

ADMINISTRATIVE PANEL DECISION

WH Smith Plc. v. Djoel Primus
Case No. D2023-5342

1. The Parties

The Complainant is WH Smith Plc., United Kingdom, represented by ZeroFox, United States of America.

The Respondent is Djoel Primus, United States of America.

2. The Domain Name and Registrar

The disputed domain name <whsmith.site> is registered with URL Solutions, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 22, 2023. On December 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. A reminder was sent on January 2, 2024. On January 2, 2024, 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 (Global Domain Privacy Services) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 3, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant asked the Center to simply amend the complaint on January 9, 2024.

The Center verified that 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 January 11, 2024. In accordance with the Rules, paragraph 5, the due date for submitting a Response was January 31, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 1, 2024.

The Center appointed Kiyoshi Tsuru as the sole panelist in this matter on February 27, 2024. 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 is a British retailer, with headquarters in Swindon, England, which operates a chain of high street, railway station, airport, port, hospital, and motorway service station shops selling books, stationery, magazines, newspapers, entertainment products and confectionery. The company was founded in 1792.

The Complainant owns, among others, the following trademark registration:

Trademark	No. Registration	Jurisdiction	Date of Registration
WH Smith	UK00906594782	United Kingdom	October 24, 2008

The Complainant owns the domain name <whsmith.com>, which resolves to the Complainant's official website.

The disputed domain name <whsmith.site> was registered on August 17, 2023. The disputed domain name resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends the following:

I. Identical or Confusingly Similar

That WH SMITH is a globally recognized brand.

That the disputed domain name is confusingly similar to the Complainant's trademark WH SMITH, since it wholly incorporates said mark.

That the only difference is that the disputed domain name uses the ".site" generic Top-Level Domain ("gTLD") instead of ".com" which the Complainant uses in relation to its official domain name.

That this is a common practice called a "TLD swap" in the domain name registration realm, where the registrant swaps the TLD in order to impersonate a company, leverage their brand for ads, or sell it back to the trademark owner for a profit.

II. Rights or Legitimate Interests

That the disputed domain has not been used or prepared for use in connection to a bona fide offering of goods or services.

That the disputed domain name currently does not resolve to a webpage that hosts any content except for an index page that has one link leading to a 403 Error, and that said index does not seem to be part of a larger effort to prepare the web page for a legitimate commercial use.

That there is no evidence that the Respondent has registered the disputed domain name for the purpose of criticism, free speech, or other non-commercial uses.

That the confusingly similar nature of the disputed domain name and the lack of any content associated thereto reinforce the claim that the Respondent has no legitimate interests in said disputed domain name.

That said confusing similarity implies a risk of confusion regarding the perceived existence of a relationship of the Respondent with the Complainant such as ownership or affiliation.

III. Registered or Used in Bad Faith

That it is well established in the decisions rendered under the Policy that the incorporation of the entirety of the Complainant's registered trademark in the disputed domain name is enough to prove bad faith registration. That the Respondent was aware of the Complainant's official site when registering the disputed domain name.

That a simple TLD swap does not change the underlying incorporation of the Complainant's trademark in the disputed domain name, and makes it more likely that it is referential to the Complainant.

That under the doctrine of "Passive Holding", even in the presence of a page that is parked or that does not resolve to an active website, the Respondent can be considered to have engaged in bad faith conduct, especially when the complainant's mark is wholly incorporated in the disputed domain name, with no significant changes.

That there is an active MX record associated with the disputed domain name, indicating that the Respondent intends to send impersonating emails as part of a phishing campaign.

That the Respondent is also using a privacy service to obfuscate his registration details and contact information. With no additional context and a lack of evidence of legitimate use, this is likely because the Respondent is using fake information or does not wish to be associated with potentially subversive activities.

B. Respondent

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

6. Discussion and Findings

Given the Respondent's failure to submit a formal response, the Panel may decide this proceeding based on the Complainant's undisputed factual allegations under paragraphs 5(f), 14(a), and 15(a) of the Rules (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#), and *Encyclopaedia Britannica, Inc. v. null John Zuccarini, Country Walk*, WIPO Case No. [D2002-0487](#)).

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

It is well established in prior decisions issued under the UDRP, with which the Panel agrees, that a gTLD may generally be disregarded when comparing a trademark with a disputed domain name. The Panel considers the “.site” gTLD to be irrelevant in the circumstances of the present case. [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the entirety of the Complainant's mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights to or legitimate interests in the disputed domain name. The Complainant has asserted that there is no relationship or affiliation between the Complainant and the Respondent, that it has not granted any authorization to the Respondent to use its trademark WH SMITH (see *Beyoncé Knowles v. Sonny Ahuja*, WIPO Case No. [D2010-1431](#), and *Six Continents Hotels, Inc. v. IQ Management Corporation*, WIPO Case No. [D2004-0272](#)).

The case file contains no evidence that demonstrates that the Respondent has used or has made demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services (see *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#); and *Associated Newspapers Limited v. Manjeet Singh*, WIPO Case No. [D2019-2914](#)).

The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights to or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The fact that the Respondent registered the disputed domain name which entirely reproduces the Complainant's trademark WH SMITH shows that the Respondent has targeted the Complainant, which constitutes opportunistic bad faith, given the Complainant's trademark distinctiveness and global recognition (see section 3.2.1 of the [WIPO Overview 3.0](#); see also *L'Oréal v. Contact Privacy Inc. Customer 0149511181 / Jerry Peter*, WIPO Case No. [D2018-1937](#); *Gilead Sciences Ireland UC / Gilead Sciences, Inc. v. Domain Maybe For Sale c/o Dynadot*, WIPO Case No. [D2019-0980](#); and *Nutricia International BV v. Eric Starling*, WIPO Case No. [D2015-0773](#)).

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain names do not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that under the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Another indicator of bad faith is the pattern of cybersquatting in which the Respondent has engaged, considering that he has been named as a respondent in another case where he has targeted a distinctive brand of a complainant (see *Association des Centres Distributeurs E. Leclerc – A.C.D. Lec. v. Djoel Primus*, WIPO Case No. [D2023-3358](#)).

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <whsmith.site> be transferred to the Complainant.

/Kiyoshi Tsuru/

Kiyoshi Tsuru

Sole Panelist

Date: February 27, 2024