

## **ADMINISTRATIVE PANEL DECISION**

**William Grant & Sons Limited v. Host Master, 1337 Services LLC**  
Case No. D2023-4891

### **1. The Parties**

The Complainant is William Grant & Sons Limited, United Kingdom, represented by Demys Limited (a Com Laude Group company), United Kingdom.

The Respondent is Host Master, 1337 Services LLC, Saint Kitts and Nevis.

### **2. The Domain Name and Registrar**

The disputed domain name <balvenieapi.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 23, 2023. On November 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 24, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 28, 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 November 30, 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 December 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 2, 2024.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on January 10, 2024. 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 is a company incorporated in the United Kingdom and located in Scotland that distills, markets and distributes Scotch whisky and other spirits under brands such as BALVENIE, GLENFIDDICH, GRANT'S, HENDRICK'S, TULLAMORE DEW, etc. The Complainant's BALVENIE whisky takes its name from Balvenie Castle, which was built in the 12th century and next to which William Grant in 1886 laid the foundation stone for its first distillery.

The Complainant owns a large portfolio of BALVENIE trademarks, including the United Kingdom Trademark Number 885731, the United States Trademark Number 888377 and the European Union Trademark Number 192591, respectively registered on October 19, 1965, March 24, 1970 and January 7, 1999.

The Complainant has also operated a website at the URL "www.thebalvenie.com" since December 2000.

The disputed domain name was registered by the Respondent on June 28, 2023, and at the time of the filing of the Complaint, it resolved to an online login webpage.

#### **5. Parties' Contentions**

##### **A. Complainant**

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

Notably, the Complainant contends that:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant is the owner of a large global portfolio of registered trademarks for the term BALVENIE, which pre-dates the registration of the disputed domain name by more than 57 years. The disputed domain name incorporates the Complainant's BALVENIE mark in its entirety, with the addition of the suffix "API", which is a common acronym for "Application Programming Interface". API is a set of defined rules that enable different applications to communicate with each other. An API allows entities, such as the Complainant, to open their application data and functionality to external third-party developers, business partners, and internal departments within their companies. BALVENIE mark is the first, most recognizable and dominant element of the disputed domain name. As such, the adornment does nothing to distinguish the disputed domain name from the Complainant's mark or dispel any confusion between the disputed domain name and the Complainant. In fact, the adornment "API" increases the potential for confusion as it suggests that the disputed domain name relates to an API system created or endorsed by the Complainant. The top-level domain name <.com> is required only for technical reasons and can be ignored for the purposes of comparison of the disputed domain name to the Complainant's mark, as is common in dispute proceedings.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant seeks to make out a prima facie case to demonstrate that the Respondent does not have rights or legitimate interests in the disputed domain name. The Complainant has found no evidence that the Respondent has been commonly known as BALVENIE or BALVENIE API prior to or after the registration of the disputed domain name. The Complainant has found no evidence that the Respondent owns any trademarks incorporating the terms BALVENIE or BALVENIE API. Equally, the Complainant has found no

evidence that the Respondent has ever traded legitimately under the business names BALVENIE or BALVENIE API. The Respondent is not a licensee of the Complainant and has not received any permission, consent or acquiescence from the Complainant to use its marks in association with the registration of the disputed domain name or, indeed, any domain name, service or product. Given the confusing similarity of the disputed domain name to its mark, there is no conceivable use to which the disputed domain name could be put now, or in the future, that would confer any legitimate interest upon the Respondent. The 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. The incorporation of its well-known BALVENIE brand and mark, in combination with an adornment that has inherent Internet connotation, falsely suggests sponsorship or endorsement of the Respondent by the Complainant. The Complainant contends that the addition of the adornment "API" does not dispel this confusion, and that the Complainant's business partners or Internet users typing in the disputed domain name or finding it via a search engine, would reasonably expect the disputed domain name to be associated with or endorsed by the Complainant. The Respondent's use of the disputed domain name to impersonate the Complainant or imply endorsement of the Respondent by the Complainant, cannot constitute a *bona fide* offering of goods and services. The Respondent's non-response to the communication sent by the Complainant's agent and failure to give an explanation to the Complainant's assertions is similarly an admission of the Complainant's contentions.

- The disputed domain name was registered and is being used in bad faith. The disputed domain name is confusing in and of itself, and its registration creates a presumption of bad faith upon the Respondent. The confusion is not dispelled by Internet users' arrival on the Respondent's website, as it lacks any disclaimer that would dispel this confusion. The lack of disclaimer is indicative of the Respondent's intention to mislead Internet users into believing that its website is an authorized website, and demonstrates the Respondent has registered and used the disputed domain name in bad faith in terms of the Policy. The Complainant has a reasonable apprehension that the disputed domain name and its associated website might be used to harvest login credentials from the Complainant's employees, suppliers, and business partners. The use of a privacy service by the Respondent is further indication of bad faith registration and use of the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

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

### **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 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.

Annex 9 to the Complaint shows registrations of BALVENIE trademarks obtained by the Complainant, including in the United Kingdom, in 1965.

The trademark BALVENIE wholly encompassed within the disputed domain name, together with the term “api”, as well as with the generic Top-Level Domain (“gTLD”) suffix “.com”.

Although the addition of other terms (here, “api”, a common acronym for “Application Programming Interface”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is also well established that the addition of a gTLD, such as “.com”, is typically disregarded when determining whether a domain name is confusingly similar to a complainant’s trademark as such is viewed as a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the 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.

## **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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the 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.

The Panel finds no indication that the Respondent is commonly known by the disputed domain name. The Complainant has asserted that the Respondent is not an authorized representative, nor has obtained any permission for the registration and use of the disputed domain name.

The Panel notes the Complainant’s argument that the composition of the disputed domain name suggests a connection with an API system created or endorsed by the Complainant, and the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

Also, the disputed domain name has been used for a website requesting credentials to login, and the Respondent did not provide any reasonable explanation for the composition or use of the disputed domain name. Panels have held that the use of a domain name for illegal activity (here, claimed impersonation/passing off) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1. The disputed domain name includes the famous trademark BALVENIE, together with a common Internet term acronym, used to make reference to a technology that allows online communication between computers and other digital systems.

Therefore, the Panel considers that the addition of the term "api" may even enhance the perception that the disputed domain name is sponsored or endorsed by the Complainant, in the present case, as it may suggest that it is the official BALVENIE portal for business partners or employees, operated by the Complainant or by an authorized online representative.

Furthermore, when the disputed domain name was registered (in 2023) the BALVENIE trademark was already connected with the Complainant's whisky worldwide.

Therefore, the Panel concludes that it is not feasible that the Respondent was not aware of the Complainant's trademark and that the registration of the disputed domain name was a mere coincidence.

The current content at the website linked to the disputed domain name does nothing to distinguish the disputed domain name from the Complainant's mark or dispel any confusion between the disputed domain name and the Complainant, as there is no disclaimer or justification for the use of the term "balvenieapi". The Respondent did not reply to the communication sent by the Complainant's agent, nor to the present Complaint. In this context, the Panel concludes that the Respondent has intentionally attempted to attract, through the registration and use of the disputed domain name, the Complainant's customers, for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website.

Furthermore, the use of the term "api" and the request to enter credentials on such a website, which is not operated by the Complainant or by parties authorized by it, at the very least raises serious suspicions of fraud, as stated by the Complainant. Panels have held that the use of a domain name for illegal activity (here, claimed unauthorized account access/hacking and impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Therefore, having reviewed the record, the Panel finds the registration and use of the disputed domain name constitutes bad faith under the Policy.

### **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 <balvenieapi.com> be transferred to the Complainant.

*/Rodrigo Azevedo/*

**Rodrigo Azevedo**

Sole Panelist

Date: January 25, 2024