

ADMINISTRATIVE PANEL DECISION

Empire Wine & Spirits, LLC v. Domain Administrator, See
PrivacyGuardian.org / Telesphore TETA
Case No. D2022-0543

1. The Parties

The Complainant is Empire Wine & Spirits, LLC, United States of America (“United States” or “US”), represented by Whiteman Osterman & Hanna LLP, United States.

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States / Telesphore TETA, Cameroon.

2. The Domain Name and Registrar

The disputed domain name <empirewineliqor.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 11, 2022. On February 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 17, 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 18, 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 March 1, 2022. The Complainant filed a further amendment to the Complaint on March 4, 2022, to clarify an administrative matter.

The Center verified that the Complaint together with the amendments 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 March 7, 2022. In accordance with the Rules, paragraph 5,

the due date for Response was March 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 29, 2022.

The Center appointed Jane Seager as the sole panelist in this matter on April 5, 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 retail business, selling wine and liquor. The Complainant operates a physical store in Albany, New York, United States, as well as an online store at the website "www.empirewine.com" (the "Complainant's website"). The Complainant ships its products to some 34 States in the United States.

The Complainant has secured the following trademarks for use in connection with its alcoholic beverages retail business:

- New York State Trademark Registration No. S23593, EMPIRE WINE, registered on March 29, 2016; and
- New York State Trademark Registration No. S23592, EMPIRE WINE & LIQUOR OUTLET, registered on March 29, 2016.

The disputed domain name was registered on July 4, 2021, using a privacy service. The underlying registrant of the disputed domain name was disclosed as being located in Cameroon.

The disputed domain name resolves to a website (the "Respondent's website") purporting to offer alcoholic beverages for sale. The Respondent's website features the words "Empire Wine" in its top left corner, together with a graphic of a man carrying a bottle of wine over his shoulder, the same as that used by the Complainant as a logo on its website and as a favicon.

5. Parties' Contentions

A. Complainant

The Complainant asserts rights in the trademarks EMPIRE WINE and EMPIRE WINE & LIQUOR OUTLET. The Complainant submits that the disputed domain name is confusingly similar to its trademarks.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant asserts that the Respondent is not connected with the Complainant in any way, nor has the Respondent received any authorization to make use of the Complainant's trademarks. The Complainant argues that the Respondent is making unauthorized use of the Complainant's trademarks to mislead and divert consumers away from the Complainant's business, thereby diluting the Complainant's strong reputation in the wine and liquor industry.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant asserts that by registering the disputed domain name, the Respondent intended to disrupt the Complainant's business. The Complainant submits that the Respondent, a competitor of the Complainant, is attempting to direct consumers away from the Complainant. The Complainant notes in this regard that the Respondent appears to have copied images from the Complainant's website, and submits that the Respondent knowingly used and relied on the Complainant's reputation and business identity for commercial gain. The Complainant states that it has received numerous inquiries from confused consumers regarding the Respondent's website.

The Complainant requests transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

In order to prevail, the Complainant must demonstrate, on the balance of probabilities, that it has satisfied the requirements of paragraph 4(a) of the Policy:

- (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 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 Complainant has provided copies of its trademark registrations for EMPIRE WINE and EMPIRE WINE & LIQUOR OUTLET, registered in New York State, United States, the registration details of which are set out in the factual background section above.

When considering UDRP standing, panels tend to carefully review certain types of automatic/unexamined registered trademarks such as US state registrations (as opposed to US federal registrations); these are not accorded the same deference and may not on their own satisfy the UDRP's "rights in a mark" standing test; see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.2.

The Panel notes that the Complainant has been engaged in the operation of a retail business selling alcoholic beverages for well over 10 years. The Complainant operates a sizeable physical store, as well as a comprehensive online sales platform. The Complainant also enjoys a well-established Internet presence with some 3,700 "likes" on Facebook, and has received over 900 Google reviews.¹ As set out below, it is clear that the Respondent has sought to target the Complainant through registration of the disputed domain name. The Panel finds that the Complainant has established rights in the trademarks EMPIRE WINE and EMPIRE WINE & LIQUOR OUTLET for purposes of standing under the UDRP, through their registration with New York State and the Complainant's use of the same in commerce.

The disputed domain name comprises the Complainant's EMPIRE WINE trademark as its leading element, omitting the space between the elements "empire" and "wine" (a space being incapable of representation *per se* in a domain name), together with the term "liquor", under the generic Top-Level Domain ("gTLD") ".com". The addition of the term "liquor" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's EMPIRE WINE trademark; see [WIPO Overview 3.0](#), section 1.8.

The disputed domain name also comprises elements of the Complainant's EMPIRE WINE & LIQUOR OUTLET trademark, omitting the spaces between the words making up the mark, the ampersand, and the final word "outlet". Despite these omissions, the dominant elements of the Complainant's EMPIRE WINE &

¹ Noting in particular the general powers of a panel articulated *inter alia* in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision; see [WIPO Overview 3.0](#), section 4.8.

LIQUOR OUTLET trademark remain recognizable in the disputed domain name; see [WIPO Overview 3.0](#), section 1.7.

The gTLD “.com” may be disregarded for purposes of comparison under the first element; see [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the disputed domain name to be confusingly similar to the EMPIRE WINE and EMPIRE WINE & LIQUOR OUTLET trademarks in which the Complainant has rights. The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

As noted above, the Respondent’s website purports to offer alcoholic beverages for sale, making use of a similar colour scheme, font, and graphics as those used on the Complainant’s website. The Respondent’s website lists a physical contact address in Staten Island, New York, United States. Based on information provided by the Complainant, it appears that the Respondent has made unauthorized use of the physical address of a third party, as well as images of that third party’s business, on the Respondent’s website. The Panel further notes that the underlying registrant appears to be located in Cameroon, while the Respondent’s website purports to serve customers in the United States.

The Panel infers that the Respondent is not operating a legitimate business within the meaning of paragraph 4(c)(i) of the Policy. Rather, the Respondent is engaged in the furtherance of an online scheme aimed at misleading potential customers of the Complainant into making payments for goods that the Respondent has no intention of supplying. Prior UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent; see [WIPO Overview 3.0](#), section 2.13.

There is no evidence that the Respondent is commonly known by the disputed domain name pursuant to paragraph 4(c)(ii) of the Policy, nor is the Respondent making legitimate noncommercial or fair use of the disputed domain name as contemplated by paragraph 4(c)(iii) of the Policy.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent’s intent to target the Complainant can be readily inferred from the nature of the disputed domain name itself, which resembles the domain name used by the Complainant, altered only by the addition of the term “liquor”, which may be read as a direct reference to the Complainant’s business. Such intent may also be inferred from the contents of the Respondent’s website, which features the words “Empire Wine” in a similar font to that used on the Complainant’s website, together with the Complainant’s logo of a man carrying a bottle of wine over his shoulder. The Panel is of the view that the Respondent registered the disputed domain name in an attempt to create a misleading impression of association with the Complainant, in bad faith. The Respondent’s registration of the disputed domain name using a privacy service, together with the provision of what appear to be inaccurate or incomplete underlying registrant details, and the use of the contact details of an unrelated third party on the Respondent’s website, amount to further evidence of the Respondent’s bad faith; see [WIPO Overview 3.0](#), section 3.6.

As noted above, the Respondent appears to be engaged in a deceptive online scheme aimed at inducing potential customers of the Complainant into making payments for goods that the Respondent has no intention of providing. Given that the use of a domain name for *per se* illegitimate activity such as phishing can never confer rights or legitimate interests on a respondent, such behaviour is manifestly considered evidence of bad faith; see [WIPO Overview 3.0](#), section 3.1.4. By using the disputed domain name in the manner described above, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s

trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and the goods offered for sale therein, in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

The Panel finds that the disputed domain name was registered and is being used in bad faith. The Complainant has satisfied the requirements of 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 <empirewineliquor.com> be transferred to the Complainant.

/Jane Seager/

Jane Seager

Sole Panelist

Date: April 19, 2022