

ADMINISTRATIVE PANEL DECISION

Saiko Marks, LLC v. Diego Ha

Case No. D2024-0710

1. The Parties

The Complainant is Saiko Marks, LLC., United States of America (“United States”), represented by Russ August & Kabat, United States.

The Respondent is Diego Ha, Peru.

2. The Domain Name and Registrar

The disputed domain name <thekidlaroimerch.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2024. On February 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 19, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (REDACTED FOR PRIVACY, Whois Privacy Protection Foundation) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 20, 2024 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 February 21, 2024.

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 February 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 13, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 14, 2024.

The Center appointed Zoltán Takács as the sole panelist in this matter on March 19, 2024. 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 in this administrative proceeding is Saiko Marks, LLC., a limited liability company organized under the laws of the state of Delaware, United States. The Complainant is owned and controlled by Charlton Kenneth Jeffrey Howard, professionally known as "The Kid Laro".

The Kid Laro is an Australian Grammy Award-nominated and multiple award-winning singer, songwriter and performer who collaborated with world renowned artists like Justin Bieber and Miley Cyrus.

Among others the Complainant is owner of the United States Trademark Registration No. 6784756 for the word mark THE KID LAROI registered since July 12, 2022, for various clothing articles and headwear. The registration has a priority date of February 16, 2021 (i.e., the date the application was filed with the United States Patent and Trademark Office ("USPTO")).

The disputed domain name was registered on September 11, 2021, and has been used in relation to a website that allegedly offers for sale apparel merchandise featuring THE KID LAROI mark, related logos and product images as well as the portraits of The Kid Laro himself.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- the disputed domain name, the main and dominant part of which is its THE KID LAROI mark is confusingly similar to the trademark;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name since it is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy;
- the use of the disputed domain name for a website that offers counterfeit apparel merchandise and prominently features its trademark, logos and imagery is evidence of bad faith registration and use of the disputed domain name.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

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

6. Discussion and Findings

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

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

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of THE KID LAROI mark is reproduced and is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here the term "merch", which is short for "merchandise" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

According to the documentary evidence submitted by the Complainant, the Respondent has been using the disputed domain name to deceive Internet users looking for the Complainant through redirecting them to its own website at which the Respondent appears to be offering for sale The Kid Laroi apparel merchandise which the Complainant assumes are counterfeit.

There is no evidence as to whether the goods offered on the Respondent's website at the disputed domain name are counterfeit or "genuine", or whether any of those goods ultimately exist. Also, there is no indication of any relationship of the Respondent with the Complainant as to the source of the products at issue and the website at the disputed domain name implies that the merchandise offered for sale on the Respondent's website originate with the Respondent and not the Complainant. Consequently, even if the merchandise appearing on the Respondent's website under the disputed domain name would exist and be genuine, the Respondent's website would still not qualify as fair use. [WIPO Overview 3.0](#), sections 2.13.2 and 2.8.1 and *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

What is evident is that the Complainant has not authorized, licensed, or allowed the Respondent or any third party to use its THE KID LAROI trademark through the disputed domain name or in any other way that would confer validity or legitimacy upon such usage.

In the Panel's view it is also evident that the Respondent has been impersonating the Complainant by using on its website at the disputed domain name the Complainant's trademark, logos and images. Panels have held that the use of a domain name for illegal activity, here impersonation/passing off can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Moreover, the inherently misleading nature of the disputed domain name, incorporating the Complainant's trademark and a descriptive term, carries risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

In the present case, the Panel notes that the Complainant's THE KID LAROI trademark is inherently distinctive and that its priority date (February 16, 2021) predates the date of registration of the disputed domain name.

The website at the disputed domain name prominently features the Complainant's trademark, logos, product images and portraits of The Kid Laroi himself. Thus in view of the Panel it is clear that the Respondent had actual knowledge of the Complainant and its trademark and registered the disputed domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark. Paragraph 4(b)(iv) of the Policy.

The Respondent's intent to target the Complainant's trademark can be readily inferred from the contents of the Respondent's website seeking to impersonate the Complainant by directing Internet traffic to its website in order to gain illegitimate profit through impersonation or false association. Visitors of the Respondent's website might reasonably believe that is connected to or approved by the Complainant as it appears to offer apparel merchandise under the Complainant's trademark, logos and imagery and give impression that the site attached to the disputed domain name is official, while that it clearly not the case. Panels have held that the use of a domain name for illegal activity, in this case impersonation/passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

The Panel finds that the Complainant has established the third element of 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 <thekidlaroimerch.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: April 2, 2024