

## **ADMINISTRATIVE PANEL DECISION**

Get Weird, LLC v. Contact Privacy Inc. Customer 0159486213 / Francesca Di Buono  
Case No. D2022-0519

### **1. The Parties**

The Complainant is Get Weird, LLC, United States of America (“United States”), represented by K&L Gates, LLP, United States.

The Respondent is Contact Privacy Inc. Customer 0159486213, Canada / Francesca Di Buono, Italy.

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

The disputed domain name <antisocialsocialclub.store> is registered with eNom, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2022. On February 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 15, 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 February 16, 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 February 21, 2022.

The Center verified that the Complaint together with 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 February 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 18, 2022.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on March 24, 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 operates since 2015 in the clothing and accessories industries, commercializing its products internationally over various online platforms as well as its own website “antisocialsocialclub.com”, under the trademark ANTI SOCIAL SOCIAL CLUB. The Panel under its general powers articulated, *inter alia*, in paragraph 10 of the Rules, has conducted various searches over the Internet regarding the Complainant and its business, and has visited the Complainant’s website “antisocialsocialclub.com”.

The Complainant owns a number of trademark registrations for the ANTI SOCIAL SOCIAL CLUB mark around the world, including:

- United States Trademark Registration No. 5,046,740, ANTI SOCIAL SOCIAL CLUB, word, registered on September 20, 2016, in Class 25;
- United States Trademark Registration No. 5,840,507, ANTI SOCIAL SOCIAL CLUB, figurative, registered on August 20, 2019, in Class 25, with the following stylized lettering:



And

- European Union Trade Mark Registration No. 018260581, ANTI SOCIAL SOCIAL CLUB, word, registered on November 27, 2020, in Classes 9, 10, 14, 21, 24, 28, 34, and 35, (collectively the “ANTI SOCIAL SOCIAL CLUB mark”).

The Complainant also owns the domain name <antisocialsocialclub.com> (registered on July 21, 2014), which resolves to its corporate website and online shop, where its goods are promoted and offered.

The disputed domain name was registered on September 29, 2020, and it is currently apparently inactive resolving to a blank page. According to the evidence provided by the Complainant, the disputed domain name has resolved to a website promoting and offering for sale clothing identified by the ANTI SOCIAL SOCIAL CLUB mark.

On January 16, 2022, the Complainant sent a cease and desist letter to the Respondent, receiving no response to this communication.

#### **5. Parties’ Contentions**

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

Key contentions of the Complaint may be summarized as follows:

Due to extensive use and promotion of the ANTI SOCIAL SOCIAL CLUB mark since 2015, the Complainant and its trademark have become a leading provider of streetwear fashion and clothing, developing a reputation in this field.

The disputed domain name is identical to the ANTI SOCIAL SOCIAL CLUB mark, being the generic

Top-Level Domain (“gTLD”) “store” a generic word that directly refers to the commercialization of the Complainant’s products and services.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has never licensed or approved the use of its trademark by the Respondent. The Respondent does not own any trademark registration or any company with this name “anti social social club”. Searches on the CompuMark Saegis trademark and company name database, list the Respondent as the owner of only an Italian trademark pending application filed on October 10, 2021 (Italian Trademark Application No.3020210001747734, 4ΠΤΪ SØ@t4Γ SØ@t4Γ ©IÜß, figurative, in Classes 14, 28, and 25), which is under examination, which does not establish rights or legitimate interests in the disputed domain name. This trademark application was filed to take advantage of the Complainant’s reputation. The disputed domain name has not been used in connection with a *bona fide* offering of goods or services, but in connection with a site that competes with the Complainant for overlapping goods and services, which does not constitute use in connection with a *bona fide* offering of goods or services under the Policy. The Respondent uses the disputed domain name to impersonate the Complainant, pretending to be a genuine retailer, violating the Complainant’s Terms and Conditions and infringing the Complainant’s trademark, to increase the traffic of the Respondent’s site for commercial purposes, to sell competing goods.

The disputed domain name was registered and is being used in bad faith. The disputed domain name was registered over four years after the first use and registration of the ANTI SOCIAL SOCIAL CLUB mark. The Respondent has deliberately attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant and its trademark. The disputed domain name deliberately incorporates Complainant’s well-known trademark, with the mere addition of the gTLD “.store”. Bad faith can be inferred by use of a privacy shield to conceal the Respondent’s identity, and is evidenced by the use of the disputed domain name to sell counterfeit products. The Respondent’s website offers counterfeit products (cheap knock-offs), instead of the Complainant’s high-quality products.

The Complainant has cited previous decisions under the Policy and various sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) that it considers supportive of its position, and requests the transfer of the disputed domain name.

The Complainant discloses that the use of the disputed domain name is involved in litigation before the Court of Genoa, Italy, in the case *Weird, LLC. v. Anti Social Social Club Srls*, Docket No. 10296/2021, which is a “cautionary provisional proceeding”, similar to a preliminary injunction. In this proceeding, the Complainant alleges that the defendant (Anti Social Social Club Srls) has denied ownership of the disputed domain name. This action is limited to the cessation of any use of the disputed domain name, along with other domain names not included in the Complaint.

## **B. Respondent**

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

## **6. Discussion and Findings**

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material, and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

### **A. Court Proceedings**

Paragraph 18(a) of the UDRP Rules gives the Panel discretion to suspend, terminate, or continue a UDRP proceeding where the disputed domain name is also the subject of other pending legal proceedings. See

section 4.14 of the [WIPO Overview 3.0](#).

The Complainant has disclosed the existence of a Court proceeding related to the use of the disputed domain name, which do not refer to the potential transfer or cancellation of the disputed domain name, and in which the Respondent is not a party. According to the Complaint, the party against which the court proceeding was initiated has denied ownership of the disputed domain name.

It is unclear to the Panel what is the relationship between the Respondent and such party, if any. However, the Panel will refer to any use of the disputed domain name for the purposes of this proceeding as the Respondent's use.

The Panel considers that this court case do not interfere or overlap with this proceeding, which should therefore continue entering into the exam of merits of this case.

## **B. Identical or Confusingly Similar**

The Complainant indisputably has rights in the ANTI SOCIAL SOCIAL CLUB mark, both by virtue of its trademark registrations and as a result of its use of this trademark in the clothing and accessories industries.

The disputed domain name incorporates the ANTI SOCIAL SOCIAL CLUB mark in its entirety, adding the gTLD “.store”, which is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity. The ANTI SOCIAL SOCIAL CLUB mark is directly recognizable in the disputed domain name. See sections 1.7, 1.8, and 1.11 of the [WIPO Overview 3.0](#).

Accordingly, this Panel finds that the disputed domain name is identical to the Complainant's trademark, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

## **C. Rights or Legitimate Interests**

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that demonstrating 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 primarily if not exclusively within the respondent's knowledge. Thus, the consensus view is that paragraph 4(c) of the Policy shifts to the respondent the burden of production to come forward with relevant evidence of rights or legitimate interests in the disputed domain name, once the complainant has made a *prima facie* case that the respondent lacks rights or legitimate interests.

The Complainant's assertions and evidence in this case effectively shift the burden of production to the Respondent of producing evidence of rights or legitimate interests in the disputed domain name, providing the circumstances of paragraph 4(c) of the Policy, without limitation, in order to rebut the Complainant's *prima facie* case.

The Panel notes that the disputed domain name incorporates in its entirety the ANTI SOCIAL SOCIAL CLUB mark, being identical to this mark, which generates a risk of implied affiliation (and risk of confusion) with the Complainant and its trademark. In the Panel's view, the disputed domain name may give the impression that it is referred to a new online store of the Complainant or any business related company. In this respect, the gTLD “.store” along the use of the disputed domain name contributes to increase the implied affiliation and risk of confusion.

The Panel further notes that, according to the evidence provided by the Complainant, the disputed domain name has been used in connection to a website promoting and offering goods identified by the Complainant's trademark.

The Complainant further alleges that the goods promoted and offered in the Respondent's website are counterfeiting goods, illegally identified with the ANTI SOCIAL SOCIAL CLUB mark.

The Panel under its general powers articulated, *inter alia*, in paragraph 10 of the Rules, has consulted the Internet web archive WayBackMachine regarding the disputed domain name, corroborating that it has been used in connection to a website that displayed the ANTI SOCIAL SOCIAL CLUB figurative mark at its heading, which offered various clothing garments bearing this trademark. The Panel notes that the website that was linked to the disputed domain name did not contain any reference to the lack of relationship between the Parties, and it reproduced the look and feel or general appearance and combination of colors of that of the Complainant's official online store ("www.antisocialsocialclub.com"). The Panel further notes that the prices of the garments commercialized in the Respondent's website were similar to the prices of the same category of products commercialized in the Complainant's official online store ("www.antisocialsocialclub.com").<sup>1</sup>

As the website that was linked to the disputed domain name offered products bearing the ANTI SOCIAL SOCIAL CLUB mark, the Panel considers the doctrine related to nominative (fair) use by resellers, distributors or service providers. The consensus view of UDRP panels, following the "Okidata test" outlined in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), is that to establish a *bona fide* offering of goods or services in such circumstances, the Respondent must comply with certain requirements, including accurate and prominent disclosure of its relationship or lack of relationship with the trademark holder. See section 2.8 of the [WIPO Overview 3.0](#).

In the Panel's view, there was no such accurate and prominent disclosure in this case. The website that was linked to the disputed domain name was dominated by the ANTI SOCIAL SOCIAL CLUB mark in the same figurative representation registered by the Complainant, and reproduced the look and feel of the Complainant's official online store, omitting any reference to the lack of relationship with the Complainant or its trademark. Taken together with the use of the Complainant's trademark in the disputed domain name, the website gave the overall impression of some sort of official connection with the Complainant and/or its trademark, being the website of an official retailer or related company. Such use of the disputed domain name could not be said to be *bona fide*. Furthermore, the Panel notes that the terms and conditions available through the website at the disputed domain name referred to the terms of use as the "agreement between you [the Internet user] and Get Weird LLC [the Complainant]" in an attempt of furtherance the risk of confusion or the impression of the website being an official website of the Complainant.

The Panel, under its general powers, has further corroborated through a search over the WIPO Global Brand Database that, according to the evidence provided by the Complainant, the Respondent owns no trademark for the terms "anti social social club". The Respondent holds an Italian trademark application for a figurative trademark that may allude to the terms "anti social social club" but does not correspond to these terms. The Italian trademark application for the mark 4ΠΤĪ SØ©t4Γ SØ©t4Γ ©lUß, which is still pending at the time of this decision.<sup>2</sup> The Panel notes that the applied mark has the following figurative appearance:



It is further remarkable that the Respondent has not replied to the cease and desist letter or to the Complaint, not alleging or providing any evidence in connection to any rights or legitimate interests in respect of the disputed domain name. On the contrary, the Respondent's reaction to the Complaint has apparently

<sup>1</sup> The prices for the ANTI SOCIAL SOCIAL CLUB markgoods, both in the Complainant's official online store and in the website that was linked to the dispute domain name, are, e.g., around EUR 48 for a t-shirt, around EUR 80 for a hoodie, around EUR 20 for a pair of socks, and around EUR 48 for a cap.

<sup>2</sup> Italian Trademark Application No. 3020210001747734, ΠΤĪ SØ©t4Γ SØ©t4Γ ©lUß, figurative, in Classes 14, 28, and 25.

been to take down the website that was linked to the disputed domain name, which currently resolves to a blank page.

Under these circumstances, the Panel concludes that the Respondent has not rebutted the Complainant's *prima facie* case, and nothing in the case file gives reason to believe that the Respondent has or has had any rights or legitimate interests in respect of the disputed domain name. Therefore, the second element of the Policy under paragraph 4(a)(ii) has been established.

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

The Policy, paragraph 4(a)(iii), requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Panel notes the extensive use of the ANTI SOCIAL SOCIAL CLUB mark and its extensive presence over the Internet, being the Complainant's products internationally promoted and offered in various online platforms included the Amazon's platform. The Panel under its general powers has conducted various searches for the ANTI SOCIAL SOCIAL CLUB mark over the Internet.

The strong presence of the Complainant's trademark over the Internet makes unlikely, in view of the Panel, that the Respondent was not aware of the Complainant and its trademark in circumstances that a simple web search for the terms "anti social social club" on any search engine would have brought them up. Additionally, the Panel notes that the Respondent operated (under the disputed domain name) a retailer website related specifically to the Complainant's products displaying the ANTI SOCIAL SOCIAL CLUB mark in its heading, which clearly supports the conclusion that the Respondent was aware of the Complainant and its trademark, and targeted them when it registered and used the disputed domain name.

The Panel further notes that the disputed domain name is identical to the ANTI SOCIAL SOCIAL CLUB mark, and it has been used for a website that has offered the various clothing garments bearing the ANTI SOCIAL SOCIAL CLUB mark, displaying the Complainant's figurative trademark in its heading and reproducing the Complainant's official website look and feel. The Panel is not able to determine with the evidence on record whether the goods offered in the Respondent's website were authentic or counterfeits, also noting that the prices for the goods in both websites are similar. In any case, the target to the Complainant and its trademark is clear, and the Panel finds that the Respondent has registered and used the disputed domain name to take advantage of its significance as a trademark owned by the Complainant.

It is further remarkable that the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain name, and has not come forward to deny the Complainant's assertions of bad faith. The Respondent's reaction to the Complaint has apparently been to take down the website that was linked to the disputed domain name.

Taking all the above circumstances into account, and in the absence of any evidence to the contrary, the Panel is satisfied that it is more likely than not that the Respondent was aware of the Complainant's ANTI SOCIAL SOCIAL CLUB mark and of its goodwill in the field of clothing and fashion accessories, when it registered the disputed domain name, having registered it to take unfair advantage of its identity with the Complainant's trademark. The Panel concludes that the Respondent has registered and used the disputed domain name in an attempt to exploit the Complainant's goodwill generating an implied affiliation and confusing Internet users to increase the traffic of its website for a commercial gain, and disrupting the Complainant's business. All circumstances in this case indicate that the Respondent has intentionally attempted to mislead third parties, in order to generate traffic to his website with a commercial purpose and to compete with the Complainant.

In light of the above, taking into consideration all cumulative circumstances of this case, on the balance of probabilities, the Panel concludes that the Complainant has met its burden of establishing that the disputed domain name has been registered and is being used in bad faith under 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 <antisocialsocialclub.store> be transferred to the Complainant.

*/Reyes Campello Estebaranz/*

**Reyes Campello Estebaranz**

Sole Panelist

Date: April 7, 2022