

## **ADMINISTRATIVE PANEL DECISION**

Music Together, LLC v. Justine Chadly, In Harmony Music  
Case No. D2023-5355

### **1. The Parties**

The Complainant is Music Together, LLC, United States of America (“United States”), represented by Riker Danzig LLP, United States.

The Respondent is Justine Chadly, In Harmony Music, United States, represented by Kinney Law, P.C, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <musictogetherofmarin.com> (the “Disputed Domain Name”) is registered with Register.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 26, 2023. On December 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 29, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and its 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 January 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 28, 2024. On January 24, 2024, the Parties requested the suspension of the dispute in order to pursue settlement discussions. On January 25, 2024, the proceeding was suspended until February 24, 2024. The settlement discussions were unsuccessful, and the suspension expired on February 24, 2024. The Response was filed with the Center on February 26, 2024.

The Center appointed David H. Bernstein as the sole panelist in this matter on March 14, 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 offers a musical education program to children under the MUSIC TOGETHER trademark at more than 3,000 locations in over 40 countries. The Complainant owns United States trademark registrations for MUSIC TOGETHER for a variety of goods and services including musical education and books containing music.

The Disputed Domain Name was initially registered by one of the Respondent's predecessors in interest in 2007. The Disputed Domain Name was then sold to another of the Respondent's predecessors in interest, who in turn sold the Disputed Domain Name to the Respondent in 2019. Like its predecessors in interest, the Respondent was a licensee of the Complainant at the time it acquired the Disputed Domain Name. That license terminated in August 2023.

The Respondent has operated In Harmony Music since 2003. Since the Respondent acquired the Disputed Domain Name, it has redirected Internet visitors to the Respondent's In Harmony Music website, which offers music courses in Marin County, California.

#### **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.

First, the Complainant alleges that the Disputed Domain Name is confusingly similar to the Complainant's MUSIC TOGETHER trademark. Specifically, the Complainant contends that the Disputed Domain Name incorporates the entirety of the Complainant's registered trademark, MUSIC TOGETHER. The Complainant also contends that the Respondent's use of the Disputed Domain Name falsely suggests that the Disputed Domain Name is connected to the Complainant.

Second, the Complainant alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Complainant asserts that the Respondent is not sponsored by or affiliated with the Complainant and that, although the Respondent was a former licensee of the Complainant, the Respondent does not have "current" permission from the Complainant to use its marks, including as part of the Disputed Domain Name. The Complainant further alleges that the Respondent is not "currently" licensed, authorized, or permitted to use or register domain names incorporating the MUSIC TOGETHER trademark. The Complainant further contends that the Respondent is not commonly known by or identified with the Disputed Domain Name and that the Respondent was not known by that name at the time the Disputed Domain Name was registered. The Complainant additionally asserts that the Respondent is creating a false association with the Complainant by using the Disputed Domain Name to attract would-be customers to the Respondent's website. Therefore, the Complainant alleges, the Respondent cannot claim that it is using the Disputed Domain Name in connection with a bona fide offering of goods or services.

Finally, the Complainant alleges that the Respondent registered and is using the Disputed Domain Name in bad faith. In support of these allegations the Complainant asserts that: (1) the Respondent registered the Disputed Domain Name long after the Complainant registered its MUSIC TOGETHER trademark in the United States; and (2) the Respondent continued to use the Disputed Domain Name after the termination of the license agreement. The Complainant additionally alleges that Respondent's use of the Disputed Domain

Name to redirect consumers to the Respondent's In Harmony Music website constitutes bad faith because it creates initial interest confusion and disrupts the Complainant's business.

## **B. Respondent**

The Respondent contends that the Complainant has not satisfied the elements required under the Policy for a transfer of the Disputed Domain Name.

First, the Respondent argues that the Disputed Domain Name is not identical or confusingly similar to a trademark in which the Complainant has rights because the Complainant has disclaimed "Music" in each of its trademark registrations, and the Respondent distinguishes its domain name by adding the geographic reference "of Marin," which avoids confusing similarity. The Respondent further argues that the Complainant has not challenged other businesses that use the words "Music Together" in their names, along with an added geographic location.

Second, the Respondent asserts that it has rights or legitimate interests in the Disputed Domain Name because it has operated a music education business since 2003, and because it purchased the Disputed Domain Name from a third party who had used the Disputed Domain Name under license from the Complainant and who represented that she had the right to use the Disputed Domain Name. The Respondent further asserts that it notified the Complainant of the Respondent's use of Disputed Domain Name in connection with its own business as early as 2019 via email, and that the Complainant raised no objections at that time. Further, the Respondent states that it has not diverted customers through the use of the Disputed Domain Name; to the contrary, it distinguishes its services by adding the geographical reference "of Marin" in the Disputed Domain Name and offers music classes under the In Harmony Music name, rather than under the MUSIC TOGETHER trademark.

Third, the Respondent asserts that the fact that it notified the Complainant of its acquisition shortly after the purchase in 2019 is proof that it did not register the Disputed Domain Name in bad faith, which was reinforced by the fact that the Complainant did not object to the Respondent's acquisition of the Disputed Domain Name. Moreover, the Respondent was a licensee of the Complainant at the time it acquired the Disputed Domain Name and, as such, its acquisition was in good faith. The Respondent also complains that the Complainant's long delay in initiating these proceedings caused the Respondent to rely on its right to use the Disputed Domain Name to support its business and livelihood.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements by a preponderance of the evidence to obtain an order that a disputed domain name be transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

For the reasons stated below, the Panel finds that the Complainant has not proven all three elements by a preponderance of the evidence.

Before addressing the evidence, the Panel first addresses a procedural issue. Following the submission of the Response, the Complainant submitted a supplemental submission in which the Complainant responded to the Respondent's arguments that its registration and use of the Disputed Domain Name was excused because the Respondent was a licensee of the Complainant at the time when the Respondent purchased the Disputed Domain Name. In that submission, the Complainant also indicated that it was "available to provide additional factual information or documentary evidence regarding the license, termination, and refusal to relinquish the domain name if such information would be helpful to the Panel to clarify the history of the

dispute.” All of the points that the Complainant made in its supplemental submission are points that the Complainant could have anticipated and addressed in the Complaint, and any necessary information or documentary evidence should have been provided at that time. Because the Complainant’s supplemental submission failed to include any new facts or legal argument that the Complainant could not have anticipated and addressed in the Complaint, the Panel has elected to disregard the supplemental submission (though the Panel notes that nothing in the supplemental submission would have changed the outcome of this matter). WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 4.6.

#### **A. Identical or Confusingly Similar**

It is well accepted that the first element of the Policy 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 3.0](#), section 1.7.

The Complainant’s federal trademark registrations establish its trademark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. That the Complainant disclaimed “Music” in its registrations is immaterial under the assessment of the first element given that the entirety of the “MUSIC TOGETHER” portion of the Disputed Domain Name was not disclaimed. Moreover, the entirety of the Complainant’s mark is reproduced within the Disputed Domain Name. Contrary to the Respondent’s arguments, it is well accepted that the addition of a geographical term (like “of Marin”) “does not prevent a finding of confusing similarity under the first element” of Policy 4(a). [WIPO Overview 3.0](#), section 1.8. Accordingly, the Disputed Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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

#### **B. Rights or Legitimate Interests**

Under section 4(c) of the Policy, respondents may demonstrate rights or legitimate interests in a domain name by asserting that, before any notice of the dispute, the respondent used or made 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. [WIPO Overview 3.0](#), section 2.1.

The Complainant has conceded that the Respondent used the Disputed Domain Name under license until August 2023. The precise terms of that license are unclear, as neither the Complainant nor the Respondent has submitted the license agreement. Regardless, the fact that the Respondent was a licensee of the Complainant shows that, for at least some period of time, the Respondent had rights and legitimate interests in the Disputed Domain Name.

Because the parties have not submitted the license agreement, it is not clear whether the Respondent continued to have any rights or legitimate interests in the Disputed Domain Name. For example, it is not clear whether the license agreement required transfer or cancellation of any domain names corresponding to the licensed trademark at the termination of the license, and/or whether the license agreement allowed some use of such domain names during a transition period. Given these uncertainties, and that the burden of proof is on the Complainant to prove that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, the Panel finds that the Complainant has failed to carry its burden of proving that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Complainant has not established second element of the Policy.

### C. Registered and Used in Bad Faith

The fact that the Respondent was a licensee of the Complainant when it acquired the Disputed Domain Name (and continued to be a licensee of the Complainant for four more years), coupled with the absence of any evidence that the Respondent was not entitled to register the Disputed Domain Name given its role as a licensee of the Complainant, is dispositive of the issue of bad faith registration. If the license agreement prohibited the Respondent from registering the Disputed Domain Name (or any domain name containing the licensed mark), then the registration may well have been in bad faith. But the Complainant has not submitted any such evidence to the Panel. Indeed, even though the burden is on the Complainant to prove bad faith registration by a preponderance of the evidence, the Complainant did not submit a copy of the license agreement to the Panel, nor did the Complainant indicate through other competent evidence that the license agreement included such a prohibition. The fact that the Complainant allowed the Respondent to remain a licensee for four years, and only terminated the license agreement in 2023, supports an inference that the Respondent was within its rights to register and use the Disputed Domain Name during the license period, which undermines any argument that the registration was in bad faith. That inference is further supported by the Complainant's careful statement that the Respondent is not "currently" licensed, authorized, or permitted to use or register domain names (which implies that the Respondent was so licensed, authorized or permitted prior to the termination of the license agreement), and also by the Respondent's claims that she was permitted to register and use the Disputed Domain Name pursuant to the license terms. If that is the case, then the registration cannot have been in bad faith.

The Complainant nevertheless asserts that the Respondent's registration of the Disputed Domain Name was in bad faith. In support of that assertion, the Complainant makes a number of arguments.

First, the Complainant argues: "The Disputed Domain Name was registered on February 1, 2007, which is more than seventeen (17) years after Complainant first registered its MUSIC TOGETHER mark in the U.S. The fact that the Respondent registered the Disputed Domain Name significantly after Complainant's MUSIC TOGETHER trademark which, together with the Music Together Registered Marks, became famous and well-known, demonstrates that Respondent registered the Disputed Domain Name in bad faith."

That argument is without merit. The relevant registration date is not the original registration by the Respondent's predecessor in interest in 2007, but rather 2019 when the Respondent acquired the Disputed Domain Name. Furthermore, the mere fact that the Disputed Domain Name was registered after the Complainant acquired trademark rights does not automatically render the domain name registration in bad faith. Rather, the relevant question is whether the Respondent acquired the Disputed Domain Name in good faith or in bad faith. Here, the Respondent's intent seems to have been done in good faith – the Respondent acquired the Disputed Domain Name from a party who had the right to use the name, received representations and warranties to that effect, and was (or became) a licensee of the Complainant at that time.

Second, the Complainant argues that, because the Respondent is "a former licensee of Complainant, it can not be disputed that Respondent knew of the existence of the Music Together Registered Marks at the time of her registration of the Disputed Domain Name. . . . Accordingly, Respondent's actions constitute bad faith per se." The Complainant fails to articulate how that knowledge, by itself, and especially in the face of an apparent transfer of license, constitutes bad faith.

Finally, the Complainant argues that "the registration and use of the Disputed Domain Name creates a form of 'initial interest confusion' which attracts Internet users to the Disputed Domain Name based on the use of the MUSIC TOGETHER Mark." That argument is misplaced and overlooks the issue of bad faith registration in favor of claimed bad faith use.

The Complainant goes on to argue that the Respondent's continued use of the Disputed Domain Name following the termination of the license constitutes bad faith use. Depending on the terms of the license agreement, that may well be true. But the Policy clearly requires both bad faith use and bad faith registration; proving only bad faith use is not sufficient.

Because the Complainant has failed to establish that the Respondent registered the Disputed Domain Name in bad faith, the Complainant has failed to establish the third element of the Policy.

#### **D. Reverse Domain Name Hijacking**

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking (“RDNH”), the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The Panel's obligation to consider whether to declare that the Complaint was brought in bad faith exists regardless of whether the respondent requests such a finding.

[WIPO Overview 3.0](#), section 4.16.

Given that the Complainant knew that the Respondent was its licensee at the time that the Respondent registered the Disputed Domain Name and the inference, based on the record – notably the lack of Complainant's provision of the relevant license, which it is therefore assumed does not operate to its favor in this case – and arguments presented, that the Respondent was authorized to register the Disputed Domain Name at that time, there could not have been bad faith registration. That means that the Complaint was doomed to failure. That the Complainant was represented by counsel only heightens the bad faith conduct that underlay the filing of this Complaint.

Accordingly, the Panel finds that the Complaint was brought in bad faith and constitutes an attempt at RDNH.

#### **7. Decision**

For the foregoing reasons, the Complaint is denied. Moreover, the Panel finds that the Complaint has been brought in bad faith and constitutes an attempt at Reverse Domain Name Hijacking.

*/David H. Bernstein/*

**David H. Bernstein**

Sole Panelist

Date: March 28, 2024