

ADMINISTRATIVE PANEL DECISION

YZ Productions, Inc. v. Aarnav Paul
Case No. D2023-5221

1. The Parties

The Complainant is YZ Productions, Inc., United States of America, represented by Aesthetic Legal, United States of America.

The Respondent is Aarnav Paul, India.

2. The Domain Name and Registrar

The disputed domain name <zamfammerch.net> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 14, 2023. On December 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 19, 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, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 21, 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 the same day.

The Center verified that the Complaint together with the amendment to the Complain 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 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 29, 2024. The Respondent sent an email communication to the Center on December 21, 2023. On January 31, 2024, pursuant to paragraph 6 of the Rules, the Center notified the Commencement of Panel Appointment Process.

The Center appointed Michael D. Cover as the sole panelist in this matter on February 2, 2024. 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 February 6, 2024, the Respondent sent an email communication to the Center with an offer to settle. On February 7, 2024, the Complainant responded to such email with an agreement to settle.

The Panel issued the Administrative Panel Procedural Order No. 1, on February 12, 2024, in which the Panel ordered as follows:

“In light of the Parties’ emails of February 7, 2024, a completed and signed Standard Settlement Form and further to paragraphs 10 and 17 of the Rules, the Panel requests the Parties to confirm by February 17, 2024 whether they wish to suspend the case in accordance with paragraph 17(a)(i) of the Rules, to implement their settlement.”

“If the Parties confirm their wish to suspend the proceedings, the panel instructs the Center to: (i) suspend the proceedings for 14 (ii) inform the Registrar, copying the Parties, of the outcome of the settlement as it relates to actions that need to be taken up by the Registrar.

If the Parties do not confirm by February 17, 2024 their wish to suspend the proceedings, the Panel may issue its decision on that basis, in accordance with the Rules and Policy.”

The Panel stated in the above-referenced Order that the Panel reserves its rights to issue any further procedural order if necessary. On February 22, 2024, the Complainant requested for the Panel to issue its decision in accordance with the Rules and Policy.

There followed a series of extensions time for the delivery of the Decision of the Panel, the last to April 2, 2024.

4. Factual Background

The Complainant is a professional multimedia production company, You Tube channel operator, and distributor engaged in the production, design, creation, distribution, and sale of multimedia content. The Complainant is the proprietor of the ZAMFAM trademark, which the Complainant has used since 2016.

The Complainant is the proprietor of registered trademarks for ZAMFAM in the United States of America under No. 6,183,433, registered October 27, 2020, International Classes 16, 25, and 41 and 7,121,951, registered July 25, 2023, in International Class 30.

The Disputed Domain Name was registered on January 29, 2023, which was several years after the Complainant commenced use of its ZAMFAM trademark and registered the same. The Disputed Domain Name resolves to a website which offers goods which compete with those of the Complainant.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

The Remedy Requested by the Complainant

The Complainant requests that the Panel decides that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions in a Response but, as already set out in this Decision, the Respondent has agreed to the transfer of the Disputed Domain Name.

6. Discussion and Findings

Consent to Remedy

Considering the Respondent's consent to the Complainant's requested remedy, section 4.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that a panel, at its discretion may find it appropriate to provide a substantive decision on the merits, regardless of the Respondent having given its consent to transfer of the Disputed Domain Name: "[s]cenarios in which a panel may find it appropriate to do so include (i) where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, (ii) where while consenting to the requested remedy the respondent has expressly disclaimed any bad faith, (iii) where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent's consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights".

In this case, while the Panel notes the Parties' apparent agreement to settle, the Complainant ultimately requested that the Panel proceed with its Decision discussing the merits of the Complaint. Accordingly, in view of the Complainant's request for a recorded decision, the Panel will proceed with a Decision on the substantive merits.

The Obligations of the Complainant

The Complainant must establish on the balance of probabilities that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the Disputed Domain Name; and, that Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established registered rights in its ZAMFAM trademark. The Disputed Domain Name is confusingly similar to the Complainant's ZAMFAM trademark, in which the Complainant has rights. In assessing confusingly similarity, the Panel takes no account of the element "merch" and does take account of the fact that the Disputed Domain Name contains the Complainant's ZAMFAM trademark in full. It is well established that the addition of the generic Top-Level Domain ("gTLD") ".net" does not prevent a finding of confusing similarity, as the addition of the gTLD is a technical requirement of registration [WIPO Overview 3.0](#) section 1.11.1.

The Panel finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Having reviewed the available record, the Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The

Respondent has not filed a Response and has not rebutted the Complainant's prima facie case and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name or otherwise.

The Respondent has used the Disputed Domain Name in an alleged offering of "merch" in association with the Complainant's trademark, yet the website to which the Disputed Domain Name resolves bear no information clarifying the relationship of said website to the Complainant and given the overall impression of the Disputed Domain Name's composition and the website content, it is clear that the Respondent sought to mislead unsuspecting Internet users into the false belief they are interacting with the Complainant, or a sponsored affiliated thereof, contrary to the fact. Such misleading user can never confer rights or legitimate interests upon a respondent. See [WIPO Overview 3.0](#), sections 2.5.1, 2.8, and 2.13.

The Panel finds that that second element of the Policy has been established.

C. Registered and Used in Bad Faith

It is a reasonable inference that the Respondent knew of the Complainant's ZAMFAM trademark when the Disputed Domain Name was registered. Not only does the Disputed Domain Name consist of the distinctive trademark in its entirety, but the website to which the Disputed Domain Name resolves is replete with personal information of the Complainant and the services provided under the trademark.

Such use as has taken place of the Disputed Domain Name involves the Disputed Domain Name resolving to a website which offers goods which compete with those of the Complainant. Such registration and use falls squarely within the bad faith envisioned under Policy paragraph 4(b)(iv), namely, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on your web site or location.

The Panel finds that the Complainant has established the third element 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 <zamfammerch.net> be transferred to the Complainant.

/Michael D. Cover/

Michael D. Cover

Sole Panelist

Date: April 6, 2024