

ADMINISTRATIVE PANEL DECISION

Fortnum & Mason PLC v. Domains by Proxy LLC / Carolina Rodrigues,
Fundacion Comercio Electronico
Case No. D2022-0961

1. The Parties

The Complainant is Fortnum & Mason PLC, United Kingdom (“UK”), represented by Boulton Wade Tennant LLP, UK.

The Respondent is Domains by Proxy LLC, United States of America (“United States” or “US”) / Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 18, 2022. On March 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 22, 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 March 23, 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 on March 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 March 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 29, 2022.

The Center appointed Rodrigo Velasco Santelices as the sole panelist in this matter on May 17, 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 the owner of the well-known FORTNUM & MASON trademark. They have multiple registrations for the word mark FORTNUM & MASON in a variety of jurisdictions. A list of the Complainant's trademark registrations can be seen at Annex 4. These include many registrations across multiple jurisdictions including Europe, Hong Kong, China, the United States and the United Arab Emirates. Many of these trademark registrations are decades old.

From the list seen in Annex 4 of the Complaint, the Complainant noted in particular the following trademark registrations:

- European Union Trademark Registration No. 9036278 FORTNUM & MASON, registered on October 28, 2010;
- US Trademark Registration No. 4336734 FORTNUM & MASON, registered on May 21, 2013; and
- US Trademark Registration No. 939980 FORTNUM & MASON, registered on August 1, 1972.

Copies of the registration certificates for the registrations individually listed above are attached at Annex 5 of the Complaint.

The Complainant has focused the Complaint on the trademark registrations listed above as they are for the mark FORTNUM & MASON and in particular there are two US Trademark Registrations that cover the USA; the relevance of which is discussed in this case.

The Complainant states that the mark FORTNUM & MASON has been used extensively with respect to a large department store in Piccadilly in central London, UK, with a history from 1707, which is known for retailing a very wide range of items, from soaps and pot pourri to silverware, from candles to jewelry, from cushions to tableware, from picnic accessories to tea sets, from rugs to electronics, from clothing to Christmas crackers. In addition, the mark is particularly famous for food and drink products, especially chocolates and biscuits, and for the supply of food and drink products in hampers. It is also well known for teas and for Afternoon Teas, which are served from various salons and restaurants within the store. There are also Fortnum & Mason shops at several travel centers around the world including London Heathrow airport and St Pancras international station, the first of which, at Heathrow, opened more than 6 years ago and besides the long-established store in Piccadilly, there are also stores in the City of London and Hong Kong, China.

It is also possible to purchase the Complainant's goods through partners in other countries, for example, the United States of America, Japan and across Europe; and the online portal at "www.fortnumandmason.com" is a very important part of the Complainant's business. This was especially the case in 2020 during lockdown in London, but even before that it has been an extremely popular website that has attracted 29 million visitors and over 800,000 orders were placed on it in the years 2016, 2017, 2018, and 2019.

The Complainant submits that it is the clear owner of rights in FORTNUM & MASON by virtue of a number of trademark registrations, and over its long history it has become extremely well known, both in the UK and around the world, for the goods and services provided under the FORTNUM & MASON mark.

The Complainant also notes that it is the owner of the domain name <fortnumandmason.com>, which was registered on April 3, 1997.

The disputed domain name was registered on September 3, 2021. The disputed domain name redirects to the Complainant's own website, although sometimes it also redirects to other third-party websites.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name contains the identical dominant and distinctive elements of the Complainant's rights. The "&" of the Complainant's trademark rights would be understood as meaning "and". The average Internet user would also expect the Complainant to have reproduced the "&" as "and" in the domain name string; especially for a brand, which has existed online for as long as the Complainant has.

The disputed domain name is essentially identical in all but one element to the Complainant's rights. It wholly reproduces the Complainant's core mark and primary domain name.

The only difference between the disputed domain name and the Complainant's trademark and domain name is the addition of the geographical indicator "USA". This would be readily understood as indicating that the website is the US targeted version of the Complainant's website.

Section 1.8 of the [WIPO Overview 3.0](#) is noted in this regard where it states that:

"Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity [...]"

This is clearly the case here. A well-known geographical indicator of the United States of America "USA", has been added to the Complainant's well known and internationally renowned mark. This does nothing to dilute the obvious similarities. It would simply be seen as indicating the country targeted by the Complainant.

There is therefore confusing similarity. Consumers would believe that the disputed domain name resolves to a website run and operated by the Complainant for their US customers.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel considers that all the information provided by the Complainant attests that the disputed domain name is confusingly similar to the Complainant's trademark FORTNUM & MASON.

Further, the Panel agrees with the Complainant's contentions that the addition of the term "USA" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark, and the addition of a geographical term -USA- can be disregarded when comparing the similarities between a domain name and a trademark. See Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Therefore, this first requirement under the Policy has been satisfied.

B. Rights or Legitimate Interests

The Respondent has not replied to the Complaint's contentions, and the Respondent has not alleged any possible rights or legitimate interests it may have in the disputed domain name. Neither has the Respondent refuted the allegations made by the Complainant.

The Panel has not found the occurrence of any of the circumstances mentioned by paragraph 4(c) of the Policy. Quite the contrary, the Complainant has effectively demonstrated to be the owner of the registered trademarks, including the company name FORTNUM & MASON, which are prior to the Respondent's registration of the disputed domain name, and that it has not licensed the use or exploitation of its trademark to the Respondent.

Accordingly, and considering the unrebutted *prima facie* case made out by the Complainant, the Panel considers that the Complaint has also fulfilled the second element required by the Policy.

C. Registered and Used in Bad Faith

This third element requires the Complainant to prove that the disputed domain name was registered in bad faith and was being used in bad faith.

According to paragraph 4(b) of the Policy, there are a variety of circumstances to evidence and demonstrate the bad faith of the respondent. In this regard, paragraph 4(b)(iv) of the Policy states: "The following 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:

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

In this case, it appears that the Respondent knew of the Complainant. They have replicated the core of the Complainant's trademarks with the only difference being a geographical indicator, which would suggest to the visitor it was the US-focused website of the Complainant. The disputed domain name has even redirected to the website of the Complainant. Panels have found that a respondent redirecting a domain name to the complainant's website can establish bad faith insofar as the respondent retains control over the redirection thus creating a real or implied ongoing threat to the complainant (Section 3.1.4 of the [WIPO Overview 3.0](#)). This all points to bad faith use and registration of the domain name.

The Complainant trademark is well-known. Thus, a simple search on the Internet would have revealed the Complainant's presence and reputation of the trademark FORTNUM & MASON.

The Panel finds the Respondent must have had knowledge of the Complainant's mark and its rights therein at the time the Respondent registered the disputed domain name. These findings are based on: (i) the Complainant's trademark having a strong reputation and being widely known; (ii) the disputed domain name is confusingly similar to the Complainant's trademark; (iii) the above finding of the Respondent having no rights or legitimate interests in the disputed domain name.

Given the similarity of the disputed domain name with the Complainant's trademark, the Panel agrees that the Respondent's motive to register the disputed domain name can only have been to create a likelihood of confusion with the Complainant's trademark within the meaning of paragraph 4(b)(iv) of the Policy. Panels have consistently found that the mere registration of domain names that are identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity – as is the case here – can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

This is especially so since the disputed domain name incorporated the Complainant's company name and trademark FORTNUM & MASON in its entirety, plus the geographical indicator USA. As stated above, the disputed domain name is confusingly similar as Internet users will directly link it to the Complainant, e.g. as referring to a Complainant's subsidiary in the United States of America.

Consequently, for all these reasons, the Panel finds that the Complainant has met the third element required by 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, <fortnumandmasonusa.com> be transferred to the Complainant.

/Rodrigo Velasco Santelices/

Rodrigo Velasco Santelices

Sole Panelist

Date: May 25, 2022