

ADMINISTRATIVE PANEL DECISION

William Grant & Sons Limited v. Ilya Krakovich
Case No. D2023-3660

1. The Parties

The Complainant is William Grant & Sons Limited, United Kingdom, represented by Demys Limited, United Kingdom.

The Respondent is Ilya Krakovich, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <glenfiddichsportsbook.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 31, 2023. On August 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 1, 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, DomainsByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 11, 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 September 15, 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 September 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 12, 2023.

The Center appointed Theda König Horowicz as the sole panelist in this matter on October 25, 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 was founded in 1887 and is a company incorporated in the United Kingdom and located in Scotland. It is known for distilling, marketing and distributing Scotch whisky and other spirits under several brands including GLENFIDDICH which has been since decades one of the world's best-selling whiskies in the world and which has received numerous awards, including in the United States.

The Complainant owns a large global portfolio of registered trademarks for the term GLENFIDDICH, including:

- United Kingdom Trademark Registration No 809941, in international class 33, of August 26, 1960
- European Union Trademark Registration No 192575, in international class 33, of October 20, 1998
- United States Trademark Registration No 3980808, in international class 33, of June 21, 2011.

The Complainant is also the owner of many domain names comprising GLENFIDDICH such as <glenfiddich.com> which was registered in August 1995 and which promotes the GLENFIDDICH whisky and brand.

The Respondent is based in the United States. The disputed domain name was created on June 27, 2023 and resolved to a pay-per-click ("PPC") advertising webpage containing third-party commercial advertising links notably related to whisky and which are not endorsed by or associated with the Complainant.

The Respondent is also the owner of several other domain names including other well-known alcoholic brands accompanied by the term "sportsbook".

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name based on the following grounds:

Firstly, the Complainant alleges to be the owner of several registrations for the trademark GLENFIDDICH. The disputed domain name contains this trademark in its entirety with the addition of the dictionary words "sports" and "book" which do nothing to distinguish the disputed domain name from Complainant's mark. The general Top-Level Domain name ("gTLD") ".com" is also not sufficient to make a difference with the disputed domain name. The Complainant therefore contends that the disputed domain name is confusingly similar to the Complainant's trademark.

Secondly, the Complainant raises that the Respondent does not have any rights or legitimate interests in the disputed domain name and seeks to make out a *prima facie* case considering that

- (i) no evidence was found that the Respondent is commonly known by the disputed domain name or that he owns any trademark rights incorporating the term GLENFIDDICH. No license or authorization was given by the Complainant to the Respondent to use its mark.
- (ii) the Respondent is not using the disputed domain name for a *bona fide* offering of goods or services. The disputed domain name actually resolves to a pay-per-click advertising webpage and thus surfs on the well-known character of the Complainant's GLENFIDDICH brand in order to misdirect Internet users to third-party advertising.

(iii) the Respondent also targeted rights of other well-known brands of alcoholic beverages by registering these brands as domain names with the same addition of the term “sportsbook”. Such pattern is indicative of the Respondent’s lack of legitimate interest.

Thirdly, the Complainant contends that the disputed domain name was registered and is being used in faith. In this regard, the Complainant reiterates that the disputed domain name resolves to a PPC webpage advertising third-party brands and thus used the attractive force of the GLENFIDDICH brand for commercial gain. The Complainant also reiterates that the Respondent has engaged in a pattern of conduct of preventing trademark holders from reflecting their marks in domain names. Such abusive domain name registrations is highly indicative that the disputed domain name was registered and used in bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules, the “Panel shall decide the Complaint in accordance with the Policy, these 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 domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) that the 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 Complainant. At the same time, in accordance with paragraph 14(b) of the Rules, “[i]f 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 Complainant has shown to have obtained trademark rights in GLENFIDDICH in several countries including in the United Kingdom and the United States.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), “[t]he standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name [...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s registered trademark GLENFIDDICH since it contains this mark in entirety. The addition of the term “sportsbook” in the disputed domain name does not prevent a finding of confusing similarity as the relevant trademark, here the well-known GLENFIDDICH trademark, remains clearly recognizable within the disputed domain name. See section 1.8 of the [WIPO Overview 3.0](#).

The gTLD “.com” is viewed as a standard registration requirement, and as such is typically disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) being commonly known by the domain name; or
- (iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made sufficient statements in order to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name.

In particular, the Complainant has not licensed or otherwise permitted the Respondent to use its trademarks. There is no evidence showing that the Respondent would be commonly known by the disputed domain name or that a legitimate business would be run by the Respondent under the disputed domain name.

The Panel therefore finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and the burden of production shifts to the Respondent who has chosen not to reply.

The Respondent has not rebutted the Complainant's *prima facie* case, and there is no evidence of the types of circumstances set out in paragraph 4(c) of the Policy that might give rise to rights or legitimate interests in the disputed domain name on the part of the Respondent in these proceedings.

The Panel notes that the disputed domain name resolves to a PPC webpage providing links to third-party websites, some of which relating to whisky as GLENFIDDICH. This behavior does not qualify as a legitimate noncommercial or fair use under the Policy.

As already stated before, nothing is contained in the case file which would show that the disputed domain name has been legitimately noncommercial or fairly used by the Respondent or that the Respondent would have any rights or legitimate interests in the disputed domain name.

Furthermore, the nature of the disputed domain name, incorporating the Complainant's well-known GLENFIDDICH trademark in its entirety with the mere addition of the term "sportsbook" does not show that the Respondent would have rights or legitimate interests in the disputed domain name and carries a risk of implied affiliation.

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

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the complainant to prove both registration and use of the 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 domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 holder's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the holder's 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 holder's respondent's website or location or of a product or service on the holder's respondent's website or location.

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

Given the circumstances of the case, including the fact that the disputed domain name identically reproduces the Complainant's well-known GLENFIDDICH trademark and resolves to a webpage that provides PPC links to third-party websites, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant's trademark and business which is widely promoted worldwide through the Complainant's official websites, notably through the website "www.glenfiddich.com".

The Respondent indeed uses without authorization Complainant's well-known trademark for its own commercial purpose. As the Complainant has shown, the Respondent developed a pattern of registering famous brands (including famous brands for alcoholic beverages), all associated with the term "sportsbook" and linked to PPC webpages, which is another indication of bad faith.

The Respondent has not contested the allegations made by the Complainant and his silence in these proceedings is an additional evidence of bad faith in these circumstances. The Panel therefore finds that the disputed domain name was registered and is being used in bad faith.

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

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, <glenfiddichsportsbook.com>, be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: November 8, 2023