

ADMINISTRATIVE PANEL DECISION

Gibson, Inc. v. Дмитрий Ионцев
Case No. D2024-1949

1. The Parties

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

The Respondent is Дмитрий Ионцев, Kazakhstan.

2. The Domain Name and Registrar

The disputed domain name <mesahollywood.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 May 9, 2024. On May 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 13, 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 the Complainant on May 14, 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 May 17, 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 May 22, 2024.

The Respondent sent a submission to the Center on May 22, 2024. The Complainant filed a reply to the Respondent’s submission on July 2, 2024.

In accordance with the Rules, paragraph 5, the due date for Response was July 14, 2024. The Response was filed with the Center on July 5, 2024.

The Center appointed John Swinson as the sole panelist in this matter on July 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 Complainant is a company based in Nashville, Tennessee that has developed, manufactured, and sold musical instruments, including electric guitars, acoustic guitars, basses, mandolins, and other stringed instruments, for over 100 years.

In January 2021, the Complainant acquired the assets of Mesa/Boogie, Ltd., an American manufacturer of amplifiers for guitars and basses. Mesa/Boogie, Ltd. had manufactured boutique amplifiers for over 50 years.

The Complainant owns a portfolio of trademark registrations for MESA and for MESA/BOOGIE in several countries, including United States Trademark Registration No. 3,268,301 for MESA that was registered on July 24, 2007.

The Complainant owns several MESA domain names, including, but not limited to, <mesaboogie.com>, <mesaboogiehollywood.com>, and <mesahollywood.info>. The domain name <mesaboogie.com> was registered in 1995.

The Complainant was the previous owner of the disputed domain name, which was originally registered on January 10, 2008. By mistake, the Complainant let the disputed domain name lapse. The Respondent subsequently registered the disputed domain name.

According to the Registrar records, the Respondent is apparently located in Kazakhstan. Little information is known about the Respondent.

After the disputed domain name was registered by the Respondent, the website at the disputed domain name showed the Complainant's content, resembling the Complainant's website at the disputed domain name before the Complainant let the disputed domain name lapse, but also including advertisements for online casinos. Subsequently, the disputed domain name was redirected to <br-jogodotigre.com>, which is a website in Portuguese that advertises online casinos. This website is titled "Fortune Tiger" and includes text (translated by Google Translate into English) that states: "The Tiger Game, known as Fortune Tiger, is a slot machine game developed by PG SOFT. The game was released in Brazil on May 19, 2023 by the company KTO Group and quickly became a topic of debate, as the game of chance is considered illegal in the country. In just one month after launch, the Fortune Tiger became extremely popular in Brazil, becoming the favorite slot machine game of Brazilians at the time. However, this popularity brought with it a number of controversies."

At the present time, the disputed domain name resolves to a website that is titled "Mesas in Hollywood: Natural Wonders on the Silver Screen" and includes a photograph of the famous Hollywood sign and text that states: "Hollywood, as the global center of the film industry, has always sought out striking natural landscapes for its movies. One such unique landform frequently used in cinema is the mesa. These flat topped plateaus with steep cliffs not only captivate with their grandeur but also serve as perfect backdrops for creating atmospheric and dramatic scenes. In this article, we will explore how mesas have become an integral part of filmmaking and highlight some famous movies that have featured these natural formations."

After the Respondent received the Complaint, the Respondent sent an email to the Center on May 23, 2024 that stated: "I can sell you this domain for \$500 with payment via paypal...". In the Response, the

Respondent stated inter alia: “I repeat, I can sell you a domain for \$500 and I don’t negotiate. I paid for this domain and I don’t see any violations here.”

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 the Respondent is utilizing the disputed domain name and the website at the disputed domain name to advertise the Respondent’s online gambling products and services. The Complainant submits that the Respondent, without authorization, has copied and reproduced the Complainant’s copyrighted website content previously displayed on the website at the disputed domain name during the Complainant’s prior ownership of the disputed domain name and linked the disputed domain name’s website content to various websites utilized for online gambling.

B. Respondent

The Respondent contends the disputed domain name contains a geographical term and that “Mesa Hollywood refers specifically to the region” and not to the Complainant. The Respondent submits that merely including a brand name in a domain name is not sufficient to succeed under the Policy.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 onus of proving these elements is on the Complainant.

A. Supplemental Filing

The Complainant filed a supplemental submission, which is stated to be a “reply” to an informal submission of the Respondent that was emailed to the Center on May 22, 2024 (the day that the Center notified the Respondent of the Complaint.) This supplemental submission primarily consists of legal arguments and not additional evidence.

Neither the Policy nor the Rules include express provision for such a submission. A Panel has the discretion to admit or invite filings under paragraphs 10(a), (b), (d), and 12 of the Rules, including further filings to a party’s main submission.

The Panel decides that the Complainant’s supplemental submission is not admissible, because at the time the Complaint was filed, the Complainant could have anticipated the arguments presented by the Respondent.

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, "hollywood") 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 website at the disputed domain name soon after the disputed domain name was acquired by the Respondent included a copy of the Complainant's content, with advertisements for online casinos placed under the Complainant's content. Panels have held that the use of a domain name for impersonation or passing off can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

After the Respondent received the Complaint, the website at the disputed domain name was changed to provide factual information about Hollywood and the use of mesas (a flat-topped hill with steep, often vertical sides, from the Spanish word meaning "table") in locations for three Hollywood films. The Panel considers that this website was created for the purpose of this dispute in an attempt to fabricate a legitimate interest. The Respondent provided no explanation why the disputed domain name was first used for a website that copied the Complainant's content and advertised casinos, and then to provide information about Brazilian slot machines, and, after being notified of this dispute, providing information about hills in Hollywood movies. Compare *Panavision Intern., LP v. Toeppen*, 938 F. Supp. 616 (C.D. Cal. 1996).

The Respondent provided no explanation why he combined the terms “mesa” and “Hollywood” in the disputed domain name. In the Panel’s view, such a combination is unusual.

In view of all these circumstances, the Panel finds it implausible that the disputed domain name is being genuinely used in connection with the dictionary meanings of the words that it contains and that it is plainly being used to trade off the Complainant’s trademark rights. Accordingly, the Panel finds that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services for the purposes of the Policy and has no legitimate interest in the same. *Consumer Reports, Inc. v. Artur Solovev*, WIPO Case No. [D2022-0558](#).

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 Respondent registered the disputed domain name after it expired, and then created a website that included the Complainant’s content but that also advertised online casinos. Clearly, the Respondent was aware of the Complainant, and registered the disputed domain name to take advantage of users looking for the Complainant’s former website or its MESA products. This is clear bad faith registration and use. *L.M. Waterhouse & Co., Inc. v. Scott Myers, Intersearch Global*, WIPO Case No. [D2021-0962](#); *DS Smith PLC v. Ryan Dunn*, WIPO Case No. [D2024-1120](#); *Captain Fin Co. LLC v. Private Registration, NameBrightPrivacy.com / Adam Grunweg*, WIPO Case No. [D2021-3279](#).

Additionally, Panels have held that the use of a domain name for impersonation or passing off 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 <mesahollywood.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: July 30, 2024