



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

Fall Nummer: D2003-0885

Entscheidung vom 23. Dezember 2003

#### **1. The Parties**

The Complainant is Diageo Ireland, Arthur Guinness Son & Co. (Dublin) Limited, Dublin, Ireland, represented by Arent Fox Kintner Plotkin & Kahn, United States of America.

The Respondent is The Director, Florida, United States of America.

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

The disputed domain name <sirguinness.com> is registered with eNom.

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 5, 2003. On November 6, 2003, the Center transmitted by email to eNom a request for registrar verification in connection with the domain name at issue. The registrar eNom failed to submit a registrar's verification response. Notwithstanding the above, the Center made a registrar's "Whois" printout on November 10, 2003, and furthermore, this Panel confirmed through the information reflected on the registrar's "Whois" website, which provides information only of the domain names that are registered by eNom, Inc., that the Respondent is listed as the registrant; that such domain name is in "registrar-lock" status; and confirmed the details for the administrative and technical contacts at which communications under this domain name dispute have been sent to. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 11, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was December 1, 2003. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 3, 2003.

The Center appointed Peter G. Nitter as the Sole Panelist in this matter on December 18, 2003. 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 leading premium drinks business, producing and marketing over 200 spirits and wines in over 200 countries under a variety of brands and trademarks, including under the trademark "GUINNESS".

Complainant is the owner of all right, title and interest in and to the GUINNESS brand, including over 1900 registrations and pending applications for GUINNESS-related trademarks and logos in over 240 countries throughout the world - including in Australia, Ireland, and the United States as well as two national

registrations for the GUINNESS trademark in Romania.

Complainant has continuously used the GUINNESS mark in connection with producing, advertising and/or marketing of GUINNESS beer in the United Kingdom since 1759, and in the United States since 1764. The Complainant also uses the GUINNESS mark to market and distribute numerous other products.

Guinness beer is one of the Complainant's flagship brands and is distributed to more than 159 markets worldwide. A total of 1,883,200,000 pints of Guinness beer are sold every year worldwide.

From the year 2000 and until January 2001, Complainant ran a promotion campaign using a racehorse named "Sir GUINNESS" as a central element. During the Promotion, the Complainant's advertising agency registered the domain name <sirguinness.com> on behalf of the Complainant and posted an extensive website at "www.sirguinness.com." The promotion campaign also included t-shirts with the slogan "That's SIR GUINNESS to you!" with the URL of the site, "www.sirguinness.com," positioned directly below the slogan. During the promotion campaign, Complainant gave away more than 90,000 such t-shirts. The Domain Name registration remained active until recently when it expired for inadvertent non-payment of the registration renewal fee.

Respondent has registered the domain name <sirguinness.com> in March 2003, without authorization from the Complainant. Respondent has redirected the domain name in question to a web page containing sexually explicit pornographic material. In addition, the site offered for sale sexually explicit pornographic images for downloading, membership to the site, anonymous e-mail service, chat, instant messaging, magazine and newsletter subscriptions and numerous links to other pornographic sites.

Respondent has later linked the domain name at issue to a web-based casino site, "www.windowscasino.com", offering casino-related software and gambling services as well as a partnership/affiliate program in connection with the site.

## **5. Parties' Contentions**

### **A. Complainant**

The domain name <sirguinness.com> is identical and confusingly similar to the Complainant's mark GUINNESS.

A review of the Domain Name shows that the only difference between the domain name and the Complainant's mark GUINNESS is the inclusion of the prefix "sir" and the inclusion of "COM" as a Top-Level Domain.

Such differences are "so de minimus and immaterial as to be inadequate to preclude any confusion from occurring." *MPL Communications, Limited and MPL Communications, Inc. v. LOVEARTH.net*, NAF Claim No. FA0104000097086, p. 15 (bad faith registration and use of domain name <sirpaulmccartney.com>). Indeed, as a result of the Complainant's Promotion, the domain name at issue and any website associated therewith have been and will continue to be associated with the Complainant and the Complainant's products and services.

Respondent has no rights or legitimate interests in the domain name at issue.

Complainant's mark GUINNESS is inherently distinctive, has been used extensively for over 200 years throughout the world in connection with the Complainant's goods and services, and is one of the most widely recognized beer brands in the world. In view of the Complainant's registered mark GUINNESS and the Complainant's long-time use of this mark as well as variations thereof, the idea suggested by <sirguinness.com> is that any possible goods or services offered in association with the contested domain name may somehow be connected with or authorized by the Complainant.

Based upon the numerous trademark registrations for, and the fame, goodwill and reputation associated with, the GUINNESS mark, it is impossible to conceive of any circumstance in which the Respondent could legitimately use the domain name at issue without creating a false impression of association with the Complainant.

In light of the Respondent's known actions with respect to domain names (e.g., registering domain names incorporating the trademarks of others, providing false contact information in the corresponding whois records, redirecting and linking to pornographic, casino and commercial websites and cyberflying a registration of a domain name during a UDRP proceeding), it is extremely unlikely that the Respondent registered the domain name unaware of the Complainant's rights in its GUINNESS mark and with an intent to use the domain name at issue in connection with any type of *bona fide* offering of goods and services. Nor has the Respondent used the domain name in connection with a *bona fide* offering of goods or services.

The Respondent has sought to capitalize upon the popularity and goodwill associated with the domain name at issue by causing unsuspecting Internet visitors to visit the Respondent's site with the belief that they were going to be presented with information on the Complainant's GUINNESS beer and brand. In addition, based upon the evidence presented, it is apparent that the Respondent is benefiting financially through advertising, commercial links, membership and affiliate programs and services from his unauthorized registration and use of the contested domain name.

Clearly, the Respondent at no time has had or will have a *bona fide* use of the domain name at issue. Nor is there any evidence that the Respondent, as an individual, business, or other organization, has been or is commonly known by the domain name or that the Respondent has acquired any trademark or service mark rights in the domain name at issue. The Complainant has not licensed, contracted, franchised or otherwise permitted the Respondent in any way to use the GUINNESS mark or to apply for any domain name incorporating such mark or any variation thereof. Furthermore, at no time has the Respondent ever had any authorization from the Complainant to register or use the Domain Name.

The Respondent has registered and is using the domain name at issue in bad faith.

Complainant's mark GUINNESS is undoubtedly famous, and it is inconceivable that the Respondent was not aware of the mark and the Complainant's ownership of the mark at all times relevant to the dispute.

It is clear that the Respondent registered the Domain Name for the purpose of selling, renting or transferring it to the Complainant. Among the circumstances that support this assertion are the fame and distinctiveness of the GUINNESS mark, the Respondent's actual knowledge of the GUINNESS mark and the Respondent's history of offering domain names for sale and the multiple redirections of the Domain Name to a variety of commercial websites.

The Respondent has registered the Domain Name to prevent the Complainant from reflecting its GUINNESS mark in a corresponding domain name and has engaged in a "pattern of such conduct" by registering multiple domain names thereby constituting bad faith registration and use of the Domain Name.

The Respondent has intentionally attempted to attract for commercial gain Internet users to its website at the contested domain name by trading on the goodwill associated with the GUINNESS brand and mark by registering and using the domain name, in which it has no legitimate rights or interests therein. By such registration and use of the domain name in view of the fame and distinctiveness of the Complainant's mark wholly incorporated therein, the Respondent has created a likelihood of confusion with respect to this mark as to the source, sponsorship, affiliation and endorsement of the corresponding website and of the products and services offered on the site.

The Respondent has been using false and inaccurate contact information in connection to the registration of the domain name at issue. A review of the whois information for the many domain names registered to the Respondent and the UDRP decision and article about the Respondent confirms that such is common practice with the Respondent. According to previous decisions under the UDRP, the above mentioned practice constitutes additional evidence as to the Respondent's bad faith.

Complainant requests the Panel to issue a decision that the registration of the contested domain name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Panel has considered the allegation by the Complainant as to the identity of the domain name at issue with the Complainant's trademarks. As a result of Respondent's default, these allegations have not been contested.

In the opinion of the Panel, Complainant's mark is to be considered a *famous mark*. The mark is integrated in its entirety into the contested domain name. GUINNESS is the relevant and distinctive part of the domain name, and the addition of the generic term "sir", is not sufficient to prevent the confusing similarity between Complainant's trademark and the contested domain name. In previous proceedings under the UDRP, Panels have found that for purposes of assessing the confusing similarity between domain names and trademarks, top-level domain extensions, spaces, hyphens and punctuation are to be ignored, see *InfoSpace.com, Inc. v. Tenenbaum Ofer*, WIPO Case No. D2000-0075, *Chernow Communications, Inc. v.*

*Jonathan D. Kimball*, WIPO Case No. D2000-0119 and *Columbia Sportswear Company v. Mahlon Keeler*, WIPO Case No. D2000-0206.

In addition, the exact words that the domain name at issue consists of, "SIR GUINNESS," has previously been used extensively in Complainant's promotion, and Complainant has furthermore previously controlled and used in its marketing the same domain name that is now contested.

For the above mentioned reasons, Internet users will in the Panel's opinion most likely believe that a website available under the domain name at issue, is at least sponsored by or affiliated to the owner of the trademark which forms the main component of the domain name.

Thus, the Panel finds that Respondent's domain name <sirguinness.com> is confusingly similar to Complainant's trademark GUINNESS.

## **B. Rights or Legitimate Interests**

The Panel has considered the allegation by the Complainant as to the lack of rights or legitimate interests of the Respondent in respect of the domain name at issue.

Complainant maintains that it has in no way authorized the respondent to register the domain name at issue. As a result of default, these allegations have not been contested by the Respondent. In the present case, it would be difficult for Complainant to prove that an authorization to register and use the domain name at issue has *not* been granted, at the same time as Respondent easily could have done so, pursuant to Paragraph 4(c) of the Policy.

Where Respondent has failed to give any response, it is therefore considered sufficient for Complainant to make a *prima facie* showing of the fact that Respondent lacks rights or legitimate interest in the contested domain name.

As a result of his default, Respondent has not produced any evidence whatsoever of his rights or legitimate interest in the contested domain name. Complainant has not granted Respondent any rights to use its trademark, nor the right to register or use the domain name at issue, nor are there any indications present that Respondent has any other rights or legitimate interests in any trademark corresponding to the domain name at issue.

Complainant has provided evidence that Respondent has directed the domain name at issue to pornographic and casino websites. Taking into consideration the fame and distinctiveness of the Complainant's trademark GUINNESS and Complainant's previous use of the word combination "SIR GUINNESS," the Panel finds it highly unlikely that Respondent would have any rights or legitimate interests in the use of a domain name that is confusingly similar to these in connection to such websites.

In the circumstances, this Panel is thus satisfied that Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interest in the contested domain name.

Hence, the Panel finds that the Respondent has no rights or legitimate interest in the contested domain name.

## **C. Registered and Used in Bad Faith**

The Panel has considered Complainant's assertions and evidence with regard to the Respondent's registration and use of the domain name in bad faith. By not submitting a response, Respondent has failed to invoke any circumstances that could demonstrate that it did not register and use the domain name at issue in bad faith.

Given the fame and distinctiveness of Complainant's trademark, and even more so the use of the word combination "SIR GUINNESS," the Panel finds that Complainant's mark undoubtedly has been known to Respondent when registering the domain name at issue.

Hence, the Panel finds that Respondent's registration and use of the domain name at issue appears to be an intentional attempt to attract, for commercial gain, Internet users to its website "www.sirguinness.com", by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of this website. These are circumstances which constitutes evidence of registration and use of a domain name in bad faith pursuant to Paragraph 4(b) of the Policy.

Other circumstances that supports the conclusion that the contested domain name is registered and used in bad faith include the Respondent's previous involvement in cybersquatting, and his submission of false and inaccurate contact information in connection to the registration of the domain name at issue.

The Panel therefore finds that the Respondent has registered and used the domain name at issue in bad faith.

## **7. Decision**

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <sirguinness.com> be transferred to the Complainant.

(Sole Panelist)