

ADMINISTRATIVE PANEL DECISION

ILTB, LLC v. Prodip Mondal

Case No. D2025-0102

1. The Parties

1.1 The Complainant is ILTB, LLC, United States of America ("United States"), represented by Miller, Griffin & Marks, PSC, United States.

1.2 The Respondent is Prodip Mondal, India.

2. The Domain Name and Registrar

2.1 The disputed domain name <tobykeithmerch.com> (the "Domain Name") is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 10, 2025. At that time, publicly available Whois details did not identify the registrant of the Domain Name.

3.2 On January 13, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 13, 2025, the Registrar transmitted by email to the Center its verification response disclosing underlying registrant and contact information for the Domain Name.

3.3 The Center sent an email to the Complainant on January 14, 2025, 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 January 14, 2025.

3.4 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").

3.5 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 15, 2025. In accordance with the Rules, paragraph

5, the due date for Response was February 4, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 5, 2025.

3.6 The Center appointed Matthew S. Harris as the sole panelist in this matter on February 7, 2025. 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

4.1 The Complainant is an Oklahoma limited liability company. It is the exclusive owner of all intellectual property rights associated with the late country music entertainer Toby Keith, including his name, likenesses, and trade mark registrations.

4.2 The following registered trade marks are owned by the Complainant, and relied upon by the Complainant in these proceedings:

(i) United States registered trade mark no. 3014178, for TOBY KEITH as a word mark in classes 21, 25, 28, and 43 with a filing date of March 11, 2004 and registration date of November 8, 2005.

(ii) United States registered trade mark no. 3910706, for TOBY KEITH as a word mark in class 41, with a filing date of June 1, 2010 and a registration date of January 25, 2011.

4.3 The Domain Name was registered on March 2, 2024. Since registration it has been used for a website that promotes and offers for sale merchandise that relates to Toby Keith. As of January 10, 2025 the text of the home page of the website read as follows:

"Toby Keith Merch Store

Welcome to the official Toby Keith Merch Store! Browse through our wide range of merchandise items that celebrate the country music legend, Toby Keith. Shop for apparel, accessories, music, home decor, collectibles, and stay up to date with Toby Keith's upcoming events. Order now and show your love for Toby Keith and his music with our official merchandise!"

4.4 That text appears on the website as at the date of the decision. Further, down the home page is the following text:

"Toby Keith Official Merch understands that every fan has their own unique style and preferences."

4.5 Further, the web page title that has appeared and continues to appear in a browser tab when viewing the website operating from the Domain Name reads "Toby Keith Merch - Official Website of Toby Keith".

4.6 On January 9, 2025 the Complainant sent a cease and desist message to the Respondent through a webform on the contact page of the website operating from the Domain Name. The Respondent did not respond to that message.

5. Parties' Contentions

A. Complainant

5.1 The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

5.2 Notably, the Complainant contends that the Domain Name contains its registered mark. It also contends that the Domain Name “creates [a] false and fraudulent association between the website/Respondent and the Complainant”. The Complainant also claims that the Respondent has intentionally attempted to attract internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant’s marks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s web site and products. In this respect it asserts that there is “unauthorized use of photographs of the late country music entertainer Toby Keith, which appear on the website” and also refers to products that are offered for sale on the website, which are said to be the same as those sold by the Complainant (but evidence in this respect has not been provided).

B. Respondent

5.3 The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

6.1 It is generally 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 trade mark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

6.2 The Complainant has shown rights for the purposes of the Policy in two registered trade marks, comprising the trade mark TOBY KEITH. [WIPO Overview 3.0](#), section 1.2.1.

6.3 The entirety of TOBY KEITH trade mark is reproduced within the Domain Name. Accordingly, the Panel finds the mark is recognisable within the Domain Name and that the Domain Name is confusingly similar to the Complainant’s marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

6.4 Although the addition of other terms (in this case, the word “merch”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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

B. Rights or Legitimate Interests and Registered and Used in Bad Faith

6.6 It is usual for panels under the Policy to consider the issues of rights or legitimate interests and registration and use in bad faith in turn. However, in this case it is more convenient to consider those issues together. [WIPO Overview 3.0](#), section 2.15.

6.7 The Domain Name in this case can only be sensibly read as a combination of the TOBY KEITH trade mark and the word “merch” (and the “.com”, generic Top-Level Domain), with the word “merch” being understood as an abbreviation of and alternative word for “merchandising”. That this was the intention of the Respondent is also clear from the website that has operated from the Domain Name. Although the Complainant has not provided copies of any pages from that website that actually offer products for sale, the screenshots of that website that the Complainant has provided demonstrates that the Respondent is seeking to sell “apparel, accessories, music, home décor [and] collectibles” related to Toby Keith.

6.8 If the Complainant is contending that the Domain Name by itself sends “a false and fraudulent” message that it is owned and operated by the Complainant, that is questionable. It appears to the Panel that it is more likely to be understood by Internet users as indicating a website where merchandise about or

related to Toby Keith is available. However, regardless of whether this is right or not, the Panel accepts that the way in which the Domain Name has been used, and in particular the website operating from the Domain Name is deceptive, and deliberately so. Not only does the website fail to disclose who is operating that website (as to which see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)), but in multiple places claims to be the “official website” for the sale of merchandise in relation to Toby Keith. The use of the word “official” is likely to be understood, and the Panel has no doubt that the Respondent intended it to be understood, by Internet users as a statement that this website is operated by the Complainant (or at least authorised by the Complainant), when it was not.

6.9 There is no right or legitimate interest in holding and using a domain name to deliberately mislead Internet users into believing that a domain name is held and being used by a trade mark owner when it is not ([WIPO Overview 3.0](#) section 2.13.1) and such holding and use provides positive evidence that no such rights or legitimate interest exists. The registration and use of a domain name for such a purpose is also registration and use in bad faith (see [WIPO Overview 3.0](#), sections 3.1.4). The Respondent’s operation of the website from the Domain Name also falls within the circumstances evidencing bad faith registration and use set out at paragraph 4(b)(iv) of the Policy.

7. Decision

7.1 For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <tobykeithmerch.com> be transferred to the Complainant.

/Matthew S. Harris/

Matthew S. Harris

Sole Panelist

Date: February 7, 2025