

ADMINISTRATIVE PANEL DECISION

ITG Brands, LLC v. Larry Wall, Epoch Inc
Case No. D2024-3295

1. The Parties

The Complainant is ITG Brands, LLC, United States of America (“United States”), represented by Dykema Gossett PLLC, United States.

The Respondent is Larry Wall, Epoch Inc, United States.

2. The Domain Name and Registrar

The disputed domain name <winstoncoupons.com> (the “Disputed 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 August 12, 2024. On August 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 13, 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 (Redacted for Privacy, See PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 13, 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 amendment to the Complaint on August 19, 2024.

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 August 30, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 19, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 21, 2024.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on September 26, 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 and its predecessors have been using the trademark WINSTON for cigarettes sold in the United States since 1952. The Complainant owns common law rights in the WINSTON mark as well as United States trademark registrations incorporating WINSTON including:

- **Winston** (Reg. No. 636, 355, registered on October 30, 1956) for cigarettes;
- WINSTON (Reg. No. 4,945,257, registered on April 26, 2016) for cigarettes; and
- WINSTON BOLD CHOICE (Reg. No. 5,488,215, registered on June 5, 2018) for cigarettes.

The Disputed Domain Name was registered on June 22, 2024.

At the time of filing the Complaint, the Disputed Domain Name resolved to a website prominently displaying the Complainant's WINSTON trademark and purportedly offering discount coupons for the Complainant's WINSTON branded cigarettes. At the time of the Decision, the Disputed Domain Name resolves to a log-in page prominently displaying the Complainant's WINSTON trademark.

5. Parties' Contentions

A. Complainant

The Disputed Domain Name is virtually identical to and is confusingly similar to the Complainant's WINSTON mark. The Disputed Domain Name consists of the Complainant's well known WINSTON mark in combination with the generic term "coupons".

Given the identical nature of the Complainant's mark and the Disputed Domain Name, the Complainant's customers and the rest of the general public are likely to believe the Disputed Domain Name is associated with, endorsed by or is otherwise sponsored and approved by the Complainant when, in fact, it is not.

The Respondent has no rights or legitimate interests in the terms WINSTON or the Disputed Domain Name because the Respondent is in no way affiliated with the Complainant. Respondent is simply trading off of the goodwill created by the Complainant and its predecessors in the WINSTON mark.

At no time did the Respondent seek or obtain a license from the Complainant to use the WINSTON mark; nor has the Respondent attempted to file any trademark applications for the mark WINSTON in connection with any goods or services, as a legitimate trademark owner would do.

There is no demonstrable use by the Respondent of the Disputed Domain Name in connection with a bona fide offering of goods or services. There is no evidence to indicate the Respondent has any legitimate interests in the Disputed Domain Name. Rather, the Respondent registered the Disputed Domain Name and is using it in a manner that has routinely been held to be in bad faith by numerous UDRP panelists, namely, for the purpose of trading off the Complainant's well known WINSTON mark for commercial gain by using it to generate an email mailing list for those who sign-up to the Respondent's website. Lastly, the Respondent is not commonly known by the Winston name.

The Respondent registered the Disputed Domain Name for the primary purpose of disrupting the Complainant's business by creating a likelihood of confusion with Complainant's WINSTON mark as to the source, sponsorship, affiliation or endorsement of any future website and/or to prevent the Complainant from having access to the Disputed Domain Name. The Respondent registered the Disputed Domain Name for the purpose of diverting customers away from the Complainant's legitimate business to its website allegedly offering discounts on WINSTON cigarettes. In reality, any issued discount coupons would be unauthorized and void ab initio. Therefore, the only reason the Respondent could possibly have registered the Disputed Domain Name was to build an email marketing list, all in bad faith.

There can be no doubt the Respondent registered the Disputed Domain Name with the bad faith intent of diverting Internet users searching for the Complainant's authentic WINSTON cigarettes.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in the famous WINSTON mark. The generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Although the Disputed Domain Name contains the additional wording "coupon", the Complainant's WINSTON trademark is incorporated in its entirety. With the Complainant's trademark being recognizable the additional term "coupons" does not prevent a finding of confusing similarity between the Complainant and the Disputed Domain Name. Therefore, the Disputed Domain Name is confusingly similar to a mark in which the Complainant has rights. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has presented a prima facie case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been commonly known by the Disputed Domain Name. The fact that the Respondent obtained the Disputed Domain Name several decades after the Complainant had begun using its famous WINSTON mark indicates the Respondent sought to piggyback on the mark for illegitimate reasons, namely, to associate itself and attract Internet users looking for the Complainant's services to illicit some commercial gain. This indicates to the Panel that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

After a complainant has made a prima facie case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Name. Furthermore, the Panel finds that because the Disputed Domain Name incorporates the Complainant's mark entirely, any use of such domain name by the Respondent carries a risk of implied affiliation with the Complainant. See [WIPO Overview 3.0](#), section 2.5.1. Such implied affiliation was clearly the intent of the Respondent given the impersonating use to which the disputed domain name was put, namely a website profusely using the Complainant's trademark in either an alleged commercial offering of discounted coupons or a login page likely setup to phish Internet users' personal and payment information, neither of which contained any disclaimer as to their lack of relationship to the Complainant.

In the absence of any evidence rebutting the Complainant's prima facie case indicating the Respondent's lack of rights or legitimate interests in respect of the Disputed Domain Name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Disputed Domain Name was registered several decades after the Complainant first registered and used its famous WINSTON trademark. The evidence on the record provided by the Complainant with respect to the extent of use and fame of its WINSTON trademark, combined with the absence of any evidence provided by the Respondent to the contrary, is sufficient to satisfy the Panel that, at the time the Disputed Domain Name was registered, the Respondent undoubtedly knew of the Complainant's WINSTON trademark.

There is prima facie no good faith reason for the Respondent to have registered the Disputed Domain Name incorporating the Complainant's WINSTON trademark with the gTLD ".com" and additional generic term "coupons", to setup a commercial website falsely implying association with the Complainant.

There is prima facie no good faith reason for the Respondent to have registered the Disputed Domain Name containing the WINSTON mark. The Disputed Domain Name previously resolved to a website prominently displaying Complainant's WINSTON trademark and purportedly offering discount coupons for Complainant's WINSTON cigarettes and currently resolves to a log-in page prominently displaying Complainant's WINSTON trademark, the Panel infers that it was a scheme to secure personal information from unsuspecting users. This clearly evidences bad faith use on the part of the Respondent. See section 3.4 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Complainant has satisfied 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 <winstoncoupons.com> be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: October 10, 2024