

## **ADMINISTRATIVE PANEL DECISION**

Viceroy Hotels, LLC and Viceroy International Hotel Management LLC v.  
Michael Kleinberg, MKCL CONSULTING LLC  
Case No. D2024-4471

### **1. The Parties**

The Complainant is Viceroy Hotels, LLC and Viceroy International Hotel Management LLC, United States of America (“United States”), represented by Neal, Gerber & Eisenberg LLP, United States.

The Respondent is Michael Kleinberg, MKCL CONSULTING LLC, United States.

### **2. The Domain Names and Registrar**

The disputed domain names <viceroyhotelsadresorts.com> and <viceroyhotelsndresorts.com> are registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 30, 2024. On October 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 31, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 1, 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 November 7, 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 November 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 5, 2024.

On December 11, 2024, due to the administrative oversight, the Respondent was given a 5-day period for Response. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 19, 2024.

The Center appointed Gary Saposnik as the sole panelist in this matter on December 27, 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 Viceroy Hotels, LLC and Viceroy International Hotel Management LLC (collectively, "Viceroy Hotels & Resorts" or "Complainant") is a company that is known in connection with the provision of hotel, resort, residential condominium and related goods and services worldwide. The Complainants are limited liability companies in Delaware, United States, and owns all right, title and interest in the VICEROY, VICEROY HOTEL, and VICEROY HOTELS & RESORTS marks and tradename (the VICEROY Marks") in connection with hotel, resort, residential condominium and related goods and services. The Complainant operates VICEROY properties located throughout the United States and world, including in Mexico, Saint Lucia, Serbia, Portugal and Panama.

The Complainant is the owner of more than 100 trademark and service mark registrations worldwide for VICEROY, VICEROY HOTEL, and VICEROY HOTELS & RESORTS, including the following:

- VICEROY, United States Registration No. 2741530, registered July 29, 2003, in class 43;
- VICEROY, European Union Registration No. 4424453, registered August 26, 2009, in classes 35, 43;
- VICEROY HOTEL, United States Registration No. 2670019, registered December 31, 2002, in class 42;
- VICEROY HOTELS & RESORTS (stylized), Turkish Registration No. 201633274, registered March 6, 2017 in classes 35, 36, 37, 43.

The Complainant further promotes its marks and services through numerous websites and social media accounts, including its @viceroyhotels Instagram account, and its website at "www.viceroyhotelsandresorts.com". The Complainant has also received significant media attention and acclaim in international publications such as Elle Décor, the New York Times, Condé Nast Traveler, Food & Wine, Travel + Leisure, and Lucky Magazine.

The disputed domain names were registered by the Respondent on July 3, 2024, without any consent from the Complainant. The disputed domain names do not resolve to any active websites. On July 31, 2024, the Complainant's counsel attempted to send a letter to the Respondent via email, demanding an immediate transfer of the disputed domain names, without any response from the Respondent.

#### **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 names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to the VICEROY marks, in that they prominently feature the VICEROY, VICEROY HOTEL, and VICEROY HOTELS & RESORTS trademarks and trade name, as well as the Complainant's <viceroyhotelsandresorts.com> domain name, but for the misspelling of the word "and". This is an intentional misspelling of the Complainant's domain name, which was likely adopted with the objectives of (i) redirecting traffic meant for

the Complainant's website to the website at the disputed domain names and/or (ii) tricking users into believing that phishing emails from the disputed domain names are legitimate emails from the Complainant. The word "and" in the Complainant's domain name can be easily mistyped as "ad" or "nd", with unsuspecting consumers and other parties exceptionally likely to be deceived by such phishing attempts.

The Complainant alleges that, based on the global renown and prestige of the Viceroy Hotels & Resorts name and brand, it is extremely likely that the disputed domain names were registered with full knowledge of the Complainant's use of and prior rights in its marks, trade name, and domain name. The Respondent's misspelling of the Complainant's mark and domain name is considered "typosquatting", which constitutes confusing similarity.

The Respondent cannot establish a legitimate right to, or interest in, the disputed domain names. The Respondent has no legal relationship with the Complainant, and the Complainant has not consented to Respondent's registration of the disputed domain names. Rather, the Complainant has objected to the Respondent's registration and use of the disputed domain names by sending a letter to the Respondent's Whols email address, to which the Respondent failed to respond. Furthermore, the Respondent is not referred to or commonly known by either domain name. Given the renown of the VICEROY marks and renown of the Viceroy Hotels & Resorts trade name, it is clear that the Respondent would not have chosen the disputed domain names unless the Respondent was seeking to intentionally trade on the Complainant's trademark and trade name rights. Accordingly, the Respondent cannot establish a bona fide interest in the disputed domain names.

The Complainant also avers that the Respondent has registered and used the disputed domain names in bad faith. The disputed domain names were registered a number of years after the Complainant obtained rights in its VICEROY marks. By registering a domain name that is virtually identical to the Complainant's marks, it is extremely likely that the Respondent chose the disputed domain names to intentionally trade on the Complainant's marks. Given that the disputed domain names include the entirety of Complainant's VICEROY, VICEROY HOTEL, and VICEROY HOTELS & RESORTS mark, and are merely intentional one-letter misspellings of the Complainant's domain name, the disputed domain names constitute typosquatting, which is further evidence of Respondent's bad faith registration and use of the disputed domain names.

The Respondent's passive holding and failure to host a website at either of the disputed domain names is further indicia of the Respondent's bad faith. *Telstra Corp. Ltd. V. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Accordingly, the Complainant requests the transfer of the disputed domain names.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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 names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The typosquatting by the Respondent, with the misspelling of the word “and” as “ad” and “nd” in the disputed domain names, does not negate the confusing similarity to the Complainant’s marks. [WIPO Overview 3.0](#), section 1.9.

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 names. 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 names such as those enumerated in the Policy or otherwise.

The Panel notes that the disputed domain names do not resolve to any active website. The Respondent has not provided any evidence of use, or of demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services. The Respondent has not shown that he is commonly known by the disputed domain names. Furthermore, the Respondent has not provided any evidence of any legitimate noncommercial or fair use of either of the disputed domain names.

As noted above, the Respondent has no legal relationship with the Complainant. Given the renown of the VICEROY marks and renown of the Viceroy Hotels & Resorts trade name, combined with a misspelling of the VICEROY marks, the Respondent would not have chosen the disputed domain names unless the Respondent was seeking to intentionally trade on the Complainant’s trademark and trade name rights. Although the Complainant has alleged, but not come forward with any evidence, of use of the domain names in a phishing scheme, it is highly unlikely that the Respondent would be putting the domain names to a legitimate use. Accordingly, the Respondent cannot establish a bona fide interest in the disputed domain names.

The Panel finds 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.

In the present case, the Panel notes that the Respondent registered the disputed domain names many years after the Complainant’s registration of its VICEROY marks and <viceroythotelsandresorts.com> domain name. The VICEROY name and marks had also obtained substantial notoriety in the hotels, resorts and

travel industries throughout the world. As the disputed domain names are merely misspellings of “and” in the Complainant’s marks, it is highly unlikely that the Respondent was unaware of the Complainant at the time of registration of the disputed domain names.

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.

Previous Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or 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. In this instance, the disputed domain names are typos of the Complainant’s mark, and the Respondent is an unaffiliated entity. Furthermore, the Complainant has provided evidence of the renown of its VICEROY marks. In addition to the Respondent’s lack of evidence of rights or legitimate interests, there is an absence of any conceivable good faith use of the disputed domain names. [WIPO Overview 3.0](#), section 3.1.4.

Although the disputed domain names did not resolve to an active website, Panels have also found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes (i) the distinctiveness or reputation of the Complainant’s trademark, and the composition of the disputed domain names, (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 failure to respond to the Complainant’s cease and desist letter, and, (iv) the implausibility of any good faith use to which the domain names may be put. Based on the totality of the circumstances, this Panel finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy. *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Victory Hotels, LLC and Viceroy International Hotel Management LLC v. Lucille Echohawk*, WIPO Case No. [D2024-1239](#).

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 names <viceroyhotelsadresorts.com> and <viceroyhotelsndresorts.com> be transferred to the Complainant.

*/Gary Saposnik/*

**Gary Saposnik**

Sole Panelist

Date: January 10, 2025