

ADMINISTRATIVE PANEL DECISION

Asprey Holdings Limited v. DOMAIN ADMINISTRATOR, Buy this domain on Dan.com ----

Case No. D2022-4407

1. The Parties

The Complainant is Asprey Holdings Limited, United Kingdom, represented by Dechert, United Kingdom.

The Respondent is DOMAIN ADMINISTRATOR, Buy this domain on Dan.com ----, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <aspreyimperialjadeite.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 18, 2022. On November 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 18, 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 November 29, 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 December 2, 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 December 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 28, 2022.

The Center appointed Gareth Dickson as the sole panelist in this matter on January 12, 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 sells, amongst other goods, leather goods, jewellery, and candles. Although incorporated in London in 1909, it has traded under the ASPREY mark (the “Mark”) since 1781. It has continued to trade under the Mark since incorporation and operates a website under the domain name <asprey.com>.

The Complainant is the owner of a number of trade mark registrations for the Mark around the world for, *inter alia*, jewellery or retail services relating to jewellery, including:

- United Kingdom trade mark registration number 900483362, registered on December 7, 1998,¹ in International Classes 3, 8, 13, 14 16, 18, 20, 21, 25, 28, 29 30, 33, and 34; and
- United States of America trade mark registration number 2320207, registered on February 22, 2000, in International Classes 35 and 42.

The disputed domain name was registered on October 14, 2022. It has been used to direct users to a website offering the disputed domain name for sale for USD 995. More recently, the disputed domain name has become inactive and does not point to any active website.

5. Parties’ Contentions

A. Complainant

The Complainant argues that it has rights in the Mark by virtue of its ownership of various trade mark registrations for the Mark around the world. It contends that the disputed domain name is confusingly similar to the Mark since it incorporates the Mark (which is recognisable within the disputed domain name) with the addition of two individually identifiable words, namely “imperial” and “jadeite”, under the generic Top-Level Domain (“gTLD”) “.com”. The Complainant has submitted evidence of the launch, in October 2022, of its “Asprey Imperial Jadeite” collection.

The Complainant confirms that the disputed domain name was registered by the Respondent without its permission and that the Respondent is not a licensee of the Complainant. It submits that there is no evidence to suggest that the Respondent is making, or intends to make, a legitimate noncommercial or fair use of it and notes that the disputed domain name was offered for sale for USD 995.

The Complainant submits that the Respondent must have known of the Complainant and the Mark when it registered the disputed domain name, and did so in bad faith. The Mark, according to the Complainant, is distinctive and is well known throughout the world, as supported by English High Court and UDRP decisions in its favour. It notes that the Respondent has concealed its identity on the Whols.

Finally, the Complainant argues that the Respondent has used the disputed domain name to attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Mark, contrary to the Policy. It contends that the (current) passive holding of a domain name remains a use in bad faith under the Policy, and that any unauthorised use of the Mark takes unfair advantage of the Mark and

¹ This trade mark registration is a so-called “comparable UK trade mark”, and was created following Brexit to maintain the protection derived from the Complainant’s European Union trade mark registration number 483362 which was also, necessarily, registered on December 7, 1998, but which ceased to have effect in the United Kingdom after December 31, 2020. For the purposes of the Policy, it is entirely correct to give comparable United Kingdom trade marks full force and effect from the date of registration noted on their certificates.

harms the Complainant's exclusivity and goodwill in it. It alleges that the Respondent is a "serial cybersquatter (*i.e.*, an individual who intentionally registers and uses domain names in bad faith for a commercial purpose)". Together, the Complainant submits that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel accepts that the Complainant is the owner of, and therefore has rights in, the Mark. Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)) provides that: "[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

Section 1.8 of the [WIPO Overview 3.0](#) further provides that: "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".

The Panel therefore finds that the disputed domain name is confusingly similar to the Mark since the disputed domain name incorporates the Mark in its entirety. The addition of the terms "imperial" and "jadeite" in the disputed domain name does not prevent a finding of confusing similarity, nor does the addition of the gTLD ".com".

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Although a complainant is required to demonstrate that a respondent has no rights or legitimate interests in respect of the domain name, as explained in section 2.1 of the [WIPO Overview 3.0](#), the consensus view of previous UDRP panels is that where a complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the current proceeding, the Complainant has established its *prima facie* case. The evidence before the Panel is that the Mark enjoys a high degree of distinctiveness that makes a coincidental adoption by the Respondent highly unlikely. The timing of the registration of the disputed domain name, incorporating "Asprey", "imperial", and "jadeite" in the same month that the "Asprey Imperial Jadeite" collection was announced puts this beyond any doubt.

The Complainant states that it has not given the Respondent permission to use the Mark, in a domain name or otherwise, and there is no evidence that the Respondent has acquired any common law rights to use the Mark, is commonly known by the Mark or has chosen to use the Mark in the disputed domain name in any descriptive manner or is making any use of the disputed domain name that would establish rights or legitimate interests as a result of a noncommercial or fair use of it.

By not participating in these proceedings, the Respondent has failed to refute the Complainant's *prima facie* case that it has met its burden under the second UDRP element.

As clearly stated in section 2.1 of the [WIPO Overview 3.0](#), “a panel’s assessment will normally be made on the basis of the evidence presented in the complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed”. Having reviewed and weighed the available evidence, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Panel notes that the Mark has already been found by previous UDRP panels, and by the English High Court in London, to be distinctive and to have a reputation, rather than being a descriptive or generic term.

The Panel notes that the disputed domain name was registered many years after the Mark was registered, in the immediate aftermath of the Complainant’s announcement of its “Asprey Imperial Jadeite” collection, and accepts that the disputed domain name was chosen by reference to the Mark and to capitalise on commercial interest in this new collection.

The Panel therefore finds that the Respondent’s registration of the disputed domain name was in bad faith since it attempted to appropriate for the Respondent, without the consent or authorisation of the Complainant, rights in the Complainant’s Mark.

The disputed domain name is also being used in bad faith.

The disputed domain name has been used for a commercial purpose in that the Respondent has sought to sell it for a price that is likely far in excess of what it would have cost the Respondent to purchase it.

Although that particular bad faith use of the disputed domain name by the Respondent has now ceased, it does not alter the Panel’s findings above and the Panel finds that the disputed domain name is still being used in bad faith, under the doctrine of passive holding.

Section 3.3 of the [WIPO Overview 3.0](#) states that relevant factors to finding bad faith in cases of passive holding 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 [...], and
- (iv) the implausibility of any good faith use to which the domain name may be put.”

The Panel notes that the Mark is distinctive of the Complainant and that the disputed domain name targets, in a precise and deliberate manner, a well-publicised and new commercial activity of the Complainant. The Panel further notes that the Respondent has not participated in these proceedings or sought to explain its registration and use of the disputed domain name. Furthermore, there is no conceivable use of the disputed domain name by the Respondent that would not be illegitimate.

The existence of an earlier UDRP proceeding having been won against the Respondent does not create a presumption of bad faith *per se*, but it does tend to support such a finding of bad faith where the Respondent has not taken any steps to rebut it. The Panel is not able to accept a characterisation of a respondent as a “serial cybersquatter” simply because he or she has registered nearly 2,000 domain names, since there is nothing inherently wrong with that activity, but notes that in addition to the UDRP Decision relied on by the Complainant, at least three other UDRP Decisions have been brought, and won, against the Respondent.

On the basis of the information available to it, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith.

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 <aspreyimperialjadeite.com> be transferred to the Complainant.

/Gareth Dickson/

Gareth Dickson

Sole Panelist

Date: February 6, 2023