

ADMINISTRATIVE PANEL DECISION

Harvey Nichols and Company Limited v. george sullivan
Case No. D2023-3394

1. The Parties

Complainant is Harvey Nichols and Company Limited, United Kingdom, represented by Lewis Silkin LLP, United Kingdom.

Respondent is george sullivan, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <harvey-nichols.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 August 8, 2023. On August 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 10, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on August 17, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on August 22, 2023.

The Center verified that the Complaint together with the amendment to the 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 August 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 13, 2023. On August 31, 2023, two third-party email addresses emailed the Center claiming to be Respondent. On September 1, 2023, the Center sent emails to both email addresses requesting clarification of their relation to Respondent. Neither party replied to the Center's request. Respondent did not submit any formal response. Accordingly, the Center notified Respondent of the Commencement of Panel Appointment Process on September 22, 2023.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on September 29, 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 the United Kingdom that is active in the fashion industry.

Complainant has provided evidence that it is the registered owner of various trademarks relating to its company name and brand HARVEY NICHOLS, *inter alia*, but not limited to the following:

- word mark HARVEY NICHOLS, European Union Intellectual Property Office (EUIPO), registration number: 002201705, registration date: October 3, 2006, status: active;
- word mark HARVEY NICHOLS, United States Patent and Trademark Office (USPTO), registration number: 4980212, registration date: June 21, 2016, status: active.

Moreover, Complainant has demonstrated to own the domain name <harveynichols.com>, which resolves to Complainant's main website at "www.harveynichols.com", used to promote Complainant's goods and related services in the fashion industry worldwide.

Respondent, according to the disclosed Whois information for the disputed domain name, is a resident of the United States who registered the disputed domain name on July 6, 2023, and is holding it passively by letting it resolve to a landing page offered by the Registrar.

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 to be renowned internationally since decades by customers and in the fashion industry for its edit of exclusive, niche and established labels and that its HARVEY NICHOLS trademark enjoys meanwhile global reputation.

Complainant submits that the disputed domain name is virtually identical to Complainant's HARVEY NICHOLS trademark as it includes the latter entirely with the only difference being a hyphen between the words "harvey" and "nichols". Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) the term "Harvey Nichols" is not descriptive in any way and does not have any generic or dictionary meaning, (2) Complainant has not given its consent for Respondent to use its HARVEY NICHOLS trademark in a domain name, (3) given the famous nature of Complainant's HARVEY NICHOLS trademark, it is likely that Respondent was aware thereof prior to registering the disputed domain name, and (4) visitors to the disputed domain name would mistakenly believe there to be an association with Complainant. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) at the time in which Respondent registered the disputed domain name, Complainant's HARVEY NICHOLS trademark had achieved such repute that no one would have selected the disputed domain name without intention to take advantage of the Complainant's trademark rights or to disrupt its business, (2) Respondent is not authorized, licensed or

otherwise permitted by Complainant to use the HARVEY NICHOLS name, and (3) in the absence of any meaningful justification for the registration of the disputed domain name that replicates Complainant's well-known HARVEY NICHOLS trademark in its entirety, Complainant submits that Respondent's passive holding of the disputed domain name constitutes use thereof in bad faith.

B. Respondent

Respondent did not formally reply to Complainant's contentions. On August 31, 2023, however, two third-party email addresses emailed the Center claiming to be Respondent and pointing to the facts that (1) due to the existence of a hyphen, the disputed domain name was very different from Complainant's domain name <harveynichols.com>, (2) so far, nothing was sold under the disputed domain name, and (3) "Harvey" and "Nichols" are personal names and generic use of the disputed domain name is argued.

6. Discussion and Findings

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 HARVEY NICOLS 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 Complainant's HARVEY NICOLS trademark is reproduced within the disputed domain name, simply added by a hyphen between the words "harvey" and "nichols. Accordingly, the disputed domain name is nearly identical, but at least confusingly similar to this 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 the 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 itself has not formally 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 such as those enumerated in the Policy or otherwise. Respondent appears to be named "george sullivan", as disclosed by the Registrar and as signed in the two third-party emails received, which bears no resemblance to the disputed domain name.

Moreover, the Panel has noted that Respondent so far has neither used the disputed domain name for a *bona fide* offering of goods or services nor for a legitimate noncommercial or fair purpose, but rather passively held it instead. UDRP panels, however, have found that the mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase, does not by itself automatically confer rights or legitimate interests therein (see [WIPO Overview 3.0](#), section 2.10.1).

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.

Also, panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine 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 or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the undisputed distinctiveness or reputation of Complainant’s HARVEY NICHOLS trademark, and the composition of the disputed domain name (which reproduces Complainant’s HARVEY NICOLS trademark entirely, simply added by a hyphen between the words “harvey” and “nichols”), and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy. Such finding even takes into account the submissions in the two third-party emails addressed to the Center of August 31, 2023 (see Section 5.B. above), which – even under the assumption that they came from Respondent – provide no evidence of any plausible good faith use of the disputed domain name which would not take unfair advantage by profiting from the undisputed reputation which Complainant’s HARVEY NICHOLS trademark enjoy. Therefore, the passive holding of the disputed domain name by Respondent does not prevent a finding that Respondent has registered and is using the disputed domain name in bad faith within the larger meaning of paragraph 4(b) of the Policy, either.

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

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, <harvey-nichols.com>, be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: October 12, 2023