

ADMINISTRATIVE PANEL DECISION

Tommy Bahama Group, Inc. v. Zhong Qing Ma
Case No. D2022-1428

1. The Parties

The Complainant is Tommy Bahama Group, Inc., United States of America (“United States”), represented by Kilpatrick Townsend & Stockton LLP, United States.

The Respondent is Zhong Qing Ma, China.

2. The Domain Name and Registrar

The disputed domain name <tommy-bahama-outlet.com> is registered with Epik, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 21, 2022. On April 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 21, 2022, 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 April 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 18, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on June 3, 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 Complainant is a manufacturer and retailer of casual, men's, and women's island-inspired apparel and related accessories, such as sportswear and activewear, denim, swimwear, and many others, operating under the TOMMY BAHAMA brand since 1993.

The Complainant operates in more than 130 retail stores for its apparel, accessories, and home furnishing in several locations through the United States and in 22 international stores, located in Australia, Canada, Japan, and other countries. The Complainant also operates 21 restaurant-retails under the TOMMY BAHAMA brand in the United States.

The Complainant is the owner of the TOMMY BAHAMA trademark in several jurisdictions, such as United States Trademark Reg. No. 1802812 for TOMMY BAHAMA, registered on January 12, 1993, in class 25.

The disputed domain name was registered on March 17, 2022. The disputed domain name redirects to a third party website that offers various products for sale.

5. Parties' Contentions

A. Complainant

The Complainant has enjoyed substantial sales under the TOMMY BAHAMA mark.

In fiscal years 2021, 2020, 2019, and 2018, the Complainant's net sales of TOMMY BAHAMA goods and services approximated USD 724 million, USD 420 million, USD 676 million, and USD 675 million, respectively. In fiscal years 2017 and 2016, the Complainant's net sales of TOMMY BAHAMA goods and services approximated USD 686 million and USD 658 million, respectively.

The Complainant has spent tens of millions of dollars promoting and marketing its goods and services under the TOMMY BAHAMA mark, and these goods and services have received an enormous amount of publicity in the United States and throughout the world.

The Complainant alleges that the disputed domain name is confusingly similar to its registered TOMMY BAHAMA mark considering that the disputed domain name reproduces the TOMMY BAHAMA mark in its entirety with the mere addition of the generic word "outlet". It actually increases the likelihood of confusion, as held by the panels in various UDRP cases with facts similar to those at hand: "One of the common meanings of the term 'outlet' is a store that sells the goods of a particular manufacturer or wholesaler."

Moreover, the Complainant argues that the Respondent lacks rights or legitimate interests in the disputed domain name since the Complainant's TOMMY BAHAMA mark, incorporated in the disputed domain name, was first used in commerce and registered in the United States in 1993, long before the Respondent's registration and use of the disputed domain name, which would indicate that the Respondent was fully aware of the Complainant's rights in the TOMMY BAHAMA mark.

In addition, the Complainant alleges that the Respondent cannot establish rights or legitimate interests in the disputed domain name, considering that the Respondent was never licensed or authorized by the Complainant to register nor use its TOMMY BAHAMA mark.

The Complainant maintains that the Respondent's registration and use of the disputed domain name is not connected to a *bona fide* offering of goods or services, since the disputed domain name redirects to a third party website that offers various products for sale. In this sense, the Respondent's use of the disputed domain name would not be considered as legitimate noncommercial or fair use of the disputed domain name.

Furthermore, the Complainant claims that the Respondent has registered and is using the disputed domain name in bad faith for commercial gain and to benefit from the goodwill and fame associated with the Complainant's TOMMY BAHAMA mark.

According to the Complainant's allegations, the fact that the Complainant's TOMMY BAHAMA mark has been in use and registered for several years before the Respondent's registration of the disputed domain name, which wholly reproduces the Complainant's TOMMY BAHAMA mark, would by itself indicate the Respondent's bad faith in the registration and use of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Policy establishes three elements, specified in paragraph 4(a), that must be established by the Complainant to obtain the requested relief. These elements are:

- (i) the 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 in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, the Complainant is required to establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

Ownership of a trademark registration is generally sufficient evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. As mentioned in section 4 above, the Complainant is the owner of TOMMY BAHAMA trademark since at least 1993.

Moreover, the disputed domain name reproduces, in its entirety, the TOMMY BAHAMA mark, with the mere addition of the word "outlet". In this regard, the Panel considers that the addition of the word "outlet" in this case does not prevent a finding of confusing similarity with the Complainant's TOMMY BAHAMA mark.

Additionally, the Panel reiterates that the addition of the generic Top-Level Domain ("gTLD") ".com" may be disregarded by the Panel in order to establish identity or confusing similarity between the disputed domain name and the Complainant's trademark (see *Topvintage.nl BV v. DOMAIN ADMIN*, [D2017-1019](#): "the various gTLDs in each of the disputed domain names are commonly disregarded for the purposes of comparison in cases under the Policy on the grounds that they are required for technical reasons only"; see also *Volkswagen AG v. Todd Garber*, [D2015-2175](#)). Thus, the Panel finds that paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out circumstances, in particular but without limitation, which, if found by the Panel, can demonstrate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances include:

- (i) before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations

to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

No evidence has been presented that, before any notice of this dispute, the Respondent was using or was making demonstrable preparations to use the disputed domain name in connection with any type of *bona fide* offering of goods or services or that the Respondent has been commonly known, as an individual, business, or otherwise, by the disputed domain name.

The uncontested evidence shows that the Complainant had well known rights in its TOMMY BAHAMA mark at the time of the registration of the disputed domain name and that the Respondent nevertheless registered it. Thus, no rights or legitimate interests can be inferred from the registration of the disputed domain name.

The Panel also finds that the Respondent's use of the disputed domain name to redirect to a third party website that offers various products for sale also does not constitute a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name.

In addition, the Complainant has never authorized, licensed, or permitted, in any way, the Respondent to register or use the disputed domain name, which entirely incorporates the Complainant's TOMMY BAHAMA mark.

Considering the evidence on file and that the Respondent failed to send a Response to the Complaint, the Panel finds that there are no elements suggesting that the Respondent has or might have had rights or legitimate interests in respect of the disputed domain name.

The Panel, therefore, concludes that the condition established at paragraph 4(a)(ii) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

In order to facilitate assessment of whether the bad-faith element is established, paragraph 4(b) of the Policy provides the following non-exclusive scenarios:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Panel finds that the circumstance described in paragraph 4(b)(iv) of the Policy fit those of the current proceeding.

That is because, the TOMMY BAHAMA mark, registered by the Complainant in many jurisdictions before the registration of the disputed domain name, can be considered as distinctive and has been in use by the Complainant for many years and in several countries to cover a variety of goods and services.

In this sense, it is unlikely that the registration of the disputed domain name - which includes the TOMMY BAHAMA mark in its entirety - would have been a coincidence and not an attempt by the Respondent to create a likelihood of confusion with the Complainant's registered mark, and, therefore, attract Internet users to the commercial website to which the disputed domain name redirects (see *Tommy Bahama Group, Inc v. Registration Private, Domains by Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, [D2019-0197](#): "The disputed domain name was registered at a time when the reputation of the Complainant and its TOMMY BAHAMA trademark was well established in the relevant marketplace in multiple jurisdictions.")

Moreover, no evidence has been presented that the Respondent has any rights or legitimate interests in respect of the disputed domain name. No evidence has been presented that, before any notice to the Respondent of this dispute, the Respondent had been using or was making demonstrable preparations to use the disputed domain name in connection with any type of *bona fide* offering of goods or services.

In addition, the fact that the Respondent has been using the disputed domain name to redirect to a website which offers various products for sale is also indicative of bad faith of the Respondent as it demonstrates that the Respondent is most likely obtaining undue commercial gain with the disputed domain name, which entirely reproduces the Complainant's TOMMY BAHAMA mark.

The Panel thus concludes that the Respondent has registered and is using the disputed domain name in bad faith and that paragraph 4(a)(iii) of the Policy has been satisfied.

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 <tommy-bahama-outlet.com> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: June 27, 2022