

ADMINISTRATIVE PANEL DECISION

Justerini & Brooks Limited v. Tang Long
Case No. D2024-4163

1. The Parties

The Complainant is Justerini & Brooks Limited, United Kingdom, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Tang Long, China.

2. The Domain Name and Registrar

The disputed domain name <justerinibrooksuk.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 9, 2024. On October 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 11, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 October 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 4, 2024.

The Center appointed Harini Narayanswamy as the sole panelist in this matter on November 20, 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 United Kingdom based fine wine and spirits merchant founded in the year 1749. The Complainant owns the trademark JUSTERINI & BROOKS and has numerous trademark registrations for the mark that include:

China trademark registration number 1316994, date of registration September 21, 1999, under class 33.

United Kingdom trademark registration number UK00000579075, date of registration August 5, 1937, under classes 32 and 33.

European Union trademark registration number 000628701 date of registration March 15, 1999, under class 33.

The Respondent Tang Long, is located in Chengdu, Sichuan province, China as per the registration records. The disputed domain name was registered on July 17, 2024.

Previous to filing the Complaint, the Respondent had hosted a website using the disputed domain name. The website offered wine, whisky and spirits, which are products associated with the Complainant's business. The Respondent's website had also displayed the Complainant's trademark. At the time of filing the present Complaint, the disputed domain name was not being used to host a website.

5. Parties' Contentions

A. Complainant

The Complainant states its a member of the Diageo group of companies and Diageo plc is its holding company. The Complainant states that it has supplied fine wine to British monarchs since the coronation of King George III in 1761. The Complainant alleges that for 270 years it has been providing quality wine to discerning collectors and is known for its expertise and personal service. The Complainant states it is the largest importer of fine wines into the United Kingdom from the best wine estates of Burgundy, Barolo, Germany, Bordeaux, the Rhone, Loire, and Champagne and has a portfolio of over 3000 different wines.

The Complainant contends that its registered trademark JUSTERINI & BROOKS is well-known and is recognized worldwide. The first use of its mark dates back to 1844. The Complainant asserts that it has made significant investments and efforts to promote the mark in the media and on the Internet and it has gained substantial goodwill. The Complainant states that it owns 38 domain names of which 16 incorporate its trademark wholly or partially. The Complainant's website is hosted from the domain name <justerinis.com>, which was registered on January 27, 2000. Its Internet presence also include its social media pages.

The Complainant contends that the disputed domain name is confusingly similar to its mark. The addition of the geographic term "uk", which is a common abbreviation for the United Kingdom, increases the confusing similarity due to its connection with the United Kingdom. Omission of the "&" sign and spaces does not diminish confusing similarity as the disputed domain name consists of the dominant part of the mark.

The Complainant argues that the Respondent lacks rights or legitimate interests in the disputed domain name for the reasons that: The Respondent is not commonly known by the disputed domain name and is not affiliated with the Complainant or authorized to use its mark. The Respondent has used the disputed domain name to sell wine and whiskey and had displayed the Complainant's trademark. The Complainant argues that this amounts to imitating and passing-off and misleading customers is not a bona fide offering.

Notably, the Complainant contends that the Respondent ought to have been aware of the Complainant's mark as the Respondent had used it in connection with wines and spirits. The Complainant has submitted that the Respondent has intentionally attempted to attract for commercial gain, Internet users to the Respondent's website or location, creating a likelihood of confusion with the Complainant and its trademark, which is bad faith registration and use of the disputed domain name.

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

B. Respondent

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

6. Discussion and Findings

The Complainant in these proceedings is required to establish three elements under paragraph 4 (a) of the Policy for transfer of the disputed domain name, these are:

- (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 lacks rights or legitimate interests in the disputed domain name; and
- (iii) The disputed domain name was registered and is being used in bad faith by the Respondent.

A. Identical or Confusingly Similar

The first element requires the Complainant to establish the disputed domain name is confusingly similar to a trademark or a service mark in which it has 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 provided evidence of its registered rights in the trademark in multiple jurisdictions including China, United Kingdom, and the European Union. The Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name consists of the significant part of the Complainant's mark, which is "justerini" and "brooks" and the additional letters "uk". The Panel finds the addition of the letters "uk" 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.

The omission of the ampersand symbol "&" and spaces between the words / names does not impact the confusing similarity of the disputed domain name with the trademark. The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

The second element requires the Complainant to make a showing that it is evident the Respondent lacks rights or legitimate interests in the disputed domain name. 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 domain name (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 that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name and is not affiliated with the Complainant and is not authorized or licensed to use the Complainant’s mark or any variations of it.

The Respondent’s website displayed wines and spirits, products that are associated with the Complainant’s business. The Panel finds under the described circumstances, that the Respondent’s unauthorized use of the mark in the disputed domain name and on the website is an attempt to impersonate the Complainant. Such use of the disputed domain name is likely to confuse and mislead Internet users, which is not a bona fide offering of products. Further, the Panel finds there is substance in the Complainant’s arguments that the addition of the letters “uk”, which is a common abbreviation for United Kingdom is likely to be associated with the Complainant’s mark. The use of this abbreviated geographic term denotes the Complainant’s place of origin and its main place of business. Where a disputed domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it impersonates or suggests sponsorship, affiliation, or endorsement by the trademark owner.

Trying to impersonate the Complainant and the unauthorized use of the Complainant’s mark does not indicate the Respondent’s rights or legitimate interests in the disputed domain name. Panels have held that the use of a domain name for illegitimate activity such as sale of counterfeit goods or impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

For the reasons discussed, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The third element under paragraph 4(a)(iii) of the Policy requires the Complainant to establish the disputed domain name has been registered and used in bad faith by the Respondent. The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy specifies circumstances, in particular, but without limitation, 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 also 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.

- (i) Circumstances indicate that the respondent has registered or acquired the domain name primarily for purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) The respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Panel finds there is sufficient material to support the Complainant's arguments that the Respondent has registered and used the disputed domain name in a manner as described under paragraph 4(b)(iv) of the Policy. The Complainant's mark is distinctive and unique to the Complainant, and it is not likely that the Respondent composed the disputed domain name without intending to create an implied association with the Complainant.

The evidence filed by the Complainant shows that the disputed domain name, which contains the Complainant's mark has been used by the Respondent in connection with a commercial website that offered products typically associated with the Complainant. The registration and use of the disputed domain name, under the discussed circumstances is indicative of the Respondent's intent to mislead online users and to benefit from the reputation associated with the mark.

It has been consistently found by UDRP panels that the registration of a confusingly similar domain name that contains a reputed trademark, by someone who is not affiliated with the owner of the trademark and has not shown good reason for registration of the disputed domain name or its legitimate use, can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.4.1. Intentionally using the Complainant's trademark in the disputed domain name and on the Respondent's website for purposes of misleading and attracting Internet users constitutes bad faith.

Panels have held that the use of a disputed domain name for sale of counterfeit goods or impersonation/passing off, or other types of fraud constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record the Panel concludes that the Respondent's registration and use of the disputed domain name targets the Complainant's well-known mark and creates a likelihood of confusion among Internet users which is bad faith under the Policy.

The Panel finds for the reasons discussed that the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy. The Complainant has established the third element of the Policy and has satisfied the requirements under the Policy for a transfer of the disputed domain name.

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 <justerinibrooksuk.com> be transferred to the Complainant.

/Harini Narayanswamy/

Harini Narayanswamy

Sole Panelist

Date: December 4, 2024