ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
Covent Garden Market Authority v. Lisa Shentall-Lee, DPA
Case No. D2025-0172

1. The Parties

The Complainant is Covent Garden Market Authority, United Kingdom, represented by Sipara, United Kingdom.

The Respondent is Lisa Shentall-Lee, DPA, United Arab Emirates, represented by Abou Naja Intellectual Property, United Arab Emirates.

2. The Domain Names and Registrar

The disputed domain names <newcoventgdn.com>, <newcoventgdn.info>, <newcoventgdn.net>, and newcoventgdn.org> are registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 16, 2025. On January 16, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 16, 2025, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 22, 2025, 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 3, 2025.

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 6, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2025. The Response was filed with the Center on February 18, 2025.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on March 5, 2025. 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 owns and manages the New Covent Garden Market which is the principal wholesale market for fruit and vegetables for London in the United Kingdom.

The Complainant was originally established under the Covent Garden Market Act 1961 to manage the then Covent Garden Market, which had been operating since the 17th century. In 1974, the Complainant relocated the market to its current location in Nine Elms, Wandsworth and the new facility was renamed the New Covent Garden Market.

Under the name New Covent Garden Market, the Complainant owns the buildings and facilities comprising the market and leases trading and office space to vendors and other traders. The site provides business premises for some 167 small and medium sized companies who employ more than 2,000 people. The Complainant's revenues in the 2022 and 2023 financial years each exceeded GBP 14 million. The businesses operating from the New Covent Garden Market had a combined turnover of GBP 888 million in the 2023 financial year.

The Panel notes from a Google search that the site of the New Covent Garden Market is some three miles from the district in London known as Covent Garden, the location of the eponymous Opera House, and a shopping and entertainment destination.

The Complainant promotes its services from a website at "www.newcoventgardenmarket.com".

The Complaint includes evidence that the Complainant owns a number of registered trademarks including:

(1) European Union Trademark No 002642882, NEW COVENT GARDEN MARKET, which has been registered with effect from April 4, 2002, in respect of a range of food products in International Classes 29 and 30 and restaurant and catering services in International Class 43;

(2) European Union Trademark No 005746052, NEW COVENT GARDEN MARKET, which has been registered with effect from April 4, 2002, in respect of a wide range of goods and services in International Classes 30, 31, 32, 33, 35, 36, 37, and 39;

(3) United Kingdom Registered Trademark No UK00003300281, for the figurative version of NEW COVENT GARDEN MARKET shown below, which has been registered with effect from March 28, 2018, in respect of a wide range of goods in International Classes 16, 29, 30, 31, 32, 33, 35, 36, 37, 38, 39, 41, 42, 43, and 45. The services covered by the Class 41 specification include education and training services, entertainment services and sporting and cultural activities.

The coloured version of the Complainant's figurative mark, which also features on its website, is:

According to the WhoIs Report, the disputed domain names were registered on June 20, 2024.

When the Complaint was filed, each disputed domain name resolved to a parking page provided by the Registrar which, according to the evidence provided by the Complainant, invited the browser to use the Registrar's domain broking service to see if it was for sale with a suggested offer price of GBP 94.99.

When the Panel entered the disputed domain names into a browser in the course of preparing this decision, each disputed domain name resolved to the Registrar's parking page featuring a button "Get This Domain" and three pay-per-click (PPC) advertising links such as "Food Menu", "London Theatre Tickets", and "Restaurant Menu" – there were slight variations in the PPC links presented on the different disputed domain names.

The Respondent has a registered trademark in the United Arab Emirates, No. 418950, for a figurative mark featuring NEW COVENT GARDEN MARKET as shown below, which was filed on March 13, 2024, and registered on October 3, 2024, in respect of services in International Class 41:

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a disputed domain name, the Complainant must demonstrate each of the following:

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

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

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

A. Identical or Confusingly Similar

The first element that the Complainant must establish for each disputed domain name is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

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 the 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.

The Complainant has proven ownership of registered trademarks for the plain word and figurative versions of NEW COVENT GARDEN MARKET.

The comparison of each disputed domain name to the Complainant's trademark simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., WIPO Overview 3.0, section 1.7.

For that reason and because this requirement under the Policy is essentially a standing requirement, the Respondent's arguments based on her registered trademark are more appropriately addressed under the other elements of the Policy.

In undertaking the comparison, it is permissible in the present circumstances to disregard the generic Top Level Domain (gTLD) components as a functional aspect of the domain name system. WIPO Overview 3.0, section 1.11.

In addition, it is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. Where the textual elements have been disclaimed in the registration or cannot fairly be described as an essential or important element of the trademark, however, different considerations may arise. See for example, WIPO Overview 3.0, section 1.10. The figurative elements of the Complainant's trademarks are not so dominating that the verbal element cannot be considered an essential or important part of the trademarks in this case. Accordingly, it is appropriate to apply the usual rule.

Disregarding the respective gTLDs and the figurative elements, therefore, each disputed domain name consists of the Complainant's registered trademark save that the acronym "gdn" has been substituted for the word "garden" and omits the word "market" entirely.

As the Complainant submits, "gdn" is a fairly obvious contraction of "garden". As this requirement under the Policy is essentially a standing requirement, this substitution and the omission of the word "market" do not preclude a finding of confusing similarity. See e.g., WIPO Overview 3.0, section 1.8. On the contrary, the Complainant's trademark essentially remains visually and aurally recognisable within the disputed domain name. As the Complainant points out, "New Covent Garden", unlike the locality in London known as "Covent Garden", is not the name of a geographical place but a substantial and significant part of the Complainant's business or trading name and trademark.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain names.

Paragraph 4(c) of the Policy sets out three examples of circumstances which can be situations in which the Respondent has rights or legitimate interests in a disputed domain name. These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a 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.

There is no dispute between the Parties that:

(1) The Respondent registered the disputed domain names after the Complainant began using the trademark and also after the Complainant had registered its trademark;

(2) The Respondent is not affiliated with the Complainant;

(3) The Complainant has not otherwise authorised the Respondent to use the disputed domain names;

(4) The disputed domain names are not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived.

These factors are usually sufficient to establish a prima case that the Respondent does not have rights or legitimate interests in a disputed domain name.

In the present case, however, the Respondent contends that she registered the disputed domain names to establish an online presence for a business within the scope of the services covered by her registered trademark. The Respondent further contends that this is a different field of business and in a different country or territory to the Complainant's business.

Where a respondent has a registered trademark corresponding to the disputed domain name, panels will typically find that the respondent has rights or legitimate interests in that domain name. However, that is not automatically the case. WIPO Overview 3.0, section 2.12.2. The panel is required to assess the legitimacy of the respondent's claim in light of all the circumstances and form a view, if possible, about whether the trademark has been registered in good faith or merely as some sort of pretext. An example where the respondent's registration of a trademark was not sufficient to confer rights or legitimate interests is *Aukro Ukraine LLC v. PrivacyYes.com, Igor Spodin*, WIPO Case No. D2013-1568. That case is not on all fours with the present case, however, as it appears at least that both parties were operating in the same field and the same country.

In the present case, the Respondent did apply to register her trademark some three months before the disputed domain names were registered. There is a factual error in the Respondent's contentions in that the Complainant's figurative registration in the United Kingdom does cover educational and entertainment services like those the Respondent apparently plans to offer. The Complainant's trademark is, however, limited in territorial scope to the United Kingdom and, as the Respondent points out, the Respondent is located in a different country to the Complainant and the Complainant has not claimed trademark-like rights in the United Arab Emirates. These considerations point in favour of the Respondent.

The different geographical locations of the Complainant and the Respondent, however, is not a decisive consideration in view of the global nature of the Internet (see e.g., WIPO Overview 3.0, section 3.2.2 (in the context of registration and use in bad faith)).

In that connection, the Panel notes that the disputed domain names are all registered in generic TLDs, not a country-specific TLD. While there is no logical or technical reason why registration in a gTLD indicates an intention to trade globally or that a registration in a country-code TLD (ccTLD) is necessarily limited to business or other activity in that country, there is nothing in the record in this proceeding to indicate that the Respondent's plans are confined to a business directed just to a market in the United Arab Emirates.

Indeed, the Response does not indicate that there is in fact an existing business. Rather, it appears to be a plan to start a business. Apart from the registration of the trademark and the disputed domain names, there

is no material before the Panel to indicate what steps have been taken by the Respondent to start up this proposed business. As already noted, the fact of the prior registration of the trademark will usually be sufficient evidence of rights or legitimate interests but, it is not invariably so.

In the present case, the striking feature is that the expression "New Covent Garden Market" is a composite term and a coined or fanciful trademark. It has significance only as the Complainant's trademark which has been in use for 50 years. Neither it, nor New Covent Garden, has any obvious or direct descriptive connection with the services the Respondent claims to be providing or, prior to her registration of the trademark, the Respondent.

Further, the Complainant appears to have built up a substantial reputation in its trademark over the 50 years of its use. Further still, it is clear that the Respondent while now located in the United Arab Emirates is from the United Kingdom. For example, the details for the registered trademark included in the Global Brand Database (which the Panel has accessed to verify the registration of the Respondent's trademark) specify the United Kingdom as the country of the trademark owner. The Complainant also introduced evidence, undisputed by the Respondent, that the Respondent has been involved as a member or director of four companies based in London. It appears likely, therefore, that the Respondent was aware of the Complainant and its trademark when adopting her trademark and the disputed domain names.

Indeed, the Respondent has not denied knowledge of the Complainant or its trademark. Nor has the Respondent offered an explanation of how she came to adopt "New Covent Garden" as her trademark.

Having regard to the reputation of the Complainant in its trademark, the distinctiveness of that trademark and its lack of any descriptive or other semantic meaning in connection with either the Respondent's proposed services or the Respondent herself, and the Respondent's connection to London, therefore, the Panel finds it is likely the Respondent adopted her trademark and the disputed domain names to take advantage of their resemblance to the Complainant's trademark and its associated goodwill. That kind of opportunistic behaviour, targeting the trademark significance of the Complainant's trademark, does not qualify as good faith under the Policy.

Accordingly, the Panel finds that the Respondent has not rebutted the prima facie case established by the Complainant. Therefore, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain names have been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g., *Group One Holdings Pte Ltd v. Steven Hafto*, WIPO Case No. D2017-0183.

For the reasons outlined in section 5B, the Panel finds it is likely that the Respondent was well aware of the Complainant's trademark when adopting her trademark and the disputed domain names and did so to take advantage of their resemblance to the Complainant's trademark and reputation. That is sufficient to constitute registration of the disputed domain names in bad faith.

Accepting for present purposes that the Respondent planned to use the disputed domain names in connection with some planned educational or cultural activities, that nonetheless is use seeking to take advantage of the reputation associated with the Complainant's trademark and likewise bad faith under the Policy.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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 <newcoventgdn.com>, <newcoventgdn.info>, <newcoventgdn.net>, and <newcoventgdn.org> be transferred to the Complainant.

/Warwick A. Rothnie/
Warwick A. Rothnie
Sole Panelist
Date: March 19, 2025