

ADMINISTRATIVE PANEL DECISION

William Grant & Sons Limited v. Kenta Ootani
Case No. D2023-2799

1. The Parties

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

The Respondent is Kenta Ootani, Japan.

2. The Domain Name and Registrar

The disputed domain name <my-glenfiddich.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on June 30, 2023. On June 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 3, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On July 8, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On July 10, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that 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 in English and Japanese of the Complaint, and the proceedings commenced on July 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 4, 2023.

The Center appointed Haig Oghigian as the sole panelist in this matter on August 25, 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.

4. Factual Background

The Complainant, incorporated in the United Kingdom and located in Scotland, is a producer of Scotch whisky and other spirits. Having over 50 global locations and 2,800 employees, the Complainant sells its products in almost 200 markets worldwide (as it appears from Annex 4 to the Complaint). Specifically, the Complainant produces and sells Speyside single malt whisky under its GLENFIDDICH brand which has received various awards as it appears from Annex 05 to the Complaint.

The Complainant owns trademark registrations for the word mark GLENFIDDICH in multiple jurisdictions (as it appears from Annex 12 to the Complaint). In particular, the Complainant draws the Panel's attention to four trademark registrations:

- GLENFIDDICH, No. 809941, registered in the United Kingdom on August 26, 1960, for goods and services in Class 33;
- GLENFIDDICH, No. 871359, registered in Japan on September 1, 1970, for goods and services in Class 28 and 33;
- GLENFIDDICH, No. 192575, registered in the European Union on October 29, 1998, for goods and services in Class 33; and
- GLENFIDDICH, No. 3980808, registered in the United States on June 21, 2011, for goods and services in Class 33.

According to the Whois records, the disputed domain name was registered on February 8, 2023 (as it appears from Annex 1 to the Complaint).

At the time the Complaint was filed, and to this day, the disputed domain name resolves to an inactive website, containing the following characters: “;) 54” (as it appears from Annex 08 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant's contentions are as follows.

First, the Complainant submits that the disputed domain name is confusingly similar to its earlier well-known trademark GLENFIDDICH. The Complainant highlights that the disputed domain name was registered more than 62 years after the earliest GLENFIDDICH trademark registration. The Complainant points out that the disputed domain name is composed of the GLENFIDDICH mark, incorporated in its entirety, the possessive pronoun “my”, and a hyphen and submits that despite these additions, the GLENFIDDICH mark remains the most recognizable and dominant element.

Second, the Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name because (1) the Respondent is not commonly known by and has no prior use of the disputed domain name and (2) the Respondent neither uses the disputed domain name in relation to a *bona fide* offering of goods or services nor in a manner that amounts to legitimate noncommercial or fair use. With respect to the former, the Complainant specifically notes that it has not granted any license nor any authorization to the Respondent to use the GLENFIDDICH trademark as part of the disputed domain name or any other domain name, service or product. With respect to the latter, the Complainant contends that: (i) the Respondent's passive holding of the disputed domain name suggests a lack of use in connection with a *bona fide* offering of goods and services as well as a lack of legitimate noncommercial or fair use, (ii) any

potential malicious use of the disputed domain name could not amount to a legitimate interest, and (iii) similarly to the circumstances in *The Commissioners for HM Revenue and Customs v. Ivan Lukanov*, WIPO Case No. [D2017-2504](#), the lack of reply on the part of the Respondent to a communication sent by the Complainant's agent suggests that the Respondent is unable to put forth any evidence of good faith use.

Third, the Complainant submits that the disputed domain name was registered in bad faith. In support of this contention, the Complainant argues that passive holding amounts to bad faith use and that the Respondent engaged in a pattern of conducts which prevents trademark holders from reflecting their marks in domain names. Furthermore, as the disputed domain name is configured with Mail eXchanger ("MX") and Sender Policy Framework ("SPF") records and is therefore capable of effective email communication, the Complainant submits that a potential for misleading emails exists (citing *Arnold Clark Automobiles Limited v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2021-3924](#)). Finally, citing *Meta Platforms, Inc., Instagram, LLC v. Tom Petropoulos*, WIPO Case No. [D2022-2121](#), the Complainant draws the Panel's attention to the lack of response on the part of the Respondent to a communication sent by the Complainant's agent.

B. Respondent

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

6. Discussion and Findings

Even in the absence of a substantive response from the Respondent, and in accordance with paragraph 4(a) of the Policy, the Complainant bears the burden to prove to the Panel each of the following elements:

- i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- 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.

After ruling on the Complainant's request that these proceedings be held in English, the Panel will successively rule on each of the three elements above.

A. Language of the Proceeding

Paragraph 11(a) of the Rules provides that, unless otherwise agreed by the parties or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise, having regards to the circumstances of the administrative proceeding.

The Registrar has confirmed that the language of the Registration Agreement of the disputed domain name is Japanese. The Complainant sets forth a number of arguments as to why the proceeding should be held in English. First, the Complainant submits that the Respondent is likely familiar with the English language because (1) the disputed domain name is comprised of the English-language mark GLENFIDDICH and the English word "my", (2) the disputed domain name is registered in the English-language top-level domain <.com> rather than <.jp>, and (3) other domain name registrations owned by the Respondent contain English words (as it appears from Annex 3 to the Complaint). In addition, it is contended that translating the Complainant's submissions into Japanese would put the Complainant to great expense and inconvenience. The Respondent did not comment on the language of the proceeding or object to the Complainant's request.

Considering the above, in accordance with paragraph 11(a) of the Rules, the Panel determines that the language of the proceeding should be English.

B. Paragraph 4(a) of the Policy

(i) Identical or Confusingly Similar

The Complainant satisfactorily established its rights in the GLENFIDDICH trademark and that the disputed domain name is confusingly similar to the GLENFIDDICH trademark.

The Complainant has shown its rights in the GLENFIDDICH trademark through the above-cited registrations in various jurisdictions (as it also appears from Annex 12 to the Complaint). Evidence of such registrations is sufficient to *prima facie* satisfy the threshold requirement of having trademark rights in the GLENFIDDICH trademark, according to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

As stated in section 1.7 of the [WIPO Overview 3.0](#), a domain name which incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the domain name will normally be considered confusingly similar to that trademark. The test for identity or confusing similarity typically involves a side-by-side comparison of the domain name, to assess whether the trademark is recognizable within the domain name.

In this case, the disputed domain name is composed of three elements: (1) the term "my", (2) a hyphen, and (3) the word "Glenfiddich". The Panel is permitted to ignore the generic top-level domain ("gTLD") ".com", in accordance with section 1.11 of the [WIPO Overview 3.0](#). Similarly to past cases, including the case referred to by the Complainant, the disputed domain name incorporates the GLENFIDDICH trademark in its entirety and the addition of the term "my" and a hyphen renders the Complainant's mark the dominant recognizable element.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the GLENFIDDICH trademark and thus the Complainant has discharged its burden under subparagraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant satisfactorily established that the Respondent has no rights or legitimate interests in the disputed domain name.

Following section 2.1 of the [WIPO Overview 3.0](#), the Complainant must demonstrate, *prima facie*, that the Respondent has no rights to or legitimate interests in the disputed domain name. If the Complainant succeeds, the burden of production of evidence on this second element of the Policy shifts to the Respondent. Here, the Respondent must now produce relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Such a legitimate interest is defined, non-exhaustively at paragraph 4(c) of the Policy, as use of the domain name in connection with a *bona fide* offering of goods or services, the Respondent being commonly known by the disputed domain name, or a legitimate noncommercial fair use of the disputed domain name, without misleading the consumers or tarnishing the trademark at issue.

In the present case, the Respondent did not file a response and thus provided no evidence that it holds any such rights or legitimate interests in the disputed domain name, namely that it has used or made preparation to use the disputed domain name in connection with a *bona fide* offering of goods and services.

The GLENFIDDICH trademark is clearly present in the disputed domain name, and in the absence of evidence from the Respondent to the contrary, this is sufficient for the Panel to agree with the Complainant's submissions that the Respondent is not a licensee of the Complainant, that the Respondent has not received any authorization from the Complainant to use its mark in association with the registration of the disputed domain name, and that there is no conceivable use to which the disputed domain name could be put that would confer any legitimate interest upon the Respondent.

Furthermore, as set out in section 2.5 of the [WIPO Overview 3.0](#), the Respondent's use of the disputed domain name does not amount to fair use because it falsely suggests an affiliation between the Respondent and the Complainant. Specifically, given that the GLENFIDDICH trademark is the dominant feature of the disputed domain name, the nature of the disputed domain name suggests sponsorship or endorsement by the Complainant, contrary to section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Respondent does not hold any rights or legitimate interests in the disputed domain name and that the Complainant has discharged its burden under subparagraph 4(a)(ii) of the Policy.

(iii) Registered and Used in Bad Faith

The Complainant satisfactorily established that the Respondent has registered and uses the disputed domain name in bad faith.

Paragraph 4(a)(iii) of the Policy states this double requirement. According to section 3.1 of the [WIPO Overview 3.0](#), bad faith occurs if the Respondent takes unfair advantage of or otherwise abuses the Complainant's trademark. The same paragraph lists non-exhaustive scenarios, which could constitute evidence of bad faith.

The Panel notes that the evidence provided to it regarding the Respondent's use or intent to use the disputed domain name is a screen capture of an inactive website page only containing the characters “;) 54” where the disputed domain name resolves (as it appears from Annex 8 to the Complaint).

First, the Panel agrees that the doctrine of “passive holding” supports the Complainant's position that the disputed domain name was registered and is being used in bad faith by the Respondent, despite the Respondent's apparent lack of actual use of the disputed domain name.

This doctrine states that when reviewing the totality of circumstances, the non-use of a domain name may not necessarily prevent a finding of bad faith, in accordance with [WIPO Overview 3.0](#), section 3.3. This section namely states that: “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

In this regard, the Panel notes that the Complainant has successfully established that the GLENFIDDICH trademark is very well-known and has been in use for over 62 years prior to the registration of the disputed domain name. What is more, in addition to the Respondent's failure to respond to the Complaint, the Respondent also failed to reply to a communication on the part of the Complainant's agent (as it appears from Annex 10 to the Complaint). Finally, as noted above, the Complainant established that the Respondent is not a licensee of the Complainant, that the Respondent has not received any authorization from the Complainant to use its mark in association with the registration of the disputed domain name, and that there is no conceivable use to which the disputed domain name could be put that would confer any legitimate interest upon the Respondent. Given the fame and reputation of the GLENFIDDICH trademark, the Panel is of the view that the Respondent was more likely than not aware of the GLENFIDDICH trademark and the Complainant's reputation.

Second, by registering several domain names containing registered trademarks owned by various brands in Scotland (as it appears from Annexes 1, 3, and 13 to the Complaint), the Panel agrees that the Respondent engaged in a pattern of conduct of preventing trademark holders from using or incorporating their own marks in domain names, pursuant to section 3.1.2 of the [WIPO Overview 3.0](#).

Third, as noted above, the disputed domain name is capable of effective email communication given that it is configured with MX and SPF (as apparent from Annex 9 to the Complaint). In line with past cases, including the one cited by the Complainant, even though the Complainant has not provided any evidence that phishing or fraudulent emails have been sent by the Respondent, this Panel concludes that there is a material risk that such emails be sent using the disputed domain name which further supports an inference of bad faith on the part of the Respondent.

Therefore, the Panel finds that the Respondent registered and used the disputed domain name in bad faith and that the Complainant has established the third element under subparagraph 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 <my-glenfiddich.com> be transferred to the Complainant.

/Haig Oghigian/

Haig Oghigian

Sole Panelist

Date: September 8, 2023