Decision for dispute CAC-UDRP-107035

Case number	CAC-UDRP-107035
Time of filing	2024-11-14 10:18:23
Domain names	btsmerchshop.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Bighit Music Co. Ltd

Complainant representative

Organization	Coöperatie SNB-REACT U.A.

Respondent

Name	Aditi Nandan Parashar

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 name.

IDENTIFICATION OF RIGHTS

The Complainant submitted evidence that it is the owner of the following trademarks (hereafter the "**Trademarks**").

- Korean trademark "BTS" (combined), registration no. 4102968910000, registered on August 19, 2014, in Nice class 35;
- International trademark "BTS" (combined), no. 1351233, registered on April 21, 2017, in Nice class 41, designating China, Japan, and the USA;
- International trademark "BTS" (combined), no. 1350916, registered on April 21, 2017, in Nice class 35, designating China, Japan, and the USA;
- International trademark "BTS" (combined), no. 1349549, registered on April 21, 2017, in Nice class 16, designating China, Japan, and the USA;
- International trademark "BTS" (combined), no. 1349542, registered on April 21, 2017, in Nice class 9, designating China, Japan, and the USA;
- EU trademark "BTS" (combined), no. 017942684, registered on July 12, 2019, in Nice classes 9, 16 and 41;
- EU trademark "BTS" (combined), no. 017942677, registered on April 27, 2021, in Nice classes 18, 21 and 25; and
- US trademark "BTS" (combined), registration no. 6082783, registered on June 23, 2020, in Nice class 41.

FACTUAL BACKGROUND

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

The Complainant is the record label representing the South-Korean music band BTS ("Bangtan Boys"). BTS released its first single in 2013 and its first album in 2014. BTS has been nominated for numerous music awards such as for Best Pop Duo/Group Performance for the 63rd Grammy Awards. Also, BTS has been awarded numerous prestigious music accolades such as the Billboard Music Awards and the American Music Awards. The BBC and Time Magazine named BTS as the "biggest K-pop group internationally".

The Complainant submitted evidence that it is the owner of several Korean, International, EU and US trademarks consisting of term "BTS", registered in classes 8, 10, 16, 21, 25, 35 and 41 (hereafter individually the "**Trademark**" and together the "**Trademarks**").

The disputed domain name <btsmerchshop.com> was registered on October 22, 2018.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name 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 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

1. **Confusing similarity**

The disputed domain name consists of the Complainant's Trademark(s) "BTS" with the addition of the words "merch" and "shop".

The Panel notes that the disputed domain name incorporates the entirety of the Complainant's "BTS" Trademark(s), with the addition of the descriptive terms "merch" (abbreviation for "merchandising") and "shop".

The Panel remarks that Section 1.7 of WIPO Overview 3.0, states that, "in cases where a domain name contains the whole of a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status".

The Panel is of the opinion that the sole addition of the descriptive terms "merch" and "shop" does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. This is supported by section 1.8 of WIPO Overview 3.0, which states: "Where the relevant mark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not preclude a finding of confusing similarity under the first

element". The gTLD ".com" may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the Panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant argues that:

- The Respondent has not acquired any prior trademark or service mark rights.

- The Respondent has no relationship with the Complainant and is not authorized or licensed by the Complainant to use or register the disputed domain name or to use the Complainant’s Trademarks.

- The disputed domain name was registered several years after the Complainant started to use the Trademarks.

- The Respondent cannot demonstrate any legitimate offering of goods and services or legitimate non-commercial or fair use under the disputed domain name.

- The disputed domain name resolves to a website that is used to sell unauthorized merchandising products bearing the Trademarks. The Trademarks are prominently displayed on the website linked to the disputed domain name.

- The Respondent tries to impersonate the Complainant or at least creates the incorrect impression that it is an official BTS Merchandising dealer. The addition of the word “merch” carries a risk of implied affiliation. This implied affiliation is strengthened by the fact that the Respondent prominently displays the Trademarks on the website linked to the disputed domain name, as well as a banner “Official BTS Merch Shop”. In fact, the Respondent is not an authorized (re)seller of BTS merchandising goods of the Complainant.

The Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that it has rights or legitimate interests in the disputed domain name (the Respondent could, inter alia, have provided evidence of the factors mentioned in paragraph 4(c) of the Policy, but failed to do so).

The Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name from the following facts:

- There is no evidence at all that the Respondent is or has been commonly known by the disputed domain name or by the term “BTS”. The WHOIS information does not provide any information that might indicate any rights to use of the term “BTS”.

- The Complainant’s Trademarks were registered and have been used well before the registration date of the disputed domain name. The disputed domain name was registered on October 22, 2018, whereas the first Trademark of the Complainant was registered on August 19, 2014.

- There is no evidence to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers. On the contrary, it appears that the Respondent is taking advantage (or at least intends to take advantage) of the Complainant's reputation and Trademarks to profit from the sale of BTS branded goods through the disputed domain name and the webpage linked to it.

- The Respondent did not show to have any trademark rights or other rights in the term “BTS”.

- The Respondent does not seem to have any consent or authorisation to use the Trademarks or variations thereof, in the disputed domain name or otherwise, and does not seem to be related in any way to the Complainant.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

3. **Bad faith**

The Complainant asserts that:

- The Trademarks were registered well before the registration of the Trademark. The Respondent had the Trademarks in mind when registering the disputed domain name.

- The Respondent is using the disputed domain name to attract Internet users to its own website and obtain commercial gain by creating a false impression of an affiliation or connection with the Complainant.

- The Respondent tries to impersonate the Complainant and thus confuses consumers.

The Panel weighs these arguments and facts as follows:

- It is evident that the Respondent had actual knowledge of the music band BTS and the Trademarks and had them in mind at the moment of registration and use of the disputed domain name. The Trademarks were registered well before the registration of the disputed domain name. The Respondent prominently displays the Trademarks and logos of the Complainant on the website linked to the disputed domain name, as well as pictures of the music band BTS.

- The Respondent tries to divert consumers by creating a false connection to the Complainant. On the website available via the disputed domain name, a banner is published “official BTS merch shop”, while in fact the Respondent is not affiliated with the Complainant. The Respondent is using the disputed domain name to sell BTS merchandising to consumers, while not being authorized or licensed by the Complainant to do so.

- The merchandising goods that are being offered for sale by the Respondent bear the Trademarks and logos of the Complainant. Several of these goods are covered by the Complainant’s registered Trademarks.

For all the reasons set out above, the Panel concludes that the Complainant did prove that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **btsmerchshop.com**: Transferred

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2024-12-07

Publish the Decision