

## **ADMINISTRATIVE PANEL DECISION**

Harry Winston SA, Harry Winston Inc. v. holy genius  
Case No. D2022-4842

### **1. The Parties**

The Complainants are Harry Winston SA, Switzerland, and Harry Winston Inc., United States of America (“United States”), represented internally.

The Respondent is holy genius, United States.

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

The disputed domain name <harryvinston.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 16, 2022. On December 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 19, 2022, 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 (Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainants on December 22, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on December 23, 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 January 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 24, 2023.

The Center appointed Evan D. Brown as the sole panelist in this matter on February 7, 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**

The Complainants are affiliated companies both wholly-owned by the Swatch Group AG. Both of the Complainants own the trademark HARRY WINSTON, which is registered in various jurisdictions around the world. For example, the Complainant Harry Winston SA owns International Registration No. 1178434 for the mark (registered on August 7, 2013), and the Complainant Harry Winston Inc. owns United States registration No. 3355622 for the mark (registered on December 18, 2007).

According to the Whois records, the disputed domain name was registered on December 7, 2022. The disputed domain name has been used to display sponsored advertisements.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainants contend that the disputed domain name is identical or confusingly similar to the Complainants trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

To succeed, the Complainants must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights, (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (iii) the disputed domain name has been registered and is being used in bad faith. The Panel finds that all three of these elements have been met in this case.

##### **A. Consolidation of Multiple Complainants**

UDRP panels have articulated principles in accordance with Paragraph 10 of the Rules governing the question of whether a complaint filed by multiple complainants may be brought against one or more respondents. These criteria encompass situations in which: (i) the complainants either have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants' individual rights in a similar fashion; and (ii) it would be equitable and procedurally efficient to permit the consolidation. The burden of showing that consolidation is proper falls on the Complainants.

The Complainants have provided sufficient evidence to support consolidating them. They share a legal interest and grievance. Specifically, they each own the mark HARRY WINSTON, and have the capacity to suffer harm in the same way from the Respondent's cybersquatting. As such, both of the Complainants have a common legal interest in a relevant right or rights that are affected by the Respondent's conduct regarding registration and use of the disputed domain name, and both of the Complainants are the target of common conduct by the Respondent that has affected their individual legal interests. Further, it is procedurally efficient to consolidate them.

Accordingly, the Panel will consolidate the Complainants.

## **B. Identical or Confusingly Similar**

This element requires the Panel to consider two issues: first, whether the Complainants have rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark. This element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainants have demonstrated their rights in the HARRY WINSTON mark by providing evidence of their trademark registrations.

A domain name is "identical or confusingly to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation, regardless of other terms in the domain name *Asurion, LLC v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1650](#); *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#).

In this case, the disputed domain name looks like the HARRY WINSTON mark. See *VMWARE, Inc. v. Whois Agent, Whois Privacy Protection Service, Inc. / Raymond Morgan*, WIPO Case No. [D2016-1629](#) (disputed domain name <vrnvare.com> found to be confusingly similar to the mark VMWARE). This similarity in appearance is sufficient to convince the Panel that the Complainants have satisfied the first element of the UDRP.

## **C. Rights or Legitimate Interests**

The Panel evaluates this element of the Policy by first looking to see whether the Complainants have made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainants make that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainants). See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

On this point, the Complainant asserts, among other things, that: (1) there are no signs that the Respondent has been commonly known by the disputed domain name, (2) the Respondent is not in any way related to the Complainants or their business activities nor have the Complainants granted a license or authorized the Respondent to use its trademarks or apply for registration of the disputed domain name, and (3) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain. Instead, the Complainants assert, the Respondent has sought to generate revenue from the page published at the disputed domain name showing sponsored advertisements.

The Panel finds that the Complainants have made the required *prima facie* showing. The Respondent has not presented evidence to overcome this *prima facie* showing. And nothing in the record otherwise tilts the balance in the Respondent's favor. Accordingly, the Panel finds that the Complainants have established this second element under the Policy.

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

The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith use and registration. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark

as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or a product or service on [the respondent's] website or location".

As noted in the discussion about the first element of the UDRP, above, the Panel finds that the Respondent registered the disputed domain name because it looks like the HARRY WINSTON mark, in a web browser address bar or in the "From:" line of an email message it would be frequently perceived as the HARRY WINSTON mark. The Panel finds no easily conceivable reason for registering and using the disputed domain name that the Respondent could make that would not be characterized as bad faith under the UDRP factors. The use of a privacy service to register the disputed domain name is an indication of the Respondent's bad faith in the circumstances of this case (particularly noting the nature of the disputed domain name). *TPS Parking Management, LLC v. Paul Shirley*, WIPO Case No. [D2022-4988](#). The use of the disputed domain name to display sponsored advertisements for commercial purposes likewise shows bad faith. *Sandals Resorts International 2000 Inc. v. Privacy service provided by Withheld for Privacy ehf / Kameila Ricketts*, WIPO Case No. [D2022-2639](#).

Absent any explanation from the Respondent as to its motives, noting the circumstances discussed above, the Panel finds that the Complainants have satisfied this third element under the UDRP.

## 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 <harryvinston.com> be transferred to the Complainant.

*/Evan D. Brown/*

**Evan D. Brown**

Sole Panelist

Date: February 21, 2023