

ADMINISTRATIVE PANEL DECISION

Gandys International Limited v. Domain Vault, Domain Vault LLC
Case No. D2023-1764

1. The Parties

Complainant is Gandys International Limited, United Kingdom (“UK”), represented by Gowling WLG (UK) LLP, UK.

Respondent is Domain Vault, Domain Vault LLC, United States of America (“United States”), represented by Schepps Law Offices, United States.

2. The Domain Name and Registrar

The disputed domain name <gandys.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2023. On April 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, 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 (Domain Protection Services, Inc.) and contact information in the Complaint.

The Center sent an email communication to Complainant on April 26, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 2, 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 Respondent of the Complaint, and the proceedings commenced on May 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2023. The Response was filed with the Center on May 22, 2023.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on June 2, 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

Complainant is a company organized under the laws of England and Wales that is active in the travel clothing and bags industry.

Complainant has provided evidence that it is the registered owner of the following trademarks relating to its company name and brand GANDYS:

- word mark GANDYS, International Property Office (UK), registration number: UK00911328549, registration date: March 8, 2013, status: active;
- word mark GANDYS, International Property Office (UK), registration number: UK00002634339, registration date: February 22, 2013, status: active.

Moreover, Complainant has demonstrated to own since 2020 the domain name <gandysinternational.com>, which resolves to Complainant's main website at "www.gandysinternational.com", promoting Complainant's travel goods worldwide.

Respondent, according to the disclosed Whois information for the disputed domain name, is a company located in the United States. The disputed domain name was first registered on September 16, 2002. By the time of rendering this decision, the disputed domain name resolves to alternating websites of different contents, including websites offering clothing and bags. Moreover, it is apparent from the case file that by the time of the filing of the Complaint, the disputed domain name resolved to a typical pay-per-click ("PPC") website showing search results relating to various industries, including e.g., "women clothing" and "men bags", thus directly pointing at Complainant's core business, for the purpose of generating PPC revenues.

Complainant requests that the disputed domain name be transferred to Complainant.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends that it launched and started trading as early as 2012, with its products having appeared ever since in over 400 stores worldwide and its GANDYS trademark being meanwhile well-known.

Complainant submits that the disputed domain name is identical to its GANDYS trademark, as it incorporates the latter in its entirety and contains nothing which would dispel confusion with the GANDYS trademark. Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Respondent has not been commonly known by the word "gandys" which solely denotes Complainant and its products, (2) Respondent has no registered trademarks for the word "gandys", and (3) Respondent has no relationship with Complainant or permission to use its GANDYS trademark by means of a license, permission, consent, or otherwise. Finally, Complainant argues that Respondent is using the disputed domain name in bad faith since (1) the public is likely to attribute the disputed domain name to Complainant and Respondent could produce website content thereunder damaging the reputation of Complainant's GANDYS trademark, (2) the word "gandys" denotes Complainant and products originating from it, which is why Complainant believes it is impossible that Respondent could

not know of Complainant's rights since its GANDYS trademark has become so well-known and distinctive of the goods and services in relation to which Complainant operates, and (3) Respondent is unfairly benefitting from the goodwill and reputation in Complainant's GANDYS brand and is clearly and indefensibly using the disputed domain name in bad faith.

B. Respondent

Respondent denies the remedy requested by Complainant to have the disputed domain name transferred.

Notably, Respondent stresses the fact that the disputed domain name was registered prior to the registration of Complainant's GANDYS trademark and that Complainant's assertions of Respondent's acting in bad faith are naked, unseemly and groundless, and not supported by any evidentiary basis, which is why Respondent considers this case to be an example of an attempt at reverse domain name hijacking, while noting that Complainant, in bringing its Complaint, did not attempt to manufacture any evidence, but admitted that there was a timing issue.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that 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.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1

The Panel finds the entirety of the GANDYS trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Panel considers that the record of this case reflects that:

before any notice to Respondent of the dispute, Respondent did not use, nor has it made demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.

Respondent (as an individual, business, or other organization) has not been commonly known by the disputed domain name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.

Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.

The record contains no other factors demonstrating rights or legitimate interests of Respondent in the disputed domain name.

By the time of the filing of the Complaint, the disputed domain name resolved and (according to verification undertaken by the Panel within its powers set forth by paragraph 10 of the Rules) by the time of rendering this decision still resolves to a typical PPC website showing search results relating to various industries, including e.g., "women clothing" and "men bags", thus directly pointing at Complainant's core business, for the purpose of generating PPC revenues. UDRP panels agree that using a domain name to host a PPC website does not present a *bona fide* offering where such PPC links compete with or capitalize on the reputation and goodwill of the complainant's trademark or otherwise mislead Internet users (see [WIPO Overview 3.0](#), section 2.9).

The Panel, therefore, concludes that Respondent has no rights or legitimate interests in respect of the disputed domain name. Such conclusion is supported by the fact that Respondent itself has put absolutely nothing forward in its Response to find for the contrary, but completely restricted its contentions to argue about timing and against acting in bad faith (see Section C. below).

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, namely:

- (i) the respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant or to a competitor of the complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name. Paragraph 4(b)(i) of the Policy, and [WIPO Overview 3.0](#), section 3.1.1.; or
- (ii) the respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, and the

respondent has engaged in a pattern of such conduct. Paragraph 4(b)(ii) of the Policy, and [WIPO Overview 3.0](#), section 3.1.2.; or

- (iii) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor. Paragraph 4(b)(iii) of the Policy, and [WIPO Overview 3.0](#), section 3.1.3.; or
- (iv) the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's trademark 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. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

The registration and use requirements set forth by paragraph 4(a)(iii) of the Policy are conjunctive ("registration *and* use of a domain name in bad faith") and Complainant bears the burden of proof on each requirement (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)). Consequently, if either requirement is not established, the Complaint must fail (*Billy Bob's Texas IP Holding LLC v. Domain Administrator, Name Administration Inc. (BVI)*, WIPO Case No. [D2016-1221](#)).

First, the Panel recognizes that, according to the case file, by the time of the filing of the Complaint the disputed domain name resolved (and by the time of rendering this decision still resolves) to a typical PPC website showing search results relating to various industries, including *e.g.*, "women clothing" and "men bags", thus directly pointing at Complainant's core business, for the purpose of generating PPC revenues. This is a clear indication that Respondent has intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with Complainant's undisputedly well-known GANDYS trademark as to the source, sponsorship, affiliation or endorsement of this website. Such circumstances are evidence of at least current use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Second, however, the Panel also recognizes that the disputed domain name was first registered on September 16, 2002. By this time, Complainant neither possessed of any trademark rights relating to the term "gandys" nor was Complainant founded, but started by its own contentions trading under the GANDYS trademark as early as 2012 (with trademark registration only in February and March 2013), thus after the registration of the disputed domain name took place. In such cases, where a respondent registers a domain name before the complainant's trademark rights accrue, UDRP panes will not normally find bad faith on the part of the respondent ([WIPO Overview 3.0](#), section 3.8.1)

In this context, the Panel has considered if any exceptions to this general rule might apply, *e.g.*, if the disputed domain name had been transferred from a third party to Respondent after it was first created in 2002, in which case the Panel would have considered such transfer date in assessing bad faith on the part of Respondent (see [WIPO Overview 3.0](#), section 3.9).

Complainant, however, has not questioned at all in its Complaint that Respondent itself registered the disputed domain name as early as 2002 – notably, it has not suggested or provided evidence of a possible later acquisition by Respondent, and Respondent kept silent on this aspect in its Response, too.

The Panel notes that the WhoIs record for the disputed domain name lists the original registration as being in the month of September whereas the last update was in the month of April, possibly suggesting a change in ownership outside the normal annual renewal cycle (it is also noted that Internet Archive pages show PPC links *e.g.*, to cell phones prior to Complainant's founding); Complainant has not, however, presented any evidence or arguments in this regard.

Also, the Panel recognizes that Complainant itself not even attempted to argue that Respondent registered the disputed domain name in bad faith, but strictly put forward that the current use of the disputed domain name was one by which Respondent would unfairly profit from the reputation connected to Complainant's GANDYS trademark and that Respondent could produce website content thereunder damaging such

reputation. Those facts alone, however, are insufficient to overcome the consensus among UDRP panels that timing of the registration of the disputed domain name and the existence of related trademark rights is crucial under the UDRP, which is why Respondent in the case at hand is not considered to have *registered* the disputed domain name in bad faith within the meaning of paragraph 4(a)(iii) of the Policy. Consequently, the Complaint fails.

Based on the available record, the Panel finds the third element of the Policy has not been established.

D. Reverse Domain Name Hijacking

The Panel also considered making a finding of Reverse Domain Name Hijacking (“RDNH”), raised as an issue by Respondent, too. RDNH is defined in paragraph 1 of the Rules as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name”. On the evidence filed, the basis for such finding would have been that Complainant should have known that the Complaint never stood a chance of success (*Bigfoot Ventures LLC v. Shaun Driessen*, WIPO Case No. [D2016-1330](#)), e.g., if Complainant knew that it could not succeed as to any of the required three elements or if Complainant even provided false evidence or otherwise attempted to mislead the Panel (see [WIPO Overview 3.0](#), section 4.16).

As shown above, Complainant has established, without major efforts and absent any objections by Respondent, the first and the second element under the Policy. Also, in relation to a bad faith acting on the part of Respondent under the third element, the Panel concluded that Respondent at least currently uses the disputed domain name in bad faith. Taking those facts all together, this case is one that fulfills two and a half out of three elements under the Policy. That the Complaint still fails, is due to a timing issue and that Complainant did not put into question as to when Respondent itself precisely registered the disputed domain name, e.g., at the time when it was first registered in 2002 or only thereafter, may be even after Complainant acquired rights in the GANDYS trademark in 2013 (notably, Respondent itself kept silent in its Response on this issue, too – choosing instead to focus on the presentation of the dates in the Complaint as an admission, and not positively stating anything in terms of its own act of registering the disputed domain name).

The Panel, therefore, is not persuaded that the circumstances to this case justify a finding of RDNH.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: June 23, 2023