

ADMINISTRATIVE PANEL DECISION

Megan Rios d/b/a Megan LuRose v. Domains By Proxy, LLC / Wangye Lin
Case No. D2022-1264

1. The Parties

The Complainant is Megan Rios d/b/a Megan LuRose, United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Domains By Proxy, LLC, United States / Wangye Lin, China.

2. The Domain Name and Registrar

The disputed domain name <meganlurose.com> 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 April 9, 2022. On April 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 11, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 13, 2022 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 April 14, 2022.

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 April 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 10, 2022.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on May 13, 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 singer/songwriter and actress who has performed under the stage name Megan LuRose since at least 2012. The Complainant's stage name is derived from the names of four women after whom the Complainant was named. The Complainant appeared in the film "Wailing", features on the Internet Movie Database website, has made at least two compact discs of music (one of which is in the Spanish language), and has appeared under said stage name in live performances.

The Complainant asserts that it was previously the registrant of the disputed domain name, originally registered on December 29, 2012 (historical Whois records provided, including one containing a screenshot of the Complainant's homepage taken on September 17, 2015). The Complainant notes that the disputed domain name was inadvertently not renewed on its expiration date of December 29, 2019, due to a miscommunication between the Complainant and its web designer. The disputed domain name lapsed thereafter and was registered by the Respondent.

The Complainant provides evidence of historic screenshots showing its website in active use in connection with the disputed domain name from April 2, 2013. Other materials are produced showing use of the corresponding URL on inlay cards accompanying music recordings by the Complainant.

The Complainant is the owner of United States Registered Trademark no. 6438255 for the word mark MEGAN LUROSE, registered on August 3, 2021, in Class 41.

The disputed domain name was registered on March 16, 2020. The Respondent is using the disputed domain name in connection with a website that provides pornographic content.

5. Parties' Contentions

A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

The disputed domain name is identical to the Complainant's MEGAN LUROSE trademark. It is well-established that the Top-Level Domain ("TLD") ".com" is a standard registration requirement and as such is disregarded under the first element confusing similarity test. The disputed domain name contains the Complainant's trademark in its entirety and only such mark. In those circumstances, it will normally be considered identical or confusingly similar to such mark.

Rights or legitimate interests

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the Complainant's MEGAN LUROSE trademark in any manner.

The Respondent cannot establish rights or legitimate interests pursuant to paragraph 4(c) of the Policy. The Respondent has never used or made preparations to use the disputed domain name or any corresponding name in connection with a *bona fide* offering of goods or services. Use of the disputed domain name for a

pornographic website is not a *bona fide* offering of goods or services. The Respondent has never been commonly known by the disputed domain name nor has acquired any corresponding trademark rights. The Whois record does not identify the Respondent as “Megan LuRose” or anything similar. Given the Complainant’s use of its MEGAN LUROSE trademark for almost ten years and the Complainant’s trademark registration, it is practically impossible that the Respondent is commonly known thereby.

The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue. Use of the disputed domain name in connection with a pornographic website is clearly commercial and tarnishes the Complainant’s trademark and well-established image.

Registered and used in bad faith

The Respondent registered the disputed domain name only after the Complainant mistakenly failed to renew it after using same between 2012 and 2020. A respondent may be found to have acted in bad faith where the timing and circumstances of the registration follow the complainant’s failure to renew it. Furthermore, it is well established that using another’s well-known mark to attract Internet users to a pornographic website constitutes bad faith use of a domain name.

It is implausible that the Respondent was unaware of the Complainant when it registered the disputed domain name given the fame of the trademark and that it is a stage name created by the Complainant and used exclusively by it since 2012. The Respondent’s motive in using the disputed domain name seems to be to disrupt the Complainant’s relationship with its customers or to attempt to attract Internet users for potential gain, constituting evidence of registration and use in bad faith. Because the disputed domain name is so obviously connected with the Complainant, the Respondent’s actions suggest opportunistic bad faith in violation of the Policy. It is likely that the Respondent knew of the Complainant’s mark due to the Complainant’s presence and brand recognition, and that the Respondent sought to obtain a commercial benefit by attracting Internet users based on that confusion.

B. Respondent

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

6. Discussion and Findings

To succeed in its Complaint, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied for the disputed domain name:

- (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 first element assessment under the Policy is typically conducted in two parts. First, the Complainant must demonstrate UDRP-relevant rights in a trademark. Secondly, the disputed domain name is compared to any such trademark to assess identity or confusing similarity, usually on a relatively straightforward side-by-side basis, excluding the TLD as being required for technical purposes only. On the basis of such a comparison, if the disputed domain name is seen to be identical to the trademark, identity will generally be found. If the trademark is otherwise identifiable in the disputed domain name, confusing similarity will usually be found. It does not matter for the purposes of the first element assessment that any trademark post-dates

the registration date of the domain name concerned, although this may be relevant to the second and third element assessments.

In the present case, the Panel is satisfied that the Complainant has UDRP-relevant rights in its MEGAN LUROSE trademark by virtue of the registered trademark listed in the factual background section above. The Panel also finds that the evidence on the present record establishes that the Complainant possesses unregistered trademark rights in said trademark dating from 2012 because such term constitutes a distinctive identifier which consumers associate with the Complainant's goods and services.¹

Turning to the comparison exercise, the Panel finds that the disputed domain name is identical to the Complainant's registered and unregistered marks. The test is an objective one, although the outcome here is to be expected because the evidence also shows that the Complainant itself originally selected the disputed domain name to be an online representation of the MEGAN LUROSE trademark for the purposes of its official website related to the Complainant's activities in the field of entertainment services.

In all of these circumstances, the Panel finds that the Complainant has carried its burden in respect of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue".

The consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made out, the burden of production shifts to the respondent to bring forward appropriate allegations and/or evidence demonstrating its rights or legitimate interests in the domain name concerned.

In the present case, the Complainant submits that it has never permitted the Respondent to use the Complainant's trademark in any manner, that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services but is pointing it to a pornographic website, that the Respondent has never been commonly known by the disputed domain name, and that the Respondent is not

¹ See section 1.3 of the of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") indicating that relevant evidence demonstrating acquired distinctiveness may include a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. The Complainant produced evidence in the present case covering use of the mark associated with musical recordings, historic website entries (including past use of the disputed domain name itself), and an extract relating to the Complainant on the Internet Movie Database, together supporting a finding in terms of factors (i), (iii) and (iv).

making a legitimate noncommercial or fair use thereof. The Panel is satisfied that these submissions make out the requisite *prima facie* case and accordingly turns to the Respondent's case in respect of any rebuttal.

No Response has been filed by the Respondent and it has therefore put forward no submissions or evidence in rebuttal seeking to demonstrate any rights or legitimate interests in the disputed domain name. In the Panel's opinion, the facts and circumstances arising from the present record raise a case for the Respondent to answer. The distinctive stage name and trademark of the Complainant has been represented in a domain name, which was in use (by the Complainant no less) for almost a decade prior to the Respondent's registration thereof. Upon its inadvertent expiration, the Respondent re-registered it and is now pointing it to a pornographic website. Instead of providing any explanation for this, the Respondent offers merely silence. This suggests to the Panel that no reasonable explanation consistent with the Respondent possessing any rights or legitimate interests in the disputed domain name could be forthcoming.

In the present case it seems clear that the Respondent likely seeks to benefit commercially from the associated Internet traffic built up during the disputed domain name's previous "life", due to the Complainant's activities as a musician and actor. In the opinion of the Panel, the registration of the disputed domain name with that intention would not confer rights or legitimate interests upon the Respondent within the meaning of the Policy. At minimum, the Respondent has not offered a countervailing legitimate explanation for its registration of the disputed domain name.

In all of these circumstances, the Panel finds that the Respondent has failed to rebut the Complainant's *prima facie* case, and therefore that the Complainant has carried its burden in respect of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- “(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) 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”.

In the present case, there does not appear to the Panel to be any basis for suggesting that the Respondent's choice of the disputed domain name was made other than with knowledge of the Complainant's lapsed registration, and by virtue thereof: its name and trademark. The disputed domain name is identical to that name and trademark, which represents the Complainant's distinctive stage name of around a decade's standing. Any suggestion that the Respondent would register the disputed domain name in the present circumstances without any awareness of the Complainant or its rights would be fanciful in the extreme. In any event, no assertion of that nature has been advanced by the Respondent, which has chosen to remain silent in the face of the Complaint.

As discussed in the previous section, the Panel considers that the most likely explanation for the Respondent's registration and use of the disputed domain name is that it is seeking to benefit commercially from Internet traffic generated by the Complainant during the time that the disputed domain name was under the Complainant's control, for example, arising from interest within the Complainant's fanbase. This constitutes an attempt to attract, 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, amounting to evidence of registration and use in bad faith in terms of paragraph 4(b)(iv) of the Policy. In addition, it cannot be overlooked that the linking of the Complainant's stage name to pornographic content amounts to tarnishment of the Complainant's mark. "Under the UDRP, tarnishment refers to unseemly conduct such as linking unrelated pornographic, violent or drug-related images, or information meant to disparage an otherwise wholesome mark." (see *Dover Downs Gaming & Entertainment, Inc. v. Domains By Proxy, LLC / Harold Carter Jr, Purlin Pal LLC*, WIPO Case No. [D2019-0633](#)). Such tarnishment may, in and of itself, constitute evidence of a respondent's bad faith (see section 3.12 of the [WIPO Overview 3.0](#)).

In all of these circumstances, the Panel finds that the disputed domain name has been registered and is being used in bad faith and, accordingly, that the Complainant has carried its burden with regard to paragraph 4(a)(iii) 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 <meganlurose.com> be transferred to the Complainant.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: May 27, 2022