

## **ADMINISTRATIVE PANEL DECISION**

Virtuoso, Ltd. v. Narendra Ghimire, Deep Vision Architects  
Case No. DIO2022-0049

### **1. The Parties**

The Complainant is Virtuoso, Ltd., United States of America (“United States”), represented Harper & Bates LLP, United States.

The Respondent is Narendra Ghimire, Deep Vision Architects, United States, represented by Greenberg & Lieberman, United States.

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

The disputed domain name <virtuoso.io> 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 October 18, 2022. On October 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 20, 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 October 25, 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 amendment to the Complaint on November 1, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy” or the “.IO Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 21, 2022.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on December 6, 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

The Complainant is a corporation established under Delaware law and headquartered in Fort Worth, Texas, United States. The Complainant has operated a network of luxury travel advisors since 1969, with member travel agencies throughout the United States and Canada and a website operating at “www.virtuoso.com” since at least 2000 (based on screenshots from the Internet Archive’s Wayback Machine).

The Complainant holds numerous VIRTUOSO and VIRTUOSO-formative trademark registrations, including the following:

MARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE
VIRTUOSO (word)	United States	3095926	May 23, 2006
VIRTUOSO (word)	United States	3102855	June 13, 2006
VIRTUOSO LIFE (word)	United States	3270062	July 24, 2007
VIRTUOSO TRAVELER (word)	United States	4314120	April 2, 2013
VIRTUOSO TRAVEL WEEK (word)	United States	4481714	February 11, 2014
VIRTUOSO (word)	International Trademark (designations for multiple countries)	1223431	July 28, 2014
VIRTUOSO (word)	International Trademark (designations for multiple countries)	1225900	July 28, 2014
VIRTUOSO TRAVEL WEEK (word)	International Trademark (designations for multiple countries)	1223634	July 28, 2014
VIRTUOSO SPECIALISTS IN THE ART OF TRAVEL (word)	International Trademark (designations for multiple countries)	1354641	March 17, 2017
VIRTUOSO SPECIALISTS IN THE ART OF TRAVEL (word)	United States	5280856	September 5, 2017
VIRTUOSO ORCHESTRATOR (word)	United States	5687364	February 26, 2019
VIRTUOSO WANDERLIST (word)	United States	6273365	February 16, 2021
VIRTUOSO WANDERLIST (word)	International Trademark (designations for multiple countries)	1488617	July 25, 2019

According to the Registrar, the disputed domain name was registered on August 16, 2020, in the name of a domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Narendra Ghimire, showing the registrant’s organization as Deep Vision Architects with a postal address in Westlake Village, California, United States. The online database of the California Secretary of State lists Deep Vision Architects, Inc., a California stock corporation registered in 2017 at the same postal address shown in the registration of the disputed domain name, with Narendra Ghimire as the registered agent. At the time of this Decision, the corporation’s status is listed as suspended by the California Franchise Tax Board. The Panel refers to Narendra Ghimire and Deep Vision Architects, Inc. (“Deep Vision”) collectively hereafter as “the Respondent”.

The disputed domain name resolves to a landing page hosted by the Registrar advertising the disputed domain name for sale. The Wayback Machine has no archived screenshots associated with the disputed domain name other than similar advertisements for the sale of the disputed domain name.

On August 17, 2022, the Complainant submitted a form via the landing page associated with the disputed domain name requesting purchase information, and on August 24, 2022, the Complainant received a response from a listing service indicating a sales price for the disputed domain name of USD 54,995. The parties did not conclude a sale of the domain name, and this proceeding followed.

The Panel notes (as the Parties did not) that the Respondent was the subject of another, similar proceeding in 2022. *Amadeus IT Group, S.A. v. Domains By Proxy, LLC / Narendra Ghimire, Deep Vision Architects*, WIPO Case No. [DCO2022-0040](#) (“*Amadeus*”). The Respondent filed a Response in that proceeding, as it did not here, and so there is more relevant information available about the Respondent. The Respondent Mr. Ghimire characterized himself as a domain investor or “domainer” who, since 2013, has purchased domain names for resale. In 2021, Mr. Ghimire registered the domain name <amadeus.co>, showing his organization as Deep Vision Architects and using a domain privacy service, just as in the present case. Amadeus IT Group, SA, which operates the AMADEUS global computerized travel reservations network, brought a complaint under the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), which is similar to the .IOPolicy. A divided panel dismissed the complaint, as discussed further below.

On November 23, 2022, the Respondent Deep Vision filed a civil action against the Complainant in the United States District Court for the Northern District of Texas seeking a declaratory judgment that the Respondent has rights and interests in the disputed domain name and has not violated the United States Anticybersquatting Consumer Protection Act (“ACPA”), and further that the Complainant’s claims in the current proceeding represent attempted reverse domain name hijacking in violation of the ACPA. That action is pending at the time of this Decision.

## **5. Parties’ Contentions**

### **A. Complainant**

The Complainant asserts that the disputed domain name is identical to its registered VIRTUOSO trademark and confusingly similar to its registered VIRTUOSO-formative marks. The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name because it is not known by a corresponding name and has made no use of the disputed domain name.

The Complainant points out that the .IO Policy requires establishing that the disputed domain name was registered or used in bad faith, not both (as the UDRP does). The Respondent registered the disputed domain name in 2020, at least 20 years after first commercial use of the Complainant’s VIRTUOSO word mark and 14 years after its first United States trademark registration. The Complainant argues that its mark was well established by then, and the “Respondent knew or should have known of Complainant’s rights in the VIRTUOSO Marks at the time the disputed domain was registered”. In any event, the Complainant argues that the Respondent acted in bad faith by demanding a sales price for the disputed domain name of USD 54,995, “a sum substantially in excess of any potential out-of-pocket costs associated with registration of the domain”. The Complainant argues that this “constitutes evidence the disputed domain was registered and is being used in bad faith”. The Complainant argues further that the Respondent’s use of a domain privacy service should be viewed as another indication of bad faith.

### **B. Respondent**

The Respondent did not file a timely Response. However, counsel for the Respondent sent email messages to the Center on November 23 and 30, 2022 referring to its federal court filing suggesting that the current proceeding should be “placed on hold” and that the Panel “has no power” as a result of the court filing. Nevertheless, counsel for the Respondent sent another email message with sixteen numbered points, dated

December 6, 2022, two weeks after the Response was due. The email begins by asserting, “[we] do not believe it is appropriate for the panel to make a ruling”, but “even though late if the panel decides to make a ruling it is requested that the below be taken into account”, arguing that there is no prejudice to the Complainant in doing so.

The substance of the email can be summarized as follows:

The Respondent reports that it filed “a federal court action pertaining to this dispute”.

The Respondent characterizes itself as a domain investor or “domainer” that purchases domain names for resale, as was the case with the disputed domain name.

The Respondent reports (consistent with the Complaint and the Wayback Machine records) that the disputed domain name has never resolved to anything other than “a sales page”.

The Respondent observes that “virtuoso” is a dictionary word used in hundreds of company names, citing Dun & Bradstreet company profiles.

The Respondent denies awareness of the Complainant before this dispute and denies any intent to create confusion with the Complainant or disrupt its business.

The Respondent argues that there is nothing illegitimate about buying “generic” domain names that are usable “for any variety of generic purposes” and reselling them.

The Respondent seems to be attempting to make a response to the Complaint without filing a Response, for which the deadline had passed.

The Rules (paragraph 5(e), (f)) provide for the extension of time to submit a Response “in exceptional cases” and provide further that the Panel shall decide the dispute based on the complaint “in the absence of exceptional circumstances”. The Respondent did not request an extension to submit a Response beyond its request under paragraph 5(b) of the Policy (which four-day extension was granted) but suggested instead that the dispute resolution proceeding should be suspended or terminated.

The time and page limits under the Rules and Supplemental Rules, and the required certification of accuracy and completeness, are designed to facilitate the swift, fair, economical, online resolution of domain name disputes with the limited possible remedies of transfer or cancellation of the domain name, without prejudice to the parties’ recourse to judicial or arbitral proceedings. As such, departures from the Rules are warranted only in exceptional circumstances. See [WIPO Overview 3.0](#), section 4.6.

In any event, apart from the Respondent’s general denial of bad faith intent, and the reference to the judicial proceeding, there is little in the email from the Respondent’s counsel to the Center that could not be deduced from the existing record. Nevertheless, the Panel will take into account the communication from the Respondent’s counsel, as it is consistent with the statements made in the certified copy of the complaint signed by counsel and submitted to the federal court in the recently filed judicial proceeding.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the 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 domain name; and (iii) the domain name has been registered or is being used in bad faith. Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

As noted above, the .IO Policy is very similar to the UDRP but differs in that the latter requires a demonstration of bad faith both at the time of registration and in subsequent use. See, e.g., *International Business Machines Corporation v. Murat Satir*, WIPO Case No. [DIO2021-0001](#) (“*International Business Machines*”). Consequently, in the discussion below the Panel will refer frequently to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) and decisions under the UDRP as appropriate.

## **6a. Preliminary Matter: Suspension or Termination of Proceeding**

It is in the discretion of the Panel to suspend or terminate a Policy proceeding in view of a pending or concurrent judicial proceeding. The Panel notes that UDRP panels are typically reluctant to do so “because of the potential for indeterminate delay” (see [WIPO Overview 3.0](#), sections 4.14, 4.14.1). The Panel chooses not to do so in this case for that reason. The dispute is properly within the scope of the Policy, and the Panel has jurisdiction to decide the dispute. This decision is without prejudice to any action that a court seized with jurisdiction may deem appropriate in furtherance of a judicial proceeding.

## **6b. Substantive Issues**

### **A. Identical or Confusingly Similar**

As with UDRP complaints, the first element of a Policy complaint is essentially a standing requirement. In this case, it is easily satisfied: the Domain Name is identical to the Complainant’s registered VIRTUOSO word mark and confusingly similar to other registered VIRTUOSO-formative marks. As usual, the Top-Level Domain “.io” is disregarded as a standard registration requirement. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel concludes that the Complainant has established the first element of the Complaint.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following: “(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or (iii) you are 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.”

Under the UDRP, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1. The same rationale should apply under the Policy, as the Respondent is in the best position to assert rights or legitimate interests in the Domain Name.

Here, the Complainant has made a *prima facie* case by establishing its trademark rights, denying that the Respondent has authorization to use the Complainant’s marks, observing that the Respondent does not appear to be known by a corresponding name, and reporting the Respondent’s non-use of the disputed domain name apart from offering it for sale. The Respondent has not filed a timely Response advancing rights or legitimate interests in the disputed domain name, but it is apparent on this record that the Respondent has purchased and advertised the disputed domain name, which is a dictionary word, for sale. The recent *Amadeus* proceeding shows that the Respondent is in the business of investing in domain names for resale, which can represent a legitimate business interest.

As the majority observed in the *Amadeus* decision, “It is well established in decisions under the UDRP, as reflected in section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), that ‘... generally speaking, panels have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be *bona fide* and is not *per se* illegitimate under the UDRP.’ In such cases, however, the panel must be satisfied that the registrant did not register the domain name in question with the relevant complainant’s trademark in mind and with the intention of ‘targeting’ that trademark by taking unfair advantage of the complainant’s goodwill attaching to it.”

The majority in that case recognized the well-established AMADEUS trademark used for international travel reservations by the Amadeus IT Group but accepted, “on the balance of probabilities”, the Respondent’s denial of prior knowledge and its claim that it registered the identical domain name for its “generic” value as a given name and family name often associated with the composer Wolfgang Amadeus Mozart and used by many businesses. The majority found that the name “Amadeus” is indeed used by many other businesses. The dissenting panelist considered targeting more likely, observing that the Respondent admitted to at least seven other domain name registrations involving common or dictionary words or phrases that are also trademarks<sup>1</sup>.

The disputed domain name here was not mentioned in the *Amadeus* decision and was apparently not listed in the record of that proceeding among other domain names registered by the Respondent. The Panel finds it significant that the Respondent registered the disputed domain name <virtuoso.io> in 2020 and the domain name <amadeus.co> in 2021 and that both are identical, save for the Top-Level Domain, to trademarks and domain names used in the travel industry. Combined with the Respondent’s history of registering other domain names composed of names, words, or phrases that are also identical to trademarks, this increases the probability of trademark targeting as a motivation for selecting the disputed domain name. A domain name such as <waterai.com>, for example (found in the Respondent’s inventory) is indeed formed of dictionary words is an unusual phrase and seems more likely selected for its trademark value.

The Panel also notes the unlikelihood that the Respondent was unaware of the Complainant before this dispute, given that the Complainant has long used the domain name <virtuoso.com> and the Complainant features prominently in search results for “virtuoso” in leading search engines.

The Panel finds that the balance of probabilities favors an inference that the Respondent chose the disputed domain name with an intent to target the Complainant’s long-established VIRTUOSO trademark and concludes, therefore, that the Complainant prevails on the second element of the Complaint.

### **C. Registered or Used in Bad Faith**

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that “shall be evidence of the registration and use of a domain name in bad faith”, including the following cited by the Complainant (in which “you” refers to the registrant of the domain name):

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name ...”

The Complainant argues that the Respondent “knew or should have known” of its VIRTUOSO trademarks and that the cited example of bad faith is apposite, given the sales price of USD 54,995 quoted when the Complainant inquired about purchasing the disputed domain name through the Respondent’s designated domain broker. The Respondent is precisely in the business of buying and selling domain names for a profit, as the Respondent stated in the *Amadeus* proceeding, and the disputed domain name has significant

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<sup>1</sup> These domain names are <roaring.us>, <pliant.us>, <camarillo.us>, <messenger.us>, <waterai.com>, <powerparenting.com>, and <deepblutechnology.com>.

potential value both as a dictionary word and as a well-established trademark. Thus, the fact that the Respondent quoted a five-figure sales price is not alone dispositive on the issue of bad faith. Nor is the fact that the Respondent registered the disputed domain name using a domain privacy service, as the Complainant remarks. Such services are often employed for legitimate reasons such as controlling undesired contacts, and the Respondent apparently furnished correct and adequate underlying registration details to the Registrar.

The real question is whether the Respondent was more likely than not aware of the Complainant's VIRTUOSO trademark and was motivated at least in part to acquire the disputed domain name to take unfair advantage of that mark.<sup>2</sup> For the same reasons outlined in the preceding section, the Panel finds that this was probably the case: the Respondent has a history of acquiring for resale domain names that are identical to trademarks based on dictionary words or phrases or common names, including another one, <amadeus.co>, widely used in the international travel industry in which the Complainant is active. It is improbable that the Respondent was unaware of the Complainant holding the ".com" version of the same name as the disputed domain name and the Complainant's mark that appears prominently in search engine results. The Respondent, a domain investor, did not provide any evidence of steps to avoid the registration of trademark-abusive domain names. In these circumstances, registering and offering the disputed domain name for sale must be considered bad faith within the meaning of the Policy.

The Panel concludes that the Complainant has established the third element of the Complaint.

## 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 <virtuoso.io>, be transferred to the Complainant.

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Sole Panelist

Date: December 20, 2022

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<sup>2</sup> The WIPO Global Brand Database shows that there are other trademarks, owned by other businesses, based on the word "virtuoso", and the potential value of implied association with those marks also may have factored into the Respondent's decision to acquire and attempt to resell the disputed domain name. This does not foreclose a finding of bad faith with respect to the disputed domain name. As the dissenting panelist in *Amadeus* observed, "the fact the Respondent targeted the Complainant's trademark in bad faith cannot be cured by the allegation that this target was not alone or exclusively to the Complainant and his trademark, but included as well other third parties' brands. The fact that the Respondent in effect may have targeted more than one trademark, even if such allegation would be true, does not cure or dilute his existing bad faith in relation to the Complainant and its well-known trademark."