

ADMINISTRATIVE PANEL DECISION

Viceroy Hotels, LLC and Viceroy International Hotel Management LLC v.
Lucille Echohawk
Case No. D2024-1239

1. The Parties

The Complainants are Viceroy Hotels, LLC and Viceroy International Hotel Management LLC, United States of America (“United States”), represented by Neal, Gerber & Eisenberg LLP, United States. The Complainants are collectively referred to in this decision as “the Complainant.”

The Respondent is Lucille Echohawk, United States.

2. The Domain Name and Registrar

The disputed domain name <viceroyhoteigroup.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 21, 2024. On March 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 22, 2024, 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 (Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 26, 2024, 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 March 31, 2024.

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 April 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2024. The Center received an email communication from the Respondent Lucille Echohawk, but from a different email address on April 12, 2024. The Center proceeded to the Commencement of Panel Appointment Process on May 2, 2024.

The Center appointed William F. Hamilton as the sole panelist in this matter on May 7, 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 offers luxury hotel accommodations. The Complainant's hotels and properties are located throughout the United States and in other countries.

The Complainant has obtained over 100 trademark registrations for the trademarks VICEROY and VICEROY HOTEL in many jurisdictions worldwide. These registrations owned by the Complainant include the United States Patent and Trademark Registration No. 2,670,019, dated December 31, 2002, for the trademark VICEROY HOTEL (the "Mark" for the purposes of this decision).

The Complainant's services are promoted through numerous websites and social media accounts maintained by the Complainant including the domain name maintained at <viceroyhotelgroup.com> and the Instagram account @viceroyhotels.

The disputed domain name was registered on December 27, 2023, and does not resolve to an active website. The Complainant sent a detailed "cease and desist" letter to the Respondent on February 8, 2024, asserting infringement of the Mark. The Respondent did not reply to the letter.

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. The Complainant asserts the disputed domain name is confusingly similar to the Mark because the disputed domain name is identical to the Mark except the disputed domain name replaces that "l" in the Mark with an "i" and adds the term "group" as a suffix. The Complainant asserts that the Complainant never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, never operated a business under the disputed domain name, and never engaged in any bona fide commercial activity in connection with the disputed domain name. The Complainant asserts that the Respondent knew of the Mark when registering the disputed domain name and that the Respondent's passive holding of the disputed domain name is in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions. The Center received an email from the Respondent on April 12, 2024, from an address different than the email address associated with registering the disputed domain name, which purported to be ignorant of the reasons and basis for the Complaint. The Center responded on April 22, 2024, requesting the email sender to identify herself and clarify any relationship with the named Respondent. No response was received.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

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

- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was 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. The Complainant has shown rights in the Mark for the purposes of the Policy by virtue of the Mark's registration. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name's only deviation from the Mark is that the disputed domain name changes the letter "l" to an "i" and adds the term "group" as a suffix. This slight alteration between the Mark and the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the Mark. The Mark is recognizable in the disputed domain name notwithstanding the term "group," and substituting the letter "i" for the letter "l" is a classic example of typosquatting, especially given the visual similarity between the letters "i" and the "l" and their adjacent locations on the standard keyboard.

The Panel finds that the first element of the Policy has been established.

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. Moreover, the disputed domain name does not resolve to an active website. The mere passive holding of a domain name does not establish rights or legitimate interests.

The Panel finds that 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.

Panels have found that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding.

Although panelists 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, the composition of the disputed domain name, and the failure to respond to the Complaint or the Complainant's cease and desist letter, and finds that in the circumstances of this case, the passive holding of the disputed domain name does not prevent a finding of bad faith registration and use under the Policy.

The Panel finds that the Complainant has 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 <viceroyhoteigroup.com> be transferred to the Complainant.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: May 21, 2024