

ADMINISTRATIVE PANEL DECISION

Harry Winston SA, Harry Winston Inc. v. wangye lin
Case No. D2023-0630

1. The Parties

The Complainants are is Harry Winston SA, Switzerland and Harry Winston Inc., United States of America (“United States”), represented internally.

The Respondent is wangye lin, Finland.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 10, 2023. On February 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 13, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 13, 2023, 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 February 14, 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 the Respondent of the Complaint, and the proceedings commenced on February 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 15, 2023.

The Center appointed Knud Wallberg as the sole panelist in this matter on March 17, 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 Complainants, Harry Winston SA and Harry Winston Inc. are wholly-owned subsidiary companies of The Swatch Group AG. Both of the Complainants own the trademark HARRY WINSTON, which is registered in various jurisdictions around the world. For example, the Complainant Harry Winston SA owns International Registration No. 1178434 for the mark, registered on August 7, 2013, for goods and services in international classes 14, 35 and 37, and the Complainant Harry Winston Inc. owns United States registration No. 3355622 for the mark, registered on December 18, 2007 for goods in international class 14.

The disputed domain name <harrywinstonofficial.com> was registered on February 15, 2022. The disputed domain name has been and is still being used for a website which displays advertisements for various gaming sites and sites with pornographic content.

5. Parties' Contentions

A. Complainant

The disputed domain name is, on its face, identical to the Complainants' registered HARRY WINSTON marks since it incorporates the entirety of the well-known trademark and trade name HARRY WINSTON with the addition of the term "official".

The Complainants further contend that the Respondent has no rights or legitimate interests in the disputed domain name. There are no signs that the Respondent has been commonly known by the disputed domain name, and the Respondent is not in any way related to the Complainants or their business activities nor have the Complainants granted a license or authorized the Respondent to use their trademarks or apply for registration of the disputed domain name. Furthermore, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain without intent for commercial gain, and so its actions do not fall within §4(c)(iii) of the Policy. To the contrary, at the time of filing of the Complaint, the disputed domain name resolved to a website displaying pornographic content.

The Complainants finally contend that the Respondent has registered the disputed domain and is using it in bad faith. By registering and using a domain comprising of the Complainants' well-known trademark and the misleading term "official", the Respondent clearly targets the Complainants' prospective customers, by diverting Internet users seeking to visit the Complainants' official website to the Respondents pornographic website, most likely with the aim of increasing Internet traffic to another website featuring pornographic content linked therein.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Preliminary procedural question: consolidation of Complainants

Both the Complainants are the trademark owners of HARRY WINSTON, and therefore the Complainants have a common grievance against the Respondent and have a common legal interest in the trademark rights that are affected by the Respondent's conduct. This consolidation is equitable and procedurally efficient.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.11.

6.2 Discussion and Finding on the Merits

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

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

- (i) that the disputed domain name registered by the respondent are identical or confusingly similar to a trademark or service mark in which the complainants have rights; and
- (ii) that the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(a) of the Policy states that the burden of proving that all these elements are present lies with the Complainants. At the same time, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules, or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar (in the sense of the Policy) to the Complainants' registered trademark HARRY WINSTON, since the disputed domain name contains this mark in its entirety. The addition of the term “official” does not prevent a finding of confusing similarity, just as the generic Top-Level-Domain (“gTLD”) “.com” is a standard registration requirement and as such is disregarded under the first element confusing similarity test. See sections 1.8 and 1.11.1 of the [WIPO Overview 3.0](#).

The Panel finds that the conditions in paragraph 4(a)(i) of the Policy are therefore fulfilled in relation to the disputed domain name.

B. Rights or Legitimate Interests

It is obvious from the Complaint, that the Complainants have not licensed or otherwise permitted the Respondent to use the trademark HARRY WINSTON.

Further, given the circumstances of this case, the Panel finds that the Complainants have established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not rebutted this. Furthermore, the way the Respondent has used the confusingly similar disputed domain name for a website with advertisements for third-party gaming sites and sites with pornographic content, supports a finding that the Respondent lacks rights or legitimate interests in the disputed domain name.

Consequently, the Panel finds that the conditions in paragraph 4(a)(ii) of the Policy are also fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the complainant to prove both registration and use of a disputed domain name in bad faith. Paragraph 4(b) of the Policy provides examples of circumstances, which shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent has registered the disputed domain names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding disputed domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the disputed domain names primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain names, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's 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.

Accordingly, for the Complainants to succeed, the Panel must be satisfied that the disputed domain name has been registered and is being used in bad faith.

Given the circumstances of the case, including the distinctive nature of the Complainants' trademark HARRY WINSTON and the way that the disputed domain name has been and is still used, it is obvious to the Panel in the current circumstances that the Respondent registered the disputed domain name in bad faith, to intentionally attempt "[...] to attract, for commercial gain, Internet users to the [Respondent's] website or other on-line location, by creating a likelihood of confusion with the [Complainant's] mark as to the source, sponsorship, affiliation, or endorsement of the [Respondent's] website[.]" See section 3.1 of the [WIPO Overview 3.0](#).

Noting that the disputed domain name incorporate the Complainants distinctive trademark HARRY WINSTON; that the Respondent has not replied to the Complainants contentions; and the use of the disputed domain name and considering all the facts and evidence in the present case, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy are also fulfilled in this case.

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, <harrywinstonofficial.com> be transferred to the Complainants.

/Knud Wallberg/

Knud Wallberg

Sole Panelist

Date: April 3, 2023