

## **ADMINISTRATIVE PANEL DECISION**

William Grant & Sons Limited v. Mohd Glenfiddichs  
Case No. D2022-3529

### **1. The Parties**

The Complainant is William Grant & Sons Limited, United Kingdom, represented by Demys Limited, United Kingdom.

The Respondent is Mohd Glenfiddichs, India.

### **2. The Domain Name and Registrar**

The disputed domain name <glenfiddichs.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 September 23, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on September 23, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint.

The Center sent an email communication to the Complainant on September 26, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amended complaint the Complaint. The Complainant filed an amended Complaint on September 27, 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 September 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 19, 2022. Aside from informal communications on September 27, 2022, and October 1, 2022, the Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on October 25, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on November 1, 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 was founded in 1887 in the United Kingdom and located in Scotland. The Complainant markets and distributes Scotch whisky and other spirits, amongst which the GLENFIDDICH, BALVENIE, GRANT'S Scotch whiskies, the HENDRICK'S gin and the TULLAMORE DEW Irish whisky.

The Complainant has operated the <glefiffich.com> domain name since August 1995, and is the owner of the following, amongst others, trademark registrations (Annex 9 to the Complaint):

- United Kingdom Trademark registration No. UK00000809941 for GLENFIDDICH, registered on August 26, 1960, successively renewed, in International Class 33;
- European Union Trade mark registration No. 000192575 for GLENFIDDICH, registered on October 29, 1998, successively renewed, in International Class 33; and
- United States of America Trademark registration No. 3,980,808 for GLENFIDDICH, registered on June 21, 2011, successively renewed, in International class 33.

The disputed domain name <glenfiddichs.com> was registered on June 8, 2022 and presently does not resolve to an active webpage. In the past, the disputed domain name resolved to a parked webpage containing pay-per-click ("PPC") links to websites operated by the Complainant's competitors or other unrelated third parties.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts that GLENFIDDICH is the world best-selling single-malt whisky with sales in excess of a million cases a year; having the Complainant's GLENFIDDICH range received more awards since 2000 than any other single malt Scotch whisky in two of the world's most prestigious competitions, the International Wine & Spirit Competition and the International Spirits Challenge.

The Complainant further states that its agent wrote to the Respondent on July 21, 2022, using the registrar's contact form but did not receive a response (Annex 08 to the Complaint).

In addition to that, the Complainant notes that after the Respondent's details were revealed, the Respondent's contact details, namely its name "Mohd Glenfiddichs", are on balance more likely than not incorrect given that the name GLENFIDDICH is derived from the Scottish Gaelic "Gleann Fhiodhaich" meaning "Valley of the Deer", which is reflected in the Complainant's GLENFIDDICH stag logo. As such, the Complainant observes that it is more likely that the Respondent used false contact details, namely the "Glenfiddichs" surname, as plausible justification for registering the disputed domain name, rather than the "Glenfiddichs" being the Respondent's actual surname.

In the Complainant's view, the disputed domain reproduces the Complainant's GLENFIDDICH trademark in its entirety with the addition of the letter "s", thus being clearly recognizable in the disputed domain name and not adding the letter "s" capable of adding any distinctiveness thereto.

Moreover, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name given that:

- (i) the Respondent is not commonly known by the disputed domain name, not being “Glenfiddichs” the Respondent’s actual surname, nor owning the Respondent any trademarks incorporating the terms GLENFIDDICH or GLENFIDDICHS, or having the Respondent ever traded legitimately under the business names GLENFIDDICH or GLENFIDDICHS;
- (ii) the Respondent is not a licensee of the Complainant and has not received any permission or consent from the Complainant to use any of its marks; and
- (iii) the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services under the Policy given that the disputed domain name resolves to a pay-per-click advertising webpage containing third-party commercial advertising links related to the Complainant’s business and activities.

As to the registration of the disputed domain name in bad faith the Complainant argues that its trademark is well-known internationally, having the Respondent specifically targeted the Complainant when registering the disputed domain name and having the Respondent intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s website or other on-line location, by creating a likelihood of confusion with the Complainant’s well-known GLENFIDDICH brand and mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or other on-line location.

In addition to that, the Complainant contends that the use of the disputed domain name in connection with pay-per-click advertising characterizes the Respondent’s bad faith regardless of whether it was directly placed by the registrant or its registrar of record.

According to the Complainant, further indicatives of the Respondent’s bad faith are the absence of reply to the Complainant’s agent communications sent prior to this proceeding as well as the use of privacy protection services and the indication of false contact details.

## **B. Respondent**

On September 27, 2022, the Respondent sent an informal communication to the Center stating “I just want to know that what you want from my end, actually I don’t know what’s happening and what are the things that have to be done from my side.”

On October 1, 2022, the Respondent sent a second informal communication stating that “Firstly apologies for the late reply, I just want to inform you that I’m not doing any business on the domain and want to sale that domain or waiting for expiring of this particular domain. If you find any business running on this domain then you can proceed for legal action, but I can’t do anything for this just having 2 options as mentioned above, that if someone purchase it or will wait for expire. Waiting for your positive response.”

The Respondent did not formally reply to the Complainant’s contentions.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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 has been registered and is being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

## **A. Identical or Confusingly Similar**

The Complainant has established its rights in the registered GLENFIDDICH trademark.

The Panel finds that the disputed domain name reproduces the Complainant's GLENFIDDICH trademark in its entirety, only adding an "s" at its end, and is therefore confusingly similar to it. It is well accepted that the first element functions primarily as a standing requirement and that the 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](#)"), sections 1.7 and 1.10).

The first element of the Policy has therefore been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate a respondent's rights to or legitimate interests in a disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, did not formally respond to the Complaint, and merely indicated that it was "not doing any business on the domain" and wanted "to sale that domain", failing thereby to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to or legitimate interests in the disputed domain name. Nevertheless, the burden of proof is still on the Complainant to make a *prima facie* case against the Respondent.

According to the information provided by the Registrar concerning the registrant of the disputed domain name, the registrant's name is "Mohd Glenfiddichs". The Panel notes that there is no evidence of the Respondent's name or surname being "Glenfiddichs". In that sense, the lack of evidence as to whether the Respondent is commonly known by the disputed domain name or the absence of any trademarks registered by the Respondent corresponding to the disputed domain name, indicates that the Respondent does not hold rights or legitimate interests in the disputed domain name.

Also, both the past use of the disputed domain name in connection with the PPC links relating to Complainant's competitors, and the present passive holding of the disputed domain name cannot characterize a *bona fide* use of the disputed domain name.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

The second element of the Policy has therefore been established.

## **C. Registered and Used in Bad Faith**

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant who is the owner

of a trademark relating to the disputed domain name or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed 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 disputed 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 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 registration and use of the disputed domain name in bad faith can be found in the present case in view of the following circumstances:

(i) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name;

(ii) the past use of the disputed domain name in connection with PPC links;

(iii) the well-known status of the Complainant's trademark and the nature of the disputed domain name (reproducing the entirety of the Complainant's trademark) suggests rather a clear indication of the Respondent's registration and holding of the disputed domain name in bad faith;

(iv) the lack of reply to the Complainant's communications prior to this proceeding.

For the reasons as those stated above, the Panel finds that the disputed domain name was registered and is being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

The third element of the Policy has therefore been established.

## **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 <glenfiddichs.com> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: November 15, 2022