



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Harry Winston Inc. and Harry Winston, S.A. v. Harry Pluviose

Case No. D2010-0210

1. The Parties

- 1.1 The Complainants are Harry Winston Inc. of New York, New York, United States of America, and Harry Winston, S.A of Geneva, Switzerland, both represented by Bricker & Eckler LLP, of the United States.
- 1.2 The Respondent is Harry Pluviose of Brooklyn, New York, United States.

2. The Domain Name(s) and Registrar(s)

- 2.1 The disputed domain name <harrywinstonmediastock.com> (the “Domain Name”) is registered with Melbourne IT Ltd (the “Registrar”).

3. Procedural History

- 3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 11, 2010. On February 12, 2010, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 15, 2010, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.
- 3.2 In response to a notification by the Center that the Complaint was administratively deficient, the Complainants filed an amendment to the Complaint on February 17, 2010. The Center verified that the Complaint together with the amendment to the 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”).
- 3.3 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 February 22, 2010. In accordance with the Rules, paragraph 5(a), the due date for Response was March 14, 2010. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 15, 2010.

- 3.4 The Center appointed Matthew S. Harris as the sole panelist in this matter on March 19, 2010. 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

- 4.1 There are two Complainants in this case. They are a New York corporation Harry Winston Inc ("US Harry Winston") and the Swiss corporation Harry Winston S.A. ("Swiss Harry Winston"). US Harry Winston is engaged in the design, manufacture, distribution and sale of fine jewellery. Swiss Harry Winston is engaged in the design, manufacture, distribution and sale of time pieces and watches. Each is part of the "Harry Winston" business that was originally founded by Harry Winston in 1932.
- 4.2 This business claims to have invented modern couture jewellery. The Complainants are also proud of the fact that the "Harry Winston" name is even mentioned in the lyrics to "Diamonds Are a Girl's Best Friend" sung by Marilyn Monroe in the 1953 film, "Gentlemen Prefer Blondes".
- 4.3 Companies that form part of the Harry Winston business own a number of registered trade marks that incorporate or comprise the terms "Winston" or "Harry Winston". They include United States registered trade mark 3,355,622 for the term HARRY WINSTON dated December 18, 2007 in class 14 registered in the name of US Harry Winston.
- 4.4 The Domain Name was registered on April 25, 2008. It is registered in the name of the Respondent, who appears to be an individual with an address in Brooklyn, New York.
- 4.5 Since the date of the Complaint, if not earlier, the Domain Name has been used for a website that appears to promote various photographs and also contains a number of links. One of those links, "Spotlight/ Events" directs the user to a web page that contains links to YouTube video clips featuring interviews and performance by hip hop artists. It also displays advertisements for unrelated goods and services. The website continues in operation at the date of this decision.

5. Parties' Contentions

A. Complainants

- 5.1 The Complainants refer to the Harry Winston business and marks. It contends that in the last 15 years there have been USD 2.4 billion of sales of products bearing the Winston name and that the Complainants have spent in excess of USD 155 million since 2001 in marketing, advertising and promoting goods and

services under its marks.

- 5.2 As a consequence of these activities the Complainants contend that their marks have “acquired an extraordinary degree of consumer recognition in the minds of the public, and are now famous and serve uniquely to identify products and services provided by them”.
- 5.3 The Complainants contend that the Domain Name is confusingly to their marks citing cases that are said to support the proposition that there is confusingly similarity for the purposes of the Policy when a domain name incorporates in its entirety a trade mark *e.g. Dell Inc. v. George Dell and Dell Net Solutions*, WIPO Case No. D2004-0512 and *Wal-Mart Stores, Inc. v. MacLeod d/b/a/ For Sale*, WIPO Case No. D2000-0662.
- 5.4 The Complainants contend that the Domain Name is being used to “capture consumers who are seeking information on Harry Winston products and services”. They also assert that the use of the Domain Name is likely to dilute the distinctiveness of its marks or to confuse consumers into believing that the persons behind the website operating from the Domain Name are associated with, endorsed by or affiliated with the Complainants.
- 5.5 In the circumstances, they assert that the Respondent has no right or legitimate interest in the Domain Name and that the Domain Name was registered and is being used in bad faith.

B. Respondent

- 5.6 The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

- 6.1 There are no exceptional circumstances within paragraph 5(e) of the Rules so as to prevent this Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to lodge a Response.
- 6.2 Notwithstanding the default of the Respondent, it remains incumbent on the Complainants to make out their case in all respects under paragraph 4(a) of the Policy. Namely the Complainants must prove that:
 - (i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainants have rights (paragraph 4(a)(i)); and
 - (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name (paragraph 4(a)(ii)); and
 - (iii) the Domain Name has been registered and is being used in bad faith (paragraph 4(a)(iii)).
- 6.3 However, under paragraph 14 of the Rules, where a party does not comply with any provision of the Rules, the Panel shall “draw such inferences therefrom as it considers appropriate”.

A. Identical or Confusingly Similar

- 6.4 It is clear that US Harry Winston is the owner of a United States registered trade mark that comprises the words “Harry Winston” alone. The Panel also accepts that the Domain Name can only be sensibly understood as the name “Harry Winston” in combination with the words “media” and “stock” and the “.com” TLD.
- 6.5 For the reasons that are set out in greater detail in *Research in Motion Limited v. One Star Global LLC*, WIPO Case No. D2009-0227, this Panel does not accept (contrary to the Complainants assertions and notwithstanding the decision in *Wal-Mart Stores, Inc v. MacLeod d/b/a/ For Sale, supra*) that it necessarily and inevitably follows from the fact that a domain name incorporates a trade mark in its entirety that a domain name must be confusingly similar to that mark. Each case must be judged on its own facts, and the assessment will always depend on the specific mark and the specific domain name in question.
- 6.6 However, as is also explained in the *Research in Motion* case, paragraph 4(a)(i) of the Policy imposes a “threshold” or “standing” requirement. As a consequence in most cases where a domain name incorporates an entire mark that requirement will be satisfied. The Panel accepts that this requirement has been easily satisfied in this particular case. The words “Harry Winston” provide the dominant element of the Domain Name and the addition of the words “media” and “stock” do not so detract from or alter the perception of those words so as prevent a finding of confusing similarity (as that term is understood under the Policy) with US Harry Winston’s mark.
- 6.7 The Complainants have therefore made out the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

- 6.8 The Complainants contend, and the Panel accepts, that the Complainants have never authorised the Respondent to use the name Harry Winston in the Domain Name. Although it appears the Respondent’s first name is Harry, there appears to be no obvious legitimate reason why the Respondent has adopted and is using the Harry Winston name, even if there is some form of genuine photographic business operating through the website under the Domain Name.
- 6.9 Indeed, for the reasons that the Panel sets out in greater detail under the heading of bad faith below, the Panel is satisfied that the Respondent is likely to have been aware of the HARRY WINSTON mark at the time that the Domain Name was registered and (in the absence of any evidence to the contrary) that it is more likely than not that he has deliberately sought to rely upon the fame of the HARRY WINSTON mark to increase the amount of traffic to his website.
- 6.10 It has long been clear that such use of a mark, even if it is in connection with an otherwise legitimate business, does not provide a right or legitimate interest for the purposes of the Policy. It is not, for example, activity that satisfies paragraph 4(c)(i) of the Policy, since the deliberate offering of goods and services under the mark of another with the intention of benefiting from confusion with that mark does not constitute a “*bona fide* offering of goods or services”.

6.11 The Complainants have therefore made out the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

6.12 The Complainants' evidence as to the extent of the notoriety of the HARRY WINSTON mark is compelling. The history and size of the business, the degree of marketing spend and the references to the mark in popular culture all make it improbable that a person (and in particular a person based in the United States) who chose to include those words in a domain name in 2008, would not be aware of the association of those words with the Complainants' business.

6.13 It does not necessarily and automatically follow from this that the Domain Name has been registered and used in bad faith. "Harry" and "Winston" are ordinary and common names. It is not beyond the realms of possibility that those names might be legitimately chosen in relation to a business enterprise, for some reason that is un-associated with the Complainants. However, there is simply no evidence before the Panel to this effect. In the absence of this evidence, the Panel accepts the Complainants' contention that the reason that these words were chosen in this case was to take unfair advantage of the reputation that the Complainants' business had built up in that mark. In particular, it accepts on the balance of probabilities that the Respondent chose and is using the Domain Name with the belief and intent that the similarity between that Domain Name and the Complainants' mark would draw a greater number of Internet users to his website with a view to either furthering his own business or other businesses advertised on that site.

6.14 Such activity involves bad faith registration and use. It falls within the scope of the example of bad faith set out at paragraph 4(b)(iv) of the Policy.

6.15 The Complainants appear to contend that there is a risk that Internet users will believe that the activities undertaken from the website operating under the Domain Name are associated with or authorised by the Complainants. Perhaps this is so, although the Panel is sceptical. However, even if it is clear to Internet users when they reach the Respondent's site that the site is unconnected with the Complainants, it does not really matter. It is sufficient for the Respondent to have intended that by reason of initial interest confusion with the HARRY WINSTON mark, a greater number of people would be drawn to that site (see for example, the discussion of this issue in *Richard L. Dubnow v. International Brains Center S.L.*, WIPO Case No. D2008-1537, where the complainant had failed to demonstrate that intent).

6.16 The Complainants have therefore made out the requirements of paragraph 4(a)(iii) of the Policy.

D. Remedy

6.17 There are two Complainants in this case. The Panel has reached its conclusions predominantly on the basis of a mark registered in the name of US Harry Winston. The Complainants have also explicitly requested that the Domain Name be transferred in the name of US Harry Winston. In the circumstances, the Panel agrees to that request.

7. Decision

- 7.1 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 <harrywinstonmediastock.com> be transferred to Harry Winston Inc.

Matthew S. Harris
Sole Panelist

Dated: March 24, 2010