

ADMINISTRATIVE PANEL DECISION

Jacques Bermon Webster II also known as Travis Scott, and Cactus Jack Publishing, LLC v. Amir Ali
Case No. D2024-1108

1. The Parties

The Complainants are Jacques Bermon Webster II also known as Travis Scott, and Cactus Jack Publishing, LLC, United States of America (“United States” or “U.S.”), represented by Kia Kamran P.C., United States.

The Respondent is Amir Ali, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <cactusjackofficial.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 13, 2024. On March 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 14, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainants on March 15, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on March 15, 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 March 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 9, 2024.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on April 29, 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

The Complainant Jacques Bermon Webster II is a recording artist also known as Travis Scott and with the nick name Cactus Jack. He started his music career and other activities in the entertainment industry in the year 2009 and has been active under the name Cactus Jack since 2017. He achieved four number-one hits on the United States Billboard 100 along with 80 charted songs. The Complainant won eight Grammy Awards as well as other music awards, toured internationally and collaborated with artists such as Kanye West, Pharrell Williams, Justin Bieber, Rihanna, and others, all as per the Complainant's website in Annexes 4 and 5 to the Complaint. The Complainant counts 11 million followers on Twitter (now X), 52.7 million followers on Instagram, 9.3 million followers on Facebook, and more than 60 million listeners on Spotify per month. He uses the brand CACTUS JACK in connection with entertainment services as well as merchandise items like clothing, jewelry, bags, etc.

The Complainant Jacques Bermon Webster II owns the company Cactus Jack Publishing, LLC. The Complainant Cactus Jack Publishing, LLC, amongst others, is the owner of the following trademarks:

- U.S. trademark registration no. 5747382 CACTUS JACK (word), registered on May 7, 2019;
- U.S. trademark registration no. 5807362 CACTUS JACK (word), registered on July 16, 2019;
- International registration no. 1659540 CACTUS JACK (word), registered on March 15, 2022, with extensions of protection to the countries such as Australia, United Kingdom, Republic of Korea, Mexico, New Zealand, Japan and Türkiye.

The Complainant Jacques Bermon Webster II and his company Cactus Jack Publishing, LLC are hereinafter referred to as "the Complainant".

The Complainant's official music and authorized merchandise are released and distributed per its official website operated under the domain name <travisscott.com>.

The Respondent has registered the disputed domain name on August 3, 2023. The website to which the disputed domain name resolves is currently inactive. It was used, before the initiation of this UDRP proceeding, for displaying and offering for sale, among other items, goods such as clothing items that bear the Complainant's trademark CACTUS JACK at discounted prices and claiming to be "CACTUS JACK OFFICIAL STORE" (Annexes 3 and 13 to the Complaint).

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 it owns rights in the trademark CACTUS JACK which predate the creation of the disputed domain name. It claims that the disputed domain name is identical or confusingly similar to the Complainant's trademark CACTUS JACK as this term is entirely included in the disputed domain name. The Complainant points out that the generic term "official" within the disputed domain name is not sufficient to avoid a likelihood of confusion, and the generic Top-Level Domain ("gTLD") having to be disregarded.

Further, the Complainant argues that the Respondent does not have any rights or legitimate interests in respect of the disputed domain name. The Respondent is not known by the term Cactus Jack, nor is it authorized or licensed by the Complainant to use this term. The Respondent cannot benefit of any legitimate, noncommercial use made of the disputed domain name, because its primary purpose is to engage in, according to the Complainant as per Annexes 3 and 13 to the Complaint, selling counterfeit products, among them merchandise like clothing items bearing the trademark CACTUS JACK without license from the Complainant. Thus, the use of the disputed domain name is intended to divert consumers to the Respondent's website for the Respondent's commercial gain by creating a likelihood of confusion with the Complainant which is not a legitimate interest.

Finally, the Complainant asserts the disputed domain name was registered and is being used in bad faith. The Complainant's trademarks for CACTUS JACK were registered in the U.S. and internationally before the registration of the disputed domain name. This trademark [annotation of the Panel: even though the Complainant in this instance refers to the trademark ASTROWORLD, the Panel takes from the context of the contentions of the Complainant that this is a clerical error and that the Complainant meant to say CACTUS JACK] is, according to the Complainant, well known. Thus, the Respondent registered the disputed domain name primarily for disrupting the Complainant's business and intended to target the value of the Complainant's name and trademark by creating a likelihood of confusion for the consumer. This is shown by the fact that on the website, to which the disputed domain name resolved, counterfeit products bearing the CACTUS JACK mark were being sold substantially under the price at which the Complainant itself distributes its merchandise.

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 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, "official", 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.

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 previously resolved to a website that displayed the Complainant's trademark without any disclaimer regarding the relationship between the Respondent and the Complainant, and purportedly offered for sale what appeared to be counterfeit goods bearing the Complainant's trademark at discounted prices. The website also falsely claimed to be "CACTUS JACK OFFICIAL STORE".

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 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 the Respondent registered the disputed domain name incorporating the Complainant's trademark CACTUS JACK, adding the term "official", to resolve to a website designated as "CACTUS JACK OFFICIAL STORE" in order to sell possibly counterfeit clothing and accessories designated and labelled, amongst others, with the brand CACTUS JACK. Therefore, by using the disputed domain name, the Respondent has internationally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark, which constitutes bad faith.

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.

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. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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 <cactusjackofficial.com> be transferred to the Complainant.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: May 13, 2024