

ADMINISTRATIVE PANEL DECISION

Connected Ventures LLC v. Orbeus sa, Lum
Case No. D2023-2436

1. The Parties

Complainant is Connected Ventures LLC, United States of America (“United States” or “US”), represented by Cooley LLP, United States.

Respondent is Orbeus sa, Lum, United States.

2. The Domain Name and Registrar

The disputed domain name <dimension20merch.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2023. On June 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 6, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on June 8, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on June 9, 2023.

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 Respondent of the Complaint, and the proceedings commenced on June 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 2, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on July 5, 2023.

The Center appointed John C. McElwaine as the sole panelist in this matter on July 10, 2023. 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

Complainant is an entertainment business that creates shows that can be viewed online. Complainant is the owner of a United States trademark registration for DIMENSION 20 (and Design), US Reg. No. 6,777,803, registered on July 5, 2022, in Classes 09 and 41.

On August 31, 2022, Respondent registered the Domain Name with the Registrar. The Domain Name resolves to an active website selling clothing related to Complainant's Dimension 20 Show.

5. Parties' Contentions

A. Complainant

As background, Complainant asserts that it is the creator of an online game show that blends comedy with role playing games (the "Dimension 20 Show"). Complainant asserts that it has used the name and mark DIMENSION 20 since at least as early as October 11, 2018, in connection with its entertainment services, and that since that time, Complainant has released over 100 episodes of the Dimension 20 Show. Complainant provided evidence that Dimension 20 Show videos have been available for 4 years on YouTube and during that time were viewed millions of times. In addition to its common law rights to the DIMENSION 20 mark, Complainant provided evidence that it is the owner of US Reg. No. 6,777,803 for the DIMENSION 20 & Design trademark (collectively, Complainant's common law and registered trademark rights are referred to as the "DIMENSION 20 Mark".) Complainant also contends that it sells merchandise, including, apparel, accessories, home goods, toys, and games under the DIMENSION 20 Mark.

Complainant alleges Respondent's website's content hosted at the Domain Name includes claims that it is the "official merch store" for Dimension 20. Complainant provided evidence that the website notes the following: "Thank you for your visit, welcome to our Dimension 20 merchandise store. This website is an official merch store that provides real products to its customers and comes up with high-quality Dimension 20 merchandise." Complainant further alleges that the website content hosted at the Domain Name repeatedly uses Complainant's DIMENSION 20 Mark and a logo that is confusingly similar to Complainant's registered DIMENSION 20 & Design trademark. In addition, Complainant points out merchandise on this website displays images of characters from Complainant's Dimension 20 Show without Complainant's permission. Complainant asserts that it has not authorized or licensed Respondent to use any of its trademarks and Respondent is not affiliated with or related to Complainant in any way. Likewise, Complainant asserts that it has not authorized Respondent to sell Dimension 20 branded merchandise and the website at the Domain Name is not the official merchandise store for Dimension 20 branded merchandise.

With respect to the first element of the Policy, Complainant contends that its DIMENSIONS 20 Mark is a valid common law trademark and that Complainant is the owner of US Reg. No. 6,777,803 for the DIMENSION 20 & Design trademark. Complainant alleges that the Domain Name is confusingly similar to its DIMENSION 20 Mark because it incorporates the distinctive DIMENSION 20 Mark in its entirety with only the addition of the word "merch".

With respect to the second element of the Policy, Complainant asserts that it has not authorized or licensed Respondent to use any of its trademarks in any way and that Respondent is not affiliated with or related to Complainant in any way. Complainant further asserts there is no evidence that Respondent is using the Domain Name containing the DIMENSIONS 20 Mark with a *bona fide* offering of goods or services or that Respondent has any connection to the Domain Name. Complainant alleges that the Domain Name is being used to misleadingly divert consumers to Respondent's website for commercial gain for the following reasons. First, the website hosted at that Domain Name repeatedly uses Complainant's DIMENSION 20 Mark and a logo that is confusingly similar to Complainant's registered DIMENSION 20 & Design trademark. Second, this website also includes claims that it is the "official merch store" for the Dimension 20 Show. Third, the website offers for sale merchandise that uses images of characters from Complainant's Dimension 20 Show without Complainant's consent.

With respect to the third element of bad faith, Complainant asserts that Respondent registered the Domain Name to attract Internet users to Respondent's website by capitalizing on consumer confusion with Complainant's DIMENSION 20 Mark. As support, Complainant re-alleges that the Domain Name (1) repeatedly uses Complainant's DIMENSION 20 trademark and a logo that is confusingly similar to Complainant's registered DIMENSION 20 & Design trademark, (2) includes claims that it is the "official merch store" for Dimension 20, and (3) offers for sale merchandise that uses images of characters from Complainant's Dimension 20 show without Complainant's consent. In addition, Complainant asserts that Respondent was aware of Complainant's DIMENSION 20 Mark and registered the Domain Name in order to create a false association with Complainant and Complainant's trademarks for its own financial benefit.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Although Respondent defaulted, to succeed in this UDRP proceeding, paragraph 4 of the Policy requires Complainant to prove its assertions with evidence demonstrating:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires Complainant show that the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights. Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2. On this point, Complainant has provided evidence that it is the owner of a United States trademark registration for the DIMENSION 20 Mark.

The Domain Name contains Complainant's DIMENSION 20 Mark in its entirety as the dominant element with the addition of the word, "merch". The addition of other terms to a trademark in a domain name does not avoid a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8 ("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."); *Mastercard International Incorporated v. Dolancer Outsourcing Inc.*, WIPO Case No. [D2012-0619](#); *Air France v. Kitchkulture*, WIPO Case No. [D2002-0158](#); *DHL Operations B.V., and DHL International GmbH v. Diversified Home Loans*, WIPO Case No. [D2010-0097](#). Here, the DIMENSION 20 Mark is clearly recognizable in the Domain Name.

Accordingly, the Panel finds that the Domain Name is confusingly similar to Complainant's DIMENSION 20 Mark in which Complainant has valid trademark rights. Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the Policy, paragraph 4(a)(ii), Complainant has the burden of establishing that Respondent holds no rights or legitimate interests in the Domain Name. A complainant needs to only make a *prima facie* showing on this element, at which point the burden of production shifts to respondent to present evidence that it has some rights or legitimate interests in the disputed domain name. See *Vicar Operating, Inc. v. Domains by Proxy, Inc. / Eklin Bot Systems, Inc.*, WIPO Case No. [D2010-1141](#); see also *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Case No. [D2000-1415](#); *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, WIPO Case No. [D2000-0252](#).

Complainant contends Respondent has not received any license or consent, express or implied, to use the DIMENSION 20 Mark in a domain name or to sell merchandise related to Complainant's Dimensions 20 Show. Complainant further contends that Respondent is not authorized to claim that it is the official merchandise store for the Dimension 20 Show.¹ In a similar case involving an allegedly unauthorized merchandise website, the panel found no rights or legitimate interests for the following reasons: (i) respondent was aware of the complainant when it registered the domain name; (ii) the complainant's unchallenged assertion that it has granted the respondent no permission to use its trademark or any variant of it; (iii) the fact that the respondent's website had the appearance of an official website for the complainant's merchandise and contained false statements to that effect; (iv) the fact that the website contained no indication that it was not an official website for the complainant's merchandise and featured no name of the entity operating the website; (v) the fact that the respondent's name had no relation to the domain name; and (vi) the absence of any response from the respondent explaining how respondent acquired rights or legitimate interests in respect of the domain name. *The Lumineers, LLC v. zengyi xu, 1*, WIPO Case No. [D2022-4055](#). As discussed above, similar facts exist here and the Panel finds that Complainant has made out a *prima facie* case under the second element of the Policy.

Although Complainant has satisfied its burden, Respondent could establish a right or legitimate interest in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- “(i) before any notice to you of the dispute, your use of, or 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; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Panel finds that Respondent cannot show rights or legitimate interests under any of the three conditions.

As an initial matter, there is no evidence that Respondent is commonly known by the Domain Name. Respondent cannot rely upon paragraph 4(c)(ii) of the Policy.

The Panel finds that the website displayed at the Domain Name was deliberately designed to give the false impression that it is affiliated with or was an “official” website related to Complainant, which is not the case. Prior panels deciding under the UDRP have held that such use of a domain name cannot be a “*bona fide* offering of goods or services” and is not “fair use of the domain name.” See *Microsoft Corporation v. Microsof.com aka Tarek Ahmed*, WIPO Case No. [D2000-0548](#) (“by using a domain name and establishing a

¹ The Panel has not based its decision in this matter with respect to Complainant's allegations that Respondent's website offers for sale merchandise that uses images of characters from Complainant's Dimension 20 show without Complainant's consent.

website deliberately designed to confuse Internet users and consumers regarding the identity of the seller of the goods and services, Respondent has not undertaken a *bona fide* or good faith offering of the goods and services.”); see *Hulu, LLC v. Helecops, Vinod Madushanka*, WIPO Case No. [D2016-0365](#) (finding that an infringing website operating under the name “HuluMovies” does not entail a *bona fide* offering of services in the sense of paragraph 4(c)(i) of the Policy, nor a legitimate noncommercial or fair use under Policy paragraph 4(c)(iii), without intent for commercial gain to misleadingly divert consumers or to tarnish the HULU mark). The Panel notes that the contentions by Complainant about the website at the Domain Name have not been rebutted by Respondent in this proceeding.

Lastly, Respondent’s use of the Domain Name is not “noncommercial or fair use” under paragraph 4(c)(iii) of the Policy. Respondent’s website hosted at the Domain Name may target fans of the Dimensions 20 Show, but its primary purpose is to sell merchandise. Such activity does not amount to a fan site, criticism or other activity that may be considered noncommercial or fair. [WIPO Overview 3.0](#), section 2.7.1 (a respondent’s fan site must be active, genuinely noncommercial, and clearly distinct from any official complainant site). In addition, the Domain Name gives the impression it is officially connected to the Complainant when it is not. [WIPO Overview 3.0](#), section 2.5.1 (domain names identical to a complainant’s trademark carry a high risk of implied affiliation; domain names consisting of a trademark plus an additional term cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner).

Accordingly, Complainant has made a *prima facie* showing of Respondent’s lack of any right or legitimate interest and Respondent has failed to come forward to rebut that showing. As provided for by paragraph 14 of the Rules, the Panel may draw such inference from Respondent’s default as it considers appropriate. The Panel finds that Respondent does not have rights or legitimate interests in the Domain Name and that Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Bad faith registration can be found where a respondent “knew or should have known” of a complainant’s trademark rights and nevertheless registered a domain name in which it had no right or legitimate interest. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#). As detailed above, Respondent registered the Domain Name, which is confusingly similar to the DIMENSION 20 Mark. The content of the website establishes this is the case: “This website is an official merch store that provides real products to its customers and comes up with high-quality Dimension 20 merchandise. Dimension20merch.com is an online store that offers a variety of collections and is a great choice for many Dimension 20 fans.” Moreover, the website hosted at the Domain Name has an “Intellectual Property Rights” link suggesting that the concept of trademark rights being owned by Complainant or other third parties was expected. There is no explanation for Respondent to have chosen to register the Domain Name other than to intentionally trade off the goodwill and reputation of Complainant’s trademark or otherwise create a false association with Complainant. With no response from Respondent, such a claim of bad faith registration is undisputed.

Also as discussed herein, Respondent registered the Domain Name and linked it to a website using Complainant’s DIMENSION 20 Mark throughout the website. This amounts to bad faith use of the Domain Name by Respondent. See *Identigene, Inc. v. Genetest Labs*, WIPO Case No. [D2000-1100](#) (finding bad faith where the respondent’s use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing that the complainant is the source of or is sponsoring the services offered at the site); *The Lumineers, LLC v. zengyi xu, 1*, WIPO Case No. [D2022-4055](#) (finding bad faith under paragraph 4(b)(iv) of the Policy where the respondent registered a domain name confusingly similar to the complainant’s mark and the domain name was used to host a website with content clearly intended to lead visitors to believe that it is an official store authorized by the complainant.)

As detailed above, the Panel finds on the record before it that Respondent's intention in registering the Domain Name was to attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with the DIMENSION 20 Mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location. Thus, the Panel holds that Complainant has met its burden of providing sufficient evidence that Respondent registered and is using the Domain Name in bad faith under paragraph 4(b)(iv) of the Policy.

For these reasons, the Panel holds that Complainant has met its burden of showing that Respondent registered and is using the Domain Name in bad faith under 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 Domain Name, <dimension20merch.com>, be transferred to Complainant.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: July 24, 2023