

ADMINISTRATIVE PANEL DECISION

TBNR, LLC v. Hasnat Ahmad Java

Case No. D2022-4867

1. The Parties

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

The Respondent is Hasnat Ahmad Java, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <firemerchandise.shop> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 19, 2022. On December 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 20, 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 (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 28, 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 December 28, 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 January 10, 2023. The Respondent sent a number of informal emails to the Center dated January 11, 13 and 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2023. No formal Response was filed with the Center.

The Center appointed Steven A. Maier as the sole panelist in this matter on February 27, 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.

On January 16, 2023, in response to emails from the Respondent, the Center sent an email to the Parties pursuant to Rules, paragraph 17, explaining that a UDRP proceeding may be suspended to implement a settlement agreement between the Parties. However, no request was made by the Complainant to explore settlement options. As such the proceeding continue to a decision.

4. Factual Background

The Complainant is a limited liability company organized under the laws of Texas, United States. The Complainant operates an online store at “www.firemerch.com” under the name and trademark FIRE MERCH, offering t-shirts, hoodies, toys, and accessories.

The Complainant is the owner of several United States trademark registrations for the word mark FIRE MERCH, including United States trademark registration number 6746456 for that word mark, registered on May 31, 2022, for goods and services including clothing in International Class 25.

The Complainant is also the registrant of United States trademarks for a distinctive “flame” design.

The disputed domain name was registered on September 21, 2022.

According to evidence submitted by the Complainant, the disputed domain name has resolved to a website headed “FIRE MERCH LIMITED COLLECTION IS HERE!” and offering a range of t-shirts, hoodies and other merchandise for sale. At the time of the decision, the disputed domain name has resolved to the registrar-parking page. On the top of the page it states “This domain is parked free of charge with NameSilo.com”.

5. Parties’ Contentions

A. Complainant

The Complainant submits that it has used the mark FIRE MERCH in commerce since March 2021, and has operated the website referred to above since October 2020. It provides printouts of that website content, including clothing featuring its trademarked “flame” design.

The Complainant submits that the disputed domain name is confusingly similar to its FIRE MERCH trademark. It observes that the disputed domain name includes the term “firemerch” and contends that the disputed domain name is similar in appearance, sound and meaning to its trademark.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that the Respondent has not commonly been known by the disputed domain name, has no relevant trademark rights and is making neither *bona fide* commercial use nor legitimate noncommercial or fair use of the disputed domain name.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. It provides printouts of the Respondent’s website, which it contends adopts a similar colour scheme and style as its own website. It submits that the Respondent’s website also uses its FIRE MERCH and distinctive “flame” trademarks and is plainly intended to deceive customers into believing they dealing with the Complainant. The Complainant submits, in particular, that the Respondent is attempting to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant’s trademark.

B. Respondent

The Respondent did not file a formal Response in the proceeding. In its informal emails to the Center, the Respondent repeatedly enquired what they needed to do in order to “get rid” of the disputed domain name and to settle the matter. The Panel observes that the actions available to the Respondent were, of course, clear from the communications received from the Center.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

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

A. Identical or Confusingly Similar

The Complainant has established that it has registered trademark rights in the mark FIRE MERCH.

The Panel finds that the trademark is recognizable within the disputed domain name, the remainder of which does not alter the clear impression that the Complainant’s trademark is recognizable in the disputed domain name.

The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

In the view of the Panel, the Complainant’s submissions set out above give rise to a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

However, the Respondent has failed to file a formal Response in this proceeding and has not submitted any explanation for its registration and use of the disputed domain name, or evidence of rights or legitimate interests on its part in the disputed domain name, whether in the circumstances contemplated by paragraph 4(c) of the Policy or otherwise. For the reasons set out below, the Panel finds that the Respondent has used the disputed domain name to impersonate the Complainant and its website, which cannot give rise to rights or legitimate interests on the Respondent’s part.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent has used the disputed domain name to operate a website, which prior to the Complaint, impersonated that of the Complainant. In particular, the website used the Complainant’s trademark FIRE MERCH in its heading, resembles the style and appearance of the Complainant’s website and offers merchandise similar to that sold by the Complainant, also adopting a “flame” design, which resembles that registered and used by the Complainant. The Panel infers in these circumstances that the Respondent registered the disputed domain name in the knowledge of the Complainant’s FIRE MERCH trademark and business and with the intention of taking unfair advantage of the Complainant’s commercial

goodwill. The Panel finds further that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

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, <firemerchandise.shop>, be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: March 8, 2023