

## **ADMINISTRATIVE PANEL DECISION**

Viacom International Inc. v. SilverEyes

Case No. D2024-2139

### **1. The Parties**

The Complainant is Viacom International Inc., United States of America (“United States” or “U.S.”), internally represented.

The Respondent is SilverEyes, Viet Nam.

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

The disputed domain name <avathartheastairbender.store> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 24, 2024. On May 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 28, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 June 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 23, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 24, 2024.

The Center appointed Zoltán Takács as the sole panelist in this matter on July 2, 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 in this administrative proceeding is a wholly owned subsidiary of one of the leading global media companies in the world Paramount Global (“Paramount”) which through its subsidiaries (including the Complainant) develops, creates and provides entertainment content, services and related brand products.

The Complainant is, and has for many years engaged in the business of producing and distributing entertainment programs in various media. One of its animated fantasy-action properties is called AVATAR: THE LAST AIRBENDER (“ATLA”) which began as an animated television series but has grown to become a multimedia franchise comprising of the original animated television series, a feature film titled “The Last Airbender” released in 2010, various books, novels, comics, video games and various merchandise.

The Complainant owns numerous ATLA related trademark registrations, for example:

- United States Trademark Registration No. 3002720 NICKELODEON AVATAR: THE LAST AIRBENDER registered on September 27, 2005; and

- United States Trademark Registration No. 4411362 THE LAST AIRBENDER registered on October 1, 2013.

The Complainant has been using its ATLA related marks and other ATLA related intellectual property rights through the production, manufacture, sale, licensing and merchandising of a wide variety of authorized goods and services at Paramount’s “www.paramountshop.com” website as well as at big multi-channel retailers Target and Walmart.

The disputed domain name was registered on January 17, 2021 and has been used in relation to a website claiming to be the “Avatar The Last Airbender Store – Official Avatar Last Airbender Merch” and allegedly offering for sale official ATLA related apparel and collectibles.

#### **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:

- if the applicable Top Level Domain (“TLD”) “.store” is disregarded the disputed domain name is identical to its ATLA related marks;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name since it is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy;
- the use of the disputed domain name for a website that offers counterfeit ATLA merchandise and prominently features the ATLA marks, logos and imagery is evidence of bad faith registration and use of the disputed domain name.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

##### **B. Respondent**

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

## 6. Discussion and Findings

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

### 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 Complainant's ATLA related marks are reproduced and are recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds that 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.

According to the documentary evidence submitted by the Complainant the Respondent has been using the disputed domain name to deceive Internet users looking for the Complainant through redirecting them to its own website at which the Respondent allegedly offers for sale official ATLA merchandise which the Complainant assumes are counterfeit.

There is no indication of any relationship of the Respondent with the Complainant as to the source of the products at issue and the website at the disputed domain name implies that the merchandise offered for sale on the Respondent's website originate with the Respondent and not the Complainant.

The Panel notes that there is no evidence as to whether the goods offered on the Respondent's website at the disputed domain name are counterfeit or "genuine", or whether any of those goods ultimately exist.

The Panel also notes that it is evident that the Complainant has not authorized, licensed, or allowed the Respondent or any third party to use its ATLA related trademarks through the disputed domain name or in any other way that would confer validity or legitimacy upon such usage. Despite the lack of authorization or relationship, the Respondent identifies its website as an "official" store for the Complainant's merchandise products.

Consequently even if the merchandise appearing on the Respondent's website under the disputed domain name would exist and be genuine, the Respondent's website would still not qualify as fair use. [WIPO Overview 3.0](#), sections 2.13.2 and 2.8.1 and *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903.

In the Panel's view it is indisputable that the Respondent has been impersonating the Complainant by using on its website at the disputed domain name the Complainant's trademarks, logos and imagery. Panels have held that the use of a domain name for illegal activity, here impersonation/passing off can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and that 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.

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

In the present case, the Panel notes that the Complainant's ATLA related marks are inherently distinctive and that their priority predates the date of registration of the disputed domain name.

The website at the disputed domain name which claims to be the "Avatar The Last Airbender Store – Official Avatar Last Airbender Merch" prominently features the Complainant's trademarks, logos and imagery. Thus in view of the Panel it is clear that the Respondent had actual knowledge of the Complainant and its marks and registered the disputed domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's marks. Paragraph 4(b)(iv) of the Policy.

The Respondent's intent to target the Complainant and its marks can be readily inferred from the contents of the Respondent's website seeking to impersonate the Complainant by directing Internet traffic to its website in order to gain illegitimate profit through impersonation or false association. Visitors of the Respondent's website might reasonably believe that is connected to or approved by the Complainant as it appears to offer merchandise under the Complainant's trademarks, logos and imagery and give impression that the site attached to the disputed domain name is official, while that it clearly not the case. Panels have held that the use of a domain name for illegal activity, in this case impersonation/passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

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 <avatharhelastairbender.store> be transferred to the Complainant.

*/Zoltán Takács/*

**Zoltán Takács**

Sole Panelist

Date: July 11, 2024