

ADMINISTRATIVE PANEL DECISION

Diamond Resorts Holdings, LLC v. Domain Name Privacy Protection /
FRANCIS, FRANCIS
Case No. D2022-1625

1. The Parties

The Complainant is Diamond Resorts Holdings, LLC, United States of America (“United States”), represented by Jackson Walker, LLP, United States.

The Respondent is Domain Name Privacy Protection, Argentina / FRANCIS, FRANCIS, Mexico.

2. The Domain Name and Registrar

The disputed domain name <diamondhotels-andresort.com> is registered with Dattatec.com SRL (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 5, 2022. On May 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 5, 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 May 9, 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 May 13, 2022.

On May 9, 2022, the Center transmitted an email communication to the Parties in both English and Spanish regarding the language of the proceeding. On May 13, 2022, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Spanish of the Complaint, and the proceedings commenced on May 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 7, 2022.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on June 14, 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

Founded in 1992, Diamond Resorts is a global leader in the vacation ownership and timeshare industry.

Diamond Resorts has a network of over 350 vacation destinations in over 30 countries around the world.

Diamond Resorts offers consumers many options to vacation at its numerous destinations and attend exclusive events and experiences.

The Complainant has been using the trademark DIAMOND RESORTS in connection with its goods and services since its founding.

The Complainant is the owner of a family of trademarks in connection with these services, including its house marks, DIAMOND RESORTS and DIAMOND RESORTS INTERNATIONAL (collectively, the "DIAMOND RESORTS Marks"), which are registered in jurisdictions worldwide, as follows:

United States Patent and Trademark Office:

Name of the trademark	Registration number	Date of the registration	Applicable class or classes.
DIAMOND RESORTS INTERNATIONAL	2,432,190	February 27, 2001	36
DIAMOND RESORTS INTERNATIONAL	2,411,329	December 5, 2000	42
DIAMOND RESORTS	3,746,815	February 9, 2010	36
DIAMOND RESORTS	5,710,959	March 26, 2019	35, 36 and 43
DIAMOND RESORTS (design)	5,710,960	March 26, 2019	35, 36 and 43
DIAMOND RESORTS INTERNATIONAL	4,361,959	July 2, 2013	35

Canada Patent and Trademark Office:

Name of the trademark	Registration number	Date of the registration	Applicable class or classes.
DIAMOND RESORTS INTERNATIONAL	TMA767565	May 20, 2010	36
DIAMOND RESORTS INTERNATIONAL	TMA851954	May 20, 2010	35, 36 and 43
DIAMOND RESORTS (logo)	TMA1102432	June 21, 2021	35, 36 and 43
DIAMOND RESORTS	TMA1011437	December 18, 2018	36

Mexico Trademark Office (Instituto Mexicano de la Propiedad Intelectual)

Name of the trademark	Registration number	Date of the registration	Applicable class or classes.
DIAMOND RESORTS INTERNATIONAL	2015753	June 27, 2019	43
DIAMOND RESORTS (logo)	2126062	June 27, 2019	35
DIAMOND RESORTS INTERNATIONAL	1232693	May 16, 2012	36

The Complainant owns and conducts its Internet activities under its DIAMOND RESORTS trademarks through its domain names, including <diamondresorts.com> registered on February 11, 1999.

The disputed domain name was registered on September 14, 2021

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its trademark DIAMOND RESORTS. Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain name and finally, that the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings.

6.1 Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, unless otherwise agreed by the parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement. The Registrar confirmed that the language of the Registration Agreement is Spanish. The Complaint was filed in English.

In addition to the Complainant's submission regarding the language of the proceeding, the Respondent did not submit a Response nor did it formally object to English as the language of the proceeding.

The Center has throughout the proceeding issued its case-related communications including the Center's Complainant notification documents, in both Spanish and English. The Respondent has chosen not to participate in the proceeding and has been notified of its default.

For all the above-mentioned reasons, in the present case the Panel concludes, according to the Rules, paragraph 11(a) that there is no prejudice or unfairness to the Respondent for these proceedings to be conducted in English and for the decision to be rendered in English. Accordingly, the Panel determines that the language of the administrative proceeding be English.

6. 2. Substantive Issues

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established its registered trademark rights over the DIAMOND RESORTS trademarks. As noted in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1: "Where the Complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case."

In order to establish the confusing similarity test, panels typically do a side-by-side comparison between the trademark and the domain name to establish if the complainant's trademark is recognizable within the domain name.

In this case, the disputed domain name <diamondhotels-andresort.com> is confusingly similar to the DIAMOND RESORTS trademark due to the fact that the mark is clearly recognizable within the disputed domain name.

Previous panels have established that even incomplete or slightly inaccurate reproductions are confusingly similar. See for example, WIPO Case No. [D2014-2018](#) *Comerica Bank v. Online Mgmt./Registration Private, Domains by Proxy, LLC* and WIPO Case No. [D2015-2305](#) *Calvin Klein Trademark Trust, Calvin Klein, Inc. v. Moniker Privacy Services*.

Moreover, the addition of other terms to a trademark does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8. In the present case, the addition of the words "hotels", "-and" does not prevent a finding of confusing similarity.

Furthermore, the applicable Top-Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.

For the foregoing reasons, the Panel finds that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a disputed domain name by demonstrating any of the following:

- (i) before any notice to you of the dispute, the respondent's 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) The respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) The respondent is 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.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the [WIPO Overview 3.0](#), a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not referred to or commonly known by the disputed

domain name or any related trademark. It further claims that it has not authorized the Respondent to use the trademark in any way including use in a domain name. At the moment of this decision the disputed domain name does not resolve to any active website and the Complainant presented arguments and evidence that the disputed domain name has been used for fraudulent purposes by the Respondent. Under these circumstances, using the disputed domain name in order to send fraudulent emails does not show any *bona fide* offering of goods or services. In the present case, the Respondent is also not making any legitimate noncommercial or fair use of the disputed domain name.

As stated in [WIPO Overview 3.0](#), section 2.13: “Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent”.

The Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not responded, and the Panel is unable to conceive any basis upon which the Respondent could have any rights or legitimate interests in respect of the disputed domain name.

For the foregoing reasons the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and the requirements of paragraph 4(a)(ii) of the Policy therefore are fulfilled.

C. Registered and Used in Bad Faith

In order to prevail under the Policy, the Complainant must show that the disputed domain name has been registered and is being used in bad faith.

The Complainant’s DIAMOND RESORTS trademarks are well known in connection with the Complainant’s travel services. The Complainant’s trademarks have been continuously and extensively used for many years and have as a result acquired considerable reputation and goodwill worldwide. Accordingly, the Panel is satisfied that the Respondent must have been aware of the DIAMOND RESORTS trademarks when it registered the disputed domain name, noting also that the disputed domain name includes the trademark together with the word “hotel”, a term related to the Complainant’s business.

Moreover, the Respondent must be have been aware of existence of the DIAMOND RESORTS trademark when registering the disputed domain name taking into consideration the time of registration of the disputed domain name in September 2021, many years after the Complainant’s first registration of its DIAMOND RESORTS trademark. The Complainant’s trademark registrations were registered at least as early as 2000. Moreover, the Complainant registered its primary domain name, <diamondresorts.com>, on February 11, 1999. The Respondent, however, did not register the disputed domain name until September 2021.

The Panel also finds that the Respondent is using the de disputed domain name in bad faith. According to the Complaint and the evidence presented by the Complainant, the disputed domain name has been used for fraudulent conduct by the Respondent.

See [WIPO Overview 3.0](#), section 3.4: “Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. (In some such cases, the respondent may host a copycat version of the complainant’s website.) Many such cases involve the respondent’s use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant’s actual or prospective customers”.

In the present case we have a distinctive trademark involved, the Respondent did not rebut the arguments of the Complaint and is in default and has been using the disputed domain name in a fraudulent conduct. Therefore, in the present case the Respondent’s conduct constitutes bad faith.

The DIAMOND RESORTS marks are uniquely associated with Complainant, and the Respondent has been using that association to pass itself off as Diamond Resorts and perpetrate fraud. The Respondent's fraudulent scheme centers around collecting Diamond Resorts' customers' information and contacting the customers to entice them into transferring their vacation memberships. These actions are taken via the webmail associated with the disputed domain name. Once a customer has agreed to transfer the membership, the imposters then request for the customer to wire a payment to the imposter to complete the transfer. The payment is then sent to the imposter, and the transfer never occurs. This fraudulent activity demonstrates bad faith. Accordingly, this Panel finds that the Respondent chose to register the disputed domain name to trade on the name and goodwill obtained by the Complainant in the DIAMOND RESORTS trademark to confuse the public and Internet users for its own commercial gain.

Therefore, the Panel concludes that the disputed domain name was registered and is being used in bad faith.

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, <diamondhotels-andresort.com> be transferred to the Complainant.

/Ada L. Redondo Aguilera/
Ada L. Redondo Aguilera
Sole Panelist
Date: June 28, 2022