

ADMINISTRATIVE PANEL DECISION

TBNR, LLC. v. Abdullah Mahmood
Case No. D2022-4390

1. The Parties

Complainant is TBNR, LLC., United States of America (“United States”), represented by Brackett & Ellis, P.C., United States.

Respondent is Abdullah Mahmood, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <prestonfiremerch.shop> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 17, 2022. On November 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 18, 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 November 21, 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 November 22, 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 November 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2022. Respondent did not submit any formal Response. The Respondent sent an informal communication on November 22, 2022.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on January 9, 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

Complainant is a company organized under the laws of the United States which provides retail store services, including clothing.

Complainant has provided evidence that it is the registered owner of various trademarks, *inter alia*, but not limited to the following:

- Word mark PRESTONS STYLEZ, United States Patent and Trademark Office (USPTO), registration number: 5,108,401, registration date: December 27, 2016, status: active;
- Word mark FIRE MERCH, USPTO, registration number: 6,746, 627, registration date: May 31, 2022, status: active.

Moreover, Complainant has demonstrated to own various domain names relating to its PRESTONS STYLEZ and FIRE MERCH trademarks, e.g. the domain names <prestonsstylez.com> (since 2015) and <firemerch.com> (since 2020), through which Complainant operates websites providing retail store services featuring clothing, toys, and electronics.

Respondent, according to the disclosed Whois information for the disputed domain name, is a resident of Pakistan who registered the disputed domain name on October 19, 2022. By the time of rendering this Decision, the disputed domain name does not resolve to any content on the Internet. Complainant, however, has demonstrated that at some point before the filing of the Complaint, the disputed domain name resolved to a website at “www.prestonfiremerch.shop” featuring clothing and utilizing the same color scheme as on Complainant’s official websites, including a stylized flame (registered as a further trademark for Complainant) as well as photos taken from those websites.

Complainant requests that the disputed domain name be transferred to Complainant.

5. Parties’ Contentions

A. Complainant

Complainant contends to have used its PRESTONS STYLEZ trademark continuously since November 29, 2010, which is more than 10 years before Respondent registered the disputed domain name.

Complainant submits that the disputed domain name is confusingly similar to its PRESTONS STYLEZ, and FIRE MERCH trademarks, as it combines both of them and is, therefore, similar in appearance, sound and meaning to those trademarks. Moreover, Complainant asserts to have found no evidence allowing to conclude that Respondent has any rights or legitimate interests in respect of the disputed domain name. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) Respondent registered the disputed domain name more than 10 years after Complainant began using its PRESTONS STYLEZ trademark and at least two years after Complainant began using its FIRE MERCH trademark, and (2) Respondent’s website under the disputed domain name utilizes the same color scheme, registered trademarks, and owner-photos as Complainant’s website which is why it appears that Respondent intends to deceive consumers placing orders on this website when those consumers are seeking Complainant’s website.

B. Respondent

Respondent did not reply formally to Complainant's contentions. Respondent sent an informal communication on November 22, 2022, mentioning that the website was created for fans, being Respondent a fan himself.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that the disputed domain name, namely <prestonfiremerch.shop>, is confusingly similar to the PRESTONS STYLEZ and FIRE MERCH trademarks in which Complainant has rights.

The disputed domain name incorporates the PRESTONS STYLEZ trademark partially and the FIRE MERCH trademark even entirely. Numerous UDRP panels have recognized that where a domain name incorporates a trademark in its entirety, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that trademark (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7). Moreover, it has been held in many UDRP decisions and has become a consensus view among UDRP panels (see [WIPO Overview 3.0](#), section 1.11) that the applicable Top-Level Domain ("TLD") in a domain name is generally viewed as a standard registration requirement and as such is disregarded under the first element test. Accordingly, the existence of the generic TLD ".shop" does not dispel the finding of confusing similarity arising from the partial incorporation of Complainant's PRESTONS STYLEZ trademark combined with the entire incorporation of Complainant's FIRE MERCH trademark in the disputed domain name.

Therefore, Complainant has established the first element under the Policy as set forth by paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Panel is further convinced on the basis of Complainant's undisputed contentions that Respondent has not made use of the disputed domain name in connection with a *bona fide* offering of goods or services, nor has Respondent been commonly known by the disputed domain name, nor can it be found that Respondent has made a legitimate noncommercial or fair use thereof without intent for commercial gain.

Respondent apparently has neither been granted a license nor has it been otherwise authorized by Complainant to use its PRESTONS STYLEZ and/or FIRE MERCH trademarks, either as a domain name or in any other way. Also, there is no reason to believe that Respondent's name somehow corresponds with the disputed domain name and Respondent does not appear to have any trademark rights associated with the terms "Preston" and/or "Fire Merch" on its own. To the contrary, Respondent, at some point before the filing of the Complaint was running a website under the disputed domain name at "www.prestonfiremerch.shop", featuring clothing and utilizing the same color scheme, a stylized flame (registered as a further trademark for Complainant) as well as photos taken from Complainant's official websites without any authorization to do so. Such making use of the disputed domain name neither qualifies as *bona fide* nor as legitimate noncommercial or fair within the meaning of the Policy.

Moreover, the nature of the disputed domain name combining two of Complainant's trademarks (the PRESTONS STYLEZ trademark partially and the FIRE MERCH trademark even entirely) is inherently misleading and carries a risk of an implied affiliation as it effectively suggests sponsorship or endorsement

by Complainant which is not the case (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, Complainant has established a *prima facie* case that Respondent has no rights or legitimate interests in respect of in the disputed domain name. Now, the burden of production shifts to Respondent to come forward with appropriate allegations or evidence demonstrating such rights or legitimate interests (see [WIPO Overview 3.0](#), section 2.1). Respondent seems to be claiming that the disputed domain name was registered for fans, and while the website includes terms such as “PRESTON Hot Selling Fan Merch”, the Panel notes that Respondent has used it basically as a commercial website without a prominent disclaimer of the relationship (or lack thereof) with Complainant.

The Panel, therefore, finds that Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

C. Registered and Used in Bad Faith

The Panel finally holds that the disputed domain name was registered and is being used by Respondent in bad faith.

Though Complainant contends to have used e.g. its PRESTONS STYLEZ trademark continuously since November 29, 2010, it does not claim that any relevant degree of distinctiveness or reputation is connected thereto. Still, Respondent by combining two of Complainant’s trademarks (the PRESTONS STYLEZ trademark partially and the FIRE MERCH trademark even entirely) has nevertheless clearly demonstrated knowledge of Complainant and its trademarks when registering the disputed domain name and that the latter is obviously targeting these very trademarks. Moreover, using the disputed domain name to run a website featuring clothing and utilizing the same color scheme, a stylized flame (registered as a further trademark for Complainant) as well as photos taken from Complainant’s official websites without any authorization to do so, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with Complainant’s PRESTONS STYLEZ and FIRE MERCH trademarks as to the source, sponsorship, affiliation or endorsement of Respondent’s website. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel concludes that Complainant has also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

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, <prestonfiremerch.shop>, be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: January 19, 2023