

ADMINISTRATIVE PANEL DECISION

Gibson Brands, Inc. v. Aston Milley
Case No. D2024-0715

1. The Parties

The Complainant is Gibson Brands, Inc., United States of America (“United States” or “U.S.”), represented by Bates & Bates LLC, United States.

The Respondent is Aston Milley, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 16, 2024. On February 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 19, 2024, 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 February 21, 2024.

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 February 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 15, 2024.

The Center appointed Martin Schwimmer as the sole panelist in this matter on March 20, 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.

4. Factual Background

Complainant is engaged in the business of developing, manufacturing, and selling musical instruments, including electric guitars, acoustic guitars, basses, mandolins, and other stringed instruments.

Complainant is the owner of the GIBSON trademark in multiple countries, including the following registrations in the United States most relevant to this proceeding:

- GIBSON (stylized), U.S. Reg. No. 0510594, registered on June 7, 1949, in International Class 15;
- GIBSON, U.S. Reg. No. 1545311, registered on June 27, 1989, in International Class 15; and
- GIBSON, U.S. Reg. No. 3877181, registered on November 16, 2010, in International Class 9.

Collectively, the GIBSON word marks and stylized marks are referred to herein as the “GIBSON Mark”.

The Domain Name was registered on June 20, 2023. The Domain Name resolves to a website offering for sale electric guitars (the “Website”).

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.

Notably, the Complainant contends that for over a century it has used the GIBSON Mark in connection with the manufacturing and sale of musical instruments. Complainant alleges that its products are offered throughout the world, and that Complainant’s name and instruments have gained worldwide recognition and reputation. Complainant further alleges that in addition to its trademarks, it owns a number of GIBSON domain names, including, but not limited to, <gibson.com>.

Complainant asserts Respondent has hidden its identity and that the Domain Name resolves to an active website making unauthorized use of Complainant’s GIBSON Mark, both in the Domain Name and on the website. In fact, Complainant contends Respondent advertises and sells counterfeit GIBSON-branded musical instruments and related products, namely guitars and basses. Complainant asserts that Respondent is not a partner, licensee, or authorized retailer of GIBSON-branded products nor does Respondent have Complainant’s consent to use the GIBSON Mark, or any other trademarks owned by Complainant, to advertise and sell Respondent’s products.

With respect to the first element of the Policy, Complainant alleges that the Domain Name incorporates Complainant’s GIBSON Mark entirely and merely adds the term, “guitars”. Thus, Complainant contends that the Domain Name is confusingly similar to the GIBSON Mark.

With respect to the second element of the Policy, Complainant points out that Respondent has not received any license, authorization, or permission to use its GIBSON Mark or any of Complainant’s other trademarks currently being used, or previously used, as a part of the website that was accessible from the Domain Name. Complainant further contends it does not have any type of business relationship with Respondent. Complainant concludes that Respondent has no rights or legitimate interests in such a confusingly similar Domain Name.

With respect to the third element of the Policy, Complainant asserts Respondent registered and used the Domain Name in bad faith, as evidenced by the fact that: (1) it is using Complainant's famous GIBSON Mark in its entirety without authorization, (2) Respondent has hidden its true identity, and (3) Respondent was attempting to trade off the goodwill Complainant has established in the GIBSON Mark.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark GIBSON is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the addition of the term "guitars" does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Additionally, panels have held that the use of a domain name for illegal activity, here, claimed sale of counterfeit goods, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Complainant has alleged that the Respondent is offering counterfeit goods bearing the GIBSON trademark, which allegation is unrebutted. Furthermore, without regard whether the goods are in fact counterfeit, the Respondent holds itself out as “Gibson Guitars” and “Gibson Guitars Store” on the Website, thus exceeding any imaginable fair use right.

Moreover, the Panel finds that the nature of the Domain Name, being confusingly similar to the Complainant’s trademarks and containing the term “guitars”, which clearly refers to the Complainant’s products and business, carries a risk of implied affiliation and cannot constitute fair use, as it effectively impersonates the Complainant and its products or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

First, the Panel notes that the GIBSON trademark is famous in relation to guitars. See *Gibson Brands, Inc. v. Super Privacy Service LTD c/o Dynadot. / Wills Eldren*, WIPO Case No. [D2021-3656](#).

In the present case, the Panel notes that, as discussed above in Section 6.B., the Respondent holds itself out as the Complainant, and has obscured its true identity through the use of proxy services and incorrect Whois information.

Finally, the Respondent has not rebutted allegations that it is offering counterfeit versions of the Complainant’s goods. Panels have held that the use of a domain name for illegal activity, here, claimed sale of counterfeit goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Clearly, the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s mark.

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 <gibsonguitars.store> be transferred to the Complainant.

/Martin Schwimmer/
Martin Schwimmer
Sole Panelist
Date: March 28, 2024