

ADMINISTRATIVE PANEL DECISION

DX Network Services Limited v. Domain Administrator, Whois Privacy Protection Foundation
Case No. D2023-1627

1. The Parties

The Complainant is DX Network Services Limited, United Kingdom, represented by Howes Percival LLP, United Kingdom.

The Respondent is Domain Administrator, Whois Privacy Protection Foundation, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <heritage-dx-logistics.com> is registered with OwnRegistrar, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 14, 2023. On April 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 17, 2023, 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, WhoisSecure) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 20, 2023, 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 April 25, 2023.

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 April 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 24, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on June 2, 2023. 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 based in the United Kingdom, providing parcel exchange and delivery services under the DX trademark.

The Complainant's official website is available at <dxdelivery.com>, being the Complainant the owner of the following trademarks (Annex 4 to the Complaint):

- European Union trademark registration No. 000151928 for the word mark DX, filed on April 1, 1996, registered on May 25, 1996, successively renewed, in classes 38 and 39;
- European Union trademark registration No. 012957189 for the word mark DX DELIVERY, filed on June 10, 2014, registered on October 31, 2014, in classes 9, 38 and 39;
- United Kingdom trademark registration No. UK00900151928 for the word mark DX, filed on April 1, 1996, registered on May 25, 1999, successively renewed, in classes 38 and 39; and
- United Kingdom trademark registration No. UK00912957189 for the word mark DX DELIVERY, filed on June 10, 2014, registered on October 31, 2014, in classes 9, 38 and 39.

The disputed domain name was registered in October 2022 and presently resolves to an active webpage offering shipping and freight services under the phrase "Heritage Dx logistics".

5. Parties' Contentions

A. Complainant

The Complainant asserts that its predecessor started operating the parcel exchange and delivery services since the mid-1970s, having the Complainant built up significant reputation in respect of its services under the DX trademark. The Complainant further asserts that, in addition to domestic delivery services, it operates an international delivery service in partnership with other distribution and delivery companies, having had an annual revenue for the year 2022 of GBP 414.5 million and delivered millions of items for public and private sector companies and individuals.

Under the Complainant's view, the disputed domain name reproduces the Complainant's DX trademark, not preventing the addition of the terms "heritage" and "logistics" a finding of confusing similarity under the Policy, there being a real risk that Internet users would believe there to be a connection between the disputed domain name and the Complainant, given that the Respondent is offering identical services to those of the Complainant at the webpage available at the disputed domain name.

Regarding the absence of the Respondent's rights or legitimate interests, the Complainant argues that:

- (i) the Respondent has no rights in the use of the DX trademark or any similar sign;
- (ii) the Complainant has no relationship with the Respondent, and has not licensed or authorized the Respondent to use the DX trademark or the disputed domain name;

- (iii) there is no evidence that the Respondent has traded under the DX or “Heritage DX Logistics” trademark prior to the registration of the disputed domain name, nor has it been commonly known by the disputed domain name or any sign similar to the DX trademark;
- (iv) the Complainant submits that given that the disputed domain name was only created on October 13, 2022, it was created in full knowledge of the Complainant’s existence, rights and existing domain name and is therefore a deliberate attempt to mimic, and utilize the reputation of the Complainant and its DX trademark, given the size and renown of the Complainant; and
- (v) the use made of the disputed domain name in connection with a webpage offering competing services to those of the Complainant does not characterize a *bona fide* offering of goods or services under the Policy.

As to the registration and use of the disputed domain name in bad faith, the Complainant states that:

- (i) the Complainant and its connected group companies is a leading provider of delivery solutions and courier and logistical services, having delivered millions of items for public and private sector companies to businesses and individuals under the DX trademark significantly prior to the registration of the disputed domain name by the Respondent, and given the reputation and circumstances of the Complainant it is almost impossible that the Respondent was unaware of the Complainant’s business and its DX trademark at the time of registration of the disputed domain name;
- (ii) the services being offered from the disputed domain name include shipping and freight delivery, which are identical to the services offered by the Complainant and those covered by DX trademark, having thus the Respondent registered and used the disputed domain name in bad faith to provide similar goods and services to the Complainant and Policy paragraph 4(b)(iv) is relied on;
- (iii) the Respondent’s bad faith is further evidenced by the fact that the webpage available at the disputed domain name does not identify the Respondent clearly, providing a telephone number (+1 (703) [...]) which contains an area code belonging to the northern part of Virginia in the United States of America while providing as address “[...], Englishtown, NJ 07726” which is not only not in Virginia but also does not appear to exist; and
- (iv) by having used a privacy protection service to conceal the Respondent’s identity, the Respondent has taken a course of conduct to obscure its identity from detection what further corroborates the Respondent’s bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

A. Identical or Confusingly Similar

The Complainant has established rights over the DX and DX DELIVERY trademarks in various jurisdictions.

The disputed domain name consists of the entire reproduction of the Complainant's DX, with the addition of the terms "heritage", "logistics" and two hyphens. Furthermore, the use of the disputed domain name in connection with a webpage offering related services to those of the Complainant, confirms a finding of confusing similarity between the disputed domain name and the Complainant's trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 1.7 and 1.15.

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a nonexclusive list of circumstances that may indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make a *prima facie* case against the Respondent.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent showing that the Respondent has not been commonly known by the disputed domain name and neither has been authorized by the Complainant to use its trademark, nor has it been licensed or is there a partnership with the Complainant; being it uncontested that the Complainant has no connection or affiliation with the Respondent.

The fact that the website at the disputed domain name appeared to be operated by an alleged entity self-identified as "Heritage DX Logistics" does not in itself give rise to rights or legitimate interests in the disputed domain name. In this regard, according to the evidence submitted by the Complainant, the use made of the disputed domain name in connection with a webpage offering related services to those offered by the Complainant using the DX description without the clear identification of the Respondent's identity or accurate contact details, cannot be regarded as a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name in these circumstances.

Accordingly, the Panel finds that the Complainant has made a *prima facie* showing of the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, both the registration and use of the disputed domain name in bad faith can be found pursuant to Policy, paragraph 4(b)(iv) in view of the use of the disputed domain name in connection with a webpage offering related services to those of the Complainant, which creates a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement thereof.

Moreover, the bad faith of the Respondent is also supported here by:

- (i) the choice to retain a privacy protection service in an attempt to conceal the Respondent's true identity;
- (ii) the lack of reply by the Respondent invoking any rights or legitimate interests; and
- (iii) the indication of false or incomplete information used by the Respondent for registering the disputed domain name, since the Written Notices was undeliverable to the Respondent by courier service.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain name.

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, <heritage-dx-logistics.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: June 16, 2023