

ADMINISTRATIVE PANEL DECISION

Phoenix Group Management Services Limited v. William Sherwood Case No. D2024-2085

1. The Parties

The Complainant is Phoenix Group Management Services Limited, United Kingdom, represented by Freeths LLP, United Kingdom.

The Respondent is William Sherwood, United States of America (“United States”), represented by FNS Law Group, United States.

2. The Domain Name and Registrar

The disputed domain name <phenixinsurance.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 17, 2024. On May 17, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 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 (“Registration Private”) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 23, 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 amendment to the Complaint on May 24, 2024.

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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 13, 2024. The Response was filed with the Center on June 13, 2024.

The Center appointed John Swinson as the sole panelist in this matter on June 24, 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 is an English company with its registered office in Birmingham, United Kingdom. The Complainant is part of the Phoenix group which is the United Kingdom's largest long-term savings and retirement business servicing approximately 12 million customers under the Complainant's pensions, savings, and life insurance brands, including the PHOENIX brand.

The Complainant has a portfolio of United Kingdom and European trademark registrations consisting solely of or including the name PHOENIX. An example trademark registration is United Kingdom Trademark Registration No. UK00003981690 for PHOENIX that was filed on November 20, 2023, and was entered in the register on May 3, 2024. Another example is the trademark registration No. 018869876 for PHOENIX FLEX in the European Union, that was filed on May 3, 2023, and entered in the register on November 8, 2023.

The Complainant uses the domain name <thephoenixgroup.com> for its main website.

The disputed domain name was registered on April 6, 2024.

The Respondent is a resident of Maryland, United States. The Respondent is beginning the process of opening his company and to that end recently registered the disputed domain name. The Respondent is seeking a license to sell insurance in Maryland. The Respondent has also paid for the design of a logo to be used by the company. The delivery date of the order placed with a graphic designer for this logo design was, according to evidence submitted by the Respondent, August 13, 2023.

At the present time, the disputed domain name resolves to a simple one-page website that states: "Phenix Insurance. Your trusted insurance partner" and that has functionality to allow a user to sign up for a newsletter update. The website does not display the Respondent's logo design. referred to in the previous paragraph.

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.

Notably, the Complainant contends that the PHOENIX trademarks have a reputation in the United Kingdom as a result of the substantial and sustained use made of them by the Complainant.

The Complainant makes the following submissions:

The disputed domain name includes the word PHENIX. The disputed domain name is highly similar to the sign PHOENIX, which is the subject of the Complainants' trademarks and rights in passing off. The Complainant's rights in the PHOENIX name predate the Respondent's registration of the disputed domain name, as do the Complainant's trademark registrations which were registered before the disputed domain name.

According to the Complainant, it is inevitable that Internet users will be confused into believing that the disputed domain name has some form of association with the Complainant.

The Complainant submits that the disputed domain name has been intentionally used to attract Internet users, for commercial gain, to the website hosted at the disputed domain name by creating a likelihood of confusion with the PHOENIX trademarks. It is clear that the disputed domain name has been registered and is being used to interfere with the Complainant's legitimate business.

B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name. In particular, the Respondent makes the following submissions:

The Respondent does not dispute that the Complainant may have trademark rights within the United Kingdom or the European Union in the name Phoenix. But those rights do not extend to the word Phenix, which is distinct in appearance, and they do not extend to the United States, where numerous other companies in the insurance business exist using that name.

Because of the extreme distance between the parties and the fact that they are in different countries with different legal requirements but both of which heavily regulate the insurance industry, the Respondent believes that it is extraordinarily unlikely that any given person could possibly be a customer of both the Complainant and the Respondent. The Respondent is seeking a license to sell insurance in Maryland, in the United States of America, and would not be legally entitled to sell insurance anywhere else in the world. The Respondent's understanding of the Complainant's business as laid out in the Complaint is that the Complainant operates in the United Kingdom and is not legally entitled to sell insurance in Maryland.

The Respondent's actions in registering the disputed domain name and taking steps to set up an insurance business were taken in good faith and without any knowledge of the Complainant's trademarks or even the Complainant's existence. However well-known the Complainant may be in its home country, it has no presence in the United States to the best of the Respondent's knowledge; the Respondent himself only became aware of the Complainant's existence when he received the notification of Complaint in this case.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (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 has been registered and is being used in bad faith.

The onus of proving these elements is on the Complainant.

An asserting party needs to establish that it is more likely than not that the claimed fact is true. An asserting party cannot meet its burden by simply making conclusory statements unsupported by evidence. To allow a party to merely make factual claims without any supporting evidence would essentially eviscerate the requirements of the Policy as both complainants and respondents could simply claim anything without any proof. For this reason, UDRP panels have generally dismissed factual allegations that are not supported by any bona fide documentary or other credible evidence. *Snowflake, Inc. v. Ezra Silverman*, WIPO Case No. [DIO2020-0007](#); *Captain Fin Co. LLC v. Private Registration, NameBrightPrivacy.com / Adam Grunweg*, WIPO Case No. [D2021-3279](#).

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 respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Based on an extract from Dictionary.com included in the Response, the term "phenix" is "a variant of phoenix".

Although the addition of other terms (here, "insurance") may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds 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 sought to rebut the Complainant's prima facie showing with evidence of its business plans.

The Respondent relies on paragraph 4(c)(i) of the Policy, namely that before notice to the Respondent of the dispute, the Respondent made demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services. [WIPO Overview 3.0](#), section 2.2.

The Respondent relies upon an order the Respondent placed for a design logo with a graphic designer, which dates back to August 11, 2023. This is before the Complaint was filed, which is the first time the Respondent became aware of the Complainant's claim. However, the evidence provided by the Respondent to support this is equivocal. The order does not refer to PHENIX. The Respondent included in the Response several different PHENIX INSURANCE logos; these are undated and only parts of them are visible in the dated messaging exchange between the Respondent and the graphic designer. Relying on this evidence, the Panel cannot be sure when these logos were ordered or created.

There is no evidence before the Panel as to if and when the Respondent has established a corporation or other business entity to operate his new business, when and why the Respondent selected the name PHENIX INSURANCE, and when this business is likely to launch. The Respondent has provided no details of any business plans or other steps that demonstrate his preparations to use the disputed domain name in connection with his proposed offering of goods and services, other than the apparent acquisition (at least ordering) of a logo. The Respondent states that he is seeking a license to sell insurance in Maryland but provided no details of such application.

The Panel acknowledges that the disputed domain name was registered by the Respondent less than four months ago, and that it takes time to develop a business plan and open a business. However, at least some credible, and the Panel would add, dated, evidence is needed to satisfy paragraph 4(c)(i) of the Policy. Compare *Qatalyst Partners LP v. Max Etingen*, WIPO Case No. [D2021-2520](#).

Based on the evidence before the Panel, at the present time the Respondent has not satisfied paragraph 4(c)(i) of the Policy.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant. *Instagram, LLC v. Domains By Proxy, LLC / Masud Rana, D-limit Ltd*, WIPO Case No. [D2022-0250](#).

The Complainant provides no evidence in respect of the third element of the Policy, but rather makes conclusory statements unsupported by evidence such as "it is inevitable that internet users will be, confused into believing that the [disputed domain name] has some form of association with the Complainant."

The Complainant provides no evidence to support this statement. The Complainant provides no evidence of its reputation or use of its PHOENIX trademarks.

The Complainant does not appear to do business in the United States under the PHOENIX trademarks and provides no reason why a person in Maryland, United States, would likely be aware of the Complainant or its trademarks. In fact, the Complaint explicitly states that the PHOENIX trademarks have a reputation in the United Kingdom which suggests that these trademarks have little or no reputation outside of the United Kingdom.

The Respondent provided evidence of third-party use of PHOENIX in respect of insurance services in the United States, and also provided a link to a webpage about the Phenix Mutual Fire Insurance Company that was established in the United States in 1886. This evidence suggests that the Complainant does not have a reputation or exclusive rights in respect of PHOENIX in the United States.

According to information included in the Response, the Complainant filed for United States trademark protection for PHOENIX (along with a logo) shortly after the Complaint was filed. This trademark application states that the Complainant has an intent to use (but no current use) of this mark in the United States. This application is yet to be examined.

The Response asserts that the Respondent had never heard of the Complainant until the Complaint was filed. Based on the materials before the Panel, this is believable. (The Panel is currently visiting Princeton, New Jersey, which is relatively close to Maryland, and conducted a Google search from Princeton for "Phoenix Insurance". The Complainant did not appear in the first ten search results.)

There is no reason to believe that the Respondent registered the disputed domain name to carry out typosquatting. As stated above, and as demonstrated by the Phenix Mutual Fire Insurance Company, "phenix" is a legitimate variant of "phoenix".

It is not clear to the Panel why a person in the position of the Respondent located in the United States would register a domain name that is slightly different to the trademark of a United Kingdom insurance company that does not carry out business in the United States, for the purposes of attracting traffic to the Respondent's website.

In short, the evidence in the case file as presented does not indicate that the Respondent's aim in registering the disputed domain name was to profit from or exploit the Complainant's trademark.

Additionally, there is no evidence that the Respondent has used the disputed domain name in bad faith.

The Panel finds the third element of the Policy has not been established.

7. Decision

For the foregoing reasons, the Complaint is denied.

/John Swinson/

John Swinson

Sole Panelist

Date: July 8, 2024