

ADMINISTRATIVE PANEL DECISION

The White Company (U.K.) Limited v. Dav labs
Case No. D2023-1803

1. The Parties

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

The Respondent is Dav labs, UK.

2. The Domain Name and Registrar

The disputed domain name <thewhitecompanygroup.com> (the “Domain Name”) 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 21, 2023. On April 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 24, 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 (Unknown / REDACTED FOR PRIVACY, PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 26, 2023 providing the registrant and contact information disclosed by the Registrar, and invited the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 28, 2023.

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 May 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 24, 2023.

The Center appointed Jon Lang as the sole panelist in this matter on June 14, 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 has registered a portfolio of trademarks for and including the THE WHITE COMPANY (the "Complainant's mark" or "Trademark") including European Union Trade Mark No: 002788578 filed on July 25, 2002 and registered on June 30, 2004, and UK trademark No: UK00002349982 filed on November 28, 2003 and registered on January 21, 2005.

The Complainant has traded under the Trademark since it was established in the UK in 1994. It now operates an international business selling a variety of products under the Trademark, including luxury clothing, footwear, homeware, home accessories, jewellery and cosmetics. The Complainant's turnover for year ending July 31, 2021 was over GBP 271 million. It has over 50 stores throughout the UK and ships across the world. Through its longstanding use, the Complainant has developed a substantial international reputation and goodwill in the Trademark.

The Complainant operates a website at "www.thewhitecompany.com" through which it 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.

The Domain Name was registered on March 2, 2023. The Respondent used the Complainant's registered business address for the purposes of the registration of the Domain Name.

At the time the Complainant became aware of the Domain Name it appeared to point to the Complainant's own website. However, at present, there is no website associated with the Domain Name, the hosting account associated with the Domain Name having been suspended.

As described further below, the Respondent has used the Domain Name to create an email address incorporating the Trademark.

5. Parties' Contentions

A. Complainant

The following is a summary of the key contentions of the Complainant.

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Domain Name is confusingly similar to the Complainant's mark in which it has extensive rights. Internet users will break down the Domain Name into four identifiable words "THE", "WHITE", "COMPANY", and "GROUP". The Trademark is replicated in the Domain Name. The Complainant forms part of an overall group of companies using the name "THE WHITE COMPANY", and the word "GROUP" would be seen as perfectly applicable to the Complainant, thus only serving to increase association and confusion with the Complainant.

A domain name incorporating a distinctive trade mark in its entirety (as is the case here) creates sufficient similarity between the mark and domain name so as to render it confusingly similar.

The Respondent has sought to take advantage of such confusion by using two different email addresses which incorporate the Trademark. One of the Complainant's clients forwarded an email to the Complainant which they had received from "[...@thewhitecompany.com]" on March 10, 2023. The email, supposedly sent by the Complainant's employee (its head of buying) and which contained the Complainant's name and postal address, provided some background to the Complainant's business, said that it was sourcing new products, suggested a potential collaboration and stated at the end, "For immediate response Send your reply to "[...@thewhitecompanygroup.com]" for our attention only" *i.e.* a different email address and one connected to the Domain Name. The address from which the email was sent was used by the Respondent to fraudulently misrepresent and falsify a connection with the Complainant.

The addition of the suffix ".com" in the Domain Name is irrelevant for the purposes of distinguishing the Domain Name from the Complainant's mark, but in any event, as ".com" features in the address of the Complainant's primary website at <thewhitecompany.com>, Internet users would perceive the inclusion of ".com" in the Domain Name as being consistent with the Complainant's use of the Trademark.

The Domain Name is highly similar to the Trademark.

The Respondent has no rights or legitimate interests in respect of the Domain Name

The Domain Name and email addresses are being used by the Respondent to misleadingly deceive the Complainant's suppliers and/or consumers by indicating that the Complainant is seeking a collaboration and to source "new products to attract new customers and retain...existing ones, creating new partnerships with companies", presumably with a view of obtaining money or free products from such consumers or suppliers.

The Domain Name was registered in March 2023, nearly 30 years after the Complainant was incorporated in the UK and 20 years after the first filing of the Trademark. Given 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 Trademark when the Domain Name was registered.

The Respondent chose the Domain Name specifically because it is confusingly similar to the Trademark.

The Respondent chose the Domain Name because it knew: (i) that the Trademark was well-known and associated with the Complainant; (ii) that use of the Domain Name (and associated emails) would create an association with the Complainant's business as a result of similarity to the Trade mark and the Complainant's domain name; and (iii), that the Domain Name and associated email addresses would draw traffic to the Respondent's website. Alternatively, the Respondent had constructive knowledge of the Complainant's rights in the Trademark, or should have known of such rights which would have been revealed by a basic search inputting the words "THE WHITE COMPANY", or "THE WHITE COMPANY GROUP" into an internet search engine.

A previous UDRP Decision has held that where a disputed domain had been used in connection with an email address from which an email was sent impersonating a complainant's managing director in an attempt to obtain goods on credit, there could be no *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy, or a legitimate non-commercial or fair use of the disputed domain name within the meaning of paragraph 4(c)(iii) of the Policy. Similarly, prior UDRP Panels have held that illegal activity *e.g.* where a disputed domain name is used to send "spoofing" emails to a complainant's customers in return for commercial gain, or phishing emails in order to deceive consumers into revealing personal and financial information in the belief that the respondent was associated with the Complainant's *bona fide* services, can never confer rights or legitimate interests on a respondent.

Use of the Domain Name in the manner described takes unfair advantage of the Complainant's rights in the

Trademark and misleadingly deceives members of the public into believing that they have been contacted by the Complainant. Alternatively, Internet users would be misleadingly diverted away from the Complainant's website to the Respondent's website. In either case, such use is neither a legitimate nor a fair use of the Domain Name. The Respondent cannot argue that it is making legitimate non-commercial or fair use of the Domain Name without the intent for commercial gain to misleadingly divert consumers or to tarnish the Trademark at issue.

There is no obvious reason why the Domain Name has been selected by the Respondent other than to trade off the reputation of the Trademark.

Prior UDRP Panels have found that a respondent redirecting a domain name to a complainant's website can establish bad faith because the respondent retains control over the redirection, thus creating a real or implied ongoing threat to the complainant.

Whilst at present, there is no website to which the Domain Name points, the Complainant is concerned that the Domain Name may in the future be used to promote goods and services that are identical or confusingly similar to those covered by the Complainant's Trademark registrations and thus would compete directly with the Complainant's business. The Complainant is also concerned about other improper activities. Any such use would not be in good faith.

The Respondent's actions could never constitute legitimate or fair use of the Domain Name unless it was authorised by the Complainant, which is not the case. The Complainant has not licensed or otherwise permitted or authorised the Respondent to use its Trademark or to apply for a domain name incorporating the Trademark. Any use of the Domain Name would take unfair advantage of the Complainant's rights in the Trademark and such use is neither a legitimate nor a fair use of the Domain Name.

The Respondent has no rights or legitimate interest in respect of the Domain Name.

The Domain Name was registered and is being used in bad faith

Given the circumstances described earlier, the Respondent has registered the Domain Name primarily for the purpose of disrupting the Complainant's business, and has used it in bad faith. The Respondent must have had actual knowledge of the Trademark and the Complainant's rights when it registered the Domain Name given that the Respondent contacted the Complainant's customer and posed as being connected with the Complainant when suggesting potential collaboration opportunities. Moreover, the Respondent fraudulently used the Complainant's registered business address as its registration contact information when registering the Domain Name.

The Respondent primarily registered the Domain Name for the purpose of diverting and misleading the Complainant's customers for its own commercial gain, suggesting that the Respondent is somehow associated with the Complainant despite the absence of any type of commercial relationship between the parties. The Respondent could not have chosen or subsequently used the Domain Name (or email addresses associated with it) for any reason other than to benefit from the Complainant's rights and to confuse and/or defraud consumers.

The Respondent operates, or intends to operate the Domain Name intentionally to detract from the Complainant's legitimate website. It has a vehicle through which, in future, it could attract Internet users to its website or other on-line locations for commercial gain by creating a likelihood of confusion with the Trademark as to the source, sponsorship, affiliation or endorsement of its websites or a product or service on its website. Given that the Complainant, the Complainant's business and Trademark are internationally renowned and that the Complainant has significant goodwill, reputation and registered trademark protection, it is inevitable that Internet users will be confused into believing that any website at the Domain Name (which is similar to the

Complainant's domain name), is registered to, operated by or authorised by the Complainant. Attracting Internet traffic by using a domain name that is identical or confusingly similar to a trademark with the intention of profiting from the reputation and goodwill of the trademark, is evidence of bad faith.

The Domain Name has also been used in a way that is likely to dilute the reputation of the Trademark, which is evidence of bad faith. The mere registration of the Domain Name has meant that the Trademark is not as unique as it was prior to registration, meaning that the Trademark is not acting as a guarantee of origin *i.e.* that goods and services provided in association with the Trademark are provided uniquely by or with the endorsement of the Complainant.

Registering the Domain Name with false information, fraudulently impersonating one of the Complainant's employees and using the Complainant's business name and business address, is evidence of bad faith registration and use of the Domain Name, as is using an email address affiliated with a confusingly similar domain name in connection with a fraudulent or phishing scheme.

It is not possible to conceive of any plausible use of the Domain Name by the Respondent that would not be illegitimate.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires a complainant to prove that a respondent has registered a domain name which is (i) identical or confusingly similar to a trademark or service mark in which a complainant has rights; and (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and (iii) that the domain name has been registered and is being used in bad faith. A complainant must prove each of these three elements to succeed.

A. Identical or Confusingly Similar

The Complainant clearly has rights in the Trademark (THE WHITE COMPANY). Ignoring the generic Top-Level Domain ("gTLD") ".com" (as the Panel may do for comparison purposes), the Domain Name comprises the Trademark followed by the word "group". As the Trademark and Domain Name are not identical, the issue of confusing similarity must be considered. Application of the confusing similarity test under the UDRP typically involves "a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name" (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("the [WIPO Overview 3.0](#)")). Section 1.7 of the [WIPO Overview 3.0](#) goes on to provide "[...] in cases where a domain name incorporates the entirety of a trademark, [...] the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

The Trademark is incorporated in its entirety and clearly recognizable within the Domain Name. The addition of the word "group" does little to diminish the visual impression created by the dominant element of the Domain Name, namely the Trademark. The addition of common, dictionary, descriptive or negative terms does not usually prevent a finding of confusing similarity and here the addition of the word "group" certainly does not do so.

The Panel finds that the Domain Name is confusingly similar to the Complainant's mark for the purposes of the Policy and thus paragraph 4(a)(i) of the Policy has been established.

B. Rights or Legitimate Interests

By its allegations, the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name.

Accordingly, the burden of production shifts to the Respondent to come forward with arguments or evidence demonstrating that it does in fact have such rights or legitimate interests. The Respondent has not done so and accordingly, the Panel is entitled to find, given the *prima facie* case made out by the Complainant, that the Respondent indeed lacks rights or legitimate interests in the Domain Name. Despite the lack of any answer to the Complaint however, the Panel is entitled to consider whether there would be anything inappropriate in such a finding.

A respondent can show it has rights to or legitimate interests in a domain name in various ways even where, as is the case here, it is not licensed by or affiliated with a complainant. For instance, it can show that it has been commonly known by the domain name or that it is making a legitimate non-commercial 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. Here, however, the Respondent is not known by the Domain Name. More significantly, there can be nothing legitimate, non-commercial or fair about the use to which the Domain Name has been put, namely to use an associated email address to impersonate a senior member of the Complainant's staff so as to deceive a third party into believing the email came from the Complainant, presumably as part of some form of scam. Clearly such use is misleading, likely done with some form of commercial gain in mind, and may well harm the Complainant and lead to tarnishment of its Trademark.

A respondent can also show that it is using a domain name in connection with a *bona fide* offering of goods or services. There can be nothing *bona fide* about the use to which the Domain Name has been put.

The Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a number of non-exclusive scenarios which may evidence a respondent's bad faith. They include, for instance, a respondent registering a domain name in order to prevent an owner of the trademark or service mark to which it is said to be confusingly similar or identical, from reflecting the mark in question in a corresponding domain name (provided that the respondent has engaged in a pattern of such conduct). A respondent registering a domain name primarily for the purposes of disrupting the business of a competitor is another scenario, as is a respondent intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or of products or services on it.

A complainant however does not have to demonstrate a precise literal application of one of the paragraph 4(b) scenarios. They are non-exclusive and illustrative only, and as long as there is evidence demonstrating that a respondent is seeking to take unfair advantage of, or to abuse a complainant's trademark, such behaviour would satisfy the general principle underlying the bad faith requirement of the Policy.

The "[...]@thewhitecompanygroup.com" email account has been used in an attempt to mislead a third party into believing they were receiving an email from the Complainant when in fact they were receiving an email from the Respondent. There was nothing at all legitimate about the email. It was a fiction. It is clear, particularly given the false contact details given by the Respondent on registration of the Domain Name (being those of the

Complainant), that the Respondent set out to acquire a domain name to assist it in its impersonation of the Complainant for its own improper ends. Such behaviour clearly takes unfair advantage of the Complainant's rights, and is abusive.

In all the circumstances, the Panel finds that, for the purposes of the Policy, there is evidence of both registration and use of the Domain Name in bad faith.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <thewhitecompanygroup.com> be transferred to the Complainant.

/Jon Lang/

Jon Lang

Sole Panelist

Date: June 28, 2023