

ADMINISTRATIVE PANEL DECISION

The Lumineers, LLC v. zengyi xu, 1

Case No. D2022-4055

1. The Parties

The Complainant is The Lumineers, LLC, United States of America (“United States”), represented by Creative Law Network, LLC, United States.

The Respondent is zengyi xu, 1, China.

2. The Domain Name and Registrar

The disputed domain name, <lumineersmerch.com> (the “Domain Name”), is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 31, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same date, 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 October 31, 2022 naming the underlying registrant (zengyi xu) as the Respondent.

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 November 14, 2022.

In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 13, 2022.

The Center appointed Tony Willoughby as the sole panelist in this matter on December 27, 2022. 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 United States Limited Liability Company, which trades as a musical band under the name "The Lumineers". The Complainant is the proprietor of numerous trade mark registrations covering the name of the band including:

United States Registration No. 4,406,896 THE LUMINEERS (standard character mark) registered on September 24, 2013 (application filed on February 18, 2013) for digital music downloadable from the Internet; musical sound recordings; pre-recorded CDs featuring music; pre-recorded electronic and digital media featuring music, in class 9; and

International Registration No. 1174772 THE LUMINEERS (standard character mark) registered on August 14, 2013 for goods in class 9 similar to those covered by the above United States registration; hooded sweatshirts, sweatshirts, t-shirts, tank-tops in class 25 and various entertainment services in class 41. This International registration has China, the Respondent's home jurisdiction, as a designated territory.

The Domain Name was registered on August 19, 2022 and is connected to a website, the home page of which shows a photograph of the Complainant's band headed "THE LUMINEERS" and offering for sale merchandise relating exclusively to the Complainant's band. One webpage has a paragraph headed "Lumineersmerch.com – The Best Lumineers Merchandise" and containing the sentence "This website is an official merch store that provides real products to its customers and comes up with high-quality Lumineers merchandise". Many of the webpages at the website feature towards the bottom of the page a line reading "Lumineers Merch from Official Lumineers Merchandise Store. Shop Official Lumineers Merch ...". The Panel has visited the Respondent's website and has been unable to locate the name of any entity operating the website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in respect of the Domain Name; and that the Domain Name has been registered and is being used in bad faith.

The essence of the Complainant's case is that the Respondent registered the Domain Name with knowledge of the Complainant's band and did so for the purpose of falsely representing the website to which it is connected to be an official merchandise store of the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

B. Identical or Confusingly Similar

The Domain Name comprises the name “lumineers” followed by the word “merch” (an abbreviation for the dictionary word “merchandise”) and the “.com” generic Top-Level Domain identifier.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) explains the test for identity or confusing similarity under the first element of the Policy and includes the following passage:

“While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

The trade mark upon which the Complainant relies is THE LUMINEERS, the dominant element of which is the name “Lumineers”. That element is readily recognisable in the Domain Name. The Panel finds that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights.

C. Rights or Legitimate Interests

The Complainant asserts that it has no connection with the Respondent and has granted the Respondent no permission to use its trade mark or any variant of it. It further asserts that the images appearing in the Respondent’s website are images the copyrights in which are owned by the Complainant and in respect of which the Respondent has been granted no licence. The Complainant further asserts that the product on offer at the Respondent’s website is counterfeit and undercuts the Complainant’s official merchandise.

The Complainant recites the circumstances set out in paragraph 4(c) of the Policy, any of which if found by the Panel to be present shall demonstrate rights or legitimate interests for the purposes of this element of the Policy, and contends that none of them is applicable. The Complainant contends that the Respondent’s effective impersonation of the Complainant cannot constitute a *bona fide* offering of goods or services for the purposes of paragraph 4(c)(i) of the Policy; there is nothing to indicate that the Respondent is commonly known by the Domain Name (paragraph 4(c)(ii) of the Policy); and the use being made of the Domain Name as described in section 4 above is a commercial use, is not fair and is not covered by paragraph 4(c)(iii) of the Policy.

The Panel finds that the Complainant has made out a *prima facie* case under this element of the Policy; in other words a case calling for an answer from the Respondent. The Respondent has not provided an answer. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name. The factors leading the Panel to come to this conclusion are:

- (i) Manifestly, the Respondent was aware of the Complainant when registering the Domain Name and has used it with the Complainant in mind;
- (ii) The Complainant's unchallenged assertion that it has granted the Respondent no permission to use its trade mark or any variant of it, an assertion that the Panel accepts as accurate;
- (iii) The fact that the Respondent's website has the appearance of an official website for the Complainant's merchandise and contains false statements to that effect;
- (iv) The fact that the website contains no indication that it is not an official website for the Complainant's merchandise and features no name of the entity operating the website;
- (v) The fact that the Respondent's name bears no relation to the Domain Name.
- (vi) In the absence of any response from the Respondent the Panel is unable to conceive of any basis upon which the Respondent could be said to have acquired rights or legitimate interests in respect of the Domain Name.

In coming to this conclusion, the Panel has found it unnecessary to assess the Complainant's copyright infringement claims in respect of the content of the website. Furthermore, the Panel has ignored the Complainant's contention that the goods on offer at the Respondent's website are counterfeit, a contention unsupported by any evidence.

D. Registered and Used in Bad Faith

By the same reasoning, the Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances, which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The Complainant relies upon sub-paragraph (iv), which provides: "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location."

Clearly, the Respondent registered the Domain Name intending to target the Complainant given that the website to which it is attached is devoted exclusively to selling merchandise associated with the Complainant. Moreover, the content of the website is clearly intended to lead visitors to believe that it is an official store authorised by the Complainant. It has the appearance of an official online store for the Complainant's merchandise. It features nothing to counter that impression. Instead it features statements such as "This website is an official merch store that provides real products to its customers and comes up with high-quality Lumineers merchandise" and "Lumineers Merch from Official Lumineers Merchandise Store" (see section 4).

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 Domain Name, <lumineersmerch.com>, be transferred to the Complainant.

/Tony Willoughby/

Tony Willoughby

Sole Panelist

Date: January 9, 2023