

## **ADMINISTRATIVE PANEL DECISION**

Dunelm (Soft Furnishings) Limited v. niko farel, e-brands  
Case No. D2024-2941

### **1. The Parties**

The Complainant is Dunelm (Soft Furnishings) Limited, United Kingdom, represented by HGF Limited, United Kingdom.

The Respondent is niko farel, e-brands, Greece.

### **2. The Domain Name and Registrar**

The disputed domain names <billadderleydunelm.com> and <dunelm.com> (the “Disputed Domain Names”) are registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2024. On July 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On July 18, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 19, 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 August 5, 2024.

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 August 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 9, 2024.

The Center appointed Nicholas Weston as the sole panelist in this matter on September 11, 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 London Stock Exchange listed home furnishings retailer with turnover exceeding £1,639 in 2023 and has more than 11,000 employees across 173 locations in the United Kingdom. The Complainant holds a number of registrations for the trademark DUNELM internationally, including European Union Trademark Registration No. 010324085 for the mark DUNELM registered on March 8, 2012.

The Complainant owns the domain name <dunelm.com> which hosts its main website.

The Disputed Domain Name <billadderleydunellm.com> was registered by the Respondent on January 27, 2024, and the respondent registered the Disputed Domain Name, <dunellm.com>, on January 25, 2024. The Disputed Domain Names are inactive.

#### **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 Names.

Notably, the Complainant cites its trademark registrations in various jurisdictions for the mark DUNELM and variations of it, as prima facie evidence of ownership.

The Complainant submits, in essence, that its rights in the DUNELM mark predate the Respondent's registration of the Disputed Domain Names. It submits that the Disputed Domain Names are confusingly similar to its trademark, because each Disputed Domain Name is comprised of a misspelling of the DUNELM trademark that varies from the Complainant's trademark by only one letter, using double "L" in both cases and in one case also using the name of one of the founders of the Dunelm business, Billy Adderley, and contends that is not sufficient to avoid a finding of confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because, I quote: "The Respondent has not responded to correspondence from *[sic]* the Complainant, despite several attempts to contact. Further, it is noted and as shown at Annex 3, the Respondent is actively using the domain names alongside the Complainant's logo as well as the Complainant's registered address. Furthermore, the Respondent is actively using the Complainant's own domain (dunelm.com) on this business card alongside the Respondent's domains, showing a clear awareness of the Complainant. Further, as noted above in relation to the history of the Complainant, the name Bill Adderley is a founder of Dunelm, thus the use of this name on the business card and within the domain www.billadderleydunellm.com demonstrates that the Respondent is aware of the Complainant with no interest in respect of the domain names, rather they are seeking to misleadingly lead consumers to believe that they are connected with the Complainant, risking damage to the Complainant or tarnish the Complainant."

Finally, on the issue of whether the registration and use of the Disputed Domain Names were, and currently are, in bad faith, contrary to the Policy and the Rules having regard to the prior use and well-known nature of the Complainant's trademark, the Complainant submits "the Respondent is directly using the domains alongside the Complainant's logo, registered address and the Complainant's own domain name (dunelm.com). The Respondent is not authorized to use DUNELM or any similar mark whether in the domain or otherwise. The Complaint contends that by using the domain names, the Respondent is

intentionally attempting to attract for commercial gain, Internet users to the Respondent's web site or other on-line location, in particular contacting their email address, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location".

## B. Respondent

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

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- (iii) that the Disputed Domain Names have been registered and are being used in bad faith.

### 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 Names. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country. [WIPO Overview 3.0](#), section 1.2.1. The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark DUNELM in a number of countries.

Turning to whether the Disputed Domain Names are identical or confusingly similar to the DUNELM trademark, the Panel observes that each Disputed Domain Name is comprised of the Complainant's trademark varied as follows:

<billadderleydunellm.com>	the name Bill Adderley has been added to the trademark and the letter "L" in the trademark DUNELM has been repeated twice.
<dunellm.com>	the letter "L" in the trademark DUNELM has been repeated twice.

Each is also followed by the generic Top-Level Domain ("gTLD") ".com".

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11. The relevant comparison to be made is with the second-level portion of each of the Disputed Domain Names, specifically: "billadderleydunellm", and "dunellm", respectively.

The Panel finds the mark DUNELM is recognizable within the Disputed Domain Names. Accordingly, the Disputed Domain Names are confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the words "Bill" and "Adderley" may bear on assessment of the second and third elements with respect to the Disputed Domain Name <billadderleydunellm.com>, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the Disputed Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Furthermore, with respect to <dunellm.com>, a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. [WIPO Overview 3.0](#), section 1.9.

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.

Although 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 difficult 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 Disputed Domain Names (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Names such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established for the Disputed Domain Names.

## **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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Names in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the distinctive nature of the Complainant’s trademark, the Panel is satisfied that the Respondent knew of and targeted the Complainant’s trademark DUNELM when it registered the Disputed Domain Names.

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Names other than to trade off the reputation and goodwill of the Complainant’s well-known trademark. [WIPO Overview 3.0](#), section 3.1.4.

Further, a gap of several years between registration of a complainant’s trademark and respondent’s registration of a disputed domain name (containing the trademark) can indicate bad faith registration. In this case, the Respondent registered the Disputed Domain Names almost 13 years after the Complainant established registered trademark rights in the DUNELM mark.

On the issue of use, the Complainant's submission is incoherent and it supplied no evidence of whether each Disputed Domain Name resolves to an active webpage or not, but has supplied an image of a business card bearing the name of one of the founders of the Complainant, Bill Adderley, alongside the Disputed Domain Names, with no background commentary despite having supplied a witness statement.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of either of the Disputed Domain Names would not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the Complainant's distinctive trademark, and the composition of the Disputed Domain Names, and finds that in the circumstances of this case that if there were passive holding of the Disputed Domain Names, it does not prevent a finding of bad faith under the Policy.

Panels may take into account particular circumstances in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the Disputed Domain Name such as here where a widely-known mark is used, and incorporating an additional term such as, in this case, the founder's name, (ii) the chosen top-level domain (e.g., particularly where corresponding to the complainant's area of business activity or natural zone of expansion), (iii) the timing and circumstances of the registration (within 2 days of each other); (v) any respondent pattern of targeting marks along a range of factors, such as a common area of commerce, intended consumers, or geographic location, (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the Disputed Domain Names, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant. [WIPO Overview 3.0](#), section 3.2.1. In the circumstances, the Panel finds the Respondent's registration and use of the Disputed Domain Names constitute bad faith under the Policy.

This Panel finds that this is a case of classic typosquatting where the Respondent has taken a recognizable version of the Complainant's trademark DUNELM and incorporated it in each Disputed Domain Name without the Complainant's consent or authorization, for the very purpose of capitalizing on the reputation of the trademark by diverting Internet users for commercial gain. The addition of "Bill Adderley" within one of the Disputed Domain Names further indicates that the Respondent was aware of the Complainant and its trademarks.

The Panel finds that the Complainant has established the third element 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 Names <billadderleydunellm.com> and <dunellm.com> be transferred to the Complainant.

*/Nicholas Weston/*

**Nicholas Weston**

Sole Panelist

Date: September 19, 2024.