

## **ADMINISTRATIVE PANEL DECISION**

William Grant & Sons Limited v. Kirsten Maley

Case No. D2022-3672

### **1. The Parties**

The Complainant is William Grant & Sons Limited, United Kingdom, represented by Demys Limited, United Kingdom.

The Respondent is Kirsten Maley, United Kingdom.

### **2. The Domain Names and Registrar**

The disputed domain names <monkeyshoulderwhiskey.com> and <monkeyshoulderwhisky.com> (the “Domain Names”), are registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 3, 2022. On October 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On the same date, 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 (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 8, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint.

On October 10, 2022, the Respondent sent an email communication to the Center confirming that she had liaised with the Complainant and confirmed her willingness to sell the Domain Names upon receipt of an acceptable offer and indicated that she was awaiting further communication in this regard.

The Complainant filed an amended Complaint on October 12, 2022. On the same date, the Respondent sent another email communication to the Center arguing that the ownership of the Domain Names had not been purchased or held in any bad faith, furthermore, the Domain Names had not been used in any way and therefore had not been misappropriated.

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 October 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 9, 2022. The Respondent did not submit any formal response. Accordingly, the Center informed the Parties that it would proceed to panel appointment on November 22, 2022.

The Center appointed Tony Willoughby as the sole panelist in this matter on November 29, 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.

As indicated above the Respondent registered the Domain Names in the name of a privacy service. In response to the Center's invitation to the Complainant to file an amended Complaint the Complainant filed the amended Complaint naming the underlying registrant as the Respondent.

#### **4. Factual Background**

The Complainant is a company incorporated under the laws of the United Kingdom and is engaged in the distillation and sale of *inter alia* Scotch Whisky. One of its Scotch Whisky brands is "Monkey Shoulder", a name in respect of which the Complainant has several trade mark registrations including United Kingdom Trade Mark Registration No. UK00002366898 MONKEY SHOULDER (words) registered on December 10, 2004 (application filed on June 28, 2004) in class 33 for alcoholic beverages.

The Domain Names were registered on December 12, 2021 and are connected to parking pages, which appear to be hosted by the Registrar. The parking pages feature advertising links all of which are labelled with words and names associated with alcoholic drinks (mainly whisky). None of the links leads to a website of or associated with the Complainant and several of them lead to websites having no association with alcoholic drinks. The parking pages include a disclaimer stating: "The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew nor the domain owner maintain any relationship with the advertisers."

On August 12, 2022 the Complainant's representative sent a warning letter by email to the Respondent (addressed to the privacy service being utilised by the Respondent) drawing the Respondent's attention to the Complainant's trade mark rights and seeking *inter alia* transfer of the Domain Names. The Respondent replied on August 15, 2022 as follows:

"Good Morning. Thank you for your email. As a whiskey enthusiast, I collect various whiskey-related items including the mentioned domains. There has been no action taken with the respect to the same nor will there be. Happy to discuss the purchase of the domains and welcome any offers in this respect."

In the ensuing correspondence the Complainant's representative's offer to reimburse the Respondent for the cost of registering the Domain Names was rejected by the Respondent. Her email timed at 11.50 on August 16, 2022 stated "Given the value of the domains in question to your client, their worth and representation of the company, I believe an offer in the six-figure range would be most appropriate for the transfer of the domains".

As indicated in section 3 above, the Respondent sent emails to the Center on October 10, 2022 and October 12, 2022. The first informed the Center that the parties had been in communication, that the Respondent had indicated her willingness to transfer the Domain Names on receipt of an acceptable offer and that the Respondent was awaiting that offer. The second argued that the Respondent had not registered the Domain Names in bad faith and that she had not made any use of them. She repeated her willingness to discuss transfer and would "welcome any offers from the Complainant to proceed".

## 5. Parties' Contentions

### A. Complainant

The Complainant contends that the Domain Names are both confusingly similar to the Complainant's MONKEY SHOULDER trade mark; that the Respondent has no rights or legitimate interests in respect of the Domain Names; and that the Domain Names have been registered and are being used in bad faith within the meaning of paragraphs 4(b)(i) and 4(b)(iv) of the Policy.

The essence of the Complainant's case is that the Respondent registered the Domain Names primarily with a view to selling them at a profit to the Complainant or a competitor of the Complainant. The Complainant also contends that the Respondent registered them with a view to deceiving Internet users into believing that the Domain Names and any use made of them is a use of or authorised by the Complainant. The Complainant produces evidence to support its contention that the Domain Names have been configured in a manner enabling them to be used for emails, but there being no evidence that the Domain Names have in fact been so used, the Panel has not felt the need to consider that allegation further.

### B. Respondent

The Respondent has not filed a formal Response, but the email correspondence briefly described in section 4 above makes clear that the Respondent registered the Domain Names not with any intention of making any active use of them, but, recognising their extreme value to the Complainant, expected to be able to sell them to the Complainant at a substantial profit.

## 6. Discussion and Findings

### A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Names, the Complainant must prove each of the following, namely that:

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

### B. Identical or Confusingly Similar

The Domain Names comprise the Complainant's registered trade mark MONKEY SHOULDER (absent the space), the descriptive word, "whisk(e)y", and the ".com" generic Top Level Domain identifier.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) explains the test for identity or confusing similarity under the first element of the Policy and includes the following passage:

"While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The Complainant's registered trade mark is readily recognizable in its entirety in each of the Domain Names. The Panel finds that the Domain Names are confusingly similar to a trade mark in which the Complainant has rights.

### C. Rights or Legitimate Interests

Section 2.0 of [WIPO Overview 3.0](#) addresses how panels approach this element of the Policy. Significant factors in the context of this case include the following:

- (i) While complainants are required to prove all three elements of paragraph 4(a) of the Policy, this element calls for the complainant to prove a negative in circumstances where it is often the case that all the relevant information is in the hands of the respondent, rendering the task impossible for the complainant. Thus, a protocol has been developed whereby the complainant is required to satisfy the panel that it has a *prima facie* case; it is then for the respondent to come forward with evidence demonstrating rights or legitimate interests;
- (ii) Paragraph 4(c) of the Policy sets out a non-exhaustive list of circumstances any of which if found by the Panel to be present shall demonstrate rights or legitimate interests for the purposes of this element of the Policy, namely (in brief) that the respondent has been using or making preparation to use the domain name in connection with a *bona fide* offering of goods or services; or has been commonly known by the domain name; or “[is] 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”;
- (iii) A respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trade mark owner (Section 2.5) and if it is identical to the complainant’s trade mark it carries a high risk of implied affiliation; (Section 2.5.1)
- (iv) Where the domain name consists of the complainant’s trade mark and an additional term it cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trade mark owner; (Section 2.5.1)
- (v) Where the domain name is used to host a parked page comprising pay-per-click links it does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users; (Section 2.9)
- (vi) However, respondent efforts to suppress pay-per-click advertising related to the complainant’s trade mark can mitigate against an inference of targeting the complainant; (Section 2.9)
- (vii) The fact that the pay-per-click links on the webpages to which the domain name connects may have been automatically generated by a third party is not necessarily an answer to a complaint and even if the respondent itself may not have directly profited would not by itself prevent a finding of bad faith. Generally, respondents cannot disclaim liability for third party material appearing on the website connected to the domain name (also in connection with the third element, Section 3.5).

The Complainant asserts that it has no association with the Respondent and specifically has granted the Respondent no permission to use its MONKEY SHOULDER trade mark.

The Complainant recites the circumstances set out in paragraph 4(c) of the Policy and contends that none of them is applicable. The Complainant contends that the Respondent’s use of the Domain Names constitutes impersonation of the Complainant and cannot constitute a *bona fide* offering of goods or services for the purposes of paragraph 4(c)(i) of the Policy; there is nothing to indicate that the Complainant is commonly known by the Domain Names (paragraph 4(c)(ii) of the Policy); and the use being made of the Domain Names is a commercial use, is not fair and is not covered by paragraph 4(c)(iii) of the Policy.

While the Domain Names are not identical to the Complainant’s trade mark, they feature an identical representation of that trade mark along with a word describing the Complainant’s product. As such, in the view of the Panel, they are likely to be regarded by Internet users as domain names affiliated with the Complainant. In the Panel’s view visitors to the websites are likely to be looking for the Complainant’s

MONKEY SHOULDER product or information in respect of it. They will not find what they are looking for. The Domain Names are connected to parking pages, which appear to be hosted by the Registrar. The parking pages feature advertising links all of which are labelled with words and names associated with alcoholic drinks (mainly whisky). None of the links leads to a website of or associated with the Complainant and several of them lead to websites having no association with alcoholic drinks. The parking pages include a disclaimer stating: "The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew nor the domain owner maintain any relationship with the advertisers."

There is nothing fair about the use being made of the Domain Names and as pointed out in section 3.5 of the [WIPO Overview 3.0](#), the Respondent cannot disclaim responsibility for this use of the Domain Names even if she did not provide the content of the websites and even if she has not profited from it.

The Panel accepts the Complainant's assertion that it has not authorized the Respondent's use of the MONKEY SHOULDER trade mark in this or any other way and finds that the Complainant has made out a *prima facie* case under this element of the Policy; in other words a case calling for an answer from the Respondent.

The only responses received from the Respondent have been those appearing in her emails to the Complainant and to the Center as set out in section 4 above. Far from answering the Complainant's contentions, they confirm the Panel in its view that the Respondent has no answer to the Complainant's contention that the Respondent set out to impersonate the Complainant with a view to extorting from the Complainant an inflated price for the Domain Names calculated by reference to the goodwill associated with the Complainant's product and the damage likely to be caused to the Complainant's business if the Domain Names were left in the hands of the Respondent.

If, as the Respondent asserts, she is merely a whisky enthusiast who collects whisky-related items and with no intention of making any use of the Domain Names, the Panel is left to wonder why she did not take immediate steps to bring to a close the use of the Domain Names for the pay-per-click parking pages described in section 4 above. Those links are calculated to deceive and to exploit the goodwill associated with the Complainant's brand. The damaging consequences for the owner of the brand would have been obvious to a whisky enthusiast and not consequences likely to commend themselves to a genuine whisky enthusiast.

On having the Complainant's trade mark rights drawn to her attention on August 12, 2022 one would have expected the Respondent to respond responsibly, recognising the merit of the Complainant's complaint. But no; the Respondent's immediate reaction was to demand from the Complainant a six-figure sum of money in exchange for transfer of the Domain Names. In the Panel's view this was not the reaction of an innocent whisky enthusiast.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Names.

#### **D. Registered and Used in Bad Faith**

As can be seen from section 4 above the Respondent has informed the Center that she is willing to sell the Domain Names to the Complainant upon receipt of an acceptable offer from the Complainant and in correspondence with the Complainant she has indicated that an acceptable offer would be in the region of six figures. She has asserted that she acquired the Domain Names as a whisky enthusiast, collecting whisky-related items. She further asserts that she did not register the Domain Names in bad faith and has made no use of them.

Manifestly, use has been made of the Domain Names and the Respondent cannot disclaim responsibility for that use. Section 3.5 of the [WIPO Overview 3.0](#) dealing with this topic is in the following terms:

"Particularly with respect to 'automatically' generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its

domain name (nor would such links *ipso facto* vest the respondent with rights or legitimate interests). Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith.

While a respondent cannot disclaim responsibility for links appearing on the website associated with its domain name, panels have found positive efforts by the respondent to avoid links which target the complainant's mark (e.g., through 'negative keywords') to be a mitigating factor in assessing bad faith."

It is to be noted that the Respondent has made no attempt to mitigate the damage to the Complainant by bringing the offending use to a close.

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances, any of which, if found by the Panel to be present, "shall be evidence of the registration and use of a domain name in bad faith". The Complainant contends that paragraphs 4(b)(i) and 4(b)(iv) are applicable. They provide as follows:

4(b)(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";

4(b)(iv) "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location".

While it is possible that the Respondent's demand for a six-figure sum was an immediate opportunistic reaction to the Complainant's representative's cease and desist letter, the Panel concludes on the balance of probabilities that it was not. The factors that the Panel has taken into account in coming to that conclusion are as follows:

- (a) A genuine whisky enthusiast collecting whisky-related items would not have registered the <monkeyshoulderwhiskey.com> Domain Name. Unlike the other Domain Name, it is a mis-spelling of the Complainant's description of its product.
- (b) As a genuine collector, she might have been expected to come forward with further details of her collection, if only to rebut the obvious inference that the explanation was a device to overcome the complaint. She came forward with nothing.
- (c) On having the Complainant's cause for complaint drawn to her attention, one might have expected an 'innocent' registrant to take immediate steps to bring the offending use to a close. She did not do so.
- (d) The terms of her email seeking a six-figure sum for the Domain Names ("Given the value of the domains in question to your client, their worth and representation of the company, I believe an offer in the six-figure range would be most appropriate for the transfer of the domains.") indicate to the Panel that she was well aware of the potential reputational damage to the Complainant if the Domain Names remained out of the Complainant's control and wanted to exploit the situation to her benefit.

As to paragraph 4(b)(iv) of the Policy, the Panel has assumed (perhaps erroneously) that the Respondent is not herself profiting from the commercial use being made of the Domain Names. However, the circumstances set out in paragraph 4(b) of the Policy are expressed to be non-exhaustive and the use being made of the Domain Names is plainly commercial and deceptive. Moreover, had she wished to do so, she could have given instructions for that use to stop. The continuing use is in bad faith and she cannot disclaim responsibility for it, even if the Respondent is not herself profiting from the commercial use being made of the Domain Names.

The Panel finds that the Respondent registered the Domain Names for the purposes for which they have been used and that they have been registered and are being used in bad faith within the meaning of

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, <monkeyshoulderwhiskey.com> and <monkeyshoulderwhisky.com>, be transferred to the Complainant.

*/Tony Willoughby/*

**Tony Willoughby**

Sole Panelist

Date: December 13, 2022