

ADMINISTRATIVE PANEL DECISION

iHeartMedia, Inc. and iHM Identity, Inc. v. Privacy service provided by
Withheld for Privacy ehf / John Stephenson
Case No. D2022-1732

1. The Parties

Complainants are iHeartMedia, Inc. and iHM Identity, Inc., United States of America (“USA”), represented by Schwegman Lundberg & Woessner, P.A., USA.

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / John Stephenson, USA.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 12, 2022. On May 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 13, 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 Complainants on May 16, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainants to submit an amendment to the Complaint. Complainants filed an amended Complaint on May 31, 2022.

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 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 23, 2022.

The Center appointed Richard W. Page as the sole panelist in this matter on July 1, 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

Complainants are the owners of common law rights as well as multiple trademark registrations worldwide for trademarks containing or consisting of IHEART or IHEART MEDIA (the "iHM Marks") for use in association with entertainment services, promotional campaigns, marketing services, Internet and radio broadcasting services, advertising services, and providing a website or software therefor. The iHM Marks predate registration of the Disputed Domain Name. Complainants own several trademark registrations in the United States for the iHM Marks, including United States Registration No. 4444152 for IHEART registered on December 3, 2013, with a first use in commerce at least as early as July 24, 2013. Complainants' iHM Marks registrations also include, without limitation: United States Registration No. 5492427 for IHEART MEDIA registered June 12, 2018, in classes 9, 38, 41 and 42.

The Disputed Domain Name was registered on January 11, 2022. The Disputed Domain Name resolves to an undeveloped landing page, however, Complainant has provided evidence the Disputed Domain Name has been used for email correspondence impersonating the Complainant.

5. Parties' Contentions

A. Complainants

Complainants contend that they have also established common law rights in IHEART and have been using IHEART to indicate Complainants or their predecessors as a source of their goods for more than 10 years. The iHM Marks predate registration of the Disputed Domain Name which was registered on January 11, 2022, more than 7 years after Complainants' first trademark registration of IHEART and more than 10 years after Complainants' first use of IHEART. Complainants further contend that they are the registrants of the domain names <iheart.com> and <iheartmedia.com>.

Complainants further contend that they have expended significant time, money, and effort to establish substantial customer recognition of the iHM Marks as identifying Complainants as the source of their goods and services related to audio media. As a result, Complainants have built up and now own valuable goodwill in their iHM Marks, symbolized by the above-mentioned trademark registrations and common law uses. Complainants further contend that the iHM Marks have been used extensively and continuously in connection with identifying Complainants' goods and services, in the advertising and promotion of Complainants' goods and services and in other ways customary in the trade, to promote their goods throughout the United States and internationally. As a result of such advertising, promotion, and widespread use, the consuming public recognizes the iHM Marks and associates these marks with Complainants and their goods and services.

Complainants allege that the Disputed Domain Name is confusingly similar to the iHM Marks in which Complainants have rights. Particularly, Complainants established rights to IHEART and IHEART MEDIA years before the registration of the Disputed Domain Name which incorporates portions of the iHM Marks in their entirety, only replacing the "i" with an "l". The lowercase "l" is easily mistaken for an uppercase or lowercase "i". Further, Complainants own the domain name <iheartmedia.com> which is remarkably similar in appearance to the Disputed Domain Name. Replacing the "i" and "l", rather than distinguishing or differentiation the Disputed Domain Name, is likely to confuse and mislead consumers into thinking it is in fact Complainants' domain name.

Complainants further allege that, when the Disputed Domain Name is used, there is a strong likelihood that confusion will result. The public is likely to believe that there is some connection, sponsorship, affiliation, or

association between the Disputed Domain Name and Complainants and their well-known iHM Marks.

Complainants submit that Respondent has no rights or legitimate interests with respect to the Disputed Domain Name. As mentioned above, the Disputed Domain Name directs to a landing page that is relatively undeveloped. Complainants further submit that Respondent's failure to develop a website corresponding to the Disputed Domain Name without any original content is evidence supporting the conclusion that Respondent has no rights or legitimate interests in this Disputed Domain Name. See *Virgin Enterprises Limited v. LINYANZHAO aka lin yan xiao*, WIPO Case No. [D2016-2302](#). Complainants further submit that no legitimate interests may arise from the abuse of third-party trademark rights. See, section 2.15, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Complainants allege that there is no evidence of Respondent's use of, or preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods or services, and Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. Additionally, Complainants have given Respondent no authorization or license to use their registered or common law marks, and there exists no connection between the Parties. There is no evidence that Respondent has been commonly known by the Disputed Domain Name or has any trademark or service mark rights to it. Further, the clear indicia of bad faith, as detailed below, suggest Respondent cannot have any rights or legitimate interests in the Disputed Domain Name.

Complainants aver that the Disputed Domain Name was registered and is being used in bad faith. As mentioned above, the Disputed Domain Name was registered on January 11, 2022, more than 10 years after Complainants first adopted and used their well-known marks, including IHEART. While the Disputed Domain Name directs to a relatively undeveloped website, the Disputed Domain Name has been used for fraudulent email correspondence, indicative of registration and use in bad faith.

Claimants further aver that on January 13, 2022, the Disputed Domain Name was used to send an email impersonating an actual iHeart Media employee. Not only was the Disputed Domain Name used to impersonate an actual iHeart Media employee, but the impersonator inserted himself in the middle of an existing email chain between iHeart Media and a vendor discussing a payment due of USD 293,854. The impersonator replied to the chain while removing the real employee from the email chain. The impersonator instructed the vendor to send the wire transfer to new preferred banking information (different than iHeart Media's banking information) multiple times. The vendor was going to proceed with the payment, but the vendor's accounting department identified that the banking information was inconsistent with previous instructions they had received from iHeart Media. Upon further inspection, the vendor then identified the difference in email addresses between the real employee and the impersonator, and brought it to Complainants' attention.

Complainants further aver that the use of Complainants' trademarks to give the appearance of association with Complainants by using an email address associated with the Disputed Domain Name to impersonate an employee of Complainants indicates an intentional effort by Respondent to confuse the public. Further the Disputed Domain Name is clearly being used to perpetrate fraud via an email scam to solicit payments from recipients who believe they are paying Complainants. The use of a confusingly similar, deceptive domain name for an email scam has previously been found by previous UDRP panels to be sufficient to establish a domain name has been registered and is being used in bad faith. *Samsung Electronics Co. Ltd. v. Albert Daniel Carter*, WIPO Case No. [D2010-1367](#). Moreover, it has been found that a domain name used for impersonation to constitute bad faith, even if the relevant domain names are used on for email. *Terex Corporation v. Williams Sid, Partners Associates*, WIPO Case No. [D2014-1742](#).

B. Respondent

Respondent did not reply to Complainants' contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.”

Even though Respondent has failed to file a Response or to contest Complainants’ assertions, the Panel will review the evidence proffered by Complainants to verify that the essential elements of the claims are met. See section 4.3 of the [WIPO Overview 3.0](#).

Paragraph 4(a) of the Policy directs that Complainants must prove each of the following:

- i) that the Disputed Domain Name is identical or confusingly similar to a trademark in which Complainants have rights; and,
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and,
- iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Section 1.2.1 of the [WIPO Overview 3.0](#) states that registration of a trademark is *prima facie* evidence of complainants having enforceable rights in their trademarks. Complainants have shown registrations of the iHM Marks, without opposition from Respondent.

Therefore, for purposes of this proceeding, the Panel concludes that Complainants have enforceable rights in the iHM Marks.

Section 1.7 of the [WIPO Overview 3.0](#) says that inclusion of the entire trademark in a domain name will be considered confusingly similar. Section 1.9 of the [WIPO Overview 3.0](#) instructs that a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. Section 1.11.1 of the [WIPO Overview 3.0](#) instructs that generic Top-Level Domain (“gTLD”) such as “.com” may be disregarded for purposes of assessing confusing similarity.

Complainants allege that the Disputed Domain Name is confusingly similar to the iHM Marks in which Complainants have rights. Particularly, Complainants established rights to IHEART and IHEART MEDIA years before the registration of the Disputed Domain Name which incorporates portions of the iHM Marks in their entirety, only replacing the “i” with an “l”. The lowercase “l” is easily mistaken for an uppercase or lowercase “i”.

Despite such misspelling, the Panel finds that the iHM Marks remain sufficiently recognizable in the Disputed Domain Name for the Disputed Domain Name to be considered confusingly similar to the iHM Marks for the purposes of the first element. In addition, the gTLD “.com” can be disregarded in the analysis of confusing similarity.

Therefore, the Panel finds that the Disputed Domain Name is confusingly similar to the iHM Marks, pursuant to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainants contend that Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

Section 2.1 of the [WIPO Overview 3.0](#) states that once Complainants make a *prima facie* case in respect of

the lack of rights or legitimate interests of Respondent, Respondent carries the burden of demonstrating he has rights or legitimate interests in the Disputed Domain Name. Where Respondent fails to do so, Complainants are deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Name:

(i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services; or

(ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Disputed Domain Name, even if you have acquired no trademark or service mark rights; or

(iii) you [Respondent] are 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 iHM Marks.

Complainants contend that Respondent has no rights or legitimate interests with respect to the Disputed Domain Name. As mentioned above, Complainants contend that no legitimate interests may arise from the abuse of third-party trademark rights. See, section 2.15 of the [WIPO Overview 3.0](#).

Complainants allege that there is no evidence of Respondent's use of, or preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods or services, and Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. Rather, Complainant has put forward evidence that the Disputed Domain Name has been used for fraudulent email correspondence. The Panel finds that such use can never confer rights or legitimate interests. See, section 2.13 of the [WIPO Overview 3.0](#). Additionally, Complainants have given Respondent no authorization or license to use their registered or common law marks, and there exists no connection between the Parties. There is no evidence that Respondent has been commonly known by the Disputed Domain Name or has any trademark or service mark rights to it.

The Panel finds that Complainants have stated a *prima facie* case that Respondent lacks rights or legitimate interests in the Disputed Domain Name. Respondent has not contested these contentions.

Therefore, the Panel concludes that Complainants have satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Complainants contend that Respondent registered and is using the Disputed Domain Name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainants to show bad faith registration and use of the Disputed Domain Name:

(i) circumstances indicating that you [Respondent] have registered or you have acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to Complainants who are the owners of the iHM Marks or to a competitor of Complainants, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Name; or

(ii) you [Respondent] have registered the Disputed Domain Name in order to prevent Complainants from reflecting the iHM Marks in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you [Respondent] have registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Disputed Domain Name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the iHM Marks as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product on your website or location.

The four criteria set forth in paragraph 4(b) of the Policy are nonexclusive. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In addition to these criteria, other factors alone or in combination can support a finding of bad faith.

Complainants aver that the iHM Marks were registered and used many years prior to the registration of the Disputed Domain Name. Complainants further aver that Respondent knew or should have known of the existence of Complainants' rights in the iHM Marks. See, section 3.2.2 of the [WIPO Overview 3.0](#).

Complainants further aver that the Disputed Domain Name has been used for fraudulent email correspondence, indicative of registration and use in bad faith.

In this regard, Complainants aver that on January 13, 2022, the Disputed Domain Name was used to send an email impersonating an actual iHeart Media employee. Not only was the Disputed Domain Name used to impersonate an actual iHeart Media employee, but the impersonator inserted himself in the middle of an existing email chain between iHeart Media and a vendor discussing a payment. The impersonator instructed the vendor to send the wire transfer to new preferred banking information (different than iHeart Media's banking information) multiple times. The vendor was going to proceed with the payment, but the vendor's accounting department identified that the banking information was inconsistent with previous instructions they had received from iHeart Media. Upon further inspection, the vendor then identified the difference in email addresses between the real employee and the impersonator, and brought it to Complainants' attention.

Complainants argue that fraudulent schemes are a basis for bad faith registration and use. See *TVS Motor Co. Ltd. V. VistPrint Techs, Ltd.*, WIPO Case No. [DCO2014-0007](#); and *Beckman Coulter, Inc. v. Suzan Wilson*, WIPO Case No. [D2010-1163](#).

The Panel finds that Complainants have shown that Respondent had actual and constructive knowledge of Complainants rights in the iHM Marks prior to registration of the Disputed Domain Name, and that the Disputed Domain Name was used in a fraudulent scheme.

Therefore, Complainants have satisfied the requirements 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 Name <lheartmedia.com> be transferred to Complainants.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: July 15, 2022