

ADMINISTRATIVE PANEL DECISION

Stefani Germanotta, Ate My Heart Inc. v. Super Privacy Service LTD
c/o Dynadot / Asep Candra
Case No. D2022-1769

1. The Parties

The Complainants are Stefani Germanotta (“First Complainant”), and Ate My Heart Inc. (“Second Complainant”), United States of America (“United States”), represented by Pryor Cashman, LLP, United States.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States / Asep Candra, Indonesia.

2. The Domain Name and Registrar

The disputed domain name <metaverseladygaga.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 16, 2022. On May 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 18, 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 Complainants the same day providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on May 19, 2022. The Complainants filed an amended Complaint on May 25, 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 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 May 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 20, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on June 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

The First Complainant is professionally known under the stage name Lady Gaga. She is an internationally-renowned recording artist, actress, and performer. Her albums have been certified Diamond and Multi-Platinum around the world, and she has won multiple Grammy Awards, Golden Globe Awards, and an Academy Award. To date, Lady Gaga has sold more than 36 million albums and over 140 million singles worldwide, and has earned 13 Grammy Awards and 34 nominations.

The First Complainant operates her business affairs through the Second Complainant.

The Second Complainant is the owner of the following trademark registrations for LADY GAGA (the “LADY GAGA trademark”);

- the United States trademark LADY GAGA with registration No. 3695038, registered on October 13, 2009, for services in International Class 41;
- the United States trademark LADY GAGA with registration No. 3695129, registered on October 13, 2009, for goods in International Class 25;
- the United States trademark LADY GAGA with registration No. 3960468, registered on May 17, 2011, for goods and services in International Classes 9, 16, 25, 35, 38 and 41; and
- the United States trademark LADY GAGA with registration No 5116758, registered on January 10, 2017, for goods and services in International Classes 3, 4, 6, 9, 11, 14, 16, 18, 22, 24, 25, 26, 28 and 35.

The disputed domain name was registered on December 19, 2021. It is currently inactive. At the time of filing of the Complaint, the disputed domain name resolved to a website with the tag “Metaverse Lady Gaga Official – The Official of Metaverse Lady Gaga”, which promoted a “Hyper deflationary token with METaverse LADY GAGA reflections” and offered visitors to buy the Metaverse Lady Gaga Token on Pancakeswap.

5. Parties’ Contentions

A. Complainant

The Complainants maintain that through the First Complainant’s fame and notoriety in the music industry, the LADY GAGA trademark has become internationally famous and serves to designate the Complainants as the sole source of the products and services featuring the trademark.

The Complainants state that the disputed domain name is confusingly similar to their LADY GAGA trademark, because it wholly incorporates the trademark with the addition of the term “metaverse” which is used to refer to a virtual-reality space in which users can interact with a computer-generated environment and other users, and this addition is insufficient to avoid confusion. According to the Complainants, the Respondent uses the term “metaverse” to modify the LADY GAGA trademark and to create the false impression that the website under the disputed domain name is offering a virtual-reality space associated with or otherwise authorized by the Complainants.

According to the Complainants, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is not commonly known as “Lady Gaga” and has never been an

authorized representative, agent, or licensee of the Complainants, and they have never consented to the Respondent's registration or use of the disputed domain name. The Complainants objected to the Respondent's registration by submitting a request to contact the Respondent through the Registrar's online form with the reason for contact being "domain name or content is infringing on a trademark or violating local laws or regulations", but the Respondent never responded.

The Complainants add that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods and services and has not made a legitimate noncommercial or fair use of the disputed domain name. According to them, the Respondent attempts to trade upon the goodwill associated with the Complainants and the LADY GAGA trademark. On December 29, 2021, the disputed domain name directed to a website promoting "The Official of Metaverse Lady Gaga", "Musicoin ladygaga", a "METAVERSE LADY GAGA token", and "METAVERSE LADYGAGA Tokenomics", while using the First Complainant's image and likeness throughout the website without the Complainants' authorization. The website stated "Metaverse Lady Gaga Token is a community-focused, decentralized cryptocurrency that works on an autonomous frictionless NFT Marketplace and liquidity generation protocol" and "Buy On Pancakeswap", implying that the unauthorized Metaverse Lady Gaga Token is offered for sale on the trading platform Pancakeswap. As of May 12, 2022, the disputed domain name directed to a website that still stated "Metaverse Lady Gaga Official – The official of Metaverse Lady Gaga" and "Copyright © 2022 Metaverse Lady Gaga Official". The Complainants point out that the Respondent's website lacks any disclaimer for the lack of relationship with them.

The Complainants contend that the disputed domain name was registered and is being used in bad faith. According to them, when registering the disputed domain name, the Respondent was well aware of the valuable goodwill and reputation of the well-known LADY GAGA trademark, which the Complainants had used since 2006. Despite this knowledge, over a decade after Lady Gaga became a household name, the Respondent registered the disputed domain name, which wholly incorporates the LADY GAGA trademark, giving consumers the false and misleading impression that the disputed domain name is associated with or authorized by the Complainants. The Complainants point out that the Respondent uses the Complainants' LADY GAGA trademark on the website under the disputed domain name and offers visitors to buy unauthorized "Metaverse Lady Gaga Token"-s under and in connection with the LADY GAGA trademark for commercial gain. According to the Complainants, the Respondent has thus intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainants' LADY GAGA trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

B. Respondent

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

6. Discussion and Findings

Pursuant to the Policy, paragraph 4(a), the Complainants must prove each of the following to justify the transfer of the disputed domain name:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the Respondent has registered and is using the disputed domain name in bad faith.

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ...”

The Respondent however did not submit a Response in this proceeding.

A. Identical or Confusingly Similar

The Complainants have provided evidence and have thus established their rights in the LADY GAGA trademark. This trademark is registered by the Second Complainant, which according to the Complaint is an entity through which the First Complainant carries out its business activities, so they should be considered as affiliated parties. As discussed in section 1.4.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), a trademark owner’s affiliate is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the Top-Level Domain (“TLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the [WIPO Overview 3.0](#). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” TLD section of the disputed domain name.

The relevant part of the disputed domain name for purposes of the first element is therefore the sequence “metaverseladygaga”. It consists of the elements “metaverse”, “lady” and “gaga”. The combination of the elements “lady” and “gaga” is identical to the LADY GAGA trademark, which is easily recognizable in the disputed domain name, while “metaverse” is a recently adopted term meaning a digital reality that combines aspects of social media, online gaming, augmented reality, virtual reality and cryptocurrencies to allow users to interact virtually. As discussed in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element.

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the LADY GAGA trademark in which the Complainants have rights.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainants contend that the Respondent has no rights or legitimate interests in the disputed domain name, stating that the Respondent is not commonly known by the disputed domain name, is not a licensee of the Complainants and is not affiliated with it. The Complainants submit that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, but in connection with the promotion and sale of unauthorized cryptocurrency on a website that features the image of the First Complainant and contains no disclaimer for the lack of relationship between the Parties. Thus, the Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not alleged that it has rights or legitimate interests

in the disputed domain name.

The disputed domain name is confusingly similar to the LADY GAGA trademark and the evidence shows that for a period of time it has resolved to a website that indeed promoted and offered for sale the so-called Metaverse Lady Gaga Tokens (described as a cryptocurrency), and contained stylized images of the First Complainant, without mentioning that lack of relationship with the Complainants. Rather, the website contained the tag “Metaverse Lady Gaga Official – The Official of Metaverse Lady Gaga”, which may well lead visitors to believe that the website is an official website of the Complainants.

In view of the above and in the lack of any denial or contrary evidence by the Respondent, the Panel is satisfied that it is more likely than not that the Respondent, being aware of the goodwill of the Complainants’ LADY GAGA trademark, has registered and used the disputed domain name in an attempt to exploit the goodwill of this trademark to attract Internet users to the Respondent’s website and to promote and offer for sale a cryptocurrency that has not been endorsed by the Complainants, but the use of the LADY GAGA trademark in its name is likely to mislead and create the contrary appearance. To the Panel, such conduct is not legitimate and does not give rise to rights and legitimate interests of the Respondent in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(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 website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The disputed domain name is confusingly similar to the LADY GAGA trademark. The Respondent does not deny that it has resolved to a website that promoted and offered for sale the so-called Metaverse Lady Gaga Tokens, contained stylized images of the First Complainant and did not mention the lack of connection of the website with the Complainants and endorsement of the offered cryptocurrency by them. Rather, the website contained the copyright notice “Copyright © 2021 Metaverse Lady Gaga Official”, which may mislead visitors that it is an official website of the Complainants.

In view of this and in the lack of any evidence to the contrary, the Panel finds that it is more likely than not that by registering and using the disputed domain name, the Respondent has intentionally attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainants’ LADY GAGA trademark as to the affiliation or endorsement of the Respondent’s website and of the cryptocurrency offered

on it and to create credibility to this offer in an attempt to induce Internet users to purchase this cryptocurrency. The fact that the disputed domain name is currently inactive does not prevent a finding of bad faith.

Therefore, the Panel finds that the disputed domain name was registered and has been used in bad faith.

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 <metaverseladygaga.com> be transferred to the Complainants.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: July 6, 2022