

ADMINISTRATIVE PANEL DECISION

Horween Leather Company v. Hassan Mirza
Case No. D2024-1448

1. The Parties

The Complainant is Horween Leather Company, United States of America (United States), represented by Faegre Drinker Biddle & Reath, United States.

The Respondent is Hassan Mirza, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <horweenleather.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 April 5, 2024. On April 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 5, 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 (WITHHELD FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 10, 2024 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 April 12, 2024.

The Center verified that the Complaint 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 April 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 19, 2024. The Response was filed with the Center on April 15, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on May 31, 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 an American company established in 1905. Since that date, it has been offering for sale and selling handmade leather under the brand name HORWEEN. Since at least 1999, the Complainant has operated a website at “www.horween.com” to market its leather products.

According to the Complaint, the result of the quality of its leather products, marketing and sales means that the Complainant has developed a strong reputation for its products under the HORWEEN trademark around the world.

The Complaint includes evidence that the Complainant has a number of registered trademarks for, or including, HORWEEN in a number of countries in North America and Europe. For present purposes, it is sufficient to note:

- (a) United States Registered Trademark No 1,741,310, HORWEEN, which has been registered in the Principal Register since December 22, 1992 in respect of leather sold in bulk (in International Class 18) and which claimed a first use in commerce in at least 1910;
- (b) Canadian Registered Trademark No 421,544, HORWEEN, which has been registered since December 24, 1993 in respect of leather (in International Class 18); and
- (c) United Kingdom Registered Trademark No UK00003963121, HORWEEN, for leather sold in bulk in International Class 18. The registration of this trademark is effective from its filing date on October 2, 2023.

The disputed domain name was registered on August 18, 2023.

It resolves to a webpage which appears to offer for sale leather products such as jackets, aprons, bags, and knife rolls. The products are offered for sale by default in USD although other currencies may be chosen through a drop-down menu. The landing page features at the top a device consisting of the letter “H” surrounded by a wreath of laurel branches over some scroll work. Adjacent to this device appear the words:

“HORWEEN
“LEATHER
“EST. 2003”

The website provides a physical address for the operator’s address in Dagenham in the United Kingdom. The website includes numerous references to “HorweenLeather®”.

In the Response, this website is said to be operated by Horween Leather Limited. This company was incorporated in the United Kingdom on September 13, 2023 with Company Registration No 15136037.

A private investigator engaged by the Complainant attempted to buy products through the Respondent’s website on three occasions in February 2024: twice from the United States and once using an address in the United Kingdom with a credit card issued by a bank in the United Kingdom. On each occasion, the private investigator was required to complete a pre-checkout process before finalizing his order. The pre-checkout process required the private investigator to supply full contact details (name, telephone number, email, and mailing address).

According to the private investigator's declaration, he completed the form using active contact information and pseudonyms.

Despite completing and submitting the form, the private investigator has not received any communications or products from the Respondent.

In reply to a letter of demand from the Complainant's attorneys, the Respondent set out an explanation of his position and why he considered it did not infringe the Complainant's rights. The Respondent's reply also stated that he had received inquiries about the potential for sale of his website and offered to sell it to the Complainant for USD 200,000.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has 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.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

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.

The Complainant has proven ownership of numerous trademarks around the world for, or featuring, HORWEEN including, in particular, the three registered trademarks for HORWEEN identified in section 4 above.

In undertaking the comparison between the disputed domain name and the Complainant's trademark, it is permissible in the present circumstances to disregard the generic Top Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".com" gTLD, the disputed domain name consists of the Complainant's registered trademark and the term "leather". As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g. [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant's trademark remains visually and aurally recognisable within the disputed domain name.

The Respondent contends that there is no risk of confusion between the disputed domain name and the Complainant's trademark as the two parties operate in different fields: the Complainant in the supply of bulk leather while the Respondent sells individual products made from leather.

The Respondent's contention, however, misunderstands the nature of the inquiry under the first requirement of the Policy. It simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.7.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a 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.

The Respondent registered the disputed domain name after the Complainant began using its trademark and also after the Complainant had registered its trademark in the United States and Canada but not, it appears, in the United Kingdom.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name. As noted above, however, the Respondent is in some way associated with a company incorporated in the United Kingdom and the Respondent registered the disputed domain name, and the company was incorporated there, before the Complainant registered its trademark in the United Kingdom.

The Respondent has advanced two explanations or justifications for the registration of the disputed domain name. First, in his reply to the Complainant's letter of demand, the Respondent claimed that the name was simply descriptive of the leather materials from which Horween Leather Limited's products are made. Secondly, in that reply and in the Response, the Respondent contends that Horween Leather Limited's business in retailing products made from leather is sufficiently remote from the Complainant's business in bulk leather materials that no confusion will arise and the Complainant will not suffer any loss or damage.

For the reasons discussed in Section 5C below, however, the Panel finds that the disputed domain name was registered in bad faith and has subsequently been used in bad faith.

Those findings also lead to the conclusion that the Respondent is not using the disputed domain name in connection with a good faith offering of goods and services. The finding of registration in bad faith also colours the incorporation of Horween Leather Limited under the name "Horween" so that the Respondent cannot claim the benefit of paragraph 4(c)(ii) of the Policy. The circumstances identified in paragraph 4(c)(ii) of the Policy may provide a basis for a finding of rights or legitimate interests in the disputed domain name because those circumstances will usually indicate the disputed domain name has been adopted independently of the Complainant's trademark rights.

For the reasons discussed in Section 5C below, that is not (or at least on the materials before the Panel is not) this case.

Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g. *Group One Holdings Pte Ltd v. Steven Hafto* WIPO Case No. [D2017-0183](#).

Ordinarily, the registration of a domain name before a complainant acquires its trademark rights will not constitute registration in bad faith for the purposes of the third requirement of the Policy. However, that is not invariably the case especially where the registrant of the domain name has sought to take unfair advantage of another's (usually nascent) trademark rights. See e.g. [WIPO Overview 3.0](#), section 3.8.1 and 3.8.2.

In the present case, the principle outlined in [WIPO Overview 3.0](#), section 3.8.1 is not applicable. The Respondent did register the disputed domain name and Horween Leather Limited was incorporated before the Complainant registered its trademark in the United Kingdom. However, the Complainant's registered trademarks in at least the United States and Canada were registered long before the Respondent registered the disputed domain name.

It is also possible that two independent businesses in two different geographic locations may both have rights in the same (or a conflicting) trademark. See e.g. *Prince plc. v Prince Sport Group Inc.* [1998] FSR 21. That may also be the case even where the two businesses are in the same jurisdiction, especially where they operate in very different fields.

The present case is not such a case. The website to which the disputed domain name resolves displays prices by default in United States dollars. There is also dropdown functionality allowing the user to display prices in Australian dollars, Canadian dollars, Euros, Swiss Francs and British pounds. In these circumstances, the Panel infers that the Respondent purports to be soliciting custom from around the world, not just the United Kingdom.

Even so, generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

In the present case, the Complainant does claim it has a strong reputation in HORWEEN around the world, from which the Panel is presumably supposed to infer the Respondent's knowledge of the Complainant's trademark. The Panel is not in a position to accept that claim which is unsupported by any evidence. There is, for example, no evidence before the Panel that the Complainant trades in the United Kingdom or Pakistan or, if it does, when it started or how extensively.

However, the other materials before the Panel do provide a basis for finding that the Respondent registered the disputed domain name with knowledge of the Complainant's trademark and to take advantage of the resemblance of the disputed domain name to that trademark opportunistically.

First, the Respondent does not appear to have had any connection with the name "Horween" such as it being part of his own name or where he is located. On the other hand, while "Horween" may be a surname, it appears on the materials before the Panel to have significance in relation to leather and leather products only because of its adoption and use by the Complainant as its trademark.

Secondly, as noted above, the Respondent has claimed that the name is merely descriptive of the materials from which the Respondent's products are made. This claim indicates that the Respondent was at the very least aware when registering the disputed domain name that there was a type or brand of leather known as "Horween" leather. One would expect therefore that in choosing to market the Respondent's products by a name which emphasized they were made from *Horween* leather, the Respondent considered consumers would understand the significance of "Horween" when used in the context of products made from leather.

Further, the Panel does not accept the Respondent's claim on the materials in this proceeding. The Complainant has pointed out that at least some of the products advertised on the Respondent's website are made (or at least, depicted) in colours that the Complainant does not make. So such products are not made from "Horween" leather.

Further, the evidence of the private investigator is that the Respondent is not actually offering any goods for sale through the website. Instead, the website appears to be used to harvest personal information. While the Respondent's website was modified after receipt of the letter of demand to remove the claims that the Respondent's products were made from the Complainant's materials, the Respondent has not disputed the private investigator's evidence or sought to explain it.

Accordingly, the Panel does not accept the first explanation offered by the Respondent for adoption of the disputed domain name.

As noted above, the second explanation offered by the Respondent is that there is no risk of confusion because the parties operate in very different fields.

The reasons for rejecting the Respondent's first contention also lead to a rejection of this claim. First, given the unchallenged evidence of the private investigator, it does not appear that the Respondent is in fact genuinely offering products made from leather for sale. That is sufficient in itself to reject this explanation. Further, the nature of the disputed domain name gives rise to a risk of implied affiliation. See e.g., [WIPO Overview 3.0](#), sections 2.5 and 2.8. Nothing about the content of the website dispels that. On the contrary, the website presents as being operated by "Horween Leather" and does not make clear the nature of the claimed (but false) relationship. This is further reinforced by the false representation that the operator of the website is the owner of the registered trademark HorweenLeather®.

Accordingly, the Panel finds that the Respondent registered the disputed domain name in bad faith.

Further, the manner of use constitutes use in bad faith. On the Complainant's case, the Respondent's website is being used to harvest personal information of the public rather than to supply products. That is not a good faith use of the disputed domain name. It is at the very least highly misleading and may very well be illegal.

In addition, the Respondent voluntarily offered to transfer the disputed domain name to the Complainant for a payment of at least USD 200,000. The Respondent has not provided evidence of the other solicitations he claims to have received. Nor has he otherwise sought to justify the amount. Given the context in which the Respondent made the offer, it appears that the Respondent fully appreciated the value of the disputed domain name arising from its resemblance to the Complainant's trademark and sought to capitalise on that.

For these reasons, the Panel finds that the Respondent has also been using the disputed domain name in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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 <horweenleather.com> be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: June 14, 2024