

ADMINISTRATIVE PANEL DECISION

Stefani Germanotta, Ate My Heart Inc. v. Registration Private, Domains By Proxy, LLC / Oscar Xavier Edan, EDANINC

Case No. D2022-1975

1. The Parties

Complainant is Stefani Germanotta, Ate My Heart Inc., United States of America (“United States”), represented by Pryor Cashman LLP, United States.

Respondent is Registration Private, Domains By Proxy, LLC, United States / Oscar Xavier Edan, EDANINC, United States.

2. The Domain Names and Registrar

The disputed domain names <ladygagametaverse.com> and <gagametaverse.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 31, 2022. On June 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 2, 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 Complainant on June 7, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on June 12, 2022, and requested the addition of a disputed domain name to the proceeding.

On June 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the additional disputed domain name. On June 14, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant for both of the disputed domain names, and providing the contact details.

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 Respondent of the Complaint, and the proceedings commenced on June 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 5, 2022. Upon request from Respondent, the due date for Response was automatically extended to July 9, 2022, pursuant to the Rules, paragraph 5(b). Respondent sent informal communications to the Center on July 5, 2022 and July 10, 2022.

The Center appointed Lorelei Ritchie as the sole panelist in this matter on July 22, 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

Complainant Stefani Germanotta, also known as Lady Gaga, is a global entertainer, artist, and entrepreneur, who, together with her affiliates, predecessors, and successors in interest (collectively, “Complainant”), owns rights to the mark LADY GAGA, along with various derivatives thereof. For years prior to the registration of the disputed domain names, Complainant has offered various goods and services under these marks. Complainant is the owner of several trademark registrations. These include, among others, United States Registration No. 3,960,468 (registered May 17, 2011) for LADY GAGA for musical compositions, clothing, and various other goods and services.

The disputed domain names were registered on December 3, 2021. The Complainant provided evidence that the disputed domain names resolve to parked websites displaying pay-per-click links related to Complainant’s area of activity. Respondent has no affiliation with Complainant, nor any license to use Complainant’s marks.

5. Parties’ Contentions

A. Complainant

Complainant contends that (i) the disputed domain names are identical or confusingly similar to Complainant’s trademarks, (ii) Respondent has no rights or legitimate interests in the disputed domain name; and (iii) Respondent registered and is using the disputed domain names in bad faith.

Specifically, Complainant contends that it owns registrations for the mark LADY GAGA, as well as for various derivatives thereof. Complainant further contends that its LADY GAGA mark is a “famous and distinctive brand” and a “household name.” In this regard, Complainant submitted a declaration of counsel, noting numerous awards received by Complainant, as well as significant international exposure of the mark.

Complainant contends that Respondent has incorporated the LADY GAGA mark in full into the disputed domain name <ladygagametaverse.com>, and the dominant portion of the mark into the disputed domain name <gagametaverse.com>, with only the addition, in each of the disputed domain names, of the dictionary term “metaverse.”

Complainant contends that Respondent lacks rights or legitimate interest in the disputed domain names, and rather has registered and is using them in bad faith, having simply acquired the disputed domain names for Respondent’s own commercial gain, likely in order to confuse consumers seeking web-based information about Complainant and its goods and services. Complainant further included evidence that Respondent has engaged in a pattern of conduct that establishes bad faith under the UDRP.

B. Respondent

As noted, Respondent submitted only informal communications. Respondent did not reply to Complainant's substantive contentions, but rather requested information from the Center regarding transfer options and procedures.¹

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel must first determine whether the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy. The Panel finds that they are.

The disputed domain name <ladygagametaverse.com> incorporates in full Complainant's registered mark LADY GAGA, and adds the term "metaverse." The disputed domain name <gagametaverse.com> incorporates a dominant portion of Complainant's registered mark LADY GAGA, and adds the term "metaverse."

As to the disputed domain name <gagametaverse.com>, incorporating a "dominant feature" of a mark may be sufficient for a finding under this first element of the UDRP. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. Furthermore, as to both disputed domain names, numerous UDRP panels have agreed that supplementing or modifying a trademark with additional terms does not prevent a finding of confusingly similarity for purposes of satisfying this first prong of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.8.

The Panel therefore finds that the disputed domain names are identical or confusingly similar to a trademark in which Complainant has rights for purposes of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel next considers whether Complainant has shown that Respondent has no "rights or legitimate interests," as must be proven to succeed in a UDRP dispute. Paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name. These examples include: (i) use of the domain name "in connection with a *bona fide* offering of goods or services"; (ii) demonstration that respondent has been "commonly known by the domain name"; or (iii) "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."

No evidence has been presented to the Panel that might support a claim of Respondent's rights or legitimate interests in the disputed domain names, and Respondent has no license from, or other affiliation with, Complainant.

Therefore, the Panel finds that Complainant has provided sufficient evidence of Respondent's lack of "rights or legitimate interests" in accordance with paragraph 4(a)(ii) of the Policy which Respondent has not rebutted.

¹ The Panel has decided to exceptionally consider the late-filed communication from Respondent, sent to the Center on July 10, 2022. However, the Panel notes that consideration thereof has not changed the outcome of this proceeding.

D. Registered and Used in Bad Faith

There are several ways that a complainant can demonstrate that a domain name was registered and used in bad faith. As noted in Section 4 of this Panel's decision, Complainant provided evidence that the disputed domain names resolve to parked websites displaying pay-per-click links related to Complainant's area of activity. In the context of this case, the Panel considers such use indicative of an intent to attempt to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's trademark.

Moreover, the Panel notes that prior UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4. However, Respondent here did not formally respond to the Complaint or otherwise object to the Complainant's contentions. Furthermore, the Panel finds that Complainant has demonstrated a likelihood that Respondent was aware of Complainant's prior use of Complainant's well-known and distinctive LADY GAGA mark for entertainment and other services.

The Panel further notes that Complainant has provided evidence that Respondent is the registrant for a number of domain names that appear to include the trademarks of third parties, such as <cdiormetaverse.com>; <smaddenmetaverse.com>; <billboardmusicawardsmetaverse.com>; and <emmyawardsmetaverse.com>. This also evidences a pattern of conduct such as to demonstrate bad faith in accordance with paragraph 4(b)(ii).

Therefore, the Panel finds sufficient evidence that Respondent registered and used the disputed domain names in bad faith for purposes of 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 names <ladygagametaverse.com> and <gagametaverse.com> be transferred to Complainant.

/Lorelei Ritchie/

Lorelei Ritchie

Sole Panelist

Date: August 4, 2022