Decision for dispute CAC-UDRP-106950

Case number	CAC-UDRP-106950
Time of filing	2024-10-21 12:02:13
Domain names	btsmerchshop.net, bangtanmerchshop.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	BigHit Music Co., Ltd

Complainant representative

Organization	Coöperatie SNB-REACT U.A.

Respondents

Name	Carmen Rios
Name	Lucas Jesus Gagichi

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant owns inter alia Korean trademark BANGTAN, Reg. No. 410235799000, registered on July 16, 2012; International trademark BTS, Reg. No. 1351233, registered on April 21, 2017; and United States (USPTO) trademark BTS and design, Reg. No. 6082783, registered on June 23, 2020. The BANGTAN and BTS marks are registered for various products and services in the field of music entertainment and merchandising.

FACTUAL BACKGROUND

The Complainant, Bighit Music Co. Ltd, is the record label representing the South Korean music band BTS, also known as the “Bangtan Boys”, which released its first single in 2013 and its first album in 2014. The band has been recognized with numerous prestigious awards. The Complainant sells merchandise related to the music band BTS on its official webshop “weverse” accessible via its official website https://ibighit.com/bts/eng/.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

No administratively compliant Response has been filed.

RIGHTS

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

PROCEDURAL FACTORS

Paragraph 3(c) of the Rules provides that a “complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder”. The Complainant requests consolidation of the disputed domain names into this single case, claiming that the disputed domain names are registered by the same domain name holder, based on the following factors: the disputed domain names use the same naming pattern, are both registered with the same registrar, are using the same web host and the same IP address and resolve to similar websites depicting the Complainant’s trademark and logos and offering for sale the BTS music band merchandise. Further, the registrants identified by the Registrar share the same contact email address and have postal addresses in the same city.

The Panel is persuaded by these factors that the requirement of paragraph 3(c) of the Rules is satisfied. Hence this decision refers to Carmen Rios and Lucas Jesus Gagichi as “the Respondent”.

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

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15(a) of the Rules 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."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(3) the disputed domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences as it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at paragraph 4.3; see also eGalaxy Multimedia Inc. v. ON HOLD By Owner Ready To Expire, FA 157287 (Forum June 26, 2003) (“Because Complainant did not produce clear evidence to support its subjective allegations [. . .] the

Panel finds it appropriate to dismiss the Complaint").

As to the first element, the Complainant has shown that it has rights in the BANGTAN and BTS marks and that the marks are very well known. The Panel finds the disputed domain names <btsmerchshop.net> and <bangtanmerchshop.com> to be confusingly similar to the Complainant's BTS and BANGTAN trademarks because each incorporates one of the marks in its entirety and merely adds the generic words "merch" and "shop", which do nothing to distinguish the domain names from the marks, together with the inconsequential top-level domains "net" or ".com", which may be ignored.

The Complainant has established this element.

As to the second element, paragraph 4(c) of the Policy sets out three illustrative circumstances as examples which, if established by the Respondent, shall demonstrate rights to or legitimate interests in a disputed domain name for the purposes of paragraph 4(a)(ii) of the Policy, i.e.

(i) before any notice to the Respondent of the dispute, the use by the Respondent of, or demonstrable preparations to use, the domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if the Respondent has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names, saying that the Complainant has no relationship whatsoever with the Respondent and has never licensed or otherwise authorized the Respondent to use the BTS and BANGTAN trademarks on its websites or in the disputed domain names. The Complainant has exclusive trademark rights which predate the registration of the disputed domain names. In the absence of a licence or permission from the Complainant concerning the use of its trademarks, no actual or contemplated bona fide or legitimate use of the disputed domain names can reasonably be claimed.

The Panel notes that the disputed domain name <btsmerchshop.net> was registered on March 27, 2022, and the disputed domain name <bangtanmerchshop.net> was registered on July 26, 2022, in each case long after the Complainant has shown that its BTS and BANGTAN trademarks had become very well known. They resolve to websites displaying the Complainant's BTS word and word and design marks and purporting to offer BTS merchandise for sale. Neither website validly disclaims any relationship between the Respondent and the Complainant, as required by the Oki Data test (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903).

These circumstances, together with the Complainant's assertions, are sufficient to constitute a prima facie showing of absence of rights or legitimate interests in respect of the disputed domain names on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show that it does have rights or legitimate interests in the disputed domain name. See JUUL Labs, Inc. v. Dryx Emerson / KMF Events LTD, FA1906001849706 (Forum July 17, 2019). The Respondent has made no attempt to do so.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant has established this element.

As to the third element, paragraph 4(b) of the Policy sets out four illustrative circumstances, which, though not exclusive, shall be evidence of the registration and use of a domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy, including:

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the Respondent's website or location or of a product or service on its website or location.

The circumstances set out above in relation to the second element satisfy the Panel that the Respondent was fully aware of the Complainant's very well-known BTS and BANGTAN trademarks when the Respondent registered the disputed domain names and that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's websites, by creating a likelihood of confusion with the Complainant's marks as to the source of the Respondent's websites and of the products promoted on those websites. This demonstrates registration and use in bad faith to attract users for commercial gain under the Policy, paragraph 4(b)(iv).

The Complainant has established this element.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **btsmerchshop.net**: Transferred
2. **bangtanmerchshop.com**: Transferred

PANELLISTS

Name	**Alan Limbury**

DATE OF PANEL DECISION 2024-11-15

Publish the Decision