

ADMINISTRATIVE PANEL DECISION

Pierce Protocols Limited v. Host Master, 1337 Services LLC
Case No. D2022-4446

1. The Parties

The Complainant is Pierce Protocols Limited, United Kingdom, represented by Joseph Hage Aaronson LLP, United Kingdom.

The Respondent is Host Master, 1337 Services LLC, Saint Kitts and Nevis.

2. The Domain Names and Registrar

The disputed domain names <heniprimary.com> and <hení.com> [xn--hen-tma.com] are registered with Tucows Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 21, 2022. On November 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 22, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on November 23, 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 1, 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 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 10, 2023.

The Center appointed Emre Kerim Yardimci as the sole panelist in this matter on January 16, 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 provides a range of services within the art industry, including selling non-fungible tokens (“NFT”s) and physical artworks to members of the public.

The Complainant owns several trademark registrations for HENI indication:

- United Kingdom trademark registration No. UK00003706419 for HENI, registered on December 31, 2021, in classes 6, and 14;
- United Kingdom trademark registration No. UK00003217825 for HENI, registered on June 2, 2017, in classes 9, 35, 38, and 41;
- United Kingdom trademark registration No. UK00003706419 for HENI, registered on December 31, 2021, in classes 6, and 14;
- United Kingdom trademark registration No. UK00801328933 for HENI, registered on June 28, 2017, in classes 16, 18, 19, 20, 21, 23, 24, 25, 26, and 27;
- United Kingdom trademark registration No. UK00801381342 for HENI, registered on June 5, 2018, in classes 9, 35, 38, and 41;

The Complainant uses its trademarks to market and sell such works via its website, “www.heni.com” including “www.heni.com/primary” and “www.nft.heni.com”. The Complainant uses its “HENI Primary” platform on which it is currently promoting a series of physical artworks by Damien Hirst titled “Paper Veils”.

The disputed domain name <hení.com> is redirected to the other disputed domain name <heniprimary.com> which is using the Complainant’s trademark HENI and H logo as well as the content of the Complainant above cited website and copyrighted works of Damien Hirst which is not party to this complaint.

The disputed domain names have been both registered on November 16, 2022.

5. Parties’ Contentions

A. Complainant

The dominant part of the disputed domain names comprises the word “heni”, which is identical to the Complainant’s registered trademark HENI. One of the disputed domain names, <heniprimary.com>, also comprises the word “primary” and the other disputed domain name <hení.com> substitutes the letter “i” for the non-ASCII character “í”. These differences do not detract from the overall impression and the disputed domain names are clearly confusingly similar to the Complainant’s registered trademark HENI.

The Complainant claims that the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services and instead the Respondent has intentionally chosen the disputed domain names in order to generate traffic and income through a website using HENI trademark together with the content of its website as well as the copyrighted works within its website and at the same time providing links within the disputed domain names to the Complainant’s website.

By using the disputed domain names, the Respondent exploits the goodwill and the image of the HENI trademark, which result in dilution and damage for the Complainant’s trademarks. The Respondent does not

own any registered trademark or trade names corresponding to the disputed domain names. The Complainant invokes that there is no doubt that by impersonating the Complainant's trademark, content and copyrighted works, the Respondent was well aware of the rights the Complainant has in the trademark at the time of its registration.

The Respondent is using the disputed domain names to attempt to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of his website.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three elements, which the Complainant must prove, during the administrative proceedings, to merit a finding that the disputed domain names be transferred to the Complainant:

- (a) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (b) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (c) the disputed domain names have been registered and are being used in bad faith.

Pursuant to paragraph 15(a) of the Rules, the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner.

As indicated above, the Complainant holds trademark registrations for HENI indication. The disputed domain names integrate the Complainant's HENI trademark, and adds the words "primary" for one of the disputed domain names and substitutes the letter "i" for the non-ASCII character "ı" which is an obvious and intentional misspelling for the other disputed domain name.

As regards the generic Top-Level Domain ("gTLD") ".com", it is typically disregarded under the confusing similarity test.

Consequently, the Panel finds that the Complainant has shown that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights and satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has made a *prima facie* showing of a lack of the Respondent's rights or legitimate interests in the disputed domain names. The Respondent is not commonly known by the disputed domain names,

and the use of the disputed domain names mimicking the Complainant's website and capitalizing on the Complainant's trademark constitutes neither a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use in this case.

The Respondent did not file a Response. Therefore, the Respondent made no effort to demonstrate any rights or legitimate interests in the disputed domain names.

Accordingly, the Panel determines the Complainant has demonstrated that the Respondent lacks rights or legitimate interests in disputed domain names.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent has registered and used the disputed domain names to intentionally attempt to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's trademark and brand at the same time.

The Panel notes the disputed domain name <hení.com> redirected to <heniprimary.com>. As a matter of fact, considering:

- the use of the Complainant's trademark and the name of its platform "HENI primary" within the disputed domain name <heniprimary.com> at the same time,
- the striking similarity of the website content under the disputed domain name <heniprimary.com> with the Complainant's own website,
- the use of the copyrighted work on its website under the disputed domain name <heniprimary.com>, and
- the use of the links within the disputed domain name <heniprimary.com> redirecting to the Complainant's actual website,

it is clear that the Respondent has targeted the Complainant, its HENI trademark, and "HENI primary" platform to further its own commercial activities.

The Respondent's registration of the disputed domain names composed of the Complainant's marks for a website impersonating the Complainant's website clearly constitutes bad faith use and registration.

Therefore, the only reason for the registration of the disputed domain names by the Respondent must have been with bad faith intent to use it to exploit, for commercial gain, the reputation of the Complainant and its trademarks. The Respondent has used the disputed domain names for precisely that purpose.

Therefore, in view of cumulative circumstances, the Panel finds that the requirement of registration and use in bad faith under paragraph 4(a)(i) of the Policy has been met.

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, <hení.com> and <heniprimary.com>, be transferred to the Complainant.

/Emre Kerim Yardimci/

Emre Kerim Yardimci

Sole Panelist

Date: February 7, 2023