

ADMINISTRATIVE PANEL DECISION

NSN Apparel Co, LLC v. Diego Hare
Case No. D2023-4249

1. The Parties

The Complainant is NSN Apparel Co, LLC, United States of America, represented by Adelman Matz P.C., United States of America.

The Respondent is Diego Hare, Peru.

2. The Domain Name and Registrar

The disputed domain name <drewmerch.com> is registered with Dreamscape Networks International Pte Ltd (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 12, 2023. On October 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 19, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 21, 2023.

The Center appointed Adam Samuel as the sole panelist in this matter on November 24, 2023. 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 manufactures and sells clothing, under the brand, "The House of Drew". It owns United States of America trademarks, number 6563146 for the name LA MAISON DREW, registered on November 16, 2021 for which the application date was February 16, 2018 and number 7164539, for the name DREW registered on September 12, 2023 for which the application date was April 26, 2021. Drew is the middle name of the singer, Justin Bieber. The DREW mark has two dark circles above the name.

The Complainant registered the domain name <thehouseofdrew.com> on February 20, 2018 through which it has promoted its products since December 25, 2018.

The disputed domain name was registered on February 1, 2020. The disputed domain name resolves to a website which appears to be marketing clothes manufactured by the Complainant. The head of the Respondent's website reproduces the DREW mark with the two dark circles above the word.

5. Parties' Contentions

A. Complainant

The disputed domain name is confusingly similar to the Complainant's trademarks, LA MAISON DREW and DREW. It incorporates the DREW mark and the dominant part of the LA MAISON DREW mark. The added word "merch" makes the disputed domain name even more confusingly similar. It denotes the idea that the Respondent sells the authentic merchandise of the Complainant.

The Respondent is not commonly known by the disputed domain name. The Respondent is not associated in any way with the Complainant and the Complainant has never given the Respondent any permission to use the Complainant's trademarks.

The merchandise being offered on the Respondent's website is a counterfeit version of the genuine merchandise of the Complainant. The Respondent's website displays Justin Bieber wearing the clothes being advertised.

The Complainant launched the Drew brand of clothing through Justin Bieber at the end of 2018, an event extensively publicized in social media, including images of Mr. Bieber wearing the clothes concerned including what became the Complainant's DREW trademark.

Registering a domain name while under constructive notice of the Complainant's trademark application is evidence of bad faith. So, is failing to respond to a cease and desist letter, in this case, the one sent to the Respondent on October 21, 2021.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

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

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

A. Identical or Confusingly Similar

The disputed domain name consists of the Complainant's trademark DREW which is also the predominant word in the Complainant's trademark LA MAISON DREW, the abbreviation "merch" which usually denotes merchandise and the generic Top-Level Domain ("gTLD") ".com".

The gTLD is irrelevant here as it is a standard registration requirement. See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Section 1.8 of the [WIPO Overview 3.0](#) says:

"Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

Here, the abbreviation "merch" is descriptive of the Complainant's activities and if anything reinforces a finding of confusing similarity with both of the Complainant's trademarks.

The disputed domain name was registered prior to the Complainant's registration of its trademarks although the Complaint was filed on October 11, 2023, after the date of their registration. Section 1.1.3 of the [WIPO Overview 3.0](#) says:

"While the UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired its rights, such rights must be in existence at the time the complaint is filed.

The fact that a domain name may have been registered before a complainant has acquired trademark rights does not by itself preclude a complainant's standing to file a UDRP case, nor a panel's finding of identity or confusing similarity under the first element."

For all these reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

The Respondent is not called "drewmerch" or anything similar. There is no evidence that the Complainant has ever authorised the Respondent to use its trademarks. The Respondent does not appear to have used the disputed domain name for any legitimate purpose.

Based on the available record, where the Complainant has made out a preliminary case that the Respondent lacks rights or legitimate interests, and in the absence of any response on this point, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name. See section 2.1 of the [WIPO Overview 3.0](#).

C. Registered and Used in Bad Faith

The disputed domain name which itself contains the Complainant's trademark resolves to a website which reproduces the Complainant's DREW trademark including its graphic features and appears to be selling the Complainant's merchandise. A number of the items being sold on the Respondent's website contain the Complainant's trademark with its two dark circles. The website gives the impression that the Respondent is selling the Complainant's merchandise. The Complainant's uncontradicted evidence is that the disputed domain name is being used for that purpose without its authority.

Using someone else's trademark in a disputed domain name and then reproducing it with its graphic elements to sell goods purporting to be manufactured by that other person without their permission suggests that the Respondent registered the disputed domain name primarily for the purpose of attracting for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. That is evidence of registration and use of a disputed domain name in bad faith under paragraph 4(b)(iv) of the Policy.

The fact that the Complainant's trademark registrations were not completed until after the registration of the disputed domain name does not affect this conclusion.

Section 3.8.2 of the [WIPO Overview 3.0](#) explains:

"in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

Such scenarios include registration of a domain name: (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant's filing of a trademark application."

In this case, the Complainant launched its range of clothes using its affiliation with Justin Bieber at the end of 2018, having filed its LA MAISON DREW trademark application earlier in the year. The Complainant's evidence includes images of Mr Bieber wearing clothes with the distinctive dark circles over the name DREW.

For these reasons, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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 <drewmerch.com> be transferred to the Complainant.

/Adam Samuel/

Adam Samuel

Sole Panelist

Date: November 30, 2023