

## **ADMINISTRATIVE PANEL DECISION**

Toteme AB v. Obcsh Pnxsq  
Case No. D2022-3702

### **1. The Parties**

The Complainant is Toteme AB, Sweden, represented by Kanter Advokatbyrå, Sweden.

The Respondent is Obcsh Pnxsq, China.

### **2. The Domain Name and Registra**

The disputed domain name <totemesale.com> is registered with Name.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 5, 2022. On October 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 6, 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 (Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 7, 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 amended Complaint on October 10, 2022.

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 the Respondent of the Complaint, and the proceedings commenced on October 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 7, 2022.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on November 10, 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 renowned fashion house, founded in the year 2014 in Sweden. The Complainant offers online shopping of high-end fashion clothing worldwide. The Complainant also has stores in Stockholm, New York City and Shanghai.

The Complainant is the owner of the trademark TOTÊME registered in the following jurisdictions:

- United States of America: trademark registration No. 4,730, 273, registered on May 5, 2015.
- European Union: trademark registration No. 018124752, registered on May 22, 2020.
- China: trademark registration No. 17060002, registered on August 27, 2017.

The disputed domain name was registered on July 12, 2022 and is being used for an online store offering fashion goods using the Complainant's mark without his authorization.

#### **5. Parties' Contentions**

##### **A. Complainant**

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the disputed domain name is identical to the TOTÊME trademark registration of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the disputed domain name.

Third, the Complainant submits that the disputed domain name was registered and is being used in bad faith.

The Complainant states that the disputed domain name resolves to a website that incorporates the Complainant's trademarks not only in the disputed domain name, but on the website header, on the start page, and in relation to all goods offered on the website. According to the Complaint, the Respondent is not only using and offering counterfeit goods under the Complainant's registered trademark, but also is using photographs and marketing materials similar to the material used by the Complainant. From this the Complainant states that it is obvious that the intention of the use of the disputed domain name is to attract consumers and Internet users to believe that the website is operated by the Complainant, or at least that the website has affiliation with or has been endorsed by the Complainant.

According to the Complaint, the use of the word "sale" reinforces the impression that the disputed domain name is the Complainant's website for selling out goods at discounted prices. The disputed domain name resolves to a website, which offers the Complainant's products (or similar products) at a much lower price pretending to be an authentic "sales store" operated by the owner of the trademarks.

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

##### **B. Respondent**

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which a complainant must satisfy in order to succeed. The Complainant must satisfy 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 in respect of 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 first element that the Complainant must establish is that the disputed domain name is identical or confusingly similar to the Complainant's trademark.

The Complainant holds several valid TOTÊME trademark registrations. The disputed domain name is identical to the Complainant's trademarks since it merely reproduces the TOTÊME trademark in its entirety without the accent (Circumflex) and with the addition of the term "sale". As numerous UDRP panels have held, where at least a dominant feature of the relevant trademark is recognizable in the domain name, it is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark. The addition of the term "sale" does not prevent the finding of confusing similarity.

The Panel finds the first element of the Policy has therefore been met.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the disputed domain name:

"(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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."

There is no evidence of the existence of any of those rights or legitimate interests. The Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or its trademarks. The Complainant has prior rights in the trademarks, which precede the Respondent's registration of the disputed domain name. The Respondent is using the disputed domain name to sell either counterfeit products or products that are not actually the Complainant's designs but rather other types of products that are branded "Toteme". Although Panels are generally not prepared to accept merely conclusory or wholly unsupported allegations of illegal activity, including counterfeiting, the Panel notes that in this case, the goods are purportedly offered at substantially discounted prices, which supports the Complainant's claim of illegal activity by the Respondent and which cannot constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use. The Complainant has therefore established a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and thereby shifted the burden to the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to rebut the Complainant's *prima facie* case.

Therefore, the Panel finds that the Complainant has satisfied the second requirement of paragraph 4(a) of the Policy.

### **C. Registered and Used in Bad Faith**

The Complainant must prove both that the disputed domain name was registered and used in bad faith.

The Complainant's allegations with regard to the Respondent's registration and use of the disputed domain name in bad faith have been considered by the Panel. The Respondent has not contested these allegations.

The Panel visited the disputed domain name and was able to verify that the website mentions specifically the trademark of the Complainant and it resolves to an online store imitating a Complainant store with the mention of its trademarks and the addition of the term "sale" with the aim of projecting the idea that it is a website for selling out goods at discounted prices. In this sense and in the absence of a response by the Respondent, the Panel has no reason to doubt that the Respondent is purportedly offering counterfeit goods of the Complainant on the website to which disputed domain name resolves, particularly given the very substantially discounted prices at which the goods are being sold. The Panel finds that such behavior is evidence of bad faith.

In light of the evidence, the Panel holds that the Respondent has intentionally attempted to attract for commercial gain Internet users to her website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website and services and products offered on it under paragraph 4(b)(iv) of the Policy, and likely to disrupt the business of the Complainant under the paragraph 4(b)(iii) of the Policy, (noting that the Respondent by purportedly offering counterfeit products is acting in opposition to the Complainant for commercial gain).

There also is evidence that the address on the site attached to the disputed domain name is inexistent, which is further indication of bad faith.

Therefore, the Panel concludes that the Complainant has made out its case that the disputed domain name was registered and used in bad faith and has satisfied the third limb of the Policy under paragraphs 4(b)(iii) and 4(b)(iv).

### **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, <totemesale.com> be transferred to the Complainant.

*/Pablo A. Palazzi/*

**Pablo A. Palazzi**

Sole Panelist

Date: November 16, 2022