

ADMINISTRATIVE PANEL DECISION

Gibson, Inc. v. Tim Joush
Case No. D2024-3915

1. The Parties

The Complainant is Gibson, Inc., United States of America (“United States”), represented by Bates & Bates LLC, United States.

The Respondent is Tim Joush, United States.

2. The Domain Name and Registrar

The Disputed Domain Name <gibsonguitarmod.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 25, 2024. On September 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 26, 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 Admin, Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 26, 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 September 30, 2024. The Complainant filed an amended Complaint on October 9, 2024.

The Center verified that the Complaint together with the amendment to the Complaint and 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 October 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2024. The Complainant forwarded the Center an informal email from the Respondent on October 4, 2024.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on November 8, 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

Complainant is engaged in the business of developing, manufacturing, and selling musical instruments, including electric guitars, acoustic guitars, basses, mandolins, and other stringed instruments under the famous GIBSON Trademark for over a century and is the owner of the GIBSON mark; e.g. United States trademark registration number 71536891 for GIBSON, registered on June 7, 1949. Complainant's products are offered throughout the world, and Complainant's name and instruments have gained worldwide recognition and reputation. In addition to its trademarks, Complainant owns a number of GIBSON domain names, including, but not limited to <gibson.com> created on May 31, 1994.

The Disputed Domain Name <gibsonguitarmod.com> was registered on September 23, 2023.

As of November 22, 2024, the Disputed Domain Name resolves to a page which claims to be selling GIBSON guitars.¹

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, Complainant contends that the Disputed Domain Name incorporates Complainant's GIBSON trademark in its entirety and the inclusion of "guitar" in the Disputed Domain Name does nothing to alleviate any confusing similarity.

Respondent has no rights or legitimate interests in the Disputed Domain Name. Respondent is not a partner, licensee, or authorized retailer of Gibson branded products nor does Respondent have Complainant's consent to use the GIBSON Trademarks, or any other trademarks owned by Complainant, to advertise and sell Respondent's products. Respondent does not appear to be commonly known by the Disputed Domain Name. Rather, Respondent registered the confusingly similar Disputed Domain Name to attract internet users to its website by falsely suggesting affiliation with, sponsorship or endorsement by Complainant as well as to trade off the tremendous goodwill Complainant has established in the GIBSON Trademarks.

Respondent has no legitimate interest in the confusingly similar Disputed Domain Name because it fully incorporates Complainant's GIBSON trademark, and falsely suggests affiliation with Complainant. Further, Respondent lacks rights and a legitimate interest as it is not using the Disputed Domain Name in connection with a bona fide offering of goods/services or a legitimate non-commercial or fair use, as the Disputed Domain Name at the time of the amended Complaint was parked and did not resolve to an active webpage. Importantly, the Respondent lacks rights and a legitimate interest as it previously utilized the Disputed Domain Name, and linked website content, to advertise counterfeit or infringing Gibson products.

¹In its Amended Complaint the Complainant stated that the Disputed Domain Name resolves to a parking page after previously resolving to a page which it asserts it selling counterfeit GIBSON branded guitars. It appears that the original website displaying for sale allegedly counterfeit GIBSON branded guitars is active once again.

Respondent has registered and is using the Disputed Domain Name in bad faith as it knew, or at least should have known, that its registration would have been identical or confusingly similar to Complainant's GIBSON Trademark as the Disputed Domain Name incorporates Complainant's famous GIBSON Trademark in its entirety. There is no explanation for Respondent to have chosen to register the Disputed Domain Name other than to intentionally trade off the goodwill and reputation of Complainant's trademark or otherwise create a false association with Complainant.

B. Respondent

Respondent did not respond to the Complainant's contentions other than to write "Hello Laura Deines We are not issuing our domain out We had a complication."

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant has demonstrated it owns registered trademark rights in the famous GIBSON mark and has shown that no other entity has rights in or uses Complainant's mark for guitars or musical instruments. The additions of "guitar" and "mod" do not prevent the Complainant's trademark from being recognizable in the Disputed Domain Name. The top-level domain ("TLD") ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Accordingly, the Disputed Domain Name is confusingly similar to a mark in which the Complainant has rights.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, and *Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*, WIPO Case No. [D2015-2316](#).

B. Rights or Legitimate Interests

Complainant has presented a prima facie case that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been commonly known by the Disputed Domain Name.

The fact that Respondent obtained the Disputed Domain Name almost 80 years after Complainant had begun using its GIBSON mark indicates that Respondent sought to piggyback on the GIBSON mark for illegitimate reasons.

After a complainant has made a prima facie case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Name. Moreover, the evidence provided by the Complainant shows that the Disputed Domain Name resolves to an active website seemingly impersonating the Complainant by featuring the Complainant's trademark, logo, and copyrighted images of the Complainant's trademarked goods. While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant and similarly, the lack of any information on the Disputed Domain Name as to the website's lack of authorization or relation to the Complainant, renders any fair use safe haven inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#).

Irrespective of the Disputed Domain Name satisfying the so-called Oki Data test, the phonetically identical nature of the Disputed Domain Name to the Complainant's trademark carries a high risk of implied affiliation, especially when considering the impersonating nature of the content exhibited at the Disputed Domain Name, and as such cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

While circumstantial, the lack of authorization and the severely discounted prices found at the Disputed Domain Name suggest that, should any products be sold at the Disputed Domain Name, they are likely to be counterfeit. Noting the above considerations, it is not necessary for the Panel to make any ultimate determination as to the nature of the goods, as the evidence clearly shows the Respondent has attempted to pass itself off as the Complainant. The Panel finds that such use cannot be qualified as a bona fide offering of goods or services or legitimate noncommercial or fair use. See section 2.13 of the [WIPO Overview 3.0](#). Rather, such illegal use can never confer rights or legitimate interests upon a respondent.

In the absence of any evidence rebutting the Complainant's prima facie case indicating the Respondent's lack of rights or legitimate interests in respect of the Disputed Domain Name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Complainant has satisfied its burden of proof in establishing the Respondent's bad faith in registration and use of the Disputed Domain Name. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a domain name to intentionally attempt to attract Internet users, for commercial gain.

Due to the renown of the GIBSON mark, it is inconceivable that the Respondent registered the Disputed Domain Name incorporating the Complainant's mark with the terms "guitar" and "mod" without knowledge of the Complainant. The Disputed Domain Name is used for a website that is allegedly selling products identical to those offered by the Complainant and bearing its trademarks, but the Complainant has established that the Respondent's use is not authorized, nor is affiliated with the Complainant in any way. The facts establish a deliberate effort by the Respondent to cause confusion with the Complainant for commercial gain. Such impersonation of the Complainant is sufficient to establish the Respondent's bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#). Under these circumstances, the Panel finds no plausible good faith reason for the Respondent's conduct and concludes that the Disputed Domain Name was registered and used in bad faith.

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 <gibsonguitarmod.com> be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: November 22, 2024