

ADMINISTRATIVE PANEL DECISION

Simply Southern Holdings, LLC v. Privacy Service Provided by Withheld for Privacy ehf / Lam Hoang Phuc
Case No. D2022-0692

1. The Parties

The Complainant is Simply Southern Holdings, LLC, United States of America (“United States”), represented by Brooks, Pierce, McLendon, Humphrey & Leonard, L.L.P., United States.

The Respondent is Redacted for Privacy, Privacy Service Provided by Withheld for Privacy ehf, Iceland / Lam Hoang Phuc, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <simplysoutherntees.org> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 28, 2022. On March 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 1, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on March 2, 2022, 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 March 2, 2022.

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 March 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 30, 2022.

The Center appointed Peter Burgstaller as the sole panelist in this matter on April 11, 2022. 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 disputed domain name was registered on December 23, 2019 (Annex 1 to the Complaint).

The Complainant owns various United States trademark registrations for SIMPLY SOUTHERN, *inter alia*:

- Registration No 3,335,887, registered November 13, 2007, in the international class 35;
- Registration No. 4, 167,424, registered July 3, 2012 in the international class 25;
- Registration No. 4,916,829, registered March 15, 2016 in the international class 9;
- Registration No 5,617,651, registered November 27, 2018 in the international class 14; as well as
- Registration No. 5,505,815, registered July 3, 2018 in the international classes 3, 5, 6, 9, 16, 18, 20, 21, 22.

The disputed domain name referred to a website which provided an online store with t-shirts and where the Complainant's logo was used (Annex 7 to the Complaint). At present, the disputed domain name does not resolve to a website.

The Complainant provides a webshop under the domain name <simplysouthern.com> where it sells its SIMPLY SOUTHERN t-shirts and apparel and other products (Annex 8 to the Complaint); the Complainant also owns the domain name <simplysoutherntees.com> which automatically redirects to <simplysouthern.com>.

5. Parties' Contentions

A. Complainant

The Complainant is a leading company for selling t-shirts in the United States under its brand SIMPLY SOUTHERN, as well as other versions such as SIMPLY SOUTHERN TEES and SIMPLY SOUTHERN TEE SHIRTS.

The Complainant invested significantly to successfully make the SIMPLY SOUTHERN mark famous for t-shirts, apparel and other products. It has various rights in the SIMPLY SOUTHERN mark, including twelve United States trademark registrations for SIMPLY SOUTHERN.

The Complainant currently employs over three hundred people to support its operations, which include both retail sales and manufacturing/wholesaling of SIMPLY SOUTHERN branded t-shirts, apparel and other merchandise. It operates twenty seven SIMPLY SOUTHERN retail stores in North Carolina, South Carolina, Georgia, Tennessee, Virginia, Ohio, Delaware, Kentucky, and Mississippi, United States, through which it sells its SIMPLY SOUTHERN branded products and other merchandise.

The Complainant also manufactures and then wholesales or distributes SIMPLY SOUTHERN brand t-shirts and other products to more than six thousand stores nationwide in the United States; it operates the commercial website under the domain name <simplysouthern.com> and sells a large volume of SIMPLY SOUTHERN brand t-shirts from this website to retailers throughout the United States. The Complainant used to operate the commercial website under the domain name <simplysoutherntees.com> at which Internet users were automatically redirected to <simplysouthern.com>.

The disputed domain name is confusingly similar to the Complainant's trademark registrations since it incorporates the entirety of the SIMPLY SOUTHERN mark. The disputed domain name only adds the additional word, "tees," which is a reference to t-shirts, one of the goods covered by multiple of the Complainant's trademark registrations.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The use of a domain name for illegal activity (e.g. the sale of counterfeit goods) can never confer rights or legitimate interests on a respondent and this is exactly what the Respondent did. In addition, the Respondent used without authorization the Complainant's logo on its website to deceive customers into thinking that its products are genuine SIMPLY SOUTHERN apparels.

The Respondent registered and used the disputed domain name in bad faith: There is no question that the Respondent knew about the Complainant's mark before registering the disputed domain name since the Complainant used its mark in connection with t-shirts and apparel for many years and the Respondent blatantly copied the Complainant's logo and incorporated the Complainant's trademark in its entirety in the disputed domain name. Finally, the Respondent used the disputed domain name for illegal activity, e.g. selling of counterfeit goods.

The Respondent deliberately targeted the Complainant in bad faith to create a likelihood of confusion by using the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that

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

A. Identical or Confusingly Similar

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the trademark SIMPLY SOUTHERN.

The disputed domain name is confusingly similar to the Complainant's registered trademark SIMPLY SOUTHERN since it entirely contains this mark and only adds the word "tees", which is a reference to t-shirts, one of the goods covered by the Complainant's trademark registrations, as suffix to the mark SIMPLY SOUTHERN.

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

Finally, it has also long been held that general Top-Level Domains ("gTLDs") are generally disregarded when evaluating the confusing similarity of a disputed domain name.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant’s mark in its entirety, together with the fact that the Respondent used the Complainant’s logo on a website addressed by the disputed domain name, cannot be considered fair as it falsely suggest an affiliation with the Complainant that does not exist (see section 2.5.1 of the [WIPO Overview 3.0](#)).

Noting the above, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

The Complainant has rights in and is the owner of the registered trademark SIMPLY SOUTHERN registered and used long before the disputed domain name was registered in 2019. Moreover, the Complainant registered and is using e.g. the domain names <simplysouthern.com> and <simplysoutherntees.com> for addressing its main website, offering its products globally.

It is inconceivable for this Panel that the Respondent registered the disputed domain name without knowledge of the Complainant’s rights, which in the circumstances of the case leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the entirety of the Complainant’s trademark SIMPLY SOUTHERN, which has a strong online presence and was extensively used by the Complainant prior to the registration of the disputed domain name.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

The disputed domain name is also being used in bad faith since it resolved to a website that not only offered competing products but also used the Complainant’s logo. By using the Complainant’s logo on the website which is addressed by the disputed domain name the Respondent imitated the legitimate SIMPLY SOUTHERN brand website, including purportedly offering numerous SIMPLY SOUTHERN brand products for sale; such use of a domain name can never confer rights or legitimate interests on a respondent – it is quite the contrary: the Respondent “free rides” on the reputation and the valuable goodwill of the Complainant’s trademark SIMPLY SOUTHERN and thus the use of the disputed domain name is suited to divert or mislead potential web users from the website they are actually trying to visit (the Complainant’s site). Hence, the Respondent disrupts the Complainant’s business and attracts, for commercial gain, Internet users to the Respondent’s website, by creating a likelihood of confusion with the Complainant’s

trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

On the basis of these facts and findings, the Panel finds that the disputed domain name was registered and is being used in bad faith according to 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 name <simplysoutherntees.org> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: April 25, 2022