

ADMINISTRATIVE PANEL DECISION

The White Company (U.K.) Limited v. Tung Pham
Case No. D2023-1002

1. The Parties

1.1. The Complainant is The White Company (U.K.) Limited, United Kingdom, represented by Dechert, United Kingdom.

1.2. The Respondent is Tung Pham, Nigeria.

2. The Domain Name and Registrar

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

3. Procedural History

3.1. The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 7, 2023. On March 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 7, 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 the Complainant on March 7, 2023, 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 March 10, 2023.

3.2. 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”).

3.3. In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 17, 2023.

3.4. The Center appointed José Pio Tamassia Santos as the sole panelist in this matter on April 25, 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

4.1. The Complainant in this administrative proceeding is The White Company (U.K.) Limited, an independent legal entity existing under the laws of England with company registration number 02998082. Its registered office is in London, United Kingdom.

4.2. The Complainant has traded under the Trade Mark since it was established in the UK in 1994. Since its foundation, the Complainant has been extremely successful and now operates an international, multi-channel business selling a variety of products under the Trade Mark, including luxury clothing, footwear, homeware, home accessories, jewelry and cosmetics.

4.3. In this scenario the Complainant has over 50 stores throughout the UK and ships across the world, including throughout the USA and UK. Through its longstanding success operating under the Trade Mark, the Complainant has developed a substantial international reputation and goodwill in the Trade Mark and for example is the owner of trade mark registrations for THE WHITE COMPANY and THE LITTLE WHITE COMPANY trade marks in various jurisdictions, including, *inter alia*, THE WHITE COMPANY Trade Mark (Registration No. 2450213) registered in the UK on March 21, 2007 and United States trademark registration for THE WHITE COMPANY (Registration No. 3029459) registered June 14, 2004.

4.4. The Complainant operates a website at "www.thewhitecompany.com" through which the Complainant offers its online retail services and markets its in-store and mail order offering. The Complainant's domain name was registered on September 17, 2001.

4.5. The Domain Name <thewhitecompanyuk.com>, was registered by the Respondent on February 1, 2023. Previously, the Domain Name appeared to redirect to the Complainant's UK Sub-Page. However, at the Notification of Complaint it resolved to a page stating that the account had been suspended.

5. Parties' Contentions

A. Complainant

5.1. The Complainant submits it has built up a substantial reputation and goodwill in the Trade Mark, and that the Domain Name is identical or confusingly similar to the Complainant's Trade Mark.

5.2. The Complainant further states that the Respondent registered without authorization the Domain Name <thewhitecompanyuk.com> on February 1, 2023. Moreover, the Complainant has not licensed or otherwise permitted or authorized the Respondent to use its Trade Mark or to apply for a domain name incorporating the Trade Mark. Therefore, the Respondent in the present case has no rights or legitimate interests in respect of the Domain Name.

5.3. Finally, the Complainant argues that the Domain Name has been registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1. Paragraph 4(a) of the Policy provides specific remedies to trade mark owners against registrants of domain names where the owner of the mark (*i.e.*, the complainant) proves each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

6.2. The Complainant has the burden of proof, by a preponderance of the evidence, in respect to each element in paragraph 4(a) of the Policy.

6.3. The Respondent, having failed to respond in the present proceeding, is in default, and in accordance with paragraph 14(b) of the Rules, “the panel shall draw such inferences [...] as it considers appropriate”.

A. Identical or Confusingly Similar

6.4. The Complainant has successfully proven its rights and reputation in the THE WHITE COMPANY Trade Mark in numerous UDRP WIPO domain name disputes, which have resulted in the transfer of the disputed domain name to the Complainant (see *The White Company (U.K.) Limited v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2021-1963](#); *The White Company (U.K.) Limited v. Carolina Rodrigues, Fundación Comercio Electrónico*, WIPO Case No. [D2020-1876](#); *The White Company (UK) Limited v. House of Logic*, WIPO Case No. [D2008-1914](#); and *The White Company (UK) Limited v. Webideas Limited*, WIPO Case No. [DCO2010-0043](#)).

6.5. The Trade Mark is replicated in its entirety in the Domain Name. The geographical term, “UK” would not prevent a finding of confusing similarity under the first element See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8. The Trade Mark is recognizable within the Domain Name,

6.6. In any event, it is well-established by previous UDRP panel decisions that a domain name incorporating a distinctive trade mark (such as the Trade Mark in this case) in its entirety creates similarity between the mark and the domain name as to render it confusingly similar see *Minnesota Mining & Manufacturing v JonLR*, WIPO Case No. [D2001-0428](#) and *LLC v Triple S Auto Parts d/b/a Kung Fu Tea Enterprise Inc.*, WIPO Case No. [D2000-0047](#).

6.7. As a matter of a fact the addition of the suffix “.com” in the Domain Name is irrelevant for the purpose of distinguishing the Domain Name from the Complainant’s Trade Marks. In this regard the Complainant relies on the *Laerdal Medical Corporation v. Lock’s Computer Supply*, WIPO Case No. [D2002-0063](#). See also [WIPO Overview 3.0](#), section 1.11.

6.8. The first element of the Policy, therefore, has been met.

B. Rights or Legitimate Interests

6.9. The Domain Name was registered in February 2023, nearly 30 years after the Complainant’s company was incorporated in the UK and 20 years after the Trade Marks were first filed. Due to the reputation and international presence of the Complainant, it is reasonable to assume that the Respondent was aware of the Complainant and its rights and reputation in the Trade Mark at the time the Domain Name was registered.

6.10. All circumstances and the evidence presented lead to believe that the Respondent chose the Domain Name specifically because it is confusingly similar to the Trade Mark associated with the Complainant and the Complainant’s Domain Name. Alternatively, the Respondent had constructive knowledge or should have

known of the Complainant's rights in the Trade Mark, which would have been revealed by a basic search of the words "THE WHITE COMPANY", or "THE WHITE COMPANY UK", using an Internet search engine.

6.11. The Respondent cannot argue, under paragraph 4(c)(iii) of the Policy, that it is making legitimate noncommercial or fair use of the Domain Name without the intent for commercial gain to misleadingly divert consumers or to tarnish the Trade Mark at issue. As at February 23, 2023, the Domain Name appeared to redirect to the Complainant's UK Sub-Page.

6.12. In any event, given that the Respondent has registered a Domain Name including the distinctive element of the Complainant's Trade Mark, in no circumstances would any use of the Domain Name by the Respondent constitute legitimate or fair use of the Domain Name unless it was authorized by the Complainant. Any use of the Domain Name would take unfair advantage of the Complainant's rights in the Trade Mark and misleadingly divert users to the Respondent's website instead of the Complainant's website by use of the Complainant's Trade Mark. Such use is neither a legitimate nor a fair use of the Domain Name and in this regard the Complainant relies on the *Microsoft Corporation v. Superkay Worldwide, Inc.*, WIPO Case No. [D2004-0071](#).

6.13. The Complainant states that it has not licensed or otherwise permitted or authorized the Respondent to use its Trade Mark or to apply for a domain name incorporating the Trade Mark.

6.14. Therefore, the Respondent in the present case has no rights or legitimate interest in respect of the Domain Name.

C. Registered and Used in Bad Faith

6.15. Paragraph 4(b) of the Policy provides that "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 a domain name in bad faith":

- (i) circumstances indicating that the respondent has registered or has 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 the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) that the respondent has registered the domain name 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) that the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's 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.

6.16. The Complainant contends that the Domain Name was registered and is being used in bad faith because the Respondent registered the Domain Name primarily for the purpose of disrupting the Complainant's business. Thus, the Respondent must have been aware of the Trade Mark and the Complainant's rights in the Trade Mark when it registered the Domain Name.

6.17. The Respondent's use of the Trade Mark in the Domain Name is intended to lead consumers to believe that they have reached the Complainant's website and so divert Internet traffic from the Complainant thereby interfering with the Complainant's business. Moreover, the Respondent could not have chosen or

subsequently used the Trade Mark in its Domain Name for any reason other than to trade on the Complainant's rights in that name and to confuse Internet users and by that means to attract them to a website with a name including the Trade Mark with the intention to profit from the reputation and goodwill of the Trade Mark. That is, in itself, evidence of bad faith, both generally and specifically, within the meaning of paragraph 4(b)(iii) of the Policy.

6.18. The Complainant states that the Respondent operates, or intends to operate, the Domain Name intentionally to detract from the Complainant's legitimate website and to have a vehicle through which, in future, they would attract Internet users to its website or other on-line locations for commercial gain by creating a likelihood of confusion with the Trade Mark as to the source, sponsorship, affiliation or endorsement of its websites or a product or service on its websites. Given that the Complainant, the Complainant's business and the use of the Trade Marks in respect of the Complainant's business are internationally renowned and that the Complainant has significant goodwill, reputation and registered trade mark protection in the Trade Mark, it is inevitable that internet users will be confused into believing that any website at the Domain Name is registered to, operated by or authorized by the Complainant.

6.19. The Respondent is currently holding the Domain Name passively. UDRP panels have consistently held that passive holding of domain names can be considered bad faith registration and use of the domain name see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Polaroid Corporation v. Jay Strommen.*, WIPO Case No. [D2005-1005](#). Such factors led to a finding of bad faith through passive holding in *Advance Magazine Publishers Inc. and Lest Publications Conde Nast S.A. v. ChinaVogue.com*, WIPO Case No. [D2005-0615](#) and *Polaroid Corporation v Jay Strommen*, WIPO Case No. [D2005-1005](#).

6.20. As a result, it is not possible to conceive of any plausible use of the Domain Name by the Respondent that would not be illegitimate, such as passing off or an infringement of the Complainant's rights under trade mark law. Finally, the composition of the Domain Name would likely mislead Internet users into believing the Domain Name is associated with the Complainant, thereby causing damage to the Complainant's legitimate rights.

In the circumstances, the Panel finds that the Respondent registered and has been using the Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

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, <thewhitecompanyuk.com> be transferred to the Complainant.

/José Pio Tamassia Santos/

José Pio Tamassia Santos

Sole Panelist

Date: May 9, 2023