

ADMINISTRATIVE PANEL DECISION

Harry Winston SA and Harry Winston Inc. v. William Zafropoulos
Case No. DAU2025-0010

1. The Parties

The Complainants are Harry Winston SA, Switzerland and Harry Winston Inc., United States of America (“United States”), represented by The Swatch Group AG, Switzerland.

The Respondent is William Zafropoulos, Australia.

2. The Domain Name and Registrar

The disputed domain name <harrywinston.au> (the “Domain Name”) is registered with Melbourne IT Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 11, 2025. On March 11, 2025, the Center transmitted by email to Melbourne IT Ltd a request for registrar verification in connection with the Domain Name. On March 17, 2025, Melbourne IT Ltd transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 20, 2025. In accordance with the Rules, paragraph 5(a), the due date for Response was April 9, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 11, 2025.

The Center appointed Nicholas Smith as the sole panelist in this matter on April 14, 2025. 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 Complainants are subsidiaries of The Swatch Group AG and are the joint owners and users of the HARRY WINSTON mark. The Complainants and their predecessors in title have been using the HARRY WINSTON mark in connection with jewellery products and various retail services in connection with jewellery products around the world since as early as 1932 and have developed a significant global reputation in the mark. The Complainants own an Australian trade mark registration for HARRY WINSTON (trade mark no. 2432337) which was registered on October 14, 2024 for goods and services in classes 14, 35, and 37 and also hold numerous marks that predate the registration date of the Domain Name such as European Union trade mark no. 003276151, for HARRY WINSTON, registered on February 1, 2005 (the "HARRY WINSTON Mark").

According to the verification provided by the Registrar, the Domain Name, <harrywinston.au>, was registered on October 3, 2022. The Domain Name resolves to a website (the "Respondent's Website") which purports to be the website for an Australian migration expert named "Harry Winston", but it contains no contact details nor evidence that a Mr. Winston exists and/or operates a migration assistance business. The uncontested evidence in the Complaint is that the Respondent's Website is a fake, consisting of a stock photo and a simple chat-bot that generates the same response to any input provided.

5. Parties' Contentions

A. Complainant

The Complainants make the following contentions:

- (i) that the Domain Name is identical or confusingly similar to the Complainants' HARRY WINSTON Mark;
- (ii) that the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is subsequently being used in bad faith.

The Complainants are the owner of the HARRY WINSTON Mark, having registered this mark in Australia and in various jurisdictions around the world. Disregarding the country code Top-Level Domain ("ccTLD") ".au", the Domain Name is identical to the HARRY WINSTON Mark.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Respondent is not commonly known as the Domain Name or a name corresponding to the Domain Name. The Respondent has no licence or right to use the Domain Name or the HARRY WINSTON Mark and has never been granted any permission by the Complainants for the registration of the Domain Name. The Respondent's Website is a fake website (consisting of a stock image and a chat-bot) generated to provide a legitimate pretext but does not generate any rights or legitimate interests in the Domain Name. Rather the Domain Name is being held for or pending use to impersonate the Complainants in some way.

The Domain Name was registered and is being used in bad faith. The Domain Name was registered and is being used with the intention of preventing the Complainants from registering the corresponding Domain Name. It is likely also used to impersonate the Complainants in some manner either for phishing purposes or otherwise misleading Internet users. Finally, the contact details provided by the Respondent refer to a cosmetic dentist's office and are likely to be fake, further indicating bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Procedural Issue: Multiple Complainants

The Complaint was filed by two complainants against a single respondent. The Complainants have made a request for consolidation and bear the onus of establishing that such a consolidation is justified.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and whether (ii) it would be equitable and procedurally efficient to permit the consolidation.

The Complainants are related entities, owned by the same principal, that jointly hold and use the HARRY WINSTON Mark. In view of these circumstances, the Panel finds that the Complainants have a common grievance against the Respondent and that it is equitable and procedurally efficient to grant the request for consolidation.

For the remainder of this decision the Complainants are referred collectively as “the Complainant” except as otherwise necessary.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements:

- (i) the domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered or subsequently used in bad faith.

The burden of proof of each element is borne by the Complainant.

A. Identical or Confusingly Similar

To prove this element the Complainant must have a name or trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant’s name, trade or service mark.

The Complainant is the owner of the HARRY WINSTON Mark, having registrations for the HARRY WINSTON Mark as a trade mark in Australia and other jurisdictions.

Disregarding the ccTLD “.au”, the Domain Name is identical to the HARRY WINSTON Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a prima facie case that the respondent lacks rights or legitimate interests in the domain name. If such a prima facie case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, is to be taken to demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the subject matter of the dispute, your bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that you have acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue.”

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the HARRY WINSTON Mark or a mark similar to the HARRY WINSTON Mark. The Respondent does appear to be commonly known by the Domain Name nor is it making a legitimate non-commercial use of the Domain Name.

The Respondent's Website is a website that, under the HARRY WINSTON Mark, purports to offer immigration assistance but actually is a fake website consisting of a stock photo and a (essentially non-functional) chat-bot. It provides no contact details and no evidence suggesting that the Harry Winston referred to is a real person that offers real services. The use of a domain name that directly corresponds to a trade mark for an obviously fake website created to misleadingly suggest rights in a domain name is not a bona fide offering of goods or services.

The Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has had an opportunity to rebut the presumption that it lacks rights or legitimate interests but has chosen not to do so. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered or Subsequently Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, 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:

- (i) circumstances indicating that the Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or
- (ii) the Respondent has registered the Domain Name in order to prevent the owner of the name, trademark or service mark from reflecting the name or mark in a corresponding domain name; or
- (iii) the Respondent has registered the Domain Name primarily for the purpose of disrupting the business or activities of another person; or
- (iv) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's name or 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; or
- (v) if any of the Respondent's representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

The Panel notes that the Policy only requires that a complainant show that a respondent registered or subsequently used the Domain Name in bad faith, however in the interest of completeness the Panel has considered both whether the Domain Name has been registered and used in bad faith.

The Panel finds, on the balance of probability, that the Domain Name was registered in bad faith. While the Complainant did not have a registered mark in Australia at the date the Domain Name was registered, it had used the HARRY WINSTON Mark globally for more than 70 years and had demonstrated a considerable reputation in the mark. It is likely that the Respondent was aware of the Complainant and its reputation in the HARRY WINSTON Mark at the time the Respondent registered the Domain Name. As the Domain Name is identical to the Complainant's trade mark, save for the addition of ".au", and identical to the Complainant's <harrywinston.com> domain name, save for the replacement of ".com" by ".au"; a simple Google search would have revealed the Complainant's existence. Furthermore, the Respondent, in registering the Domain Name, acted to hide its identity through the use of what appears to false contact details, which suggests registration in bad faith. Finally, there is no obvious reason, nor has the Respondent offered an explanation, for the Respondent to register a domain name identical to the HARRY WINSTON Mark and have it resolve to an obviously fake website unless there was an intention to create a likelihood of confusion between the Domain Name and the Complainant and its HARRY WINSTON Mark.

The Domain Name, which is identical to the Complainant's HARRY WINSTON Mark, has been used by the Respondent to redirect visitors to a website that, as discussed above, is an obviously fake website that exists only to confuse or mislead visitors. The Panel is prepared to infer, based on the conduct of the Respondent, including the nature of the Respondent's Website, the use of clearly false and misleading contact details, and the failure by the Respondent to participate in this proceeding or otherwise provide any explanation of its conduct, that the Domain Name is most likely being held pending use in a manner that will take advantage of any confusion between the Domain Name and the HARRY WINSTON Mark. As such, the Panel finds that the current use of the Domain Name is use in bad faith.

The Panel, while noting that the Policy only requires that a complainant shows that a respondent registered or used the Domain Name at issue in bad faith, finds that the Respondent has registered and has subsequently used the Domain Name in bad faith under paragraph 4(a)(iii) of the Policy.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <harrywinston.au> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: April 17, 2024