

ADMINISTRATIVE PANEL DECISION

Speciality Drinks Limited v. Kem Ben
Case No. D2023-1711

1. The Parties

The Complainant is Speciality Drinks Limited, United Kingdom, represented by Pernod Ricard, Canada.

The Respondent is Kem Ben, United States of America.

2. The Domain Name and Registrar

The disputed domain name <thewhiskeyexchangeclub.com> is registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 18, 2023. On April 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 19, 2023, 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 (PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 20, 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 amendment to the Complaint on April 20, 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 the Respondent of the Complaint, and the proceedings commenced on April 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 22, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on May 30, 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 Complainant defines itself as the world's leading specialist online retailer for fine whiskies and spirits. The Complainant undisputedly contends that it had been trading under the name THE WHISKY EXCHANGE since 1999.

It further results from the Complainant's documented allegations, which remained undisputed, that it holds trademark registrations consisting of the word elements THE WHISKY EXCHANGE, in particular European Union trademark (verbal), registered on May 2, 2011 with no. 009585605 for goods and services in classes 33 and 35. This mark has duly been renewed and is in force.

The disputed domain name was registered on March 4, 2023. The language of the Registration agreement is English.

The Complainant has provided – undisputed – evidence demonstrating that the disputed domain name resolves to a website that is an exact duplicate of the Complainant's official website, *i.e.* reproducing the THE WHISKY EXCHANGE trademark in the header, the product photos and descriptions and therefore giving the false appearance of being a legitimate website, which is, however, not the case.

Finally, the Complainant sent two emails, respectively on March 29, 2023 and on April 3, 2023, to the Registrant via the Registrar, asking to contact the Respondent regarding the disputed domain name. No response has been received.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the disputed domain name is confusingly similar to its trademarks THE WHISKY EXCHANGE, since it incorporates them almost entirely. The addition of the common English word "Club" to the Complainant's mark does not serve to defeat confusing similarity. Regarding the use of the alternate spelling of WHISKY, except for a difference of one letter in the word WHISKY of the Respondent's disputed domain name, the Complainant's registered trademark and those of the Respondent are identical.

Secondly, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant declares that the Respondent has never been given any authorization whatsoever to use WHISKY EXCHANGE register any corresponding name. In particular, the Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. Furthermore, use and adoption of a domain name including both WHISKEY and EXCHANGE could accordingly not be fair if not authorized by the Complainant. Finally, the disputed domain name is currently directed to a template website, identical to the Complainant's official website, giving it the superficial appearance of a legitimate website but does not function as one.

Thirdly, the Complainant finds that the Respondent's registration and use of the disputed domain name constitutes bad faith. The website is an exact duplicate of the Complainant's official website. Therefore, the Respondent uses the disputed domain name to intentionally attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website. This conduct confirms that the Respondent has used the disputed domain name in bad faith. In addition, by hiding behind a privacy service, the Respondent took active steps to conceal its identity which further evidences the Respondent's bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (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 is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first of all establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The Complainant is the owner of trademark registrations consisting of the word elements THE WHISKY EXCHANGE, in particular European Union trademark (verbal) No. 009585605 which has duly been renewed and is in force.

The Panel notes that the Complainant’s registered trademark THE WHISKY EXCHANGE is fully included in the disputed domain name and merely followed by the term “club”. Furthermore, the term “WHISKY” is spelled “WHISKEY”, with an additional “e”.

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 (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7). The Panel shares this view and holds that the trademark THE WHISKY EXCHANGE remains clearly recognizable within the disputed domain name, despite the above divergencies.

The Top-Level Domain “.com”, which is a technical requirement, is generally disregarded for the purpose of the analysis of confusing similarity ([WIPO Overview 3.0](#), section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests in a disputed domain name. In the Panel’s view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

First, it results from the Complainant's uncontested evidence that the disputed domain name resolves to a website that is an exact duplicate of the Complainant's official website, *i.e.* reproducing the THE WHISKY EXCHANGE trademark in the header, the product photos and descriptions and therefore giving the false appearance of being a legitimate website, which is, however, not the case. In this Panel's view, such use cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since such use is likely to mislead Internet users. In addition, the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use the disputed domain name. In particular, the Complainant's uncontested allegations demonstrate that it has not authorized or licensed the Respondent's use of the THE WHISKY EXCHANGE trademark for registering the disputed domain name which is confusingly similar to the Complainant's trademark.

Furthermore, the Panel notes that there is no evidence in the record or Whois information showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, the Panel notes that there is no evidence in the record either showing that the Respondent might be making a noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue pursuant to paragraph 4(c)(iii) of the Policy. In particular, the Panel considers it obvious that the Respondent wanted to mimic the Complainant's original website under the disputed domain name which entirely incorporates the trademark THE WHISKY EXCHANGE. Noting the absence of any disclaimer, the disputed domain name's content exacerbates the confusion caused by the incorporation of the Complainant's trademark in the construction of the disputed domain name by further impersonating the Complainant. Accordingly, further to section 2.8 of the [WIPO Overview 3.0](#), the Respondent's use of the disputed domain name to host an impersonating webstore excludes any *bona fide* offering, noncommercial, or fair use of the disputed domain name from the outset.

It is acknowledged that once the Panel finds a *prima facie* case has been established, the burden of production shifts to the Respondent to come forward with relevant and concrete evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances that the Panel finds applicable to the present dispute is that the Respondent by using the disputed domain name, 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand:

It results from the documented and undisputed evidence provided by the Complainant that the disputed domain name resolves to a website that is an exact duplicate of the Complainant's official website, *i.e.* reproducing the THE WHISKY EXCHANGE trademark in the header, the product photos and descriptions and therefore giving the false appearance of being a legitimate website, which is, however, not the case. However, the Complainant has not given any authorization for such use and is not linked to the Respondent or its website. For the Panel, it is therefore evident that the Respondent positively knew the Complainant's trademarks and webshop. Consequently, and in the absence of any evidence to the contrary, the Panel is

convinced that the Respondent also knew that the disputed domain name included the Complainant's trademark THE WHISKY EXCHANGE entirely when it registered the disputed domain name. Registration of a domain name which contains a third party's trademark, in awareness of said trademark and in the absence of rights or legitimate interests is suggestive of registration in bad faith (see *e.g. Vorwerk International AG v. ayoub Iagnadi, Lagnadi LTD*, WIPO Case No. [D2022-1592](#) with further references). While the ability to purchase the goods is not known to the Panel, the alleged commercial offering and impersonation of the Complainant is sufficient to establish the Respondent's bad faith intent to mislead Internet users.

In addition, the finding of bad faith registration and use is supported by the following further circumstances resulting from the case at hand:

- (i) the trademark THE WHISKY EXCHANGE is fully and almost identically incorporated in the disputed domain name. At the date the Respondent registered the disputed domain name, the Complainant had been using that designation in commerce for more than 20 years;
- (ii) the Respondent's failure to submit a formal response and to reply to the communications sent to before starting the present UDRP proceedings;
- (iii) the Respondent's failure to provide any evidence of actual or contemplated good-faith use;
- (iv) the implausibility of any good faith use to which the disputed domain name may be put; and
- (v) the Respondent hiding his identity behind a privacy shield.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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 disputed domain name, <thewhiskeyexchangeclub.com> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: June 12, 2023