

## **ADMINISTRATIVE PANEL DECISION**

### **Gibson Brands, Inc. v. Mayandican, Mayandican Case No. D2022-2626**

#### **1. The Parties**

Complainant is Gibson Brands, Inc., United States of America (“United America”), represented by Bates & Bates LLC, United States.

Respondent is Mayandican, Mayandican, United States.

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

The disputed domain name <epiphone-sale.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 19, 2022. On July 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 21, 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 Complainant on July 25, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on July 25, 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 Respondent of the Complaint, and the proceedings commenced on July 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 18, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 22, 2022.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on August 30, 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**

Complainant is the owner of registration of the word and design trademark EIPHONE on the Principal Register of the United States Patent and Trademark Office (“USPTO”), registration number 0964189, registration dated July 17, 1973, in international class (“IC”) 15, covering stringed musical instruments, specifically guitars, electric guitars, banjos and mandolins. Complainant is the owner of registration for word trademark EIPHONE, registration number 1957393, registration dated February 20, 1996, in ICs 9 and 15, covering amplifiers for electric guitars and stringed musical instruments, as further specified. Complainant has provided a list of registrations for the trademark EIPHONE in a substantial number of countries other than the United States.<sup>1</sup>

Complainant develops, manufactures and sells musical instruments and it has long used the EIPHONE trademark in connection with the marketing and sale of guitars and other stringed instruments. Complainant operates a commercial website at “www.epiphone.com” at which it offers guitars for sale, and which was initially created in 1995. The Panel takes administrative notice that the EIPHONE trademark is well known among purchasers and users of guitars and other stringed instruments.

According to the Registrar’s verification, Respondent is registrant of the disputed domain name. According to an ICANN Lookup provided by Complainant, the record of registration for the disputed domain name was created on April 12, 2022. There is no indication on the record of this proceeding that any party other than Respondent has owned or controlled the disputed domain name since the date of registration.

Respondent has used the disputed domain name to direct Internet users to a website that substantially replicates or clones Complainant’s commercial website. Respondent’s clone website prominently displays Complainant’s stylized EIPHONE trademark and offers new EIPHONE-branded guitars for sale. There is nothing on the screenshots of Respondent’s clone website (furnished by Complainant) that appears to distinguish that website from Complainant’s commercial website, *e.g.*, a prominent disclaimer by Respondent of affiliation with Complainant. In its Complaint, Complainant states on information and belief that Respondent is selling counterfeit EIPHONE-branded guitars.<sup>2</sup>

#### **5. Parties’ Contentions**

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

Complainant alleges that it owns rights in the EIPHONE trademark and that the disputed domain name is confusingly similar to that trademark.

Complainant contends that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Respondent’s use of the disputed domain name falsely suggests affiliation with Complainant; (2) the disputed domain name fully incorporates Complainant’s trademark; (3) Complainant has not authorized, licensed or otherwise permitted Respondent to use its trademark on its website, and; (4) Complainant does not have any type of business relationship with Respondent.

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<sup>1</sup> The Panel confirmed on the USPTO TESS database the two registrations for Complainant’s trademark listed in the text above. Panel visit of September 3, 2022.

<sup>2</sup> Complainant has not provided specific evidence of Respondent’s sale of counterfeit guitars.

Complainant argues that Respondent registered and is using the disputed domain name in bad faith because: (1) Respondent is using Complainant's famous EPIPHONE trademark in its entirety without authorization; (2) Respondent has hidden its true identity; (3) Respondent is attempting to trade off the goodwill that Complainant has established in its trademark, and; (4) Respondent is not making a legitimate use of Complainant's trademark.

Complainant requests the Panel to direct the registrar to transfer the disputed domain name to Complainant.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

The registration agreement between Respondent and the Registrar subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, one of which is the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email addresses provided in its record of registration. Courier delivery of the Written Notice to Respondent could not be undertaken because of manifestly incomplete and inaccurate contact information in Respondent's record of registration. There is no indication of problems with the transmission to Respondent of email. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) 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.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

### **A. Identical or Confusingly Similar**

Complainant has provided substantial evidence of rights in the word, and word and design, trademark EPIPHONE, including by registration at the USPTO and through use in commerce. See Factual Background, *supra*. Respondent has not attempted to challenge Complainant's assertion of rights. The Panel determines that Complainant has established rights in the trademark EPIPHONE.

The disputed domain name directly and fully incorporates Complainant's trademark, and this is sufficient to establish confusing similarity under the Policy. Addition by Respondent of the term "-sale" to Complainant's trademark in the disputed domain name does not prevent a finding of confusing similarity. The Panel determines that the disputed domain name is confusingly similar to Complainant's trademark.

The Panel determines that Complainant has established rights in the trademark EPIPHONE and that the disputed domain name is confusingly similar to that trademark.

## **B. Rights or Legitimate Interests**

Complainant's allegations to support Respondent's lack of rights or legitimate interests in the disputed domain name are outlined above, and the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name.

Respondent has not replied to the Complaint and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

Respondent has created a website that is very substantially a replication or clone of Complainant's commercial website, appearing to offer new EPIPHONE-branded guitars for sale. That website is identified by the disputed domain name, which is confusingly similar to Complainant's trademark.

Presumably there are circumstances in which authorized third-party retailers of Complainant's new EPIPHONE-branded guitars are permitted to use Complainant's trademark in the online advertising and sale of Complainant's products. The record does not indicate whether Complainant has authorized any third party to use its trademark in a domain name. Whether or not Complainant has done so is not relevant here.

Complainant has stated that Respondent has not been authorized to use its trademark in any way, and Respondent has not challenged that assertion. Respondent, by creating a website that replicates the appearance of Complainant's commercial website, by using Complainant's distinctive stylized logo on that website and by failing to provide any notification to Internet users that it is not an authorized retailer of Complainant's products, has gone beyond a plausible claim of fair commercial use of Complainant's trademark in the disputed domain name.

Complainant on information and belief alleges that Respondent is selling "counterfeit" versions of Complainant's products on Respondent's website. Such use by Respondent would further and manifestly undercut a claim of fair commercial use by Respondent. A factual finding of selling counterfeit products is not necessary under the circumstances here to establish that Respondent is not fairly using Complainant's trademark.

Respondent's use of the disputed domain name does not otherwise manifest rights or legitimate interests.

Respondent's registration and use of the disputed domain name to establish a website replicating Complainant's commercial website and using Complainant's well-known trademark on that website to sell Complainant's branded products without authorization by Complainant does not establish rights or legitimate interests on the part of Respondent. The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

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

In order to prevail under the Policy, Complainant must demonstrate that the disputed domain name "has been registered and is being used in bad faith" (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy states 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". These include that, "(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online

location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location".

Complainant's EPIPHONE trademark was well known and distinctive at the time Respondent registered and used the disputed domain name. Respondent's creation of a website that substantially clones Complainant's website is clear evidence of Respondent's awareness of Complainant's rights in its trademark.

Respondent is using the disputed domain name that is confusingly similar to Complainant's trademark to attract Internet users to Respondent's website to offer for sale products branded with Complainant's trademark. Respondent is not in any way authorized by or affiliated with Complainant. Such use by Respondent creates a likelihood of confusion for Internet users regarding Complainant acting as source, sponsor, affiliate or endorser of Respondent's website. Respondent has not attempted to justify its conduct.

The Panel determines that Respondent registered and is using the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) 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, <epiphone-sale.com>, be transferred to Complainant.

*/Frederick M. Abbott/*

**Frederick M. Abbott**

Sole Panelist

Date: September 12, 2022