

ADMINISTRATIVE PANEL DECISION

TAS Rights Management, LLC v. osama tariq
Case No. D2024-0861

1. The Parties

The Complainant is TAS Rights Management, LLC, United States of America (“United States”), represented by Venable LLP, United States.

The Respondent is osama tariq, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <taylorswift-merch.shop> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 28, 2024. On February 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 5, 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 (REGISTRANT UNKNOWN) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 5, 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 amendment to the Complaint on March 6, 2024.

The Center verified that the Complaint together with the amendment to 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 March 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 5, 2024.

The Center appointed Zoltán Takács as the sole panelist in this matter on April 12, 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 is the intellectual property management company of the world-renowned musical artist Taylor Swift.

In addition to numerous achievements in the entertainment business Taylor Swift has been followed by millions of fans on social media platforms.

The Complainant owns over 160 trademark registrations around the world comprising of or containing Taylor Swift's name, including the International Trademark Registrations Nos. 1056673 and 1147583 for the word mark TAYLOR SWIFT registered on October 13, 2010, and January 18, 2013, respectively.

The Complainant has strong presence on the Internet, e.g., it operates a website at "www.taylorswift.com" featuring Taylor Swift's photographs, videos, tour date information, and links to social media accounts as well as a link to the official Taylor Swift merchandise store.

The corresponding domain name <taylorswift.com> was registered on February 6, 2002.

The disputed domain name was registered on July 13, 2023, and used to resolve to a mirrored version of the Taylor Swift's official website and web store and was allegedly offering for sale Taylor Swift merchandise.

The website at the disputed domain name extensively featured the TAYLOR SWIFT mark and the titles of Taylor Swift's albums followed by the word "merch".

At the time of filing of the Complaint, the disputed domain name was not resolving and currently it does not resolve to any active website.

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 which incorporates the TAYLOR SWIFT mark in its entirety with addition of the term "merch" 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 registration of the disputed domain name with the Complainant's mark in mind and use of the disputed domain name for a website that offered counterfeit apparel merchandise and prominently featured its famous trademark and imagery is indication of the Respondent's bad faith.

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 TAYLOR SWIFT 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 a hyphen and the term "merch" (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 used the disputed domain name to impersonate the Complainant by hosting a copycat website allegedly offering for sale allegedly fake versions of the Complainant's goods.

There is no evidence as to whether the goods offered on the Respondent's website at the disputed domain name were counterfeit or "genuine", or whether any of those goods ultimately existed. While panels have recognized the limited rights of resellers to use a third party's trademark, such use must satisfy fair use requirements e.g., as described in [WIPO Overview 3.0](#), section 2.8.

Here, there was no information disclosing the lack of relationship between the Respondent and the Complainant and the website at the disputed domain name implied that the merchandise offered for sale on the Respondent's website originated with the Complainant, contrary to the fact that it did not. Consequently, even if the merchandise that appeared on the Respondent's website under the disputed domain name would have existed and would have been genuine, the Respondent's website would still have not qualified as fair use. [WIPO Overview 3.0](#), sections 2.13.2 and 2.8.1 and *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

What is evident is that the Complainant never authorized, licensed, or allowed the Respondent or any third party to use its TAYLOR SWIFT mark 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 was impersonating the Complainant by using on its website at the disputed domain name the Complainant's trademark and imagery. 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.

In addition to the impersonation on the website and lack of disclaimer, the misleading nature of the disputed domain name, incorporating the Complainant's trademark and a descriptive term "merch" (short for "merchandise"), carries risk of implied affiliation, reflecting the Respondent's ultimate intent to mislead Internet users. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds that 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 TAYLOR SWIFT trademark is well known and that its registration date predates the date of registration of the disputed domain name.

According to Encyclopedia Britannica, Taylor Swift is one of the most influential artists in contemporary music, while Wikipedia references Taylor Swift as one of the most prominent celebrities of the 21st century whose musicality and business activity has inspired artists and entrepreneurs worldwide.

Thus, in the Panel's view there is no doubt that the TAYLOR SWIFT mark is globally well known. The mere registration of a domain name that is identical or in this case confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

The website at the disputed domain name prominently featured the Complainant's TAYLOR SWIFT trademark and the titles of Taylor Swift's albums followed by the word "merch". Thus, in view of the Panel, it is clear that the Respondent had actual knowledge of the Complainant and the TAYLOR SWIFT 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 have reasonably believed that it was connected to or approved by the Complainant as it appeared to offer merchandise under the Complainant's trademark and imagery and gave impression that the site attached to the disputed domain name was official, while that it clearly was 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.

As mentioned above, at the time of filing of the Complaint the disputed domain name was not resolving, and currently it does not resolve to any active website. However, this does not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

Considering the totality of the circumstances of the case in this context, the Panel notes the distinctiveness and worldwide reputation of the TAYLOR SWIFT trademark, the composition of the disputed domain name, the nature of the Respondent's previous use of the disputed domain name as mentioned above, the Respondent's failure to submit a response, as well as that any good faith use to which the misleading disputed domain name may be put again appears to be implausible. The Panel finds that in these circumstances the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

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 <taylorswift-merch.shop> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: April 25, 2024