondent has engaged in "a pattern of conduct" by registering 84 disputed domain names "to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name" and the Respondent by using the disputed domain names has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **salestommyhilfiger.com**: Transferred
2. **tommyhilfigerchiletiendas.com**: Transferred
3. **tommychile.com**: Transferred

4. **tommyhilfigerenmexico.com**: Transferred
5. **tommyhilfigercanadaonline.com**: Transferred
6. **tommyhilfigerparis.com**: Transferred
7. **tommyhilfiger-ireland.com**: Transferred
8. **tommyhilfigerpolskaoutlet.com**: Transferred
9. **tommyhilfigercanada.com**: Transferred
10. **tommyhilfiger-gr.com**: Transferred
11. **tommyhilfigeroutletscanada.com**: Transferred
12. **tommyhilfigerturkiyeonline.com**: Transferred
13. **tommyhilfiger-italia.com**: Transferred
14. **tommyhilfigeroutlethungary.com**: Transferred
15. **tommyhilfigersfinland.com**: Transferred
16. **tommyhilfigeroutletaustalia.com**: Transferred
17. **tommyhilfigerphilippine.com**: Transferred
18. **tommyhilfigercanadaca.com**: Transferred
19. **tommyhilfigeronlinestores.com**: Transferred
20. **tommyhilfigerfinland.com**: Transferred
21. **tommyhilfigers-gr.com**: Transferred
22. **tommyhilfigerstoreph.com**: Transferred
23. **tommyhilfigeraustraliaonline.com**: Transferred
24. **tommyhilfigersalenz.com**: Transferred
25. **tommyhilfigergrandindonesia.com**: Transferred
26. **tommyjeanssingapore.com**: Transferred
27. **tommyhilfigerthailand.com**: Transferred
28. **tommyhilfigerfactoryoutlet.com**: Transferred
29. **tommyhilfigeruaedubai.com**: Transferred
30. **tommyhilfigerukwebsite.com**: Transferred
31. **tommyhilfigerisrael.com**: Transferred
32. **tommyhilfigerpuertorico.com**: Transferred
33. **tommy-hilfiger-ksa.com**: Transferred
34. **tommy-hilfiger-thailand.com**: Transferred
35. **tommyhilfigerperth.com**: Transferred
36. **tommy-hilfiger-ireland.com**: Transferred
37. **tommyhilfiger-uruguay.com**: Transferred
38. **tommyhilfigermonterrey.com**: Transferred
39. **storetommyhilfiger.com**: Transferred
40. **tommyjeansperu.com**: Transferred
41. **tommyhilfigeril.com**: Transferred
42. **tommyhilfigeroutletfrance.com**: Transferred
43. **tommyhilfigerit.com**: Transferred
44. **tommyhilfigerzurich.com**: Transferred
45. **tommyhilfigersuisse.com**: Transferred
46. **tommyhilfigerptonline.com**: Transferred
47. **tommyhilfigerlojas.com**: Transferred
48. **tommyhilfigermedellin.com**: Transferred
49. **tiendastommyhilfigercostarica.com**: Transferred
50. **tommyhilfigerhelsinki.com**: Transferred
51. **tommyhilfigeraltopalermo.com**: Transferred
52. **tommyhilfigergreek.com**: Transferred
53. **tommyhilfigercl.com**: Transferred
54. **tommyhilfigerhr.com**: Transferred
55. **tommyhilfigeruaeonline.com**: Transferred
56. **tommyhilfigeregyp.com**: Transferred
57. **tommyhilfigerksa.com**: Transferred

- 58. **tiendatommyhilfigermadrid.com**: Transferred
- 59. **tommyhilfigeramsterdam.com**: Transferred
- 60. **tommyhilfigerwinkels.com**: Transferred
- 61. **tommyhilfigerstoreberlin.com**: Transferred
- 62. **tommyhilfigerwien.com**: Transferred
- 63. **tommyhilfiger-sk.com**: Transferred
- 64. **tommyhilfigernloutlet.com**: Transferred
- 65. **tommyjeansgreece.com**: Transferred
- 66. **tommyhilfiger-pt.com**: Transferred
- 67. **tommyhilfigerbarcelona.com**: Transferred
- 68. **tommychileoutlet.com**: Transferred
- 69. **tommyhilfigerdk.com**: Transferred
- 70. **tommyhilfigelromania.com**: Transferred
- 71. **tommyhilfigelturkiye.com**: Transferred
- 72. **tommyhilfigeroutletberlin.com**: Transferred
- 73. **tommy-hilfiger-schweiz.com**: Transferred
- 74. **codepromotommyhilfiger.com**: Transferred
- 75. **tommy-hilfiger-italia.com**: Transferred
- 76. **tommyhilfigereshop.com**: Transferred
- 77. **tommyoutletaustralia.com**: Transferred
- 78. **tommyhilfigersi.com**: Transferred
- 79. **tommyhilfigersrbijaonline.com**: Transferred
- 80. **tommyhilfigerucuz.com**: Transferred
- 81. **tommyhilfigerdubai.com**: Transferred
- 82. **tommyhilfigergreeceeshop.com**: Transferred
- 83. **tommyhilfigerquito.com**: Transferred

PANELLISTS

Name	Igor Motsnyi
DATE OF PANEL DECISION	2023-12-13
Publish the Decision	
