

ADMINISTRATIVE PANEL DECISION

VKR Holding A/S v. Privacy Service Provided by Withheld for Privacy ehf / Bill Philips

Case No. D2022-2839

1. The Parties

The Complainant is VKR Holding A/S, Denmark, represented by CSC Digital Brand Services AB, Sweden.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Bill Philips, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <veluxinvestment.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 2, 2022. On August 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 2, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 2, 2022, 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 August 5, 2022.

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 August 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 31, 2022.

The Center appointed Torsten Bettinger as the sole panelist in this matter on September 5, 2022. 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, domiciled in Denmark, is the parent company of the VRK Group. The VRK Group consists primarily of the VELUX and the DOVISTA Groups. The VELUX Group runs business in the field of roof windows and modular skylights, as well as decorative elements, blinds, roller shutters, installation solutions, and home automation. The Complainant VELUX Group has business presences in 40 countries and employees 15,400 individuals.

Complainant is the registered owner of the trademark VELUX for various classes across numerous jurisdictions all over the world, including the following:

- VELUX (registration No. 199209825) registered in Denmark on October 23, 1992, for the class 37;
- VELUX (registration No. 198602340) registered in Denmark on August 29, 1986, for the class 6, 19, 20, and 24;
- VELUX (registration No. 00900651869) registered in the United Kingdom on July 16 2004, for the classes 6, 9, 16, 19, 20, 22, 24, 37, 41, and 42;
- VELUX (registration No. 1091446) registered in United States of America, the domicile country of the Registrar, since May 16, 1978, for class 19;
- VELUX (registration No. 000651869) registered in the European Union since July 16, 2004, for the classes 6, 9, 16, 19, 20, 22, 24, 37, 41, and 42;
- VELUX (registration No. 000955609) registered in the European Union on March 31, 2000, for the classes 6, 7, 9, and 11;
- VELUX (International Registration No. 928560, registered on March 28, 2007, for the classes 19, 20, 24, 37, 41, and 42.

Furthermore, Complainant is running portals in the Internet under the domain names <velux.com> and <velux.dk>.

Respondent registered the disputed domain name on February 27, 2022.

The disputed domain name resolves to an inactive site and is not being used.

The Complainant has sent numerous cease and desist letters to the Respondent without receiving a response.

5. Parties' Contentions

A. Complainant

The Complainant claims that it has spent substantial time, effort, and money advertising and promoting VELUX, and has thus developed substantial goodwill in the VELUX brand. Complainant asserts that through such widespread and extensive efforts, VELUX has become distinctive and uniquely associated with Complainant and its products and services.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that the disputed domain name is confusingly similar to its registered trademark VELUX as

- the disputed domain name contains the Complainant's complete VELUX trademark and can be considered as capturing, in its entirety, Complainant's VELUX trademark;
- the mere addition of the generic term "investment" to the Complainant's trademark does not negate the confusing similarity between the disputed domain name and the Complainant's trademark under the Policy;
- the generic Top-Level Domain ("gTLD") extension is viewed as a standard registration requirement and as such is disregarded under the confusing similarity test of the Policy.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the Respondent is not sponsored by or affiliated with Complainant in any way;
- the Complainant has not given Respondent permission to use Complainant's trademarks in any manner, including in domain names;
- the Respondent is not commonly known by the disputed domain name;
- the Complainant has not licensed, authorized, or permitted Respondent to register domain names incorporating Complainant's trademark;
- the Respondent has failed to make use of this disputed domain name's website and has not demonstrated any attempt to make legitimate use of the domain name and website, which evidences a lack of rights or legitimate interests in the disputed domain name;
- at the time of filing the complaint, Respondent was using a privacy WhoIs service, which past panels have also found to equate to a lack of legitimate interest.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Complainant and its VELUX trademark are known internationally, with trademark registrations across numerous countries;
- at the time of registration of the disputed domain name, the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks
- the registration of domain names containing well-known trademarks constitutes bad faith *per se*;
- there is sufficient evidence of bad faith registration and use where a complainant's trademark is a well-known mark, which complainant used and registered many years before respondent registered the domain name.
- the Respondent had both constructive and actual knowledge of the Complainant's mark and chose nevertheless to exploit it and the goodwill developed in it;
- that the word bad faith "use" does not require a positive act on the part of the Respondent – instead, passively holding a domain name can constitute a factor in finding bad faith registration and use pursuant to Policy;
- the disputed domain name can only be taken as intending to cause confusion among internet users as to the source of the disputed domain name, and thus, the disputed domain name must be considered as having been registered and used in bad faith pursuant to Policy, with no good faith use possible;
- where the disputed domain name incorporates the Complainant's trademark in its entirety, adds the generic term "investment" whilst resolving to a blank page lacking content, there is no plausible good-faith reason or logic for the Respondent to have registered the disputed domain name, rather, it is indicative of an intention to hold the disputed domain name "for some future active use in a way which would be competitive with or otherwise detrimental to the Complainant;
- under the circumstances of this case, any use of the disputed domain name whatsoever, whether actual or theoretical, would have to be in bad faith;

- the Respondent, at the time of initial filing of the Complaint, had employed a privacy service to hide its identity, which past Panels have held serves as further evidence of bad faith registration and use;
- the Respondent's failure to respond to the Complainant's cease-and-desist letter may properly be considered a factor in finding bad faith registration and use of a domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following 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

The Complainant has demonstrated that it owns multiple trademark registrations for the mark VELUX prior to the registration of the disputed domain name on February 27, 2022.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases (see sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In this case, the disputed domain name contains the disputed domain name in its entirety and only differs from the Complainant's trademark VELUX by the addition of the term "investment".

The Panel notes that it has long been established under the UDRP case law that the addition of wording to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of [WIPO Overview 3.0](#)). The Panel therefore agrees with the Complainant's assertion that the addition of the term "investment" does not prevent a finding of confusing similarity the disputed domain name from the Complainant's trademark.

Furthermore, it is well accepted under the UDRP case law that the specific generic gTLD designation such as ".com", ".net", ".org" is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable Top-Level suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#) section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to the Complainant's VELUX trademarks in which the Complainant has exclusive rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

"(i) before any notice to you [the Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [the Respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Complainant provided evidence of its extensive use and promotion of its VELUX trademark and stated that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized by the Complainant to register the disputed domain name.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent chose not to contest the Complainant’s allegations and has failed to come forward with any evidence to refute the Complainant’s *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

On this basis and in light of the fact that the disputed domain name except for the addition of the descriptive designation “investment” contains the Complainant’s trademark in its entirety the Panel concludes that the Respondent lacks rights and legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed 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 Respondent has engaged in a pattern of such conduct; or

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

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

The Complainant holds multiple trademark registrations for the VELUX trademark in various countries that predate the registration of the disputed domain name. The VELUX mark is distinctive and is clearly associated with the Complainant and its products and services through widespread and intensive use.

It is therefore more likely than not from the record of the evidence in this proceeding that the Respondent did not coincidentally register the disputed domain name, but registered the disputed domain name with knowledge of the Complainant's rights in the VELUX mark in bad faith. Indeed, prior UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

The fact that the disputed domain name has not yet been actively used to show any substantive content does not prevent a finding of bad faith use.

UDRP Panels have consistently found that, in certain circumstances, passive holding does not prevent a finding of bad faith under the Policy. (See, e.g., *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also [WIPO Overview 3.0](#), section 3.3.)

While UDRP panels will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include:

- (i) the degree of distinctiveness or reputation of the complainant's mark,
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;
- (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and
- (iv) the implausibility of any good faith use to which the domain name may be put. (See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also [WIPO Overview 3.0](#), section 3.3.)

The circumstances of the present case are sufficiently similar to those present in *Telstra* to establish bad faith passive holding of the disputed domain name.

Based on the record in this proceeding, the Panel is satisfied that the Complainant's VELUX mark is distinctive and widely-known.

Given that the disputed domain name consists of the Complainant's VELUX mark in combination with the descriptive term "investment", the disputed domain name is also not susceptible to be used in a good faith manner.

Furthermore, the Respondent has not replied to the Complaint nor provided any evidence of actual or contemplated good faith use of the disputed domain name.

Finally, the contact details provided by the Respondent for the registration of the disputed domain name appear false, since the courier was unable to deliver the Center's written communication.

The Panel therefore finds that the circumstances, as described above, show that the Respondent's registration and passive holding of the disputed domain name equals a bad faith registration and use of the disputed domain name and therefore the Complainant also established the third element of 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, <veluxinvestment.com> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: September 16, 2022