

ADMINISTRATIVE PANEL DECISION

315 Bowery Holdings, LLC v. Prodip Mondal
Case No. D2024-3024

1. The Parties

The Complainant is 315 Bowery Holdings, LLC, United States of America (United States), represented by Neal, Gerber & Eisenberg LLP, United States.

The Respondent is Prodip Mondal, India.

2. The Domain Name and Registrar

The disputed domain name <cbgbmerch.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 24, 2024. On July 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 25, 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 (Redacted for privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 26, 2024, 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 August 8, 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 August 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 2, 2024.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on September 9, 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's CBGB venue – CBGB being an acronym for “Country, Bluegrass, Blues, and Other Music For Uplifting Gourmandizers” – first gained widespread recognition in the 1970s as an iconic place for various punk rock and new wave music artists.

The Complainant owns registered trademark rights for CBGB in numerous countries, including the United States Trademark Registration number 1532062, registered on March 28, 1989.

The CBGB mark was adopted and has been continuously used in the United States since as early as 1976 in connection with clothing, t-shirts, sweaters, accessories, and other goods.

The disputed domain name <cbgbmerch.com> was registered on April 27, 2024.

The Panel accessed the disputed domain name on September 20, 2024, when it was not linked to any active website. ¹ However, the Complainant brought evidence that the disputed domain name recently resolved to a webstore named “CBGB Merch Official Store”, where, allegedly, counterfeits of CBGB clothing items were offered for sale. The website claims to sell authentic CBGB merchandise, features the Complainant's CBGB trademark, and does not contain a disclaimer of the lack of association with the Complainant.

Furthermore, the website displays the following text on its frontpage: “Welcome to the CBGB Merchandise Store. Are you a fan of punk rock music? Do you want to show your love for the iconic CBGB club? Here at CBGB Merch, we have a wide range of merchandise that will help you express your passion for this legendary venue. Shop now and let your punk rock spirit shine!”

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The trademark CBGB has been widely recognized since the 1970s as a hallmark for punk rock and new wave music in New York City, and later for various merchandise including clothing items and accessories. The mark is not only registered by the Complainant since 1989, but also has considerable goodwill and an extensive online presence, particularly through the Complainant's official merchandise website at <shop.cbgb.com>. The disputed domain name includes the trademark CBGB in its entirety, only adding the term “merch” as a suffix and the generic Top-Level Domain (gTLD) “.com”, which are not sufficient to differentiate from the Complainant's mark.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name.

¹Further to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.8, “[n]oting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name...”.

The disputed domain name is being used to sell counterfeit products purporting to be official CBGB merchandise, misleading consumers. This use does not constitute a bona fide offering of goods or services or legitimate non-commercial or fair use. The Respondent is not known by the CBGB mark nor has any business or individual relationship that justifies such use. As such, any claim by the Respondent to rights or legitimate interests in the disputed domain name is negated by its own actions.

- The disputed domain name was registered and is being used in bad faith. The Respondent is exploiting the CBGB trademark's fame and goodwill by creating a counterfeit online store at the disputed domain name that deceives consumers into believing they are purchasing legitimate CBGB products. This misuse includes trading on the Complainant's reputation to sell infringing products and possibly gathering sensitive personal data and financial information from unsuspecting customers. The Respondent's failure to respond to takedown requests and the continuation of its misleading practices further substantiate the bad faith claim. The disputed domain name was registered with prior knowledge of the CBGB trademark's reputation, which is indicative of bad faith under trademark law principles.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (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 3.0](#), section 1.7.

Exhibit 5 to the Complaint shows registrations for the CBGB trademark obtained by the Complainant as early as in 1989. Based on the available record, the Panel finds 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 trademark CBGB is wholly encompassed within the disputed domain name, together with the term "merch", as well as with the gTLD extension ".com".

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 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.

It is also well established that the addition of a gTLD, such as ".com", is typically disregarded when determining whether a domain name is confusingly similar to a complainant's trademark as such is viewed as a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, 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 Complainant has not licensed nor authorized the use of its trademark to the Respondent, and the Panel finds no indication that the Respondent is commonly known by the disputed domain name.

Furthermore, the Complainant has shown that the disputed domain name was linked to a website offering for sale CBGB clothing items, reproducing the Complainant’s trademark and logo. However, according to the Complainant, the Respondent is not an authorized reseller, nor has it obtained any permission for such reproductions of trademarks and logos.

Additionally, although encompassing the Complainant’s trademark CBGB at the disputed domain name and entitling the respective website “CBGB Merch Official Store”, the website does not accurately and prominently disclose the registrant’s relationship with the trademark holder. On the contrary, the website purports to be the official merch store of the Complainant’s clothing items, which is denied by the Complainant. Therefore, the Respondent does not pass the “Oki Data test” to characterize a legitimate interest with regards to the disputed domain name (see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)).

Furthermore, the Panel finds that the composition of the disputed domain name carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, 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.

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 Panel concludes that it is not feasible that the Respondent was not aware of the Complainant’s trademark and that the registration of the disputed domain name was a mere coincidence.

When the disputed domain name was registered (in 2024) the CBGB trademark was already connected with the Complainant's clothing items, especially in the United States.

The disputed domain name includes the trademark CBGB in its entirety, just adding the term "merch", which is a common acronym for "merchandise" in the English language. According to the [WIPO Overview 3.0](#), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The Panel notes that the disputed domain name currently resolves to an inactive page. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

The non-collaborative posture of the Respondent, i.e., (a) not presently using the disputed domain name, (b) not indicating any intention to use it, and (c) not at least submitting a Response to this procedure or providing justifications for the use of a third-party trademark, certainly cannot be used in benefit of the Respondent in this Panel's opinion.

Furthermore, the content at the website recently linked to the disputed domain name - including reproductions of the Complainant's trademark and logo – and the false claims that the clothing items sold there were official and authentic make it clear that the Respondent intentionally attempted to attract the Complainant's customers, for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website.

Based on the available record, the Panel finds the third element of the Policy has been established

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 <cbgbmerch.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: September 23, 2024