

ADMINISTRATIVE PANEL DECISION

Varoom Whoa, Inc. v. Gretchen Mihaly Gretchen Mihaly, Gretchen Mihaly
Case No. D2024-3162

1. The Parties

The Complainant is Varoom Whoa, Inc., United States of America ("United States"), represented by Akerman LLP, United States.

The Respondent is Gretchen Mihaly, Gretchen Mihaly, Gretchen Mihaly, United States.

2. The Domain Name and Registrar

The disputed domain name <paramoreus.com> (the "Disputed Domain Name") is registered with CNOBIN Information Technology Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 1, 2024. On August 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 5, 2024, 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 (Registration Private) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 9, 2024, 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 August 12, 2024.

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 August 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 11, 2024.

The Center appointed Lynda M. Braun as the sole panelist in this matter on October 2, 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 is a Tennessee corporation with a principal place of business in Franklin, Tennessee, United States, that operates Paramore, an American rock band. Founded in 2004, the band has received critical acclaim throughout the world with numerous awards and nominations in the music industry, including winning multiple Grammy awards. The band has garnered unsolicited media attention due to its fame and recognition. The Complainant uses its PARAMORE mark in connection with its music-related services, as well as in connection with goods and merchandise relating to the band.

The Complainant owns several registered trademarks through the United States Patent and Trademark Office, including, but not limited to: PARAMORE, United States Trademark Registration No. 3,430,716, registered on May 20, 2008, in international class 41; PARAMORE, United States Trademark Registration No. 3,507,475, registered on September 30, 2008, in international class 25; PARAMORE, United States Trademark Registration No. 3,974,072, registered on June 7, 2011, in international class 16; and PARAMORE, United States Trademark Registration No. 4,048,005, registered on November 1, 2011, in international class 9 (hereinafter collectively referred to as the “PARAMORE Mark”). The PARAMORE Mark has developed significant goodwill due to the extensive promotion of the brand beginning approximately two decades ago and the PARAMORE Mark has become a distinctive identifier associated with the Complainant and its goods and services.

The Complainant also owns the <paramore.net> and <paramoreisaband.com> domain names, which were first registered in 2000 and 2024, respectively, and which resolve to the “www.paramore.net” and “www.paramoreisaband.com” websites. The “www.paramoreisaband.com” website features an embedded music video and links to the band’s official YouTube channel, and the “www.paramore.net” website redirects to the former website.

The Disputed Domain Name was registered on May 23, 2024, and resolved to a website that offers and sells allegedly knock-off and infringing goods using the PARAMORE Mark. Such goods are in direct competition with the Complainant’s authentic goods. The Disputed Domain Name’s resolving website consisted of prominent and frequent use of the PARAMORE Mark, alongside images associated directly with the band, including images of the band members and images associated with the band’s musical albums and tours.

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. Notably, the Complainant contends that:

- the Disputed Domain Name is confusingly similar to the Complainant’s trademark because the Disputed Domain Name contains the entirety of the PARAMORE Mark, followed by the geographic term “us” (the abbreviation for United States), and then followed by the generic Top-Level Domain (“gTLD”) “.com”, and thus does not prevent a finding of confusing similarity;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, among other things, the Complainant has not authorized the Respondent to register a domain name containing the PARAMORE Mark, the Respondent was not making a bona fide offering of goods or services through the Disputed Domain Name, and the Respondent has never been commonly known by the PARAMORE Mark or any similar name; and

- the Disputed Domain Name was registered and is being used in bad faith because, among other things, the Respondent used the Disputed Domain Name to feature counterfeit goods on its resolving website for the purpose of deceiving unsuspecting consumers.

The Complainant seeks the transfer of the Disputed Domain Name in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the PARAMORE Mark as explained below.

It is well accepted that the first element 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. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

It is uncontroverted that the Complainant has established rights in the PARAMORE Mark based on its years of use as well as its registered trademarks for the PARAMORE Mark for entertainment services, goods, sound recordings and printed material in the United States. The consensus view of panels is that "registration of a mark is prima facie evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the PARAMORE Mark.

The Disputed Domain Name consists of the entirety of the Complainant's registered PARAMORE trademark, followed by the term "us", and then followed by the gTLD ".com". The test for confusing similarity involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Here, the PARAMORE Mark is recognizable within the Disputed Domain Name.

Further, as stated in section 1.8 of [WIPO Overview 3.0](#), "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". Thus, the addition of the term "us" to the Complainant's PARAMORE Mark in the Disputed Domain Name does not prevent a finding of confusing similarity. See e.g., *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Finally, the addition of a gTLD such as “.com” in a domain name is a technical requirement. As such, it is well established that a gTLD may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s PARAMORE Mark.

Based on the available record, the Panel finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name. Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise. The Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the PARAMORE Mark nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods or services. See Policy, paragraph 4(c). Further, the Respondent is not now, nor has it ever been an authorized retailer of the Complainant’s merchandise. Based on the use made of the Disputed Domain Name to resolve to a website allegedly promoting and selling counterfeit goods bearing the PARAMORE Mark, the Panel finds that the Respondent is not making a bona fide offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name. Such use would not support a claim to rights or legitimate interests.

Moreover, the Panel concludes that nothing on the record before it would support a finding that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. Rather, the Panel finds that the Respondent is using the Disputed Domain Name for commercial gain with the intent to mislead by deceiving the Complainant’s customers into incorrectly believing that they arrived at the Complainant’s website. Such use cannot conceivably constitute a bona fide offering of a product within the meaning of paragraph 4(c)(i) of the Policy or a noncommercial or fair use of the Disputed Domain Name.

Based on the available record, the Panel finds that the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent’s bad faith registration and use of the Disputed Domain Name pursuant to paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity, as here selling knock-offs, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy due to the Respondent's impersonation of the Complainant to offer allegedly counterfeit goods to unwitting customers.

Further, the use of a domain name to intentionally attempt to attract Internet users to a respondent's website or online location by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of the registrant's website or online location for commercial gain demonstrates registration and use in bad faith. Here, the Respondent's registration and use of the Disputed Domain Name indicates that such registration and use had been done for the specific purpose of trading upon and targeting the trademark and reputation of the Complainant. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Moreover, the Panel concludes that the Respondent's registration of the Disputed Domain Name was an attempt to disrupt the Complainant's business. See *Banco Bradesco S.A. v. Fernando Camacho Bohm*, WIPO Case No. [D2010-1552](#). The Respondent's use of the Disputed Domain Name was also likely to confuse Internet users into incorrectly believing that the Respondent was authorized by or affiliated with the Complainant.

Finally, the Respondent attempted to pass off as the Complainant by creating an impersonating website offering allegedly counterfeit products (regardless of their genuine nature, competing products), demonstrating bad faith. Therefore, it strains credulity to believe that the Respondent had not known of the Complainant or its PARAMORE Mark when registering the Disputed Domain Name. See *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. [D2001-0763](#) ("a finding of bad faith may be made where the respondent 'knew or should have known' of the registration and/or use of the trademark prior to registering the domain name"). In addition, how could the Respondent not be aware of the Complainant and its branded clothing when the Respondent featured same types of goods bearing the PARAMORE Mark on its website? Rather, the Panel notes that the composition of the Disputed Domain Name, together with the addition of the term "us", affirms the Respondent's intention to take unfair advantage of the likelihood of confusion between the domain name and the Complainant as to the origin or affiliation of the Disputed Domain Name's resolving website. In sum, the Panel finds that the Respondent had the Complainant's PARAMORE Mark in mind when registering the Disputed Domain Name.

Based on the available record, the Panel finds that the third element of the Policy has been established

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 <paramoreus.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: October 15, 2024