

## **ADMINISTRATIVE PANEL DECISION**

Varoom Whoa, Inc. v. James Bold  
Case No. D2024-2353

### **1. The Parties**

The Complainant is Varoom Whoa, Inc., United States of America (“USA”), represented by Akerman LLP, USA.

The Respondent is James Bold, United Kingdom.

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

The disputed domain name <paramoremerch.shop> is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 7, 2024. On June 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 11, 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 (Domain Administrator, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 12, 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 June 24, 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 June 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2024.

The Center appointed Miguel B. O'Farrell 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, Varoom Whoa Inc., is the business entity that operates Paramore, an American rock band founded in 2004, which has received critical acclaim throughout the world with numerous awards and nominations in the music industry, including winning multiple Grammy Awards.

Paramore currently consists of three band members, Hayley Williams (lead vocalist), Taylor York (lead guitarist), and Zac Farro (drummer), whose images are closely associated with the band, itself.

The Complainant owns several registrations for its PARAMORE marks in the USA, including the following.

USA Trademark Registration No. 3430716 PARAMORE, registered on May 20, 2008, in class 41;

USA Trademark Registration No. 3507475 PARAMORE, registered on September 30, 2008, in class 25:

USA Trademark Registration No. 3974072 PARAMORE, registered on June 7, 2011, in class 16.

The Complainant owns the domain names <paramore.net> and <paramoreisaband.com>, registered in 2000 and 2024, respectively, which it uses for the promotion of its goods and services.

The disputed domain name <paramoremerch.shop> was registered on May 8, 2023 and resolves to a website which offers similar goods to those offered by the Complainant which the Complainant claims to be counterfeits.

#### **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 uses the disputed domain name to offer and sell knock-off and infringing goods using the PARAMORE mark. Such goods are in direct competition with the Complainant's legitimate goods, which it sells on its own websites and through its authorized licensees and distributors. The infringing website consists of prominent and frequent use of the PARAMORE mark, alongside offers of products that comprise images associated directly with the Paramore band and false statements alluding to a non-existent relationship between the Complainant and the infringing website (i.e., "Official Website for Paramore Merch"; "Direct Support for Paramore"; "By buying his [sic] merch, not only you directly support the band's music and tour production...").

Further, a comparison of genuine products offered by the Complainant and products sold on Respondent's website shows that Respondent is using images uniquely associated with the Paramore band (and by extension, the Complainant) to trade off the goodwill in the PARAMORE mark to sell knock-off and infringing goods.

The Complainant requests the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainant.

## **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 "merch" 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 ".shop" generic Top-Level Domain is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

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 as applicable to this case: sale of counterfeit goods, passing off, or other types of fraud 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.

The Panel is satisfied that the Respondent must have been aware of the Complainant's business and trademark PARAMORE mentioned in section 4 above (Factual Background) and also the Complainant's websites to which its domain names resolve to when the Respondent registered the disputed domain name on May 8, 2023. By that time the Complainant had registered and used the trademark PARAMORE for many years.

By registering the disputed domain name, the Respondent was targeting the Complainant and its business by incorporating the Complainant's trademark PARAMORE in the disputed domain name in its entirety.

The fact that there is a clear absence of rights or legitimate interests coupled with no explanation for the Respondent's choice of the disputed domain name and the nature of the disputed domain name, are indicative of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)).

The Complainant has proven that the website to which the disputed domain name resolves offers goods, counterfeit or not, which are similar to those offered by the Complainant and includes the Complainant's trademark PARAMORE, which leads Internet users to mistakenly think that the website is an official website of the Complainant and thereby the Respondent may capitalize on the prestige of the trademark PARAMORE for its own monetary benefit.

The Panel finds that the Respondent registered and is using the disputed domain name in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

Therefore, 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 <paramoremerch.shop> be transferred to the Complainant.

/Miguel B. O'Farrell/  
**Miguel B. O'Farrell**  
Sole Panelist  
Date: July 31, 2024.