

## **ADMINISTRATIVE PANEL DECISION**

Ronica Holdings Ltd v. Stukalov Bielerude, Merry-Go-Round  
Case No. D2023-2312

### **1. The Parties**

The Complainant is Ronica Holdings Ltd, British Virgin Islands, United Kingdom, represented by Russ August & Kabat, United States of America (“United States”).

The Respondent is Stukalov Bielerude, Merry-Go-Round, Rwanda.

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

The disputed domain name <deadmau5merch.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 27, 2023. On May 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 1, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 2, 2023, 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 June 2, 2023.

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 June 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2023.

The Center appointed Clive Duncan Thorne as the sole panelist in this matter on July 17, 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

The Complainant is Ronica Holdings Ltd which is a private company limited by shares and incorporated under the laws of the British Virgin Islands. The Complainant is owned and controlled by Joel Zimmerman who is professionally known as Deadmau5.

According to the Complainant he is a highly successful and internationally recognized electronic dance music artist, performer and producer. His stage name and trade mark DEADMAU5 has become widely recognized by fans and industry professionals alike.

His rise to fame began in the early 2000s when he began producing and releasing electronic dance music tracks on various online platforms. Over the years, he has amassed a substantial fan base and has been credited with popularizing the “progressive house” sub-genre of electronic dance music. He and his music have been featured in video games, movies, and television shows, and he has won numerous awards for his work, including six Grammy Award nominations and a JUNO Award for Electronic Album of the Year. According to the Recording Industry Association of America, he has earned multiple gold and platinum certifications for his music in the United States.

He has performed at some of the world’s most prestigious music festivals, such as Coachella, Lollapalooza, and Ultra Music Festival. He has also headlined his own tours, including the “Meowingtons Hax” and “Cube V3” tours which were both critically acclaimed and commercially successful.

In addition to his music career, he has also been involved in various business ventures including the creation of his own record label and merchandise featuring his distinctive mark DEADMAU5. He has also been involved in numerous philanthropic efforts including working alongside the Make-A-Wish Foundation and raising tens of thousands dollars for various charities. The success of these ventures has further cemented his status as a highly respected and influential figure in the music industry under the name and mark DEADMAU5.

The trade mark DEADMAU5 owned by the Complainant is well protected by registration throughout the world. A schedule of the Complainant’s marks worldwide is set out in the Complaint and more fully in Annex 10 to the Complaint including registrations in Australia, Canada, China, European Union, India, Japan, Peru, Republic of Korea, United Kingdom, United States.

In particular the Complainant relies for the purposes of this Complaint upon four United States trade mark registrations for DEADMAU5 alone whose certificates of registration are exhibited in Annexes 4 to 7 to the Complaint. Evidence of the assignment of trade marks 3,836,647 and 3,930,481 to the Complainant is set out in Annexes 8 and 9 to the Complaint.

The United States registrations for DEADMAU5 referred to and relied upon by the Complainant are:

- No. 3,836,647 in classes 9, 16, 25, and 41, registered August 24, 2010;
- No. 3,930,481 in classes 18, and 28, registered March 15, 2011;
- No. 4,887,529 in classes 9, 16, 18, 25, 28, and 41, registered January 19, 2016 (in stylized form);
- No. 6,924,489 in class 20, registered December 13, 2022.

In the absence of a Response the Panel finds the above evidence adduced by the Complainant to be true.

The disputed domain name was registered on October 20, 2022, and resolves to a website which purportedly offered for sale Deadmau5 branded products.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant submits that:

- i. the Complainant owns trade mark registrations throughout the world for the mark DEADMAU5 and related logos and that the disputed domain name is confusingly similar to the Complainant's registered trade marks DEADMAU5.
- ii. on the evidence adduced by the Complainant the Respondent has no rights or legitimate interests in respect of the disputed domain name.
- iii. on the evidence adduced by the Complainant the Respondent registered and is using the disputed domain name in bad faith.

### **B. Respondent**

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

## **6. Discussion and Findings**

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

The Panel finds for the reasons set out in Section 4 above that the Complainant owns registered trade marks throughout the world and in particular in the United States for the mark DEADMAU5.

The Complainant submits that the disputed domain name incorporates the "main and dominant" part of the mark DEADMAU5. The Panel notes that DEADMAU5 is incorporated in its entirety. The addition of the word "merch" does not, in the Panel's view, affect a finding of confusing similarity. It is also well established that the Top-Level Domain, in this case ".com" should be disregarded in assessing confusing similarity.

Accordingly the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trade marks DEADMAU5 within paragraph 4(a)(i) of the Policy.

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

The Complainant submits that the Respondent has no rights or legitimate interest in respect of the disputed domain name because:

- a. The Respondent is currently using the disputed domain name in connection with the offering of goods or services under the trade mark DEADMAU5 which is unauthorized by the Complainant;
- b. The Respondent is not commonly known or referred to by the disputed domain name, regardless of whether the Respondent has acquired trade mark rights, which it has not;
- c. The Respondent is not making a legitimate, noncommercial or fair-use of the disputed domain name, but rather registered the disputed domain name with the intent to exploit the Complainant's fame and goodwill for its own commercial gain; to misleadingly divert users to its website, and / or to tarnish the DEADMAU5 trade marks.

In support of these submissions the Complainant relies upon the evidence set out in Annex 11 to the Complaint which consists of screenshots taken by the Complainant showing apparel merchandise prominently featuring the Complainant's trade mark DEADMAU5 available for sale on the Respondent's website and accessible by using the disputed domain name. The screenshot refers to:

“Deadmau5 Merch Official Store for all Deadmau5 fans. Shop Official Deadmau5 Merch. Deadmau5 merchandise Hoodies. Tshirts and Posters with big discount. Fast Shipping Worldwide.”

The Complainant also claims that the products sold on the Respondent’s website are counterfeit. Although those products are offered for sale at discounted prices, based on the available record, the Panel cannot conclude if those products are counterfeit.

However, regardless of authenticity of the products sold on the Respondent’s website, taking into account the evidence of the Respondent’s trading activities using a domain name incorporating the Complainant’s trade mark in its entirety and falsely claiming that the website is an official store which would *prima facie* in the Panel’s view infringe the Complainant’s trade mark DEADMAU5 the Panel is satisfied and finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name within paragraph 4(a)(ii) of the Policy.

The Panel also takes into account that where the Complainant makes out a *prima facie* case that the Respondent lacks rights or legitimate interests the burden of production passes to the Respondent to demonstrate such rights. In this case it has failed to do so.

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

The Complainant submits, on the basis of the evidence of the Respondent’s infringing activity referred to in section 6B above and Annex 11 to the Complaint, that the Respondent by using the disputed domain name intends for its own commercial gain to attract users and / or consumers to the Respondent’s website by creating a likelihood of confusion with the Complainant’s trade mark DEADMAU5 as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website, or of a product or service the Respondent provides or intends to provide on its website.

It is also well established (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), sections 3.1.4) that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. That is the position in this Complaint.

Based on the evidence adduced by the Complainant as to the Respondent’s trading using the disputed domain name the Panel finds that the disputed domain name has been registered and is being used in bad faith in accordance with 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 <deadmau5merch.com> be transferred to the Complainant.

*/Clive Duncan Thorne/*

**Clive Duncan Thorne**

Sole Panelist

Date: July 31, 2023