

ADMINISTRATIVE PANEL DECISION

Rolls-Royce Motor Cars Limited v. Domain Administrator, See PrivacyGuardian.org / NameSilo, LLC, Domain Administrator
Case No. D2022-1118

1. The Parties

The Complainant is Rolls-Royce Motor Cars Limited, United Kingdom, represented by Kelly IP, LLP, United States of America (“United States”).

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States / NameSilo, LLC, Domain Administrator, United States.

2. The Domain Names and Registrar

The disputed domain names <rollsroyceofficial.top> and <rollsroyceofficial.xyz> (the “Domain Names”) are registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 31, 2022. On April 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On April 1, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 7, 2022, 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 amended Complaint on April 11, 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 the Respondent of the Complaint, and the proceedings commenced on April 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 3, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 6, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on May 11, 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 Complainant is a United Kingdom corporation specializing in the manufacture and sale of luxury automobiles. The Complainant and its predecessors in title have produced luxury automobiles under the trade mark "Rolls-Royce" (the "ROLLS-ROYCE Mark") since 1904. The Complainant sells its luxury cars worldwide through a network of 140 dealers and has developed a considerable reputation in the ROLLS-ROYCE Mark, both through third party recognition and through marketing and promotion.

The Complainant has registered the ROLLS-ROYCE Mark, generally for goods in Class 12, in various jurisdictions including the United States where the Complainant is the owner of trade mark registration 325,195 for the ROLLS-ROYCE Mark, issued on June 11, 1935, with a date of first use of 1906.

The Domain Names were registered on March 9, 2022. The Domain Names are presently inactive but prior to the commencement of the proceeding redirected to a website ("Respondent's Website") that advertised the minting and sale of non-fungible tokens ("NFTs") under the ROLLS-ROYCE Mark. The Respondent's Website associated itself with the Complainant through the reproduction of the ROLLS-ROYCE Mark, use of the Complainant's copyrighted video, and reproduction of photos of the Complainant's automobile products.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) that the Domain Names are confusingly similar to the Complainant's ROLLS-ROYCE Mark;
- (ii) that the Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) that the Domain Names have been registered and are being used in bad faith.

The Complainant is the owner of the ROLLS-ROYCE Mark, being the owner of trade marks registered in various international jurisdictions for the ROLLS-ROYCE Mark. The Domain Names are confusingly similar to the ROLLS-ROYCE Mark as each of the Domain Names reproduces the word mark ROLLS-ROYCE in its entirety (other than the hyphen) and add the descriptive term "official" and a generic Top-Level Domain ("gTLD").

The Respondent is not commonly known by the Domain Names nor does it have any trade marks that correspond to the Domain Names. The Complainant has not authorized or licensed the Respondent to use the ROLLS-ROYCE Mark or any confusingly similar variations thereof. The Respondent has registered the Domain Names to pass itself off as connected with the Complainant which does not amount to *bona fide* use or a legitimate noncommercial fair use. The Respondent's use of the Domain Names does not grant the Respondent rights or legitimate interests in the Domain Names.

The Respondent has registered and uses the Domain Names in bad faith. The Respondent's Website operates to expressly create a false impression of an association with the Complainant in order for the Respondent to receive a financial benefit. This conduct amounts to registration and use of the Domain Names in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

To prove this element the Complainant must have trade or service mark rights and the Domain Names must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the ROLLS-ROYCE Mark, having registrations for the ROLLS-ROYCE Mark as trade marks in various countries around the world, including the United States.

Each of the Domain Names incorporates the ROLLS-ROYCE Mark in its entirety with the addition of the dictionary term "official". The addition of a term to a complainant's mark does not prevent a finding of confusing similarity, see *Wal-Mart Stores, Inc. v. Henry Chan*, WIPO Case No. [D2004-0056](#). The Panel finds that each of the Domain Names is confusingly similar to the Complainant's ROLLS-ROYCE Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant may make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. If such a *prima facie* case is made out, the respondent then has the burden of demonstrating rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(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 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 Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Names or to seek the registration of any domain name incorporating the ROLLS-ROYCE Mark or a mark similar to the ROLLS-ROYCE Mark. There is no evidence that the Respondent is commonly known by the Domain Names or any similar name.

There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Names in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial use. Rather the evidence before the Panel indicates that the Respondent has sought to use the Domain Names to expressly and misleadingly associate the Respondent with the Complainant for financial gain. The use of the Domain Names for the sole purpose of benefiting from the confusion between the Domain Names and the ROLLS-ROYCE Mark is not, on its face, a *bona fide* offering of goods or services or for a legitimate noncommercial use

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or interests in the Domain Names. The Respondent has chosen not to respond to the Complaint and thus has

failed to provide any evidence of rights and legitimate interests in the Domain Names. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Names under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the Domain Names in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registrations to the Complainant who is the owner of the trade mark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Names; or
- (ii) the Respondent has registered the Domain Names in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the Domain Names primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Domain Names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the Respondent's website or location or of a product or service on the Respondent's website or location.

The Panel finds that the Respondent must have been aware of the Complainant and its reputation in the ROLLS-ROYCE Mark at the time the Respondent registered the Domain Names. The Complainant has been offering luxury automobiles under the ROLLS-ROYCE Mark for over 100 years and the Respondent's Website makes express reference to the Complainant, including copying the Complainant's copyrighted materials and reproducing images of the Complainant's automobiles. The registration of the Domain Names in awareness of the ROLLS-ROYCE Mark and in the absence of rights or legitimate interests in this case amounts to registration in bad faith.

The Respondent has used the Domain Names to intentionally attempt to attract, for commercial gain, Internet users to a website, by creating a likelihood of confusion with the ROLLS-ROYCE Mark as to the source, sponsorship, affiliation or endorsement of its website. The Respondent's Website consisted of a website purporting to offer NFTs associated with the Complainant and its luxury brand of automobiles, notwithstanding that there is no connection or association between the Respondent and the Complainant. It is therefore highly likely that the Respondent received or intended to receive revenue from Internet users who happen to come across the Respondent's Website by means of confusion with the ROLLS-ROYCE Mark and/or purchased the NFTs advertised by the Respondent on the understanding that they were associated with the Complainant in some way. The Panel finds that such use amounts to use in bad faith pursuant to paragraph 4(b)(iv) of the Policy. The fact that the Domain Names are presently inactive does not prevent a finding of bad faith.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Names 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 Names, <rollsroyceofficial.top> and <rollsroyceofficial.xyz> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: May 17, 2022