

Decision for dispute CAC-UDRP-105327

Case number CAC-UDRP-105327

Time of filing 2023-04-04 09:27:08

Domain names tommyfranchise.com

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization Tommy Hilfiger Licensing B.V.

Complainant representative

Organization Coöperatieve Vereniging SNB-REACT U.A.

Respondent

Name Douglas Michael

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns numerous trade mark registrations for TOMMY HILFIGER and for TOMMY throughout the world including European trade mark registration 0180093680 registered on 21 December 2019 for TOMMY.

FACTUAL BACKGROUND

Founded in 1985, the Complainant is a leading global corporation that designs, sources, distributes, sells, and markets fashion apparel, accessories, and other products throughout the world, among others, under the trademarks TOMMY HILFIGER and TOMMY. The Complainant is a corporation founded in the USA, with its worldwide headquarters in Amsterdam since 2007. In 2019, the Complainant's global revenue was approximately USD 9,2 billion and in 2020 the trademark TOMMY HILFIGER was ranked as the world's 75th most valuable brand. The Complainant's products are distributed and sold to consumers through department stores, retail stores, and authorised e-commerce sites throughout the world, including through the official e-commerce website launched in 2004 and located at the <tommy.com> domain name.

The disputed domain name was registered on 26 December 2020 and prior to the date of filing resolved to a website that publicised the availability of "Tomy Hilfiger" franchises and which used the TOMMY HILFIGER mark and logo.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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 name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is 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.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has demonstrated that it owns European trade mark registration 0180093680 registered on 21 December 2019 for TOMMY. The disputed domain name wholly incorporates the Complainant's TOMMY mark. The addition of the common English word "franchise" does not prevent a finding of confusing similarity and the Panel therefore finds that the Complainant owns trade mark rights within the meaning of paragraph 4(a)(i) of the Policy and that the disputed domain name is confusingly similar to the Complainant's TOMMY trade mark.

The Complainant has submitted that it has no relationship with the Respondent and has not licensed or authorised its use to the Respondent. Further the Complainant has submitted that it has exclusive trademark rights which predate the registration of the disputed domain name and that the Respondent cannot demonstrate any legitimate offering of goods or services under the "Tommy" and "Tommy Hilfiger" trade mark and that it is not commonly known by and owns no rights in those marks or in the disputed domain name.

The Complainant has submitted that the Respondent is impersonating the Complainant in order to mislead third-parties into applying for a so-called possibility to "own a Tommy Hilfiger franchise or to own an exclusive Tommy Hilfiger franchise right/license or distributorship" in any country and has provided in evidence the web page to which the disputed domain name resolved prior to the date of filing of this Complaint which publicised the availability of "Tomy Hilfiger" franchises and which used the TOMMY HILFIGER mark and logo and even included a "Tommy Hilfiger Franchise" copyright notice. The Complainant has submitted that this amounts to the Respondent actively using the Complainant's trade marks in connection with a non-existent business relationship, which leads internet users into believing that Respondent is somehow affiliated to or authorised by the Complainant to offer such franchising opportunities.

It has further submitted an example of the fraudulent use of the disputed domain name by the Respondent in order to extort funds from unsuspecting potential franchisees. It says that on 2 February 2023, a fraudulent e-mail was sent out from the e-mail address "Tommy Hilfiger Franchise info@tommyfranchise.com" with the subject line "APPLICATION APPROVED". The e-mail was sent with Approval Department <approval@tommyfranchise.com>; alegra <alegra@tommyfranchise.com>; Finance Department <finance@tommyfranchise.com> in CC to an addressee (redacted for privacy reasons) who filled out the form which is available on the website connected to the disputed domain name.

The Complainant has noted that in the e-mail, the Respondent presents himself as an employee of the Complainant, namely the "Global Franchise Licensing Coordinator" of the Complainant's franchising department and that the addressee is asked to sign a "TOMMY HILFIGER Franchise Refundable Commitment Fee Contract" and a "FRANCHISE LETTER OF CONSENT AND AUTHORIZATION". It has noted that both documents use various trade marks of the Complainant, with the clear aim of impersonating the Complainant or at least of creating the impression that the Respondent is authorised by the Complainant to offer franchising opportunities. Moreover, the Complainant mentioned that the Respondent asserts in the aforementioned Fee Contract and Letter that the documentation is "genuine/authentic and acceptable for all international correspondence of TOMMY HILFIGER" and that the Respondent added the visual marks of well-known financial institutions at the bottom of the Fee Contract with the text "OFFICIAL BANKING PARTNERS". Finally, the Complainant noted that the Fee Contract states that by signing the document, the addressee commits itself to "[...] make the required deposit of \$30,000 USD through bank wire transfer within 1-2 Working days[...]". As submitted by the Complainant, it appears that the Respondent has used an email address based on the disputed domain name to procure the payment of a significant amount of money with the false promise of becoming a franchisee of the Complainant. The use of the disputed domain name in connection with such apparently fraudulent conduct cannot confer rights or legitimate interests on the Respondent and it therefore can have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

The Complainant has demonstrated that it owns registered trade mark rights for TOMMY under European trade mark registration 0180093680 registered on 21 December 2019 for TOMMY and has operated under the TOMMY or TOMMY HILFIGER marks since approximately 1985 and is extremely well known worldwide, having as it does a very substantial international business. The disputed domain name was only registered in December 2020 and according to the Complainant formerly resolved to a website on which the Respondent masquerades as if it is the Complainant, or is authorised by the Complainant, to offer franchising opportunities for the Complainant's business. Further and as described above, there is evidence on the record of the disputed domain name having been used in a fraudulent e-mail scheme in which the Respondent masqueraded as if he was the Complainant. In these circumstances it is more likely than not that the Respondent was very well aware of the Complainant and its TOMMY mark when it registered the disputed domain name in 2020.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website. In this case the Complainant has submitted evidence that the disputed domain name formerly resolved to a website at which the Respondent impersonated the Complainant and falsely offered franchises upon its behalf. It is apparent that this was with a view to obtaining franchise fees fraudulently as described above in relation to the various fraudulent e-mail representations. This conduct fulfils the requirements of paragraph 4(b)(iv) of the Policy which amounts to evidence of registration and use of the disputed domain name in bad faith.

Further, the evidence as described above of the fraudulent e-mail representations amounts in its own right to evidence of use of the disputed domain name in bad faith and this is exactly the sort of conduct that the Policy seeks to proscribe.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **tommyfranchise.com**: Transferred

PANELLISTS

Name	Mr Alistair Payne
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DATE OF PANEL DECISION 2023-05-08

Publish the Decision
