

ADMINISTRATIVE PANEL DECISION

Jacques Bermon Webster II also known as Travis Scott, and LaFlame Enterprises, Inc. v. Fahad bin Khalid, Punjab University
Case No. D2024-0933

1. The Parties

The Complainants are Jacques Bermon Webster II also known as Travis Scott, and LaFlame Enterprises, Inc., United States of America (“United States”), represented by Kia Kamran P.C., United States.

The Respondent is Fahad bin Khalid, Punjab University, Pakistan.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 2, 2024. On March 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 4, 2024, 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 (See PrivacyGuardian.org), and contact information in the Complaint. The Center sent an email communication to the Complainant on March 5, 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 March 5, 2024 by the Center.

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 March 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 2, 2024.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on April 9, 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

It results from the Complainant's undisputed allegations that it is the recording artist Jacques Bermon Webster II, professionally known as Travis Scott together with his company LaFlame Enterprises, Inc, active in the entertainment industries since the year 2009.

According to the information in the Complaint, the Complainant has used the term "astroworld" in commerce as early as the year 2018 in connection with entertainment services, live performance, music and merchandise (such as clothing, jewelry, bags, cups, paper goods).

The Complainant is the registered owner of many trademarks worldwide for the mere verbal element "astroworld", e.g.

- United States Trademark registration no. 5,701,553, registered on March 19, 2019, for services in class 41,
- European Union Trademark registration no. 018532715, registered on January 6, 2022, for goods and services in classes 9, 14, 18, 25, and 41.

The disputed domain name was registered on September 3, 2019. Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name resolves to a website purportedly offering for sale products under the Complainant's trademark and prominently displaying the Complainant's ASTROWORLD trademark and logo without the Complainant's authorization.

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 Complainant further contends that it has acquired a worldwide fame.

Notably, the Complainant contends that the disputed domain name is identical and confusingly similar to the Complainant's trademark, since it includes the entirety of the Complainant's ASTROWORLD trademark. The mere addition of the word "merch" does not eliminate any confusion, as it is well settled that adding a generic term to a mark is not sufficient to avoid confusion.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent is not commonly known by the name "Astroworld", and it is not authorized or licensed by Complainant to use this term in or as part of any trademark or domain name. Furthermore, the Respondent cannot claim any legitimate, noncommercial or fair use of the use of the disputed domain name, for criticism or as a fan site, because its primary purpose is to commercial use in competition with the Complainant and primarily for the sale of counterfeit goods on the website associated with the disputed domain name bearing the Complainant's name, likeness, and trademarks.

Furthermore, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, it has acquired a worldwide fame and the Respondent registered

the disputed domain name primarily for the purpose of disrupting the Complainant's business by selling counterfeit products branded under the Complainant's trademarks.

B. Respondent

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

6. Discussion and Findings

6.1 Procedural issues – Consolidation of the Complainants

The Complaint was filed by both Jacques Bermon Webster II also known as Travis Scott and his company LaFlame Enterprises, Inc.. In addition, each of the Complainants are individually the owner of registered trademarks for ASTROWORLD in different jurisdictions.

As set forth in section 4.11.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation".

In the light of the above, the Panel finds that the Complainants have a specific common grievance against the Respondent because they share a common legal interest in the trademark rights on which this Complaint is based since both Complainants own registrations for the trademark ASTROWORLD and allege a corporate connection. Against this background, the Panel does not see reasons why a consolidated Complaint brought by the Complainants against a single Respondent would not be fair and equitable. Moreover, the Respondent failed to come forward with any allegations or evidence to object the consolidation. For reasons of procedural efficiency, fairness and equity the Panel therefore accepts the joint Complaint.

6.2 Substantive issues

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 each 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

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 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 entirety of the mark is reproduced 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.

Although the addition of other terms here, “merch”, may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

Finally, the generic Top-Level Domain (“gTLD”) “.net” of the disputed domain name may be disregarded under the first element confusing similarity test, [WIPO Overview 3.0](#) at section 1.11.1.

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.

The Panel notes that the disputed domain name is clearly constituted by the Complainant’s registered trademark and a term (i.e. “merch” which is an abbreviation of the English term “merchandise”).

The website to which the disputed domain name currently resolves (direct forwarding to “www.astromerch.shop”) is described in the section “About us” as “*Hard-Core Travis Scott fan, listing down our favorite Merchandise items from La Flame’s official albums*”. For purposes of assessing fair use under UDRP paragraph 4(c)(iii), a respondent’s fan site must be active, genuinely noncommercial, and clearly distinct from any official complainant site, [WIPO Overview 3.0](#), section 2.7.1. This is not the case in the case at hand. The Panel rather holds that it is primarily a pretext for commercial activity, since the website is essentially an online shop allegedly selling the Complainant’s products and reproducing without authorization the Complainant’s trademark and logo.

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, but 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.

In the present case, the Panel notes that it results from the Complainant's documented allegations that the disputed domain name resolved to a website displaying the Complainant's trademark and logo, and purportedly offering for sale products under the Complainant's trademark. For the Panel, it is therefore evident that the Respondent positively 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith, [WIPO Overview 3.0](#), section 3.2.1.

In this regard, 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:

(i) the nature of the disputed domain name (incorporating the Complainant's mark plus the addition of a descriptive term relevant to the Complainant's business);

(ii) the content of the website to which the disputed domain name direct, displaying the Complainant's trademark, logo, and purportedly offering for sale the Complainant's products;

(iii) a clear absence of rights or legitimate interests and lack of any evidence of actual or contemplated good faith use of the disputed domain name coupled with no response for the Respondent's choice of the disputed domain name. The Panel also notes that there is only a brief disclaimer which appears in small at the very foot of the home webpage stating: "Note that this site is not affiliated with Travis Scott but satisfy high quality standards". Therefore, such disclaimer cannot be considered as satisfying the requirement of making clear to Internet users visiting it that the Respondent's website is not operated or sponsored by the Complainant and cannot cure the Respondent's bad faith .

(iv) the Respondent's use of a privacy service to conceal its identity.

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, <astroworldmerch.net>, be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: April 23, 2024