

## **ADMINISTRATIVE PANEL DECISION**

Paws, Incorporated v. Fomichev Artemy, Fidget  
Case No. D2024-3043

### **1. The Parties**

The Complainant is Paws, Incorporated, United States of America, internally represented.

The Respondent is Fomichev Artemy, Fidget, Russian Federation.

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

The disputed domain name <garfieldplush.com> 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 July 25, 2024. On July 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 29, 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 the Respondent (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 29, 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 July 29, 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 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 28, 2024.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on August 30, 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 wholly owned subsidiary of Paramount Global which is a premier global media company. Paramount Global, through its subsidiaries (including the Complainant) develops, creates and provides entertainment content, services and related branded products. The Complainant is, and has for many years, engaged in the business of producing and distributing entertainment programs in various media, including television.

Garfield is a property that is owned and distributed by the Complainant. Garfield began as a comic strip in 1978 and has since grown to become a multimedia franchise comprising animated and live action films, animated television series, various books, novels and comics, video games, and merchandise including toys, clothing, hats, housewares and other collectibles.

The Complainant holds numerous trademarks for GARFIELD on a worldwide basis, inter alia:

- United States of America Trademark Registrations: registration n° 1151014, registered April 14, 1981 (wordmark GARFIELD) and registration n° 2186737, registered September 1, 1998, covering inter alia plush toys (wordmark GARFIELD STUFF),
- European Union Trademark Registration, registration n° 002513695, registered May 16, 2003, covering inter alia stuffed toy animals and soft toys,
- Russian Federation Trademark Registration, registration n° 252023, registered July 22, 2003, covering inter alia plush toy figures and soft toys; the Respondent is apparently located in the Russian Federation.

These registrations have been duly renewed and are still valid. The registrations will jointly be referred to, in singular, as the "Trademark".

The disputed domain name was first registered on September 27, 2022.

Shortly before the Complaint was filed the disputed domain name resolved to a website that prominently displays the Trademark. This website offered plush dolls and other merchandise goods with the same appearance as the cartoon character Garfield.

At the time of the Decision the disputed domain name does not resolve to an active website.

The Complainant sent the Respondent a cease and desist letter dated June 10, 2024, via the email listed on the website the disputed domain name resolved to demanding that the Respondent immediately, amongst other things, cease all marketing and sales of unauthorized merchandise on its website, relinquish and assign the disputed domain name to the Complainant. A further follow up email was sent to the Respondent on June 24, 2024. The Respondent did not respond or comply with any of its demands.

#### **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 it owns and controls copyrights, trademarks, service marks and trade dress associated with the world-famous Garfield franchise, which is a valuable and popular property and has, since the introduction in 1978, developed a dedicated and vast following of fans worldwide. The Complainant has produced, licensed and marketed thousands of products and services throughout the world utilizing the copyrights, trademarks, service marks and trade dress derived from and related to Garfield. Sales of Garfield both by the Complainant and its licensees are an important component of the Complainant's licensing program. The Complainant has spent substantial sums on the advertising and promotion of Garfield around the world.

The Complainant contends that the disputed domain name is identical or confusingly similar to the Trademark in which the Complainant has rights. The disputed domain name incorporates the Trademark and, in fact, is identical to the Trademark but for the addition of the generic word “plush” and the generic Top Level Domain (“gTLD”) “.com”. These additions are irrelevant.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has no statutory or common-law trademark rights (or any other rights or legitimate interest) in the Trademark, copyright work or the disputed domain name. Moreover, the Respondent is not a licensee of the Complainant, nor has the Complainant granted any permission or consent whatsoever for the Respondent to use the Trademark or any domain name incorporating the Trademark or the copyright work. Furthermore, the Respondent is not commonly known by the Garfield name, or any variation of this, and nothing in the Whois contact information for the Respondent states or even implies otherwise.

The use such as the Respondent’s, which intentionally trades on the fame of another cannot constitute a bona fide offering of goods or services. The Respondent has and continues to derive revenue from selling unlicensed merchandise featuring the Garfield character. Such use evidences the Respondent’s intent to derive commercial gain by misleading or diverting consumers into believing that the disputed domain name is the official online store for Garfield merchandise when this is not the case.

The disputed domain name was registered and is being used in bad faith.

The Respondent has demonstrated its bad faith by: (1) registering a domain name that is virtually identical to the Complainant’s famous Trademark, thereby creating an inescapable likelihood of confusion; and (2) deriving commercial gain via its sale of unauthorized merchandise featuring the Trademark. It is clear that the Respondent is attempting to benefit from the goodwill which the Complainant has established in its Trademark. The fame of Garfield is sufficient – in and of itself – to demonstrate the Respondent’s bad faith in registering the disputed domain name.

Any registration and/or use of a domain name confusingly similar to a famous mark is an opportunistic attempt to attract customers, and that such use constitutes bad faith under paragraph 4(c) of the Policy. No plausible explanation exists as to why the Respondent selected the Trademark as part of its domain name other than to trade on the goodwill of the Trademark, further supporting a conclusion of bad faith registration and use.

The Respondent’s bad faith is further demonstrated by the fact that there were many news articles in and around September 2022 regarding the change of release date of The Garfield Movie in 2024. The disputed domain name was registered in September 2022. It is clear that the official announcement of the new release date prompted the registration of the disputed domain name.

The Respondent’s launch of the Website was intentionally done for commercial gain and to trade on the goodwill of the Trademark in anticipation of the new film release.

The Complainant requests 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**

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following three elements in order to succeed in its Complaint:

(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.

The burden of proof of each element is borne by the Complainant. The Respondent's default does not by itself mean that the Complainant is deemed to have prevailed. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.3.

### **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.

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 Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "plush") 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 Respondent has no statutory or common-law trademark rights (or any other rights or legitimate interest) in the Trademark or the disputed domain name. Moreover, the Respondent is not a licensee of the Complainant, nor has the Complainant granted any permission or consent whatsoever for the Respondent to use the Trademark or any domain name incorporating the Trademark. Furthermore, the Respondent is not commonly known by the disputed domain name, or any variation of this, and nothing in the Whois contact information for the Respondent states or even implies otherwise.

Panels have held that the use of a domain name for illegal activity (here, claimed sale of counterfeit goods) 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.

In the present case, the Panel notes that on a balance, and certainly lacking a response, the Panel finds that given the notoriety of the Complainant's rights in its GARFIELD Trademark, the Respondent must have had knowledge of the Complainant's rights in its Trademark, when registering the disputed domain name and subsequently using it for its website to which the disputed domain name resolved.

No plausible explanation exists as to why the Respondent selected the Trademark as part of its domain name other than to trade on the goodwill of the Trademark, further supporting a conclusion of bad faith registration and use.

The Complainant has demonstrated that the Respondent used the disputed domain name for a website on which apparently unauthorized merchandise bearing the GARFIELD Trademark were offered for sale, without the consent of the Complainant. The Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Trademark. The Respondent is attempting to benefit from the goodwill which the Complainant has established in its Trademark.

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.

Discontinuing use that qualifies as bad faith use and after the Complainant has summoned the Respondent to do so, neither precludes a finding of bad faith.

Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's Trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Panels have held that the use of a domain name for illegal activity (here, claimed the sale of counterfeit goods) 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 circumstances that the Respondent did not reply to the letter sent by the Complainant, nor respond formally to the Complaint, supports a finding of registration and use in bad faith.

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 <garfieldplush.com> be transferred to the Complainant.

*/Richard C.K. van Oerle/*

**Richard C.K. van Oerle**

Sole Panelist

Date: September 9, 2024