

ADMINISTRATIVE PANEL DECISION

NSN Apparel Co, LLC v. Saratovskaya Oblast
Case No. D2023-3758

1. The Parties

The Complainant is NSN Apparel Co, LLC, United States of America, represented by Adelman Matz P.C., United States of America.

The Respondent is Saratovskaya Oblast, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <drewmerchandise.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 September 8, 2023. On September 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 11, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 12, 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 amendment to the Complaint on September 12, 2023.

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 September 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 6, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on October 19, 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 sells unisex clothing and apparel under the brands DREW, THE HOUSE OF DREW, La MAISON DREW, and DREW HOUSE since at least 2018. The brand DREW is based on the middle name (“Drew”) of Justin Bieber, a famous singer/musician who is one of the founders of the Complainant’s Brand.

It results from the Complainant’s documented allegations, which remained undisputed, that it owns several trademarks consisting of or comprising the verbal element DREW, including stylized Hong Kong, China trademark DREW, no. 305069791 registered on September 27, 2019, for goods/services in classes 25, 35.

The disputed domain name was registered on December 12, 2022. The language of the Registration agreement is English.

The Complainant has provided – undisputed – evidence demonstrating that the disputed domain name resolves to a website which, despite being unauthorized, purports to advertise and sell clothing and merchandise under the Complainant’s DREW mark and even attributing the Respondent’s Website to be owned amongst others by Justin Bieber.

On May 25, 2023, the Complainant sent a letter to the Respondent and to the Registrar asking to takedown the content of the website available under the disputed domain name. According to the Complainant’s undisputed allegations, the Respondent failed to respond to the letter or take any action thereto.

5. Parties’ Contentions

A. Complainant

Firstly, the Complainant contends that the disputed domain name is confusingly similar to the Complainant’s mark since it incorporates the entirety of the mark DREW. Additionally, adding the descriptive term “merchandise” followed by the generic Top-Level domain (“gTLD”) “.shop” makes it even more confusingly similar. The added word “merchandise” is a term implying that the Respondent is authorized to sell the Complainant’s “merchandise”.

Secondly, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. In particular, the Complainant submits that it did not authorize the Respondent to register the disputed domain name. Additionally, prior to the notice of the dispute, there is no evidence the Respondent is using the disputed domain name, or a trademark corresponding to the domain name, in connection with a *bona fide* offering of goods or services. Instead, the Respondent uses the disputed domain name for its own illegitimate website where it is unauthorizedly selling illegitimate counterfeit merchandise bearing the DREW HOUSE Marks without permission. Finally, the Respondent wants consumers to falsely associate its website with the Complainant’s DREW HOUSE Marks.

Thirdly, the Complainant argues that the Respondent registered and uses the disputed domain name in bad faith. The Complainant contends that the Respondent is intentionally trying to attract consumers to its website for Respondent’s own commercial gain by selling counterfeit merchandise using Complainant’s marks without any authorization. Furthermore, the Respondent had constructive notice of the Complainant’s mark for at least four years. Finally, in the Complainant’s view there can be no doubt that the Respondent had constructive notice of the Complainant’s name and reputation and deliberately designed the disputed domain name and website to take advantage of the world-famous reputation associated with said marks.

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 the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should 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 is satisfied that the registrant of record for the disputed domain name is the Respondent and 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 several trademarks consisting of or comprising the verbal element DREW, including stylized Hong Kong, China trademark DREW, no. 305069791 registered on September 27, 2019.

Many UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark for purposes of the first element where the relevant trademark is recognizable within the disputed domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). This Panel shares the same view and notes that the disputed domain name contains the Complainant's registered trademark DREW, which is placed at the beginning of the disputed domain name. In particular, the Panel considers the addition of the term “merchandise” to the Complainant's trademark in the disputed domain name would not prevent a finding of confusing similarity under the first element of the UDRP. The Panel has no doubts that in a side-by-side comparison of the disputed domain name and the relevant trademark DREW, the latter mark remains clearly recognizable within the disputed domain name.

Finally, the gTLD “.shop” of the disputed domain name may be disregarded under the first element confusing similarity test (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In light of the above, the Panel finds that the disputed domain name is confusingly similar 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 or legitimate interests in the disputed domain name:

(1) First, it results from the Complainant's uncontested evidence that the disputed domain name resolves to a web shop which purports to advertise and sell clothing and merchandise under the Complainant's DREW mark and even attributing the Respondent's Website to be owned amongst others by Justin Bieber. In this Panel's view, such use cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since such use is likely to mislead Internet users, particularly noting the descriptive additions of "merchandise" and the gTLD ".shop" that directly relate to the retail industry in which the Complainant operates. In addition, the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use the disputed domain name. In particular, the Complainant's uncontested allegations demonstrate that it has not authorized or licensed the Respondent's use of the DREW trademarks for registering the disputed domain name which is confusingly similar to the Complainant's trademark. In this Panel's view, it is therefore evident that the Respondent selected the disputed domain name with the intention to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the Complainant's registered trademark DREW by registering a domain name containing that trademark and resolving to a website that mimics the Complainant's original website, brand, and products.

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

(3) Finally, the Panel notes that there is no evidence in the record either showing that the Respondent might be making a noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue pursuant to paragraph 4(c)(iii) of the Policy. In particular, the Panel considers it obvious that the Respondent wanted to mimic the Complainant's original website under the disputed domain name which entirely incorporates the trademark DREW. Noting the absence of any disclaimer, the disputed domain name's content exacerbates the confusion caused by the incorporation of the Complainant's trademark in the construction of the disputed domain name by further impersonating the Complainant. Accordingly, further to section 2.8 of the [WIPO Overview 3.0](#), the Respondent's use of the disputed domain name to host an impersonating webstore excludes any *bona fide* offering, noncommercial, or fair use of the disputed domain name from the outset.

(4) Finally, previous UDRP panels have found 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. Since 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 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 that the Panel finds applicable to the present dispute 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 is the view of this Panel that these circumstances are met in the case at hand:

It results from the documented and undisputed evidence provided by the Complainant that the disputed domain name resolves to a web shop which purports to advertise and sell clothing and merchandise under the Complainant’s DREW mark and even attributing the Respondent’s Website to be owned amongst others by Justin Bieber. However, the Complainant has not given any authorization for such use and is not linked to the Respondent or its website. For the Panel, it is therefore evident that the Respondent positively knew the Complainant’s trademarks and products. 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 trademarks DREW entirely when it registered the disputed domain name. Registration of a domain name which contains a third party’s trademark, in awareness of said trademark and in the absence of rights or legitimate interests is suggestive of registration in bad faith (see e.g., *Vorwerk International AG v. ayoub Iagnadi, Iagnadi LTD*, WIPO Case No. [D2022-1592](#) with further references). While the ability to purchase the goods is not known to the Panel, the alleged commercial offering and impersonation of the Complainant is sufficient to establish the Respondent’s bad faith intent to mislead Internet users.

In addition, the finding of bad faith registration and use is supported by the following further circumstances resulting from the case at hand:

- (i) the trademark DREW is fully and identically incorporated in the disputed domain name.
- (ii) the Respondent’s failure to submit a formal response or to reply to the take-down letters;
- (iii) the Respondent’s failure to provide any evidence of actual or contemplated good faith use;
- (iv) the implausibility of any good faith use to which the disputed domain name may be put, and
- (v) the fact that the details disclosed for the Respondent by the Registrar are incomplete, noting the courier’s inability to deliver the Center’s Written Notice.

In the 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, <drewmerchandise.shop> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: November 2, 2023