

ADMINISTRATIVE PANEL DECISION

**B&Q Limited v. Privacy Service Provided by Withheld for Privacy ehf /
Sam Rutela**

Case No. D2022-0364

1. The Parties

The Complainant is B&Q Limited, United Kingdom, represented by Sipara, United Kingdom.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Sam Rutela, United States of America.

2. The Domain Name and Registrar

The disputed domain name <bandq-online.shop> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 2, 2022. On February 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 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 February 3, 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 amendment to the Complaint on February 7, 2022.

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 February 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 3, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 7, 2022.

The Center appointed Adam Taylor as the sole panelist in this matter on March 11, 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 operates a chain of some 300 home improvement (or “DIY”) stores in the United Kingdom and Ireland under the mark “B&Q”, which has been in use since 1969.

In 2020/2021, the Complainant’s turnover under the mark was some GBP 3.8 billion.

The Complainant operates its main website at “www.diy.com”, to which it redirects other domain names including <bandq.com> and <bandq.shop>.

The Complainant owns a number of registered trade marks for B&Q including United Kingdom Trade Mark No. 1327953, filed November 25, 1987, registered May 24, 1991, in classes 1-9, 11, 12, 16-22, 24, 26-28, 31 and 32.

The disputed domain name was registered on August 24, 2021.

As of January 12, 2022, the disputed domain name resolved to a website branded “DIY”, which purported to offer various electronic products for sale and included a fake email address. The “About Us” page of the site stated: “b&q is a British electrical retailer operating in the United Kingdom and [...] Ireland, owned by Dixons Carphone [...] Talk business with us today in any b&q PC World store.”

As of February 2, 2022, visiting the website at the disputed domain name brought up an antivirus warning of “Trojan Spyware”.

5. Parties’ Contentions

A. Complainant

The following is a summary of the Complainant’s contentions.

The disputed domain name is confusingly similar to the Complainant’s mark.

The only differences are that the ampersand in the Complainant’s mark has been replaced with the word “and”, and the mark has been supplemented by a hyphen and by the non-distinctive words “online” and the generic Top Level Domain (“gTLD”) “.shop”, which in fact reinforce the likelihood of confusion given that the Complainant is a retailer.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

There are no circumstances in which the Respondent could have acquired *bona fide* rights or legitimate interests in the disputed domain name, given the extent of the reputation acquired by the Complainant’s mark as a result of over 50 years’ use.

The Complainant has not authorised the Respondent to use its mark.

The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods and services; on the contrary, it has used the disputed domain name for malware, data mining and/or scams. The use of the “B&Q” branding is designed to create an association with the Complainant. The claim by the Respondent to be part of “Dixons Carphone”, and the invitation to visit it at “any b&q PC World store”, are clearly fictitious and deliberately misleading.

The disputed domain name was registered and is being used in bad faith.

It is inevitable that the Respondent was aware of the Complainant's mark prior to registration of the disputed domain name, given the distinctiveness and fame of the Complainant's marks. Mere registration of a domain name comprising a famous mark plus a descriptive term creates a presumption of bad faith.

The Respondent could not legitimately use the disputed domain name without infringing the Complainant's mark.

The disputed domain name has been used to resolve to malware and data mining websites that harm the Complainant's reputation and create confusion as to the association of the Complainant with other unrelated retailers.

The Complainant's use of the disputed domain name to resolve to a website referring to "B&Q" and "DIY" shows that the Respondent set out to mislead Internet users into thinking that the Respondent's site was associated with the Complainant.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established registered rights in the mark B&Q, as well as unregistered trade mark rights deriving from the Complainant's extensive and longstanding use of that mark.

Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") makes clear that, where the relevant trade mark is recognisable within the disputed domain name, the addition of other terms, whether descriptive or otherwise, would not prevent a finding of confusing similarity under the first element.

Here, the Complainant's distinctive trade mark is readily recognisable within the disputed domain name and, accordingly, neither the addition of a hyphen, nor the descriptive term "online" or the gTLD ".shop" prevent a finding of confusing similarity. Nor does the irrelevant substitution of the ampersand in "B&Q" by the word "and".

The Complainant has therefore established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

As explained in section 2.1 of [WIPO Overview 3.0](#), the consensus view is that, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Here, the Complainant has not licensed or otherwise authorised the Respondent to use its trade mark. Paragraph 4(c) of the Policy gives examples of circumstances which, if proved, suffice to demonstrate that a respondent possesses rights or legitimate interests.

As to paragraph 4(c)(i) of the Policy, for reasons explained below the Panel considers that the Respondent has used the disputed domain name to intentionally attempt to attract, confuse and profit from Internet users seeking the Complainant's goods and/or services. Such use of the disputed domain name could not be said to be *bona fide*. Moreover, the illegal use of the disputed domain name for distributing malware, or other types of fraud, can never confer rights or legitimate interests upon the Respondent.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy apply in the circumstances of this case.

The Panel finds that the Complainant has established a *prima facie* case of lack of rights or legitimate interests and there is no rebuttal by the Respondent.

For the above reasons, the Panel concludes that the Complainant has established the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

In the Panel's view, it is obvious that the Respondent was aware of the Complainant's mark when it registered the disputed domain name.

Not only has the Respondent used the Complainant's distinctive and well known mark within the disputed domain name itself and on the "About Us" page of its website ("b&q"), but the site is branded "DIY", which reflects exactly the nature of the Complainant's retail stores as well as the Complainant's own website at "www.diy.com".

The Panel further notes that the Respondent has not appeared in this proceeding to deny the Complainant's assertions including that the Respondent used the disputed domain name for malware, data mining and/or scam websites, and that the Respondent has made a false attempt to connect the website with another, unrelated, well-known United Kingdom retailer.

In these circumstances, the Panel has little difficulty in concluding that paragraph 4(b)(iv) of the Policy applies. By using the disputed domain name, comprising the Complainant's distinctive trade mark, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trade mark.

For the above reasons, the Panel considers that the Complainant has established the third element of paragraph 4(a) 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 <bandq-online.shop> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: March 25, 2022