

DISPUTE RESOLUTION SERVICE

D00022852

Decision of Independent Expert

William Grant & Sons Limited

and

Mr Craig Richardson

1. The Parties:

Lead Complainant: William Grant & Sons Limited
The Glenfiddich Distillery
Dufftown
Banffshire
AB55 4DH
United Kingdom

Respondent: Mr Craig Richardson
Southport

2. The Domain Name(s):

grantswhiskey.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

| | | |
|----------------|-------|---|
| 21 July 2020 | 11:21 | Dispute received |
| 22 July 2020 | 15:15 | Complaint validated |
| 22 July 2020 | 15:19 | Notification of complaint sent to parties |
| 23 July 2020 | 09:37 | Response received |
| 23 July 2020 | 09:37 | Notification of response sent to parties |
| 27 July 2020 | 15:10 | Reply received |
| 28 July 2020 | 02:30 | Reply reminder sent |
| 31 July 2020 | 14:50 | No reply received |
| 04 August 2020 | 15:45 | Mediator appointed |
| 05 August 2020 | 11:30 | Mediation started |
| 25 August 2020 | 11:50 | Mediation failed |
| 25 August 2020 | 11:50 | Close of mediation documents sent |
| 26 August 2020 | 11:34 | Expert decision payment received |

4. Factual Background

The Complainant, William Grant & Sons Limited, distills, markets, and distributes Scotch whisky, vodka, and other spirits. It is the holder of the following trade marks related to one of its products, a blended Scotch whisky:

- GRANT'S, UK trade mark No. 542300 registered on 15 June 1933 in class 33;
- GRANT'S, EU trade mark No. 192484 registered on 16 April 2003 in class 33.

The Domain Name was registered on 3 January 2019 and currently points to a parking page.

After having obtained the redacted contact details of the Respondent through Nominet, the Complainant contacted the Respondent on 10 June 2020. This triggered correspondence between the parties, which can be summarized as follows:

- The Respondent firstly noted that it is not *"his intention to use this domain name in a commercial capacity"*. He initially *"wanted to create a website focusing on whisky reviews for enthusiasts"*. In the same email, the Respondent states the following: *"Around the time of purchasing the domain I believe it did attempt to contact the main contact centre via email sent to:grantswhisky@grantswhisky.com in order to notify you of the purchase. I*

will certainly transfer the domain. It would be my intention to sell the domain back to you for a fair price.”

- The Complainant’s agent asked the price for which the Respondent would be willing to sell the Domain Name. The Respondent replied suggesting *“I feel a fee of £4.500 would be fair.”*
- When asked why the Respondent had valued the Domain Name at this amount the Respondent observed: *“To be honest I just feel it is a fair price. I am no expert so I cannot quote the rules on how domain names are valued but I would imagine it comes down to what your client is willing to do, within reason.”*
- The Complainant rejected the Respondent’s suggested price and offered to pay his out-of-pocket costs relating to the registration and renewal of the Domain Name. The Respondent refused.
- After some discussions regarding the DRS Policy, the Respondent concluded with the following: *“I can confirm that it is no longer my intention to sell the domain name. I will keep hold of the domain name, I do not intend to use the domain name maliciously, but I intend, as is my right, to hold on to the domain name as I bought it and registered it legally. I initially wanted to sell the domain name when you contacted me but I believe that your client views me as someone who is attempting to take advantage of their status. Thinking on the initial offer my view was that it was fair but your clients response has highlighted to me that their belief is that my intention is abusive, therefore again I confirm it is no longer my intention to sell the domain name.”*

5. Parties’ Contentions

5.1 The Complainant’s contentions can be summarised as follows:

- the Domain Name only differs from the Complainant’s GRANT’S mark mentioned above by the addition of the generic dictionary word “whiskey”. Given that this word is intrinsically associated with the Complainant and its GRANT’S mark, it does not distinguish the Domain Name from the Complainant’s mark or lessen any potential for confusion.
- the Complainant further contends the Domain Name is an Abusive Registration in terms of Policy paragraph 5.1.1.1, in that it is clear from the correspondence between the Parties that the Respondent registered the Domain Name for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name.

According to the Complainant, the Respondent's offer to sell the Domain Name for £4,500 is well in excess of the Respondent's out-of-pocket costs in relation to the registration of the Domain Name.

- The Complainant indicates that while the Respondent initially noted that he "...wanted to create a website focusing on whisky reviews for enthusiasts", there is no evidence that these were the Respondent's true intentions. In the absence of any evidence of a *bona fide* use, the Complainant avers that on balance it is more likely than not that the Respondent's intention renders the Domain Name an Abusive Registration.
- In the Complainant's view, the passive holding of the Domain Name does not prevent the Domain Name from being confusing and/or misleading. Given the Domain Name so clearly relates to the Complainant, the Domain Name will constitute just such a threat to the Complainant's Rights and interests and that web users will likely be misled into thinking that the Domain Name is registered to, operated or authorised by the Complainant, when in fact it is not. In such circumstances, the Complainant contends that the Domain Name is an Abusive Registration in terms of the Policy.
- Finally, the Complainant claims that the Respondent cannot rely on any of the factors in paragraph 8 of the Policy to show that the Domain Name is not an Abusive Registration.

5.2 The Respondent's contentions can be summarised as follows:

- the Respondent purchased the Domain Name whilst attempting to gain a domain name for a potential whiskey lovers web page, although it hasn't been set up due to other commitments.
- the Respondent claims he has not done anything malicious nor has used the Domain Name for his own gain. In the Respondent's view, we live in a free society and as long as he is doing nothing malicious to hurt the Complainant's brand, the Respondent does nothing wrong.
- the Respondent claims that the Complainant is attempting to get its own way without entertaining any other option. He therefore told the Complainant that the Domain Name was not for sale.

6. Discussions and Findings

Pursuant to paragraph 2 of the Policy a Complainant must show, on the balance of probabilities, that:

- (i) it has Rights in respect of a name or mark which is identical or similar to the Domain Name, and that
- (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

'Rights' are defined in the Policy as "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights and descriptive terms which have acquired a secondary meaning".

It is well accepted that the question of Rights falls to be considered at the time that the Complainant makes its Complaint and is a test with a low threshold to overcome.

The Complaint provided evidence of registered trade mark rights in the word GRANT'S, as well as evidence demonstrating trading activity under the GRANT'S brand name.

Therefore, the Expert finds that the Complainant has Rights in respect of the word GRANT'S.

The Domain Name incorporates the Complainant's GRANT'S trade mark in its entirety and simply adds the generic, non-distinctive term 'whiskey'.

As mentioned in the Experts' Overview (available on the DRS website), such *'additional elements rarely trouble experts'*. For example, in DRS 06973 veluxblind.co.uk the expert commented "The Domain Name consists of the Complainant's distinctive trademark and the descriptive word "blind", which does nothing to distinguish the Domain Name from the mark, since the mark is associated in the public mind with the Complainant's blinds."

Similarly, in the present case, the word "whiskey" does nothing to distinguish the Domain Name from the Complainant's GRANT'S mark, since the mark is associated in the public mind with the Complainant's whisky. The Expert accepts the Complainant's argument that while it typically uses the British spelling of "whisky", the Respondent's use of the American or Irish "whiskey" does not sufficiently distinguish the Domain Name from the Complainant's mark or lessen any potential for confusion.

It is well established under the Policy that the first and second level domains may be ignored for the purposes of similarity.

The Complainant has therefore satisfied paragraph 2.1.1 of the Policy and demonstrated that it has Rights in a name or mark which is identical or similar to the Domain Name.

Abusive Registration

Under paragraph 1 of the Policy, an Abusive Registration means a domain name which either:

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- (ii) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

This definition covers both the time of the registration and later use. It is sufficient to satisfy either of the limbs for there to be a finding of an Abusive Registration.

Under paragraph 5.1.1.1 of the Policy, the following may be evidence of an Abusive Registration: circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name.

In the present case, the Respondent did not contest the fact that his offer to sell the Domain Name for £4,500 was well in excess of his out-of-pocket costs in relation to the registration of the Domain Name. In his correspondence with the Complainant, the Respondent stated the following in that regard: *"To be honest I just feel it is a fair price. I am no expert so I cannot quote the rules on how domain names are valued but I would imagine it comes down to what your client [the Complainant] is willing to do, within reason."*

The above clearly shows that the Respondent intended to make profit with the sale of the Domain Name to the Complainant at some point, even if it is unclear whether it is the Complainant or the Respondent which took the first initiative to contact the other party. Evidence shows that the Complainant reached out to the Respondent in June 2020 but the Respondent states that he tried to contact the Complainant around the time of purchasing the Domain Name, which was acquired in January 2019. The Respondent claims that his initial intention was to use the Domain Name for a potential whiskey lovers web page, which would suggest that selling the Domain Name at a profit would not be the Respondent's primary intention. However, the Respondent did not provide any evidence supporting his claim.

In any event, the Expert finds that in the present case, other circumstances also point to an Abusive Registration.

The Respondent essentially takes the view that as long as he is doing nothing malicious to hurt the Complainant's brand, the Respondent does nothing wrong. The Respondent ultimately claims he does not want to sell the Domain Name but simply wants to hold on to it. It is true that failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration. However, in certain circumstances, e.g. where the name is a known brand and the Respondent has no obvious justification for having adopted the name, the non-use itself can constitute a threatened abuse hanging over the head of the Complainant (see paragraph 1.3 of the DRS Expert's Overview and DRS 17902 enterprise-car.co.uk et al. where the expert found that *"given the nature of the Disputed Domain Names (which can have no other meaning except in relation to the Complainant), the Respondent's non-use of the Disputed Domain Names constitutes a threat hanging over the head of the Complainant that amounts to Abusive Registration within the meaning of the Policy, as internet users will likely be misled into thinking that the Disputed Domain Names are registered to, operated or authorised by the Complainant, when in fact they are not."*).

In the Expert's view, this reasoning applies to the present case. The Complainant's GRANT'S mark was registered decades before the Domain Name, and the Complainant has provided evidence of longstanding use of the mark in relation to a whisky product. The Domain Name combining the Complainant's GRANT'S mark and the word "whiskey" can therefore have no other meaning except in relation to the Complainant.

Finally, paragraph 8 of the Policy provides a non-exhaustive list of circumstances which may be evidence that the Domain Name is not an Abusive Registration. None of those circumstances would seem to assist the Respondent:

- as mentioned above, the Respondent has put forward no reasonable evidence that the Domain Name was to be used in association with any genuine offering of goods and services;
- the Respondent does not show that he is commonly known by or legitimately connected with the term "GRANT'S" or "GRANT'S WHISKEY" or any other similar term;
- despite the Respondent's allegations that his initial intention was to use the Domain Name for a potential whiskey lovers web page, the Respondent did not make legitimate non-commercial or fair use of the Domain Name;
- the Domain Name is not generic or descriptive as the dominant element is the Complainant's mark GRANT'S.

Under these circumstances, the Expert finds that the Domain Name has been used in a manner which has taken unfair advantage of the Complainant's Rights. The Complainant has therefore, on the balance of probabilities, demonstrated Abusive Registration pursuant to paragraph 2.1.2 of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in a name and mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name <grantswhiskey.co.uk> be transferred to the Complainant.

Signed: Flip Petillion

Dated: 17 September 2020