

ADMINISTRATIVE PANEL DECISION

Viacom International Inc. v. Le Mai Anh

Case No. D2024-2145

1. The Parties

The Complainant is Viacom International Inc., United States of America, internally represented.

The Respondent is Le Mai Anh, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <avathelastairbender-store.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 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 disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (DOMAINS BY PROXY, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 4, 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 amended Complaint on June 4, 2024.

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 the Respondent of the Complaint, and the proceedings commenced on June 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 1, 2024.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on July 10, 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 Viacom International Inc., a wholly owned subsidiary of Paramount Global. The Complainant is a Delaware corporation with its principal place of business located in New York NY, USA. Paramount, through its subsidiaries (including the Complainant), develops, creates and provides entertainment content, services and related branded products. The Complainant is, and has been for many years, engaged in the business of producing and distributing entertainment content in various media, including television. AVATAR: THE LAST AIRBENDER is an animated fantasy/action property that is owned and distributed by the Complainant. AVATAR: THE LAST AIRBENDER began as an animated television series but has grown to become a multimedia franchise.

The original animated television series ran from 2005-2008 and is currently available on the streaming services Netflix, Amazon Prime and Paramount+ around the world. The 2010 feature film "The Last Airbender" alone took in USD 319.7 million at the box office worldwide.

The Complainant has trademark registrations for the THE LAST AIRBENDER, AVATAR: THE LAST AIRBENDER and NICKELODEON AVATAR: THE LAST AIRBENDER trademarks.

The Complainant is, inter alia, the owner of:

United States of America trademark AVATAR: THE LAST AIRBENDER (word), filed on June 23, 2021, registration number 6898474 registered on November 15, 2022, first use in commerce January 7, 2007.

United States of America trademark THE LAST AIRBENDER (word), filed on April 16, 2010, registration number 4411362, registered on October 1, 2013, first use in commerce August 6, 2012.

Mexican trademark NICKELODEON AVATAR: THE LAST AIRBENDER (word), filed on April 29, 2016, registration number 1658443, registered on July 21, 2016;

The disputed domain name was registered on June 15, 2021.

On the Respondent's website the message "Avatar The Last Airbender Store – Official Avatar The Last Airbender Merch - Avatar The Last Airbender Store is the best Merchandise Store for Avatar The Last Airbender manga fans" is displayed. This website also displays purported AVATAR THE LAST AIRBENDER branded goods and the Complainant's copyrighted images.

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 disputed domain name is confusingly similar to the Complainant's trademarks, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and particularly that the Respondent showed bad faith when it registered and used the disputed domain name, which redirects to a website displaying purported AVATAR THE LAST AIRBENDER branded goods and the Complainant's copyrighted images, thereby creating an inescapable likelihood of confusion and deriving commercial gain via its sale of counterfeit merchandise featuring the Complainant's trademarks.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to obtain a transfer of the disputed domain name, paragraph 4(a) of the Policy requires that the Complainant must demonstrate to the Panel that:

- (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.

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 Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the THE LAST AIRBENDER trademark and to the AVATAR: THE LAST AIRBENDER trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here a hyphen and "store", may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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.

Panels have held that the use of a domain name for illegal activity here, claimed to be used to sale counterfeit goods, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

In addition, and irrespective of whether the products offered at the website are genuine or not, the Panel notes the composition of the disputed domain name, and the way the website displays copyrighted images of the Complainant, its trademarks, its logos, and pretends to be an “official” website. The Panel finds that the disputed domain name and the corresponding website carry a risk of implied affiliation with the Complainant and its website. [WIPO Overview 3.0](#), section 2.5.1.

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 intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s trademark.

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.

The disputed domain name was registered sixteen years after the Complainant started its AVATAR: THE LAST AIRBENDER animated television series which ran from 2005-2008 (still available on the streaming services Netflix, Amazon Prime and Paramount+ around the world). The wording “AVATAR: THE LAST AIRBENDER” is not a common or descriptive term, but a renowned trademark in the manga field. The fact that the disputed domain name reproduces the Complainant’s trademarks, together with its use to sell purported counterfeit goods branded with AVATAR: THE LAST AIRBENDER on a website with a message claiming that it is the official “Avatar The Last Airbender Store”, are therefore clear indications that the Respondent was aware of the Complainant’s trademark and activity when registering the disputed domain name.

Panels have held that the use of a domain name for illegal activity as in the case here, allegedly for the sale of counterfeit goods and impersonation/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 <avatarthelastairbender-store.com> be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: July 24, 2024