

ADMINISTRATIVE PANEL DECISION

Louis Tomlinson v. Privacy service provided by Withheld for Privacy ehf /
Aamir Ali, Aamir
Case No. D2022-1389

1. The Parties

The Complainant is Mr. Louis Tomlinson, United Kingdom, represented by Demys Limited, United Kingdom.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Aamir Ali, Aamir, Pakistan.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 19, 2022. On April 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 19, 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 April 20, 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 April 20, 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 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 Isabelle Leroux as the sole panelist in this matter on May 20, 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 Louis Tomlinson, a singer and songwriter, best known as a former member of the popular British band “One Direction” since 2010. As of 2020, the band has sold over 200 million records worldwide.

The Complainant also benefits from individual fame as he debuted his solo career in 2016. He released his debut album “Walls” in 2020, which sold 35,000 copies upon its release.

For the needs and purposes of its activities, the Complainant is the owner of several trademarks including his name, including the following:

- United Kingdom word trademark, LOUIS TOMLINSON, No. 00910341031 registered on February 22, 2012 for goods and services in classes 3, 16, 25 and 28 and duly renewed;
- European Union word trademark, LOUIS TOMLINSON, No. 010341031 registered on February 22, 2012 for goods and services in classes 3, 16, 25 and 28 and duly renewed;
- International word trademark, LOUIS TOMLINSON, No. 1398194, designating Australia, Japan, Mexico and the United States of America, filed on June 1st, 2017, under priority of the European Union trademark no. 010341031 and registered for goods and services in classes 9, 16, 25 and 41;

Hereafter the “Trademarks” or “Trademark”

The Complainant also appears to operate the following domain names, although it did not provide any registration certificates:

<louis-tomlinson.com>
<merch.louis-tomlinson.com>.

The Disputed Domain Name <louistomlinsonmerch.com> was registered on December 16, 2020 and reverts to an online shop selling clothing goods.

5. Parties’ Contentions

A. Complainant

The Complainant claims that:

a) the Disputed Domain Name is identical or at least confusingly similar to the Complainant’s Trademarks since it only differs by the lack of space between “louis” and “tomlinson” and the descriptive term “merch” presumably as a contraction of the word “merchandise”.

The Complainant outlines that for technical reasons, white spaces cannot be included in a domain name and can therefore either be replaced by a hyphen or removed completely as it is the case with the Disputed Domain Name.

b) the Respondent has no rights nor legitimate interests in the Disputed Domain Name since:

- The Respondent does not own any LOUIS TOMLINSON or LOUIS TOMLINSON MERCH trademarks;
- The Respondent is not commonly known by the Disputed Domain Name, nor has he ever traded legitimately under the business names “LOUIS TOMLINSON” or “LOUIS TOMLINSON MERCH”;
- The Respondent is not a licensee of the Complainant and has not received any permission or consent by the Complainant to use the Trademarks;

- The offering of merchandise by the Respondent on the website to which the Disputed Domain Name reverts cannot be construed as a *bona fide* offering of goods and services since the goods offered are probably counterfeited and, in any case the website is designed to attract and mislead users in believing that the goods come from the Complainant;
- The Respondent's identity is redacted on Whois and its contact details are not available on the website.

c) the Respondent has registered and is uses the Disputed Domain Name in bad faith given the following factors:

- The Disputed Domain Name is at first glance confusing average Internet users since it fully incorporates the well-known Trademarks LOUIS TOMLINSON of the Complainant, differing only in the removal of the space separating the two names and the addition of the term "merch";
- The Disputed Domain name was registered a few days after a record-breaking concert of the Complainant. It is therefore inconceivable to the Complainant that the Respondent did not have him clearly in mind when registering the Disputed Domain Name;
- The website to which the Disputed Domain Name reverts is intentionally confusing to the average Internet user as it reproduces the Trademarks, and uses the same logos and designs as the official legitimate merchandise online shop of the Complainant;
- The website to which the Disputed Domain Name reverts appears to be selling counterfeited goods related to the Complainant;
- The Respondent seems to have registered the Disputed Domain Name in order to take advantage of the Complainant's reputation and mislead Internet users into visiting its website rather than the Complainant's.

Therefore, according to the Complainant, the Respondent had knowledge of the Complainant's trademark when registering the Disputed Domain Name, and the Respondent is unfairly and intentionally taking advantage of the reputation of the Complainant's earlier rights in order to mislead Internet users.

Finally, 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

A. Identical or Confusingly Similar

First of all, the Panel finds that the Complainant has provided evidence that it has prior rights on the Trademarks and that they have been filed and registered several years before the Disputed Domain Name.

Then, the Panel notices that the Disputed Domain Name is composed of the identical reproduction of the Trademarks in their entirety, to which has been added the term "merch".

The addition of the descriptive term "merch" to designate merchandise does not avoid a finding of confusing similarity.

Furthermore, the gTLD ".com" is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Consequently, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademarks. The first element of the paragraph 4(a)(i) of the Policy is thus fulfilled.

B. Rights or Legitimate Interests

Numerous UDRP panels have found that, even though the Complainant bears the general burden of proof under paragraph 4(a) (ii) of the UDRP, the burden of production shifts to the Respondent once the Complainant makes a *prima facie* showing that the Respondent lacks rights or legitimate interests. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Hence, after the Complainant has made a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name, it will be deemed to have satisfied paragraph 4(a)(ii) of the UDRP when the Respondent fails to submit a response.

In this case, the Complainant brings forward the following elements:

- No license or permission has been granted by the Complainant to the Respondent and
- There is no evidence that the Respondent is known under the Disputed Domain Name, has ever traded legitimately under it, as a business name, nor that he ever had any trademark rights on such name; and
- The Complainant has no relationship whatsoever with the Respondent.

In addition, while the Disputed Domain Name reverts to a website offering for sale goods relating to the Complainant, the Panels finds that there are sufficient indications that this offering is not a *bona fide* offering of goods and services. Indeed, the website shows logos and designs affixed on goods also used on the official legitimate merchandise online shop of the Complainant found at <merch.louis-tomlinson.com>.

Therefore, the Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

The Respondent has not responded to the Complainant's contentions and therefore not proved otherwise.

Given these circumstances, the Panel finds that the second element of the paragraph 4(a) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the Disputed Domain Name was registered and is being used by the Respondent in bad faith.

First of all, regarding the registration of the Disputed Domain Name in bad faith, the Panel finds that the Complainant's Trademarks are highly distinctive. This distinctiveness has been previously established by a previous UDRP Panel. See *Louis Tomlinson c/o Lee & Thompson LLP v. Whois Privacy, Private by Design, LLC / minh pham Cardinal*, WIPO Case No. [D2021-1542](#).

The Complainant also sufficiently showed that the Complainant is a well-known artist for several years, in particular through the number of followers his social media accounts evidence (Annex 5 of the Complaint). The Complainant and his Trademarks are obviously linked for the average Internet user, since they cover and are identical to his name.

Given these elements and the high similarity, of the Disputed Domain Name with the Complainant's earlier Trademarks, the Panel finds that the registration of the Disputed Domain Name by the Respondent cannot be a mere coincidence. Furthermore, these elements actually suggest that it was registered with a deliberate intent to mislead Internet users and/or to create an impression of an association with the Complainant.

As to the use of the Disputed Domain Name in bad faith, paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a panel to be evidence of bad faith registration and use of a domain name. It provides that for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but

without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

“(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

In this case, the Disputed Domain Name resolving to a website featuring the Complainant’s Trademarks, logos and designs, and offering allegedly fake goods bearing the Complainant’s trademark LOUIS TOMLINSON for sale clearly demonstrates that the Respondent was aware of, and intended to target, the Complainant and his Trademarks with a deliberate intent to mislead Internet users for his commercial gain.

The Respondent’s failure to formally reply to the Complainant’s contentions give no other basis to the Panel to believe that the Disputed Domain Name might conceivably be put to good faith use.

Consequently, the Panel finds that the Disputed Domain Name was registered and used in bad faith, so that the third and final element of paragraph 4(a) of the Policy is met.

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 <louistomlinsonmerch.com> be transferred to the Complainant.

/Isabelle Leroux/

Isabelle Leroux

Sole Panelist

Date: June 3, 2022