

## **ADMINISTRATIVE PANEL DECISION**

ekaterra Group IP Holdings B.V. v. Mohammed Al-Sarraf, Wingmen Media LTD

Case No. D2023-0661

### **1. The Parties**

Complainant is ekaterra Group IP Holdings B.V., Netherlands, represented by CSC Digital Brand Services Group AB, Sweden.

Respondent is Mohammed Al-Sarraf, Wingmen Media LTD, United Kingdom.

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

The disputed domain names <liptontecas.com>, and <liptonyellowlabelteas.com> are registered with Paragon Internet Group Ltd (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 13, 2023. On February 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 20, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted For Privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on February 21, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on February 21, 2023.

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 Respondent of the Complaint, and the proceedings commenced on February 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 14, 2023. Respondent did not submit a formal response. Accordingly, the Center notified the Parties of Respondent’s default on March 15, 2023. On March 15, 2023, Respondent sent an e-mail stating that it had been ill. On March 16, 2023, the Center notified the Parties that they may

request suspension for settlement discussions by March 23, 2023. On March 16, 2023, Complainant asked Respondent to confirm that it agreed to transfer the disputed domain names. On March 17, 2023, Respondent responded discussing settlement conditions. On the same day, Complainant proposed settlement conditions and requested Respondent's confirmation.

The Center appointed Ingrida Kariņa-Bērziņa as the sole panelist in this matter on March 24, 2023. 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.

The Panel noticed that the record indicated that there is a settlement possibility between the Parties. On April 12, 2023, the Panel issued Procedural Order No. 1 inviting Respondent, by April 17, 2023, to provide a response to Complainant's proposed terms of a settlement agreement as expressed in its email of March 17, 2023, and inviting Complainant to consider suspension of the proceedings based on Respondent's possible response. Both Parties responded on April 12, 2023. The Parties did not agree to a settlement. Accordingly, the Panel has proceeded to issue this Decision on the merits.

#### **4. Factual Background**

Lipton is a British brand of tea, owned by Complainant. The company is named after its founder, Sir Thomas Lipton, who first sold tea branded as "Lipton Yellow Label" in 1890. Today, Complainant's products are available in 100 countries worldwide. Complainant registered the domain name <liptontea.com> on January 26, 1999.

Complainant is the proprietor of numerous trademark registrations, including the following:

- United Kingdom Trade Mark No. UK00000408088 for LIPTON (word mark), registered on September 23, 1920 for goods in class 30;
- United Kingdom Trade Mark No. UK00001108810 for LIPTON YELLOW LABEL TEA (device mark), registered on February 2, 1979 for goods in class 30;
- European Union Trade Mark No. 001531227 for LIPTON (word mark), registered on March 19, 2001 for goods and services in classes 5, 29, 30 and 32.

The disputed domain names <lipton teas.com> and <liptonyellowlabelteas.com> were registered on November 17, 2016. They do not resolve to active websites.

The record states that Complainant sent a cease-and-desist letter to Respondent on December 29, 2022 and January 10, 2023, requesting to transfer the disputed domain names in return for reimbursement of registration costs. Respondent responded on January 11, 2023, stating that it had invested more than GBP 10,000 developing its e-commerce platform, and proposed running an e-commerce site devoted to Complainant's LIPTON products, which are its bestsellers, in partnership with Complainant.

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

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

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that the disputed domain names comprise Complainant's LIPTON mark along with the descriptive terms "teas" and "yellow label teas." The fact that such terms are closely linked and associated with Complainant's brand and trademark only serves to underscore and increase the confusing similarity between the disputed domain names and Complainant's mark.

Under the second element, Complainant states that Respondent is not sponsored by or affiliated with Complainant in any way, nor has Complainant given Respondent permission to use Complainant's trademarks in any manner, including in domain names. Complainant has not licensed, authorized, or permitted Respondent to register domain names incorporating Complainant's mark. Respondent is using the disputed domain names to direct Internet users to websites that resolve to blank pages that lack content. Respondent has offered to sell the disputed domain names to Complainant for an amount that far exceeds Respondent's out-of-pocket expenses in registering the disputed domain names. The disputed domain names were registered long after Complainant established its rights in its LIPTON mark.

Under the third element, Complainant states that its LIPTON mark is known internationally, with trademark registrations across numerous countries. Complainant has marketed and sold its goods and services using this mark since 1893, which is significantly before Respondent's registration of the disputed domain names on November 17, 2016. Respondent has demonstrated specific knowledge of Complainant, whose products it wished to resell. The LIPTON mark is well-known. The disputed domain names are being passively held.

Complainant requests transfer of the disputed domain names.

## **B. Respondent**

Respondent did not provide a formal reply to the Complaint. In an email dated March 17, 2023, Respondent stated that the Parties had been in settlement discussions prior to this Proceeding. Respondent stated that the disputed domain names had "never been used in any malicious way nor used to present ourselves as someone we are not ie Lipton. They were simply purchased to increase seo terminology to allow us to sell purely Lipton products since they were such good sellers". Respondent stated that it operated an e-commerce site and that it had proposed a partnership with Complainant. Respondent wished to, at the least, recoup its investment into the dispute domain names and hosting.

In its April 12, 2023 response to Procedural Order No. 1, Respondent stated that "We were offered 500 for each before. We have spent much more than that. Now you have offered 200. I want a fair amount for the domains so we can recoup some of our expenses. I'm willing to settle straight away for £2k gbp as this will cover most of our related expenses".

## **6. Discussion and Findings**

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) Respondent has registered and is using the disputed domain names in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

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

Complainant has provided evidence establishing that it has trademark rights in the LIPTON and LIPTON YELLOW LABEL TEA marks through registration in the United Kingdom and other jurisdictions. Complainant thereby 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.

In comparing Complainant's marks with the disputed domain names, the Panel finds that the disputed domain names are confusingly similar to them. The LIPTON mark is reflected in both disputed domain names. The LIPTON YELLOW LABEL TEA mark is reflected in the <liptonyellowlabelteas.com> disputed domain name. It is the consensus view of UDRP panels that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark. Moreover, 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. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

It is the well-established view of UDRP panels that a generic Top-Level Domain ("gTLD") such as ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

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

The Panel finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain names. Respondent is not authorized by Complainant and has no rights in the LIPTON or LIPTON YELLOW LABEL TEA marks. The disputed domain names reflect Complainant's marks. Such a composition may suggest sponsorship or endorsement by the trademark owner and cannot confer rights or legitimate interests. See, for example, [WIPO Overview 3.0](#), section 2.5.1.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

Respondent has not demonstrated rights or legitimate interests. The Panel notes that there is no evidence that Respondent is commonly known by the disputed domain names, nor that there are any circumstances or activities that would establish Respondent's rights therein. Respondent states that it has purchased the disputed domain names to increase traffic to its other websites. Respondent has offered the domain names for sale to Complainant. These circumstances do not support a finding of rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.5.2.

There is no evidence to indicate that any of the possible defenses available under Paragraph 4(c) of the Policy would establish Respondent's rights or legitimate interests in the disputed domain name. In particular, the Panel notes that Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services as a reseller, since it is not actually operating any website in connection with the disputed domain names. See *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). The Panel finds that using disputed domain names reflecting Complainant's marks to increase Internet traffic to other websites is commercial activity that cannot establish rights or legitimate interests therein. See [WIPO Overview 3.0](#), section 2.5.3.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

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

The Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain names. Complainant's rights in its LIPTON and LIPTON YELLOW LABEL TEA marks predate the registration of the disputed domain names by over 100 and 40 years, respectively. The record reveals that Respondent selected the disputed domain names specifically because they contain

Complainant's marks. Accordingly, the Panel finds that the evidence supports a finding that Respondent had Complainant's mark in mind when registering the disputed domain names. Moreover, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity, as in this case, can by itself create a presumption of bad faith on the part of Respondent. See [WIPO Overview 3.0](#), section 3.1.4.

In circumstances where the disputed domain names reflect Complainant's well-known LIPTON mark, no website is established and Respondent states that the disputed domain names increased visibility of its other commercial websites, Respondent's requests for compensation in the amounts of GBP 10,000 and, later, GBP 2,000 represent amounts in excess of its costs related to the disputed domain names, thereby demonstrate bad faith use of the disputed domain names. See [WIPO Overview 3.0](#), section 3.1.1.

The Panel notes that settlement negotiations can serve a legitimate useful purpose and are not necessarily indicative of bad faith. Under the circumstances, the Panel finds that Respondent's statements in these negotiations demonstrated Respondent's intent in registering and using the disputed domain names in bad faith. See [WIPO Overview 3.0](#), section 3.10.

Accordingly, the Panel finds that Complainant has established the third element under 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 names <lipton teas.com> and <lipton yellow label teas.com> be transferred to Complainant.

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: April 26, 2023