Decision for dispute CAC-UDRP-102457

Case number	CAC-UDRP-102457
Time of filing	2019-05-15 14:34:14
Domain names	tm104.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	UMG Recordings, Inc.

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky

Respondent

Name	Bachelor Fortune

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings, pending or decided, which relate to the disputed domain name

IDENTIFICATION OF RIGHTS

The Complainant has evidenced to be the owner of the following trademark registration:

Word mark TM104, Benelux Office for Intellectual Property, Registration No.: 1395147, Registration Date: May 6, 2019.

Also, Complainant claims to have acquired unregistered rights and goodwill in the trademark TM104 through the well-known American Rapper Jeezy who had announced already in March 2018 its next album with Def Jam Recordings, one of Complainant's major recording labels, called "TM104" with Complainant having its merchandising partners as well as Jeezy himself beginning to sell TM104-branded merchandise (hoodies and t-shirts).

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Preliminary

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.” In order to succeed in its claim, Complainant must demonstrate that the three elements enumerated in paragraph 4(a) of the Policy have been satisfied, specifically: (i) the Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (ii) Respondent has no rights to or legitimate interests in respect of the Domain Name; and (iii) Respondent has registered and is using the Domain Name in bad faith. The applicable standard of proof is the “balance of probabilities." E.g., Bayer AG v. Cagri Savan, WIPO Case No. D2015-1573 (Oct. 26, 2015). The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (Forum July 31, 2000).

I. The Disputed Domain Name is Identical or Confusingly Similar to a Trademark or Service Mark in which Complainant has Rights (Policy Par. 4(a)(ii)).

Paragraph 4(a)(i) of the Policy requires a two-fold enquiry – a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark.

Complainant UMG Recordings, Inc. ("UMG"), a Delaware corporation is a flagship subsidiary owned by Vivendi S.A., a publicly traded French corporation, and “Universal Music Group” is a trade name for UMG, one of the world's most innovative companies (see http://www.umusic.com). At the end of last calendar year, Universal Music Group had revenues of €6.023 billion, and is the world leader in music, engaged in recorded music, music publishing and merchandising. Id., at 3. It owns more than 50 labels covering all music genres. Id., at 6. Last year for example, several of the world’s most iconic artists signed or re-signed with UMG, including deals with Taylor Swift, The Rolling Stones and Sir Elton John. Id, at 3. Across all music genres, UMG has been home to the greatest local and international artists of all time, including The Beatles. Id., at 8. The UMG merchandising business produces and sells artist-branded and other branded products through multiple sales channels, including fashion retail, concert touring and the Internet, and brings fans closer to the artists they love, through social media, meet-and-greet events, pop-up stores, promotions and brand partnerships. Id.

A. UMG Satisfies the Threshold Requirement of having Trademark Rights in the Mark TM104 for Purposes of the First Element of the Policy because it owns a Valid Trademark Registration for that Mark.

UMG establishes rights in the TM104 mark pursuant to Policy paragraph 4(a)(i) through registration of its mark with the Benelux Office for Intellectual Property (BOIP) covering t-shirts and hoodies in Cl. 25. (registration no. 1395147, registered May 6, 2019). Generally, panels find that a complainant can be found to have established rights in a mark if the complainant registered that mark with a trademark authority. E.g., Hammy Media, Ltd. and xHamster IP Holdings Ltd v. Maxim Ermak, Claim No. FA1704001728900 (Forum June 6, 2017) (finding BOIP registration suffices to establish rights under paragraph 4(a)(i)) (citing Thermo Electron Corp. v. Xu, FA 713851 (Forum July 12, 2006) (finding that the complainants had established rights in marks where the marks were registered with a trademark authority). "The location of the trademark, its date of registration (or first use) and the goods and/or services for which it is registered, are all irrelevant for the purpose of finding rights in a trademark under the first element of the UDRP." Assurances Premium SARL v. Whois Privacy Shield Services / Daisuke Yamaguchi, WIPO Case No. D2016-1425 (Sep. 6, 2016).

Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. WIPO Jurisprudential Overview 3.0 (hereinafter, "WIPO Overview"), Section 1.2.1. Accordingly, UMG has established rights in TM104 for purposes of the first element of paragraph 4(a) of the Policy.

B. UMG also has Unregistered Trademark Rights and Goodwill in the Mark TM104 that Pre-Date Registration of the Disputed Domain Name.

Here, Complainant discusses its common law rights that pre-date the registration of the disputed domain name as it is relevant to the third element of the Policy establishing registration and use in bad-faith (discussed below, Point III).

Unregistered or common law trademark rights exist when a party proves by a preponderance of the evidence that there is enough goodwill and reputation in and to a name and sufficient association of the same with the party itself or its goods or services, "no matter how strong or weak those trademark and service mark rights may be." Imperial College v. Christophe Dessimoz, WIPO Case No. D2004-0322 (June 30, 2004) (hereinafter, "Imperial College"). The fact that secondary meaning may only exist in a particular market niche does not preclude establishing trademark rights under the UDRP. Id. ("[E]ven if Complainant's mark...acquired goodwill and reputation only in a limited academic field, this would still be sufficient to establish common law trademark rights...").

Relevant evidence demonstrating acquired distinctiveness may include a range of factors apart from necessarily looking to the duration and extent of sales volume, such as the nature and extent of advertising using the mark, and the degree of actual public recognition. E.g., NTM Engineering, Inc. v. Registration Private, Domains by Proxy, LLC, DomainsByProxy.com / James Priya NA, WIPO Case No. D2019-0434 (Apr. 11, 2019) (hereinafter, "NTM Engineering") ("[G]iven Complainant's use of NTM ENGINEERING as a trade name, including on Complainant's social media pages, it is likely that Complaint has acquired some common law rights in the NTM ENGINEERING mark."). "Depending upon the circumstances, goodwill can be generated very quickly these days by way of mass advertising and promotion." GOVIA Limited v Keith Painter, WIPO Case No. D2002-0199 (Apr. 15, 2002) ("[O]n the balance of probabilities... given the terms of the original press release...and given the likely motives of the Respondent, the Complainant must have acquired the relevant rights by the date the Domain Name was registered").

A respondent's targeting of complainant's mark has a tendency to support that it has achieved significance as a source identifier. NTM Engineering ("Most importantly, Respondent has clearly targeted Complainant. This fact supports the contention that Complainant's mark has achieved significance as a source identifier.").

C. Through the Legendary American Rapper Jeezy Signed to Def Jam Recordings, one of UMG's Major Recording Labels, TM104 has Becomes a Distinctive Identifier Associated with UMG or its Goods or Services Prior to When the Disputed Domain was registered on April 11, 2019.

Mr. Jay Wayne Jenkins, better known by his stage name 'Jeezy' (formerly Young Jeezy) is an American rapper and certified legend that was signed since 2004 to an unincorporated division of UMG--Def Jam Recordings--one of UMG's major recording labels. Def Jam has represented the cutting-edge in hip-hop music for decades, after having established its dominance with superstar acts like Jeezy, and its music has grown into a global brand and the most-followed major label on all major social media platforms. Id., at 8-9.

Def Jam's debut by Jeezy, "Let's Get It: Thug Motivation 101" (the first in what became a series and widely referred to as "TM101" by industry and fans) was released the year after he was signed, and debuted at #2 on the Billboard 200, selling 172,000 copies in its first week (id., at 7-8) and was certified double-platinum (2 million copies sold) by the Recording Industry Association of America (RIAA). Id, at 6. UMG's lead single by Jeezy, "Soul Survivor," became a top-ten hit in the US. UMG's second Def Jam album by Jeezy in the series, The Inspiration: Thug Motivation 102 (referred to as "TM102" by industry and fans), succeeded Let's Get It in late 2006 to become a number one smash. Id. Def Jam's first two singles by Jeezy went platinum. UMG's Def Jam debut by Jeezy, "TM103: Hustlerz Ambition" ("TM103"), debuted at number three on the US Billboard 200, selling 233,000 copies in the first-week alone, and certified gold by the RIAA on January 31, 2012. Id., at 9, 12. Those in the hip-hop scene and fans were already discussing "TM104" (as in Thug Motivation 104) when TM103 was released years ago. Id., at 28, 29.

As a celebrity in the hip hop space, Jeezy is capable of significantly strengthening UMG"s common law rights in its Def Jam TM album series by Jeezy, including the final debut TM104. For example, Jeezy has a significant following on social media--with over 2.5 million monthly listeners on Spotify, and over 3.5 million followers on Instagram. Id., at 21. To his over a million Twitter followers, on the morning of March 22, 2018 (well over a year before the disputed domain name was registered), Jeezy announced that UMG's next Def Jam album in the Thug Motivation (TM) series, TM104, would be the final installation

of the series. Id., at 3. Further strengthening TM104 as a unique identifier for its final Def Jam album by Jeezy, UMG had its merchandising partners and Jeezy begin to sell its TM104-branded merchandise (hoodies and t-shirts). Id, at 4. Of course, this created immediate "buzz" in industry publications and the hip hop scene for UMG's goods or services, specifically as a unique identifier for the final Def Jam album by Jeezy that will be debuted. Id., at 13, 23-26. Google search results from prior to April 11, 2019--when the disputed domain name was created by Respondent--corroborates that TM104 had already been associated with UMG, or its goods or services--specifically, as a distinctive identifier for the final UMG (Def Jam) album by Jeezy. Id., at 18, 19.

Then on April 12 this year--literally within a day of when Respondent registered the disputed domain name, UMG received an e-mail from "Bachelor Fortune" (identified as Respondent in the Whois Record) that was sent to several UMG employees, stating that the disputed domain name has been re-directed to the @Jeezy official Instagram page, [purportedly] so as not to disrupt the Def Jam album anticipation from Jeezy's followers, and that Mr. Fortune's inbox has already become allegedly "overly saturated with inquiring minds anxious to get their hands on the domain name."

Based on the celebrity-based "buzz" marketing of UMG's TM104 album through Jeezy's social media, the merchandising of TM104-trademarked t-shirts and hoodies, and coverage in leading music industry publications such as Billboard--it is likely that UMG had acquired some common law rights under these circumstances where goodwill was being generated very quickly.

Respondent's unsolicited e-mail to UMG immediately after registering the disputed domain name further supports that the TM104 mark had achieved significance as a source identifier for UMG or its goods or services, because Respondent clearly targeted UMG directly by e-mail immediately after registering the disputed domain name. On the balance of probabilities, UMG acquired the relevant rights before the disputed domain was registered this year on April 11.

D. The Disputed Domain Name is Identical or Confusingly Similar to TM104.

The threshold for satisfying this first element is low, involving a reasoned but relatively straightforward comparison; generally, panels have found that fully incorporating the identical mark in a disputed domain name is sufficient to meet the threshold. E.g., Alfred Dunhill, Inc. v. Registration Private, Domains By Proxy, LLC / Abdullah Altubayieb, WIPO Case No. D2017-0209 (Apr. 12, 2017). The applicable Top Level Domain (e.g.,".com") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. E.g., SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services, WIPO Case. No. D2015-0565 (May 19, 2015); Tupelo Honey Hospitality Corporation v. King, Reggie, FA 1732247 (Forum July 19, 2017) ("Addition of a gTLD is irrelevant where a mark has been fully incorporated into a domain name and the gTLD is the sole difference.").

Accordingly, the first element of paragraph 4(a) of the Policy has been satisfied.

II. Respondent has no Rights or Legitimate Interests in the Disputed Domain Name (paragraph 4(a)(ii) of the Policy).

While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See generally WIPO Overview, Section 2.1. "Relevant information includes the WHOIS, assertions by a complainant regarding the nature of its relationship with a respondent, and other evidence in the record to support these assertions." TechStars Central, LLC. v. Suspended Domain, Forum Claim Number: FA1904001836857 (April 25, 2019) ("TechStars") (internal citations omitted).

Respondent is not commonly known by the disputed domain name as evidenced by the Whois records made of record, Chevron Intellectual Property LLC v. Fred Wallace, FA1506001626022 (Forum July 27, 2015) (finding that the respondent

was not commonly known by the <chevron-europe.com> domain name under Policy paragraph 4(c)(ii), as the WHOIS information named “Fred Wallace” as registrant of the disputed domain name), nor has Complainant authorised, licensed, or otherwise permitted Respondent to use the trademark. Navistar International Corporation v. N Rahmany, FA1505001620789 (Forum June 8, 2015) (finding that the respondent was not commonly known by the disputed domain name where the complainant had never authorized the respondent to incorporate its NAVISTAR mark in any domain name registration). Furthermore, based on his email targeting UMG as the rights holder, Annex 9, Respondent is obviously not the owner or beneficiary of a trademark that is identical to the domain name before any notice to Respondent of the dispute.

Respondent uses the disputed domain name to re-direct to his commercial website that has no affiliation with UMG or its goods or services, or at times, to Jeezy's Instagram page. Annexes 4, 9. "Using a domain name that is confusingly similar to a trademark to redirect Internet users to the trademark owner's own website without authorization does not give rise to rights or legitimate interests under the Policy..." TRIPADVISOR LLC v. Hulmiho Ukolen / Poste restante, Claim No. FA1902001828562 (Forum Mar. 11, 2019) (citing Emerson Electric Co. v. Mariusz Kowalczyk, FA 1770167 (Forum Feb. 28, 2018) (finding lack of rights or interests where sole apparent use of domain name was to redirect users to complainant's own website); Ripple Labs Inc. v. NGYEN NGOC PHUONG THAO, FA 1741737 (Forum Aug. 21, 2017) (“Respondent uses the [disputed] domain name to divert Internet users to Respondent’s website… confusing them into believing that some sort of affiliation exists between it and Complainant… [which] is neither a bona fide offering of goods or services under Policy paragraph 4(c)(i) nor a legitimate noncommercial or fair use under Policy paragraph 4(c)(iii).”).

Given the proximity to when the domain was registered to the time that Respondent contacted UMG, it is very unlikely that Respondent registered the disputed domain name contemplating a bona fide offering of goods or services, or a legitimate noncommercial or fair use.

Accordingly, the second element of paragraph 4(a) of the Policy has been satisfied.

III. The Disputed Domain Name was Registered and is Being Used in Bad Faith (para. 4(a)(iii) of the Policy).

Complainant must show that the disputed domain name was registered and is being used in bad faith. Under paragraph 4(b)(i) of the Policy, bad faith may be shown by evidence that a domain name was acquired "primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [Respondent's] documented out-of-pocket costs directly related to the domain name." Under paragraph 4(b)(iv), bad faith may be shown by evidence that "by using the domain name, [Respondent] intentionally attempted to attract, for commercial gain, Internet users to [Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [Respondent's] web site or location or of a product or service on [Respondent's] web site or location."

Respondent contacted UMG directly within a day of registering the disputed domain name, undermining the possibility that Respondent registered the disputed domain name contemplating a bona fide offering of goods or services or a legitimate noncommercial or fair use. Even assuming, for argument's sake, that UMG did not have a matured common law mark with secondary meaning, it is nonetheless, still very likely, the disputed domain name was registered fully conscious of, and to unfairly capitalize on, TM104 as an anticipated nascent unique identifier for UMG's final Def Jam album by Jeezy (see above, Point I.B of the Complaint) given the close proximity between when the domain was registered and the unsolicited e-mail sent to UMG by Respondent. Cf. General Growth Properties, Inc., Provo Mall LLC v. Steven Rasmussen/Provo Towne Centre Online, WIPO Case No. D2003-0845 (Jan. 15, 2004) (collecting some cases in which bad faith was found where the disputed domain name was opportunistically registered prior to the registration of the trademark at issue). Also, "registration of a disputed domain name to which a respondent has no known connection may indicate an intent to sell the same. Jireh Industries Ltd. v. DVLPMNT MARKETING, INC. / Domain Administrator, FA1735270 (Forum July 8, 2017)

Here, Respondent also misdirects visitors from the disputed domain name to Respondent's own commercial website, http://buckheadmag.com, which causes a likelihood of confusion. The landing page is likely owned, managed or controlled by Respondent as some of the same contact information was used in the past to register this domain as was used to

register the disputed domain, at 17-23, and the notice sent to Respondent on April 12 was signed using the nickname of "MrBuckhead.com," which re-directs to the same landing page as the disputed domain name.

Furthermore, Respondent has registered other trademarks, and advertised them for sale. For example, he is currently offering <trumpbook.com> for sale for fifteen thousand US dollars (Id. at 5-10), and in the past, he was responsible for registering <trumpcasinohotel.com> (Id., at 11-20). Respondent also registered <mariahcarey.info>. Id., at 30. These domains were registered using the same Yahoo account as the domain name to which he now has been misdirecting the disputed domain name.Id., at 7, 12, 19, 30. Other commonalities supporting that these domains are currently or in the past under Respondent's ownership, management or control include either a "Bachelor" signature on the site or re-directing to the same domain, the same false phone number in the registration records (Travis Hill v. Needalife.com, Claim No. FA0008000095345 (Aug. 3, 2000) ("The domain name was further registered by the Respondent in bad faith in that the application for same contained a false telephone number."), and using either a UPS store address in Georgia or Florida for his contact information. Id., at 21, 30; Id. at 2, 7, 12, 15, 19, 23.

When Respondent had previously registered <trumpcasinohotel.com>, he mis-directed visitors to his own commercial website, Id., at 26-29, just like he is doing now with the disputed domain name.

Accordingly, the third element of paragraph 4(a) of the Policy has been satisfied.

Conclusion

For all of the foregoing reasons, UMG the Complainant has satisfied all three elements of the Policy.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain name is identical to the Complainant’s TM104 trademark since the disputed domain name incorporates the latter in its entirety with the top level domain .com being a standard registration requirement and as such being disregarded under the first element test. The fact that the disputed domain name was registered already on April 11, 2019, thus about a month before the registration of the Complainant’s Benelux trademark TM104 took place, does not by itself preclude the Complainant’s standing to file this UDRP Case, but need to be evaluated in connection with the finding below whether or not Respondent acted in bad faith.

Moreover, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent has neither made use, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name, nor is the Respondent commonly known thereunder. The Complainant has provided evidence that it was contacted by the Respondent through an email of April 12, 2019, thus immediately after the registration of the disputed domain name took place, which was sent to several of the Complainant's employees, stating, inter alia, that the disputed domain name had been redirected to Jeezy's official Instagram page so as not to disrupt the Def Jam album anticipation from Jeezy's followers and that the Respondent's inbox had already become allegedly "overly saturated with inquiring minds anxious to get their hands on the domain name". Such Respondent's behavior clearly demonstrates that the Respondent registered the disputed domain name in full knowledge of the TM104 Def Jam album and possible rights (whether registered or unregistered) which the Complainant had acquired therein, moreover, that the Respondent aimed at profiting therefrom. Such behavior neither qualifies as a bona fide offering of goods or services nor as a legitimate noncommercial or fair use without intent for commercial gain. Besides, the Respondent is not commonly known by the disputed domain name nor has the Complainant otherwise licensed or otherwise permitted the Respondent to use its TM104 trademark. Accordingly, the Panel comes to the finding that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Finally, the Complainant argues, and the Panel agrees to this line of argumentation, that – given the proximity of when the disputed domain name was registered to the time that the Respondent contacted the Complainant, it is obvious that the Respondent's registration and making use of the disputed domain name was directly targeting at Complaint's rights in the TM104 trademark – whether or not the Complainant had acquired registered and/or unregistered rights therein or whether or not such rights accrued before or after the registration of the disputed domain name took place. The case at hand is very particular in that it can be concluded from the Respondent's own behavior that it acted with the intention to commercially profit from the term "TM104" as an anticipated nascent unique identifier for Complainant's Def Jam album by Jeezy and that under these particular circumstances the registration and making use of the disputed domain name even in anticipation of the Complainant's accruing trademark rights in the term "TM104" justifies the finding of an acting of the Respondent in bad faith within the meaning of the third element under the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **TM104.COM**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2019-06-27

Publish the Decision