

ADMINISTRATIVE PANEL DECISION

Universal Music Group v. “Steven Carless, Universal Music Group” Case No. D2022-3126

1. The Parties

The Complainant is Universal Music Group, United States of America (“United states”), represented by Lane IP Limited, United Kingdom.

The Respondent is “Steven Carless, Universal Music Group”, United States.

2. The Domain Name and Registrar

The disputed domain name <uptownrecords.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 24, 2022. On August 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 26, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 30, 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 September 5, 2022.

The Complainant requested the suspension of the proceeding, which was suspended on September 5, 2022. Upon request of the Complainant, the proceeding was reinstated on December 9, 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 December 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the commencement of Panel appointment process on January 5, 2023.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on January 12, 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 Complaint names the Complainant as “Universal Music Group” of the United States and refers to several different corporate entities. According to the Complainant’s principal website at “www.universalmusic.com”, the group’s parent corporation is a Dutch public company with corporate headquarters in Hilversum, Netherlands and operational headquarters in Santa Monica, California. The Complaint refers to two United States subsidiaries incorporated in the State of New York, Universal Music Group Holdings, Inc. (incorporated in 1991) and Universal Music Group, Inc. (incorporated in 2005), which hold or are licensed to use various trademarks used by the group. Another United States subsidiary, UMG Recordings, Inc. (a Delaware corporation headquartered in Santa Monica, California), also holds the registered UPTOWN trademark, as shown below. As these entities are related in ownership and interests, the Panel refers to them collectively as the “Complainant”.

The Complainant is one of the world’s largest music companies, recording and distributing the works of many musical artists since the 1990s after acquiring the libraries of Decca Records and other record labels. The Complainant has operated the Complainant’s website mentioned above since 2000, as well as other websites including “www.umgcatalog.com” and “www.umusicpub.com”.

The Complaint recounts that “Uptown Records” was a record label founded in 1986 by rapper Andre Harrell. It was part of MCA Records, a major entertainment conglomerate that was later acquired by the Complainant. The Complaint reports that approximately 27 records sold under the “Uptown Records” label from 1986 through 1994 became “gold records” (more than 500,000 copies sold) or “platinum records” (more than one million sold). Two of the best-known artists recorded under the “Uptown Records” label are Mary J. Blige and Sean John Combs (aka Puff Daddy/P Diddy), who both refer to the “Uptown Records” label on their current websites. The Complainant also refers to the “Uptown Records” label on its three websites mentioned above.

The Complaint attaches multiple examples of media references to the “Uptown Records” label within the past five years, as well as evidence that the Complainant has used UPTOWN RECORDS to label records and compact disks sold online between 2006 and 2019. In 2017, the Complainant published a playlist labelled “UPMG Uptown Records” on its website at “www.umgcatalog.com”. In 2019, Black Entertainment Television (BET) produced a three-part television mini-series entitled “Uptown” on the history of the Uptown Records label. In May 2020, there was renewed public interest in the “Uptown Records” label following media coverage of the death of its founder Andre Harrell. The Complainant currently maintains “Uptown Records” accounts with followers on the Instagram, Twitter, and TikTok social media platforms.

The Complainant’s relevant trademark registrations include the following:

MARK	HOLDER	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE
UPTOWN (combined word and design) (application April 30, 1993) ¹	UMG Recordings, Inc.	Japan	3234910	December 25, 1996

¹ The Panel notes that a similar design mark is the subject of pending United States trademark applications by the Complainant, referring to prior United States registrations.

UPTOWN (combined word and design) (application April 30, 1993)	UMG Recordings, Inc.	Japan	3234911	December 25, 1996
UPTOWN (word) (application August 11, 2010)	UMG Recordings, Inc.	United Kingdom	UK00909308644	November 15, 2018
UPTOWN (word) (application August 11, 2010)	UMG Recordings, Inc.	European Union	9308644	November 15, 2018
UPTOWN (word) (claimed first use in commerce June 13, 1988)	UMG Recordings, Inc.	United States	5784529	June 25, 2019

The Registrar's Whois database shows that the disputed domain name was created on January 16, 1998. The disputed domain name was registered in the name of a domain privacy service, but after receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant name as Steven Carless, listing the registrant organization as Universal Music Group, with a postal address in New York, New York, United States and a "@me.com" email address.² The address given in New York is in fact the location of one of the Complainant's offices. The Panel notes that the online database of the New York Department of State lists only two legal entities with corresponding names currently or formerly registered to do business in the State of New York. Both of these entities are associated with the Complainant. Furthermore, the Panel notes that the name Steven Carless corresponds to a former senior executive employee of the Complainant. Moreover, although the disputed domain name was created in 1998, the Complaint attaches historical Whois records showing that "Universal Music Group" of New York acquired the disputed domain name on August 6, 2020.

Given these facts, the Panel refers to the Respondent as "Steven Carless, Universal Music Group" for the purposes of this proceeding only (according to the details provided in the Registrar's verification), and considers the registrant details to be fictitious. The Panel does not consider the Complainant, or any former employee of the Complainant, to be the registrant of the disputed domain name. The Panel also finds that the relevant date on which the Respondent acquired the disputed domain name is August 6, 2020.

The Complaint attaches a screenshot of the landing page associated with the disputed domain name at the time the Complaint was filed. That website displayed pay-per-click ("PPC") advertising links to third-party sites, including those selling music albums in competition with the Complainant. At the time of this Decision, the disputed domain name redirects to a third-party site flagged by antivirus software for malware threats.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name "wholly comprises the Complainant's name and contains its registered trade mark" UPTOWN and asserts that "the Complainant has rights in and a reputation as UPTOWN RECORDS".

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent has no corresponding name and makes no *bona fide* commercial offering or fair use in connection with the disputed domain name.

² The Complainant's representative submitted a simple amendment merely adding the registrant details provided by the Registrar as the Respondent.

The Complainant contends further that the Respondent's registration of the disputed domain name using an organization name matching the Complainant's name, and giving as its address one of the Complainant's office addresses, is an effort to impersonate the Complainant and is an indication of bad faith. The Complainant cites the Respondent's subsequent use of the disputed domain name for PPC advertising, particularly for competing music album sales, as further evidence of bad faith. Finally, the Complainant argues that the nameservers associated with the disputed domain name (with hosts such as "www.buydomains.com" and "www.this-domain-for-sale.com") indicate that the Respondent continues to be interested chiefly in selling the disputed domain name and has "no legitimate interest in or use for" the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (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. Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A. Identical or Confusingly Similar

The first element of a UDRP complaint "functions primarily as a standing requirement" and entails "a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant states that the disputed domain name "wholly comprises the Complainant's name and contains its registered trade mark". This statement clearly refers to the Complainant's registered UPTOWN trademark, but it is not clear what the Complainant means by saying that the disputed domain name wholly comprises the "Complainant's name", as the record in this proceeding does not indicate that the Complainant currently operates under the name "Uptown Records". In any event, in this UDRP proceeding the name "Uptown Records" is relevant only if the Complainant can demonstrate that it is a "trademark or service mark" in which the Complainant "has rights".

The Complaint repeatedly refers to "Uptown Records" as a historic "record label" acquired by the Complainant and offers evidence of sales and publicity under that name in recent years, as well as in earlier decades when a predecessor company was actively producing albums under that name. The Panel notes that in the music industry, a "record label" may refer to a record company or publisher or to its brand – or both. The Complaint does assert at one point that the Complainant "has rights in and a reputation as UPTOWN RECORDS". The Panel finds sufficient evidence to conclude that UPTOWN RECORDS acquired distinctiveness ("secondary meaning") as a common law mark branding music recordings produced under the UPTOWN RECORDS label in the 1980s and 1990s and subsequently distributed by the Complainant in various media. Despite the lack of specific sales and advertising figures, the record in this proceeding includes substantial evidence of trademark use of the mark in advertising, sales, publicity, and recognition in mass media and industry awards, as well as a continuing presence online and in social media. See [WIPO Overview 3.0](#), section 1.3 (evidence of unregistered or common law marks).

In any event, the Complainant has also provided clear evidence of registered trademark rights in the UPTOWN mark.

The disputed domain name is identical to the Complainant's common law UPTOWN RECORDS mark (apart from the space between the words that cannot be included in domain name system addresses for technical reasons) and incorporates the Complainant's registered UPTOWN mark in its entirety (with the mere addition of the term "records", which would not prevent a finding of confusing similarity). As usual, the addition of the Top-Level Domain ".com" may be disregarded as a standard registration requirement (see *id.* section 1.11.1).

The Panel finds that the disputed domain name is identical or confusingly similar to the Complainant's marks and concludes that the Complainant has established the first element of the Complaint.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

- (i) before any notice to it 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 has been commonly known by the domain name, even if it 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.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has demonstrated trademark rights and denies any association with the Respondent. The disputed domain name carries a high risk of implied affiliation with the Complainant, as it is identical to the Complainant's common law mark and entirely incorporates the Complainant's registered mark. See [WIPO Overview 3.0](#), section 2.5.1. The Respondent enhanced this implied affiliation by impersonating the Complainant's name, former employee, and address in the underlying registration contact details. The Complainant has shown that the disputed domain name has not been used for a *bona fide* commercial offering or legitimate noncommercial fair use but rather for PPC advertising, including links to competitors of the Complainant. Thus, the Complainant has made a *prima facie* case, and the burden of production shifts to the Respondent. The Respondent did not respond to the Complaint, and no rights or legitimate interests are evident from a perusal of the sites associated with the disputed domain name.

The Panel finds that the Respondent has failed to meet its burden of production and concludes that the Complainant prevails on the second element of the Complaint.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that "shall be evidence of the registration and use of a domain name in bad faith", including the following (in which "you" refers to the registrant of the domain name):

"(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other online 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 historical Whois record indicates that the Respondent acquired the disputed domain name in August 2020, when there was a resurgence of interest in UPTOWN RECORDS music following publicity surrounding the death of the founder of the “Uptown Records” label. The Respondent was clearly aware of the Complainant and the brand, as the underlying registration details for the disputed domain name falsely list the Complainant as the registrant organization, a former employee of the Complainant as the registrant name, and give the Complainant’s postal address in New York. The disputed domain name has since been used only for PPC advertising and redirection to other more dubious sites, meeting the example of bad faith described in the Policy, paragraph 4(b)(iv). It may be, as the Complainant suspects, that the Respondent anticipated ultimately reselling the disputed domain name, but the registration and use to date is sufficient to indicate bad faith within the meaning of the Policy.

The Panel finds bad faith on this record and concludes that the Complainant has established the third element of the Complaint.

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 <uptownrecords.com> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: January 30, 2023