

ADMINISTRATIVE PANEL DECISION

Top Drawer Merch, LLC v. Jenna Staggs

Case No. D2023-3532

1. The Parties

The Complainant is Top Drawer Merch, LLC, United States of America ("United States"), represented by Venable, LLP, United States.

The Respondent is Jenna Staggs, China.

2. The Domain Name and Registrar

The disputed domain name <electricfamily.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 August 21, 2023. On August 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 22, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 August 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 19, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on October 2, 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 the registered owner of United States trademark registration No. 4918574 ELECTRIC FAMILY (word) registered on March 15, 2016 for goods in class 25 and United States trademark registration No. 6147378 ELECTRIC FAMILY (word) registered on September 8, 2020 for goods in class 14.

The disputed domain name was registered on June 29, 2023. Furthermore, the evidence provided by the Complainant proves that the disputed domain name resolved to a website allegedly offering for sale products under the Complainant's trademarks and displaying the Complainant's trademark and products images.

5. Parties' Contentions

A. Complainant

It results from the Complainant's allegations that it was founded in 2017 and is a full-service merchandise, technology, and web3 agency. Electric Family, a related brand, was founded in 2012 as a collaboration with top DJs and producers to make bracelets and apparel for music fans. The Complainant markets the ELECTRIC FAMILY Marks in connection with hats, pants, t-shirts, and bracelets.

The Complainant conducts business on the Internet. It operates an online store at "www.electricfamily.com".

The Complainant contends that its trademark is well-known within the music and fashion industries and among consumers throughout the United States.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's earlier trademarks since it incorporates the entire ELECTRIC FAMILY trademark, with the addition of the generic Top-Level Domain ("gTLD") identifier ".shop", which is an insignificant addition which does not remove the likelihood of confusion between the trademarks and the domain name, as it only indicates that the disputed domain name is registered in the ".shop" gTLD.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, there is no evidence that the Respondent uses the disputed domain name in connection with the *bona fide* offering of goods or services, nor that the Respondent has been commonly known by the domain name. The Respondent has not received any license or consent, express or implied, to use the ELECTRIC FAMILY trademarks in a domain name or in any other manner from the Complainant, nor has the Complainant acquiesced in any way to such use or application of the ELECTRIC FAMILY trademarks by the Respondent. The disputed domain name is used by the Respondent in an attempt to pass itself off as the Complainant. The website <electricfamily.shop> offers for sale counterfeit ELECTRIC FAMILY products, including but not limited to clothing and accessories using photographs taken from the Complainant's authentic website without the Complainant's permission or authorization. The Complainant's ELECTRIC FAMILY trademarks are depicted on the website as well as its product listings and photographs. It is impossible to conceive of a circumstance in which the Respondent could legitimately use this disputed domain name without creating a false impression of association with the Complainant.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, because of the distinctive nature of the ELECTRIC FAMILY trademarks, the Respondent is likely to have had constructive notice as to the existence of the Complainant's trademarks at the time the Respondent registered the disputed domain name. In addition, the disputed domain name is used by the Respondent in an attempt to pass itself off as the Complainant. It may be inferred the Respondent has registered the disputed domain name to purposefully disrupt the business of the Complainant, and its official website and to create a likelihood of confusion with the ELECTRIC FAMILY trademarks. By offering for sale counterfeit goods similar or identical to authentic goods sold by the

Complainant under the ELECTRIC FAMILY trademarks, the Respondent has intentionally attempted to attract for commercial gain Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

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

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of trademark registration for ELECTRIC FAMILY as indicated in the Factual Background of this Decision.

Prior UDRP panels have found that a disputed domain name is identical or confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark ELECTRIC FAMILY is fully included in the disputed domain name.

Finally, the gTLD ".shop" of the disputed domain name may be disregarded under the first element confusing similarity test. The practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to "new gTLDs"); the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment of the first element (see [WIPO Overview 3.0](#) at section 1.11).

In the light of the above, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights to or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the trademark ELECTRIC FAMILY, e.g., by registering the disputed domain name comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the Panel notes that the nature of the disputed domain name carries a high risk of implied affiliation, since the disputed domain name is identical to the Complainant's trademark ELECTRIC FAMILY and that the trademark ELECTRIC FAMILY is not a trademark that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. This is also confirmed by the content of the website to which the disputed domain name resolves, allegedly offering for sale products under the Complainant's trademarks and displaying without authorization the Complainant's trademark and products images. Generally speaking, previous UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation (see [WIPO Overview 3.0](#), at section 2.5.1). The Panel shares this view.

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see [WIPO Overview 3.0](#) at section 2.1). Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It results from the Complainant's documented allegations that the disputed domain name resolved to a website allegedly offering for sale products under the Complainant's trademarks and displaying without authorization the Complainant's trademark and products images. For the Panel, it is therefore evident that the Respondent knew the Complainant's mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademark when it registered the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant's registered trademark ELECTRIC FAMILY.

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

- (i) the nature of the disputed domain name (a domain name identical to the Complainant's mark);
- (ii) the content of the website to which the disputed domain name resolves, displaying the Complainant's trademark and product images and allegedly offering for sale products under the Complainant's trademark;
- (iii) a clear absence of rights or legitimate interests coupled with no response for the Respondent's choice of the disputed domain name.

In light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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, <electricfamily.shop>, be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: October 16, 2023