

ADMINISTRATIVE PANEL DECISION

Mycoskie, LLC v. Client Care, Web Commerce Communications Limited
Case No. D2023-3242

1. The Parties

The Complainant is Mycoskie, LLC, United States of America, represented by SILKA AB, Sweden.

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

2. The Domain Names and Registrar

The disputed domain names <toms-osterreich.com>, <tomsschuhe-schweiz.com>, and <tomsswitzerland.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 July 27, 2023. On July 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 28, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which the Complaint had stated as being "Not Disclosed". The Center sent an email communication to the Complainant on July 28, 2023, 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 amendment to the Complaint on August 2, 2023.

The Center verified that the Complaint together with the amendment to 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 August 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 28, 2023.

The Center appointed Dr. Clive N.A. Trotman as the sole panelist in this matter on September 5, 2023. 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 factual background is based on information provided in the Complaint. The Complainant is the owner of trademarks for TOMS, which is evidently derived from its motivation, the “shoe for Tomorrow Project”, a project to design and market shoes but also to donate currently one-third of its profit in the form of shoes to needy people, initially children in Argentina. The project has expanded from the manufacture of shoes, into eyewear, coffee, apparel and handbags.

The Complainant describes three of its other divisions as follows:

TOMS Eyewear: this division provides 13 countries with prescription glasses, medical treatment, sight-saving surgery since its launch in 2011;

TOMS Roasting Co.: the division provides people in 6 countries with liters of safe water for each purchase of its coffee products since 2014; and

TOMS Bag Collection: provides training for skilled birth attendants and distributes birth kits containing items that help a woman safely deliver her baby in 4 countries.

The Complainant works with more than 150 giving partners in over 82 countries and has given away 95 million pairs of shoes internationally.

The Complainant owns some 114 trademarks in various jurisdictions internationally, of which the following trademarks are representative for the purposes of the present proceeding:

TOMS, logo embodying the word TOMS in upper case, United States Patent and Trademark Office, registered on March 23, 2010, registration number 3765503, in class 25;

TOMS, word mark, Swiss Federal Institute of Intellectual Property, registered on May 22, 2013, registration number 643898, in classes 9, 25 and 35;

TOMS, stylized word mark, Intellectual Property Corporation of Malaysia, registered on September 19, 2012, date of legal status December 1, 2014, registration number 2012015867, in class 9;

TOMS, European Union Trade Mark, registered on June 21, 2013, registration number 011555497, in class 25.

The Complainant also owns and uses a number of domain names including <toms.com>, which was registered on July 30, 1995 and provides the Complainant's main online presence.

The Respondent has not provided any background information. The disputed domain names <toms-osterreich.com> and <tomsswitzerland.com> were registered on April 19, 2023 and previously resolved to websites offering shoes and apparel for sale. The disputed domain name <tomsschuhe-schweiz.com> was registered on April 11, 2022 and when screen captured on July 13, 2023, resolved to a website selling shoes with prices in Swiss currency.

5. Parties' Contentions

A. Complainant

The Complainant's extensive contentions include the following.

As a preliminary matter, the Complainant contends that the three dispute domain names are under common control and requests they be consolidated in a single Complaint.

The Complainant contends that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The disputed domain names incorporate the entirety of the Complainant's trademark. They also incorporate alternatively the words "osterreich" ("Austria" in German), "switzerland", or "schweiz" ("Switzerland" in German). The disputed domain name <tomsschuhe-schweiz.com> incorporates the word "schuhe" ("shoe" in German). The Complainant submits that these various additional words, in this case, should not prevent a finding of confusing similarity to the Complainant's trademark.

The Complainant says that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant has not authorized the Respondent to use the Complainant's trademark or to incorporate it in the disputed domain names. The WIPO Global Brand Database reveals no evidence the Respondent has rights in any trademark similar to the disputed domain names. There is no evidence the Respondent has been commonly known by any names similar to the disputed domain names.

The Complainant also says the Respondent is not making any *bona fide* use of the disputed domain names but that <tomsschuhe-schweiz.com> has resolved recently to a website through which the Respondent has offered for sale products similar to the Complainant's products and which displays the Complainant's trademark. Cached versions of the websites to which the disputed domain names <toms-osterreich.com> and <tomsswitzerland.com> previously resolved show them to have been used for the sale of men's, women's and children's shoes and other apparel. There is no evidence any of the disputed domain names have been used by the Respondent for a legitimate noncommercial or fair purpose.

The Complainant further contends that the disputed domain names were registered and are being used in bad faith. The Respondent should have been aware of the Complainant's trademark, which the Complainant has used for about 16 years before the Respondent registered the disputed domain name <tomsschuhe-schweiz.com>. Any reasonable search of trademark registers or the Internet would have found the Complainant's trademark. Given the Respondent's incorporation of the Complainant's trademark in the disputed domain names and use of them for websites for the sale of products similar to the Complainant's products, it is implausible that the Respondent would have been unaware of the Complainant.

The Complainant submits that the registration of a domain name that is identical or confusingly similar to a famous trademark by an unaffiliated entity can itself create a presumption of bad faith.

The Complainant has cited previous decisions under the Policy that it considers helpful to the Panel.

The Complainant requests the transfer of 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

The generic Top-Level Domain “.com” may be disregarded in the determination of confusing similarity. Each disputed domain name features prominently the entirety of the Complainant’s trademark TOMS. The additional geographical terms “osterreich”, “switzerland”, or “schweiz” respectively, or the descriptive word “schuhe”, are found not to prevent a finding of confusing similarity between each disputed domain name and the Complainant’s trademark.

The Panel finds for the Complainant under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Respondent has not been authorised to use the Complainant’s trademark in any way. According to the Complainant’s enquiries, there is no evidence the Respondent has rights in any trademark similar to any of the disputed domain names and the Respondent has never been commonly known by any of the disputed domain names. Screen capture evidence produced by the Complainant shows each of the three disputed domain names to have been used at various times for the sale of shoes and apparel similar to the Complainant’s products including items specifically labelled under the Complainant’s trademark, for example “Toms Schuhe Schweiz” under a photograph of a shoe, which by appropriation of the Complainant’s trademark without authority, cannot constitute a *bona fide* use.

Paragraph 4(c) of the Policy provides for the Respondent to contest the Complainant’s *prima facie* case under paragraph 4(a)(ii) of the Policy and to establish rights or legitimate interests in a disputed domain name. The Respondent has not responded or asserted any such rights or legitimate interests.

The Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain names and finds for the Complainant under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove under paragraph 4(a)(iii) of the Policy that each disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy lists four alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, of which paragraph 4(b)(iv) is pertinent:

“(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location”.

The Complainant has produced evidence in the form of screen captures of the websites to which the disputed domain names have resolved at various times. The disputed domain name <tomsschuhe-schweiz.com> has resolved to a website headed TOMS incorporating a close-up photograph of shoes being worn, the photograph bearing an exact reproduction of the Complainant’s blue, white and black TOMS logo. Below are shots of models and a number of shoes with prices, showing purported reductions from higher prices. The website makes several references to the Complainant’s trademark and includes the spurious copyright notice “Copyright © 2023 Toms Outlet Store Powered by <tomsschuhe-schweiz.com>”.

As an instance, a shoe coloured grey with white sole and distinctive orange flashings labelled “Toms TRVL LITE Sneakers Herren” on the Respondent’s website is indistinguishable, down to the shadows under the shoe, from the illustration labelled “TRVL LITE Sneaker” on the Complainant’s website.

Cached copies of the websites to which the two other disputed domain names have previously resolved portray shoes under the Complainant's trademark, for example "Toms Sneakers Online" through <tomsswitzerland.com>, and "Toms Alpargata Cotton Canvas" through <toms-osterreich.com>, together with other apparel than shoes.

The evidence of the nature of the Respondent's websites in focusing on shoes, together with other apparel similar to the Complainant's products, and in using the Complainant's trademark in each of the disputed domain names and in the body of each respective website, leads the Panel to conclude that the Respondent was aware of and targeted the Complainant at the time of registration of each disputed domain name. On the evidence and on the balance of probabilities, the Panel finds under paragraph 4(b)(iv) of the Policy that the Respondent has used the disputed domain names with intent to attract Internet users to the Respondent's websites by confusion, including by initial interest confusion, with the Complainant's trademark for the purpose of commercial gain.

Accordingly, registration and use of the disputed domain names in bad faith are found in the terms of paragraph 4(a)(iii) 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, <toms-osterreich.com>, <tomsschuhe-schweiz.com> and <tomsswitzerland.com>, be transferred to the Complainant.

/Dr. Clive N.A. Trotman/

Dr. Clive N.A. Trotman

Sole Panelist

Date: September 13, 2023