

## **ADMINISTRATIVE PANEL DECISION**

Electric Lady, LLC v. Ray Cuevas, Electric lady  
Case No. D2024-1299

### **1. The Parties**

Complainant is Electric Lady, LLC, United States of America (“United States” or “U.S.”), represented by K & G Law LLC, United States.

Respondent is Ray Cuevas, Electric lady, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <electricladymiami.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 26, 2024. On March 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 27, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on April 2, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on the same date.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on April 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 26, 2024.

The Center appointed Scott R. Austin as the sole panelist in this matter on May 16, 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 following facts appear from the Complaint (as amended) and its attached annexes, which have not been contested by Respondent, and which provide evidence sufficient to support:

Complainant is the owner of a recording studio developed by iconic rock guitarist Jimi Hendrix in 1970 from a converted nightclub at 52 W 8th Street in New York's Greenwich Village, which venue Hendrix had frequented for impromptu performances and late-night jam sessions before purchasing it for studio transformation. Complainant has operated its recording and production business since 1970 under the trademarks ELECTRIC LADY and ELECTRIC LADY STUDIOS (collectively, the "ELECTRIC LADY Marks"), to identify the recording studio and music production services Complainant provides and which Marks Complainant asserts are world famous. On August 26, 1970, Hendrix hosted the grand opening of his studio to fellow musicians and friends which included artists Steve Winwood, Eric Clapton, Ron Wood, and Patti Smith.

Complainant shows that its business is the oldest operating recording facility in the Northeast, and it continues to be a highly sought-after recording studio today. Famous artists who have recorded at Complainant's studios using its services under the ELECTRIC LADY Marks include The Rolling Stones, Led Zeppelin, Stevie Wonder, David Bowie, and Patti Smith in the 1970's, and more recently, Taylor Swift, Adele, St. Vincent, Japanese Breakfast, Frank Ocean, and Lorde. Complainant's website shows that world renowned artist Taylor Swift recorded her most recent release, "Tortured Poets Department" at ELECTRIC LADY STUDIO, which on April 19, 2024, became the first album on the Spotify music streaming platform to amass more than 300 million streams in a single day.

Complainant's recording studio location has been used as a venue for live music performances, including a live, recorded performance by artist Patti Smith on August 26, 2015 of her landmark debut LP, *Horses*, originally recorded at the facility in 1975, as well as a live performance by The Kills in 2018.

Complainant owns a number of registrations in the United States for the ELECTRIC LADY mark, including the following:

United States Registration No. 5,730,792, ELECTRIC LADY, registered April 23, 2019, for a range of clothing products in International Class 25, and "Recording studio services; Recording studios; Audio recording and production", in International Class 41, claiming a first use in commerce date of August 27, 1970;

United States Registration No. 5,779,312, ELECTRIC LADY STUDIOS, registered on June 18, 2019, for "Audio recording and production services" in International Class 41, claiming a first use in commerce date of August 27, 1970;

United States Registration No. 7,233,347, ELECTRIC LADY STUDIOS, registered on December 5, 2023, for a range of products and services in International Classes 9, 25 and 41, and claiming a first use in commerce date of August 26, 1970;

United States Registration No. 6,005,429, ELECTRIC LADY NEW YORK, words plus design, registered on March 10, 2020, for a range of products in International Class 25, and claiming a first use in commerce date of December 31, 2011;

United States Registration No. 7,273,730, LIVE AT ELECTRIC LADY, registered on January 16, 2024, for a range of products and services in International Class 9, and claiming a first use in commerce date of December 31, 2015;

Complainant incorporates the ELECTRIC LADY Mark into its official registered domain name <electricladystudios.com>, registered since October 30, 1996, which Complainant uses to connect its recording and music production community and promote its products through its official website accessed at "www.electricladystudios.com" (the "Official ELECTRIC LADY Mark Website").

Complainant sent a cease and desist letter on December 14, 2023 to the email address displayed on the disputed domain name's webpage, which letter referenced a social media link used by Respondent "www.instagram.com/electriclady\_wynwood/?hl=en" demanding the cessation of all unauthorized uses of Complainant's ELECTRIC LADY Marks. Respondent did not respond to Complainant's cease-and-desist letter.

Respondent registered the disputed domain name <electricladymiami.com> on September 17, 2023, and it resolves to Respondent's website displaying Complainant's ELECTRIC LADY mark to advertise for beverage and bottle services seemingly for a nightclub. Complainant has also provided evidence showing that "Electric Lady" venue associated with Respondent's website was listed as a live music venue in connection with Miami Music Week in Miami, Florida.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name: that the disputed domain name is confusingly similar to Complainant's trademark; that Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

### **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of the probabilities that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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 finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

## 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 Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

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. Complainant has demonstrated its rights because it has shown that it is the holder of numerous valid and subsisting trademark registrations for its ELECTRIC LADY Marks. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant's rights in the ELECTRIC LADY Marks established, the remaining question under the first element of the Policy is if the disputed domain name is identical or confusingly similar to Complainant's ELECTRIC LADY Marks.

The entirety of Complainant's ELECTRIC LADY mark is reproduced within the disputed domain name while adding the geographic location "miami", and the generic Top-Level-Domain ("gTLD") ".com". 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 "miami", 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; see also *Eurochannel Inc. v. Sarah Staar*, WIPO Case No. [D2007-0165](#); see also *Rakuten, Inc. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Matthew Connor, No Company*, WIPO Case No. [D2019-2983](#).

The gTLD, in this case ".com", is disregarded for this comparison because it is functionally necessary for the disputed domain name to be registered. See *Research In Motion Limited v. Thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#) (gTLD irrelevant for confusing similarity determination); [WIPO Overview 3.0](#), section 1.11 ("The applicable Top Level Domain ('TLD') in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.").

Complainant's ELECTRIC LADY mark is incorporated in its entirety into the disputed domain name and for that reason the Panel finds the disputed domain name confusingly similar to the ELECTRIC LADY mark in which Complainant has rights. Complainant has satisfied paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which 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. See also, *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#).

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

First, Complainant contends that Respondent is not and has never been a representative or licensee of Complainant nor is Respondent authorized by Complainant to register or use the ELECTRIC LADY mark. Prior panels have found the fact that a respondent is not authorized to register or use a complainant's mark, "on its own, can be sufficient to prove the second criterion [of the Policy]". *Six Continents Hotels, Inc. v. IQ Management Corporation*, WIPO Case No. [D2004-0272](#); see also *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) (finding no rights or legitimate interests where domain name incorporated complainant's registered mark and respondent was not a licensee of complainant).

Second, it is clear from the record submitted that Respondent is using the disputed domain name to create a false association with or impersonate Complainant and thereby intentionally misdirect and divert, for commercial gain, Internet users to Respondent's website, by creating a likelihood of confusion with Complainant and Complainant's well-known ELECTRIC LADY Marks. The general nature of Respondent's website content reinforces the notion that Respondent sought to mislead Internet users to its own contact information and music venue business via the use of Complainant's distinctive ELECTRIC LADY mark. Complainant shows that Respondent's own website provides a menu for "drinks" "appetizers" and "bottle service" seemingly for a nightclub and live music venue, which is likely to cause confusion with Complainant's ELECTRIC LADY mark where Respondent is attempting to pass itself off as Complainant or an affiliate or associate of Complainant in Miami, Florida. In addition, Complainant shows that Respondent also has linked an "Electric Lady" venue with a physical address identical to the address displayed on the webpage at the disputed domain name to a recent live music festival in Miami complete with a digital image of a bar, advertising Respondent's nightclub as a musical venue and providing a listing of performers appearing at its venue as featured among the promotional website images for the Miami music festival.

Prior panels have consistently held that use of a disputed domain name to misdirect Internet users seeking a complainant to a competitive or related site is not a bona fide offering of goods or services or a legitimate noncommercial or fair use under the Policy. See *Kosmea Pty Ltd. v. Krpan*, WIPO Case No. [D2000-0948](#). Accordingly, Respondent is not making a bona fide offering of goods or services and, therefore, Respondent has no rights or legitimate interests in the disputed domain name under the circumstances described in paragraph(4)(c)(ii) of the Policy.

Complainant has also shown that Respondent is not commonly known by the disputed domain name. The Registrar disclosed the underlying registrant name and organization as, "Ray Cuevas, Electric lady", which Complainant amended its Complaint to name as Respondent. Respondent registrant as an individual bears no resemblance to the disputed domain name whatsoever and the addition of the registrant organization may have been chosen to falsely suggest an affiliation. These facts combined with Respondent's lack of a response to the Complaint, and the well-known status of the ELECTRIC LADY mark and the lack of evidence in the record to suggest otherwise allows this Panel to find that Respondent is not commonly known by the disputed domain name or any variation thereof pursuant to Policy paragraph 4(c)(ii). See *Six Continents Hotels, Inc. v. Trasporto di Networ and Pro Intel*, WIPO Case No. [D2004-0246](#) ("given Complainant's established use of its... marks, it is unlikely that the Respondents are commonly known by any of these marks").

It is also generally regarded as prima facie evidence of no rights or legitimate interests if a complainant shows that the disputed domain name is identical or confusingly similar to a complainant's trademark, that the respondent is not commonly known by the disputed domain name, and that a complainant has not authorized the respondent to use its mark (or an expression which is confusingly similar to its mark), whether in the disputed domain name or otherwise. See *Roust Trading Limited v. AMG LLC*, WIPO Case No. [D2007-1857](#).

Most importantly, Complainant contends Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services because, as Complaint's submitted evidence of web page printouts shows the disputed domain name resolves to a website where Respondent is attempting to pass itself off as Complainant or an affiliate or associate of Complainant in Miami, Florida. Complainant shows that Respondent also has linked an "Electric Lady" venue with a physical address identical to the address displayed on the webpage at the disputed domain name to a recent live music festival in Miami complete with a digital image of a bar, advertising Respondent's nightclub as a musical venue and providing a listing of performers appearing at its venue as featured among the promotional website images for the Miami Music Festival. The Panel notes this evidence submitted in the annexes to the Complaint persuasively supports Complainant's argument because it shows that by using Respondent's website at the disputed domain name displaying Complainant's ELECTRIC LADY mark, Respondent advertises for and directs individuals to its live music performances at the its competing Electric Lady nightclub. Further the Panel notes appending the geographical location "Miami" to the end of mark in the disputed domain name is similar in configuration to Complainant's addition of "New York" in its registered ELECTRIC LADY NEW YORK mark listed in Section 4 above. The use of a domain name which is identical or confusingly similar to Complainant's trademark with an intention of deriving advantage from user confusion and diverting Internet users to other commercial sites does not confer rights or legitimate interests on Respondent. See *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#); *Bridgestone Corporation v. Horoshiy, Inc.*, WIPO Case No. [D2004-0795](#). Based on these facts the Panel finds Respondent's actions are clearly not legitimate and clearly are misleading. Respondent, therefore, cannot establish rights or legitimate interests pursuant to paragraph 4(c)(iii) of the Policy. See *Six Continents Hotels v. "m on"*, WIPO Case No. [D2012-2525](#).

In view of the above, the Panel finds that Complainant has made out a prima facie case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has not submitted any evidence to rebut Complainant's prima facie case. The Panel determines, therefore, that Respondent does not have rights or legitimate interests in the disputed domain name and Complainant has successfully met its burden under Policy paragraph 4(a)(ii).

### **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.

Paragraph 4(b) of the Policy also 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. See also *The Knot, Inc. v. In Knot We Trust LTD.*, WIPO Case No. [D2006-0340](#).

Complainant contends that Respondent registered the disputed domain name in bad faith because Respondent has created a disputed domain name that is confusingly similar to Complainant's well-known ELECTRIC LADY mark, as found in section 6.A above. Prior UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a widely known or famous trademark by an unaffiliated entity can by itself create a presumption of bad faith. See, [WIPO Overview 3.0](#), section 3.1.4. See also *B&B Hotels v. King Yeotan, Zion Prayer International Ministry*, WIPO Case No. [D2022-4803](#).

Given the record shows that Complainant's well-known ELECTRIC LADY mark is protected by trademark registrations in the United States where Respondent is purportedly located, registered over 5 years prior to Respondent's registration of the disputed domain name, which like Complainant's official domain name <electricladystudios.com>, encompasses the ELECTRIC LADY mark in its entirety, the Panel finds it is implausible to believe that Respondent did not have actual knowledge of Complainant's well-known ELECTRIC LADY mark when it registered the confusingly similar disputed domain name.

Prior panels have held that a respondent's actual knowledge of a complainant's mark may serve as a basis for finding bad faith registration. See *OSRAM GmbH v. Azarenko Vladimir Alexeevich, Azarenko Group Ltd*, WIPO Case No. [D2016-1384](#) (finding bad faith where "Respondent must have been aware of Complainant and its said trademark when it registered the disputed domain name" and "the Panel cannot conceive of any use that Respondent could make of the disputed domain name that would not interfere with Complainant's long-established trademark rights"). Accordingly, the Panel finds that Respondent had actual knowledge of the ELECTRIC LADY mark when it registered the disputed domain name, and such a showing is sufficient to establish bad faith registration of the disputed domain name.

The Panel also notes that Complainant has submitted evidence sufficient to support a finding of Respondent's bad faith registration and use of the disputed domain name under Policy paragraph 4(b)(iv).

It is well settled that the registration and commercial use of a confusingly similar domain name, to create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the respondent's website, thereby taking advantage of the complainant's mark for a respondent's commercial gain, supports a finding of bad faith registration and use under Policy paragraph 4(b)(iv). See *Converse Inc. v. Perkins Hosting*, WIPO Case No. [D2005-0350](#).

Here, Respondent, who is unaffiliated with Complainant, has registered the disputed domain name to display under the impersonating and misleading title "ELECTRIC LADY", advertising for food, beverage, and bottle services for a nightclub and live music venue, which is likely to cause confusion with Complainant's ELECTRIC LADY mark. The Panels finds such use of the disputed domain name that is confusingly similar to Complainant's ELECTRIC LADY Marks, to divert Complainant's consumers to Respondent's website is bad faith registration and use under the Policy paragraph 4(b)(iv). See e.g., *AT&T Corp. v. Yong Li*, WIPO Case No. [D2002-0960](#).

Respondent also did not respond to Complainant's cease-and-desist letter and did not explain or justify Respondent's use of Complainant's trademark in the disputed domain name and in Respondent's Instagram advertisement link shown in the letter which uses the ELECTRIC LADY Mark followed by "Wynwood". The Panel notes the term added by Respondent to Complainant's Mark is a slight misspelling but phonetic equivalent of the surname of one of the artists present when Jimi Hendrix hosted the studio's opening in 1970 – Steve Winwood, which possibly provides further evidence of Respondent's awareness of Complainant's Mark and targeting by Respondent to create an implied association between Respondent and Complainant. Prior UDRP panels have held that failure to respond to a cease-and-desist letter may be considered a factor in finding bad faith registration and use of a domain name. *Remy Cointreau Luxembourg S.A. v. Deividas Samulionis, UAB "Sentosa,"* WIPO Case No. [D2016-2232](#).

Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy. The Panel finds that 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 <electricladymiami.com> be transferred to Complainant.

/Scott R. Austin/

**Scott R. Austin**

Sole Panelist

Date: June 16, 2024