

ADMINISTRATIVE PANEL DECISION

Cheyne Capital Holdings Limited v. Private by Design, LLC / Pm Ding
Case No. D2022-2640

1. The Parties

The Complainant is Cheyne Capital Holdings Limited, United Kingdom, represented by Dechert LLP, United Kingdom.

The Respondent is Private by Design, LLC, United States of America (“United States”) / Pm Ding, United States.

2. The Domain Name and Registrar

The disputed domain name <cheynecapital.cloud> (the “Disputed Domain Name”) is registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 19, 2022. On July 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. Also on July 20, 2022, 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 and contact information in the Complaint.

The Center sent an email communication to the Complainant on July 26, 2022, 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 also on July 28, 2022.

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 July 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 19, 2022.

The Center appointed Mariya Koval as the sole panelist in this matter on August 23, 2022. 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 leading international investment manager across a range of asset classes including in corporate credit, real estate and asset backed strategies, event driven, equity and equity-linked strategies, distressed European credit, social impact property, and tailor-made investment strategies. The Complainant markets its products globally and has offices in London, New York, Dubai, Dublin, Berlin, Madrid, Paris, Sydney, Zurich, and Bermuda, having assets under management of approximately USD 9.6 billion and a turnover of GBP 84 million in the year ending March 31, 2021. The Complainant's reputation is further demonstrated by its industry recognition, having won multiple awards for its products and services.

The Complainant is the owner of a large CHEYNE and CHEYNE CAPITAL Trademark (the "Trademark" registrations portfolio throughout the world, among which are:

- United States CHEYNE Trademark Registration No. 2661408, registered on December 17, 2002, in respect of services in class 36;
- United Kingdom CHEYNE / CHEYNE CAPITAL Trademark Registration No. 2217132, registered on June 9, 2000, in respect of services in class 36;
- Bermuda CHEYNE CAPITAL Trademark Registration No. 32796, registered on January 9, 2001, in respect of services in class 36;
- Cayman Islands CHEYNE CAPITAL Trademark Registration No. T0001253, registered on August 5, 2005, in respect of services in class 36.

The Complainant operates domain name <cheynecapital.com> reflecting its CHEYNE and CHEYNE CAPITAL Trademarks for offer and promotion of its services.

The Disputed Domain Name was registered on June 10, 2022. According to the evidence submitted by the Complainant, at the time of the filing of the Complaint, as well as at the date of this Decision, the Disputed Domain Name resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it and its affiliates have traded under the Trademark since being established in the United Kingdom in 1999 and have developed a substantial international reputation and goodwill in the Trademark.

The Complainant further contends that the Disputed Domain Name is confusingly similar to the Trademark in view of the fact that the Disputed Domain Name contains the CHEYNE and CHEYNE CAPITAL Trademarks in its entirety.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name in view of the following:

- the Disputed Domain Name was registered in June 2022, over 20 years after the Complainant's business was founded and after the Trademark was filed for registration;

- due to the reputation and international presence of the Complainant, it is reasonable to assume that the Respondent was aware of the Complainant and its rights and reputation in the Trademark at the time the Disputed Domain Name was registered;
- the Respondent chose the Disputed Domain Name because it knew: (i) that the Trademark and the Complainant's domain name were well known and associated with the Complainant; (ii) that use of the Disputed Domain Name would create an association with the Complainant's business as a result of its similarity to the Trademark and the Complainant's domain name; and (iii) that the Disputed Domain Name would as a result draw traffic to the Respondent's website;
- there is currently no website at the Disputed Domain Name. However, even if the Respondent claims to or indeed has made demonstrable preparations to use the Disputed Domain Name, the Complainant is concerned that the Disputed Domain Name may in the future be used to promote goods and services which are identical or confusingly similar to those covered by the Complainant's rights under the Trademark;
- the Complainant has not licensed or otherwise permitted or authorized the Respondent to use its Trademark or to apply for a domain name incorporating the Trademark. The Respondent's name does not include the Trademark or anything similar and it is not commonly known under the Trademark.

The Complainant claims that the Disputed Domain Name was registered and is being used in bad faith because of the following:

- the Respondent registered the Disputed Domain Name in order to unfairly benefit from the Complainant's rights in its Trademark;
- the Respondent's use of the Trademark in the Disputed Domain Name is intended to lead consumers to believe that they have reached (or have not been able to reach, as the case may be) the Complainant's website and so divert internet traffic from the Complainant thereby interfering with the Complainant's business;
- the Respondent could not have chosen or subsequently used the Trademark in the Disputed Domain Name for any reason other than to trade on the Complainant's rights in that name and to confuse Internet users and by that means to attract them to a website with a name including the Trademark with the intention to profit from the reputation and goodwill of the Trademark;
- the Respondent is currently holding the Disputed Domain Name passively;
- the Disputed Domain Name has also been used in a way that is likely to dilute the reputation of the Trademark and as such is evidence of bad faith. The mere registration alone of the Disputed Domain Name by the Respondent and not the Complainant has meant that the Trademark is not as unique as it was prior to the registration of the Disputed Domain Name;
- the Respondent's use of a privacy or proxy service to avoid the disclosure of its name and contact details is also consistent with an inference of bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant demonstrated that it has the rights in the CHEYNE and CHEYNE CAPITAL Trademarks in view of a number of registrations in different jurisdictions and continuous use of its Trademarks.

The Disputed Domain Name completely reproduces the Complainant's CHEYNE and CHEYNE CAPITAL Trademarks in combination with the generic Top-Level Domain ("gTLD") ".cloud". Pursuant to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11, the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

In view of the above, the Panel concludes that the Disputed Domain Name is identical to the Complainant's CHEYNE CAPITAL Trademark and therefore, the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

The Complainant contends that it has not licensed or otherwise permitted or authorized the Respondent to use its CHEYNE and CHEYNE CAPITAL Trademarks or to apply for any domain name incorporating the Trademarks, that the Disputed Domain Name was registered over 20 years after the Complainant's business was founded, and that the Respondent is not commonly known by the Disputed Domain Name.

According to the [WIPO Overview 3.0](#), section 2.5.1, "UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation".

In accordance with section 2.1 of the [WIPO Overview 3.0](#) while the overall burden of proof in UDRP proceedings is on the Complainant, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidences demonstrating rights or legitimate interests in the Disputed Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is generally deemed to have satisfied the second element.

The Respondent did not respond to the Complaint and did not participate in this proceeding, accordingly, the Respondent has failed to present any evidence to support any rights or legitimate interests in the Disputed Domain Name.

There is no evidence that the Respondent appears to own any CHEYNE or CHEYNE CAPITAL trademark, nor is the Respondent commonly known by the Disputed Domain Name. Furthermore, the Panel concludes that in view of the CHEYNE CAPITAL Trademark being distinctive it is highly unlikely that anybody could

legitimately adopt the Disputed Domain Name for commercial use other than for an intent to create confusion with the Complainant.

Also, taking into consideration the long use of the Complainant's CHEYNE CAPITAL Trademark, which also represents the Complainant's full corporate name that has been used long prior to the official registration of the trademark, it is implausible to assume that the Respondent was unaware of the Complainant's Trademark at the time of registration of the Disputed Domain Name.

Moreover, the website under the Disputed Domain Name is inactive from the registration date, which gives no grounds for considering the use the Disputed Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy indicates some circumstances, 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:

(i) circumstances indicating that you [respondent] have registered or you have acquired the domain name primarily for the 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.

The Panel comes to the conclusion that the Disputed Domain Name was registered and has been used in bad faith in view of the following. The Disputed Domain Name was registered long after the Complainant registered its CHEYNE and CHEYNE CAPITAL Trademarks. The Disputed Domain Name incorporates the CHEYNE and CHEYNE CAPITAL Trademarks in their entirety, therefore the Panel finds that the Respondent was well aware of the Complainant's Trademarks when it registered the Disputed Domain Name.

The Respondent obviously chose to register the Disputed Domain Name, which is confusingly similar to the Complainant's CHEYNE Trademark, and identical to the Complainant's CHEYNE CAPITAL Trademark and corporate name, with the intention to benefit from the Complainant's reputation. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

The Complainant claims that the Disputed Domain Name did not resolve to an active website at the time of filing the Complaint. The Panel notes the Respondent's non-use of the Disputed Domain Name does not prevent a finding of bad faith under the doctrine of passive holding. According to section 3.3 of the

[WIPO Overview 3.0](#), from the inception of the UDRP, panelists 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. The factors that are typically considered when 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 concealment of its identity or its use of false contact details and (iv) the implausibility of any good faith use to which the domain name may be put.

Applying these factors to the current circumstances: (i) the Complainant’s CHEYNE and CHEYNE CAPITAL Trademarks are inherently distinctive; (ii) the Respondent has not replied to the Complaint nor provided any evidence of actual or contemplated good faith use of the Disputed Domain Name; and (iii) the Panel is unable to consider any plausible good faith use to which the Disputed Domain Name could be put. These circumstances support a finding of bad faith.

In light of the above, the Panel concludes that the third element has been established by the Complainant with respect to 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 <cheynecapital.cloud> be transferred to the Complainant.

/Mariya Koval/

Mariya Koval

Sole Panelist

Date: September 6, 2022