

ADMINISTRATIVE PANEL DECISION

Skrewball Spirits, LLC v. Privacy Protection / Alecia Barr
Case No. DCO2022-0013

1. The Parties

The Complainant is Skrewball Spirits, LLC, United States of America (“United States” or “U.S.”), represented by SafeNames Ltd., United States.

The Respondent is Privacy Protection, United States / Alecia Barr, United States.

2. The Domain Name and Registrar

The disputed domain name <skrewballwhiskey.co> (the “Disputed Domain Name”) is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2022. On February 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 9, 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 10, 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 February 10, 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 February 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 14, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on March 16, 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 San Diego, California company launched in July 2018 by founders Steven and Brittany Yeng. The Complainant is known for the sale of its peanut butter-flavored whiskey, which has expanded from its hometown market to include nationwide and international success. The Complainant first partnered with Infinium Spirits to expand across the United States, and soon extended its partnerships with Republic National Distributing Company and Breakthru Beverage Group, which encompass over 75 percent of the nationwide marketplace. The sales of the Complainant grew exponentially, and it has become one of the fastest-growing spirits companies on the U.S. market. The Complainant now offers its product in 5 different sizes across a wide range of retailers.

The Complainant, its affiliates, subsidiaries and associated companies own the following trademarks in the United States and various jurisdictions worldwide, including, but not limited to: SKREWBALL, United States Trademark Registration No. 5,838,602, registered on August 20, 2019, in international class 33; SKREWBALL SPIRITS, United States Trademark Registration No. 5,687,912, registered on February 26, 2019, in international class 33; SKREWBALL, European Union Trademark Registration No. 018155101, registered on September 16, 2020 in international classes 21, 25 and 33; and SKREWBALL SPIRITS, International Registration No. 1421750, registered on July, 13, 2018, in international class 33 (hereinafter collectively referred to as the “SKREWBALL Mark”).

The Complainant has spent a considerable amount of time, money and effort promoting, marketing and using the SKREWBALL Mark to identify and distinguish its goods domestically and internationally. As a result, the SKREWBALL Mark has acquired distinctiveness in its market worldwide with customers that rely on the brand’s name, quality and reputation.

The Complainant owns the domain name <skrewballwhiskey.com>, which resolves to its official website at “www.skrewballwhiskey.com”, and which provides the Complainant’s product descriptions and history, as well as direct links to online retailers for purchase of the Complainant’s products. The Complainant also owns the <skrewballwhiskey.ca>, <skrewballwhiskey.eu>, and <skrewballwhiskey.net> domain names.

The Disputed Domain Name was registered on December 8, 2021, and resolves to an inactive website with no substantive content. Although the Respondent does not use the Disputed Domain Name to host an active website, the Complainant submits that the Respondent has used the Disputed Domain Name to facilitate email phishing attacks. The Respondent used the Disputed Domain Name to perpetuate a phishing scheme in which the Respondent configured the Disputed Domain Name for email functions and used the email address “[...]@skrewballwhiskey.co” to impersonate an officer of the Complainant and send fraudulent emails purportedly from the Complainant to its customers. The purpose of the emails was to mislead the Complainant’s customers into sending payments to the Respondent. Moreover, the Respondent, in a further attempt to impersonate the Complainant, attempted to obtain sensitive information regarding the Complainant’s financial status. Following the phishing attack using the Disputed Domain Name, the Complainant’s representatives sent a successful takedown request to the Registrar on December 22, 2021.

5. Parties’ Contentions

A. Complainant

The following are the Complainant’s contentions;

- the Disputed Domain Name is confusingly similar to the Complainant’s SKREWBALL Mark;

- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith; and
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(a) of the Policy.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (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.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the SKREWBALL Mark.

It is uncontroverted that the Complainant has established rights in the SKREWBALL Mark based on its several years of use as well as its registered trademarks for the SKREWBALL Mark in the United States and various jurisdictions worldwide. The general consensus is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the SKREWBALL Mark. Moreover, the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Thus, the Panel finds that the Complainant has rights in the SKREWBALL Mark.

The Disputed Domain Name consists of the SKREWBALL Mark in its entirety followed by the dictionary or descriptive term "whiskey", and then followed by the country code Top-Level Domain ("ccTLD") ".co". It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), "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 under the first element". For example, numerous UDRP decisions have reiterated that the addition of a dictionary or descriptive term to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Finally, the addition of a ccTLD such as “.co” in a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#); and [WIPO Overview 3.0](#), section 1.11. Thus, the Disputed Domain Name is confusingly similar to the Complainant’s SKREWBALL Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name at issue. Once such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1. In this case, the Panel finds that the Complainant has made out a *prima facie* case. In particular, the Respondent has not submitted any arguments or evidence to rebut the Complainant’s *prima facie* case and there is no evidence in the record that the Respondent is in any way associated with the Complainant.

Moreover, the Complainant has not authorized, licensed, or otherwise permitted the Respondent to use its SKREWBALL Mark in the Disputed Domain Name. The name of the Respondent has no apparent connection to the Disputed Domain Name that would suggest that it is related to a trademark or service mark in which the Respondent has rights. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any name similar to it nor has the Respondent made any demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

Furthermore, the Respondent used the Disputed Domain Name for the purpose of perpetrating a fraudulent phishing scheme on unwitting customers of the Complainant. The Respondent has not disputed the Complainant’s contentions or responded to this matter in any way. “UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.” [WIPO Overview 3.0](#), section 2.13.1. Given the phishing scheme that the Respondent operated by reconfiguring the Disputed Domain Name to impersonate the Complainant’s president and obtain the Complainant’s confidential information, the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name.

Moreover, the composition of the Disputed Domain Name, comprising the entirety of the SKREWBALL Mark plus the additional term “whiskey”, related to the Complainant’s products, which (especially in the absence of an explanation from the Respondent) does not seem to be a mere coincidence, carries a risk of implied affiliation and cannot constitute fair use here, as it may effectively suggest sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent’s bad faith pursuant to paragraph 4(b) of the Policy.

First, the Respondent used the Disputed Domain Name to impersonate the Complainant and perpetrate a phishing scheme directed against the Complainant, a strong indication of bad faith. The Respondent’s phishing scheme to send a fraudulent email purporting to come from the Complainant’s president, seeking

payments from the Complainant's customers, evidences a clear intent to disrupt the Complainant's business, deceive individuals, and trade off the Complainant's goodwill by creating an unauthorized association between the Disputed Domain Name and the Complainant's SKREWBALL Mark. See *Banco Bradesco S.A. v. Fernando Camacho Bohm*, WIPO Case No. [D2010-1552](#). Such conduct is emblematic of the Respondent's bad faith registration and use of the Disputed Domain Name. See *Petróleo Brasileiro S.A. - Petrobras v. AK Bright*, WIPO Case No. [D2013-2063](#) (considering the reputation of the complainant and the emails sent by the respondent using the complainant's trademark, the respondent is held to have registered and used the disputed domain name in bad faith). Further, UDRP panels have found that email-based phishing schemes that use a complainant's trademark in the disputed domain name are evidence of bad faith. See, e.g., *DeLaval Holding AB v. Registration Private, Domains By Proxy LLL / Craig Kennedy*, WIPO Case No. [D2015-2135](#).

Second, the registration of a domain name that is confusingly similar to a trademark by an entity that has no relationship to that mark may be sufficient evidence of bad faith. See *Ebay Inc. v. Wangming*, WIPO Case No. [D2006-1107](#); and *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#). Based on the circumstances here, the Respondent registered and is using the Disputed Domain Name in bad faith to target the Complainant's SKREWBALL Mark for commercial gain.

Finally, Panel finds that the Respondent knew that the Complainant had rights in the SKREWBALL Mark when registering the Disputed Domain Name. The Respondent used the Disputed Domain Name to impersonate the Complainant's president, making clear that the Respondent was well aware of the Complainant and its SKREWBALL Mark, thus demonstrating bad faith. It therefore strains credulity to believe that the Respondent had not known of the Complainant or its SKREWBALL Mark when registering the Disputed Domain Name. See *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. [D2001-0763](#) (respondent's knowledge of the registration and use of a trademark prior to registering the domain name constitutes bad faith). The use of the Disputed Domain Name that incorporated the SKREWBALL Mark in its entirety to configure email addresses through which the Respondent disguised itself as an officer of the Complainant, was symbolic of bad faith registration and use. Moreover, the use of the Complainant's president's name further confirms the Respondent's knowledge of the Complainant's business and trademark. In sum, the Panel finds that the Respondent had actual knowledge of the Complainant's SKREWBALL Mark when registering the Disputed Domain Name.

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

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 <skrewballwhiskey.co> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: March 30, 2022