

## **ADMINISTRATIVE PANEL DECISION**

British Airways Plc v. Softline Studios

Case No. D2023-2188

### **1. The Parties**

The Complainant is British Airways Plc, United Kingdom, represented by Maucher Jenkins, United Kingdom.

The Respondent is Softline Studios, United States of America (“United States”).

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 18, 2023. On May 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 19, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 June 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 29, 2023. The Response was filed with the Center on June 29, 2023.

On June 30, 2023, the Complainant forwarded to the Center an email, which the Complainant had received from the Respondent’s principal, Loren Stocker, and to which the Respondent had attached an invoice for the value of Ms. Stocker’s time in preparing the Response.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on July 27, 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 part of the International Airlines Group (IAG), which embraces a number of different airline brands. The Complainant is headquartered at London Heathrow airport. The Complainant has a fleet of over 280 aircraft flying to more than 200 destinations in 80 countries. It carries more than 40 million customers a year. This dispute, however, concerns its “The Wine Flyer Club”.

For some 20 years, the Complainant had been offering to its Executive Club members the opportunity to buy alcoholic and non-alcoholic beverages through a service provided by Direct Wines Ltd. Initially, the service was known as the Wine Explorer. In May 2019, however, the service was relaunched under the name “The Wine Flyer”.

As part of this re-launch, Direct Wines Ltd. registered the domain name <bawineflyer.co.uk>. The service was offered to both members of the Complainant’s Executive Club and also, at least from October 2020, British Airways American Express cardholders. As noted above, however, the service was promoted under the name “The Wine Flyer”.

On October 4, 2022, however, the Complainant launched a new wine club known as “The Wine Flyer” after the relationship with Direct Wines Ltd. came to an end. The Complainant offered this new club directly in collaboration with the loyalty program offered by the Complainant’s parent, IAG. This new wine club is available to members of the Complainant’s Executive Club and the Complaint states that it has been, or is in the course of being, expanded to all IAG’s airlines’ loyalty programs.

Accompanying that launch, the Complainant registered and uses the domain name <thewineflyer.co.uk>. The Complainant registered this domain name on July 22, 2022. As it puts it, it adopted this “generic” domain name to facilitate its use by the other airlines in IAG. The Complainant also has The Wine Flyer accounts or pages on Facebook and Instagram. The Facebook page has 55 followers; the Instagram page 240 followers.

According to the Complaint, the Complainant generated GBP 4.2 million in revenues under its THE WINE FLYER mark in 2021 and GBP 3.5 million in 2022.

The Complainant is also the owner of two registered trademarks for THE WINE FLYER:

- (a) European Union Trademark (EUTM) No. 018089482; and
- (b) United Kingdom Registered Trademark No. UK00918089482.

Both trademarks were filed on July 1, 2019 and entered on the Register on February 11, 2020. Both trademarks are also registered in respect of wines, spirits and liqueurs and alcoholic beverages in International Class 33 and retail and wholesale services, including on-line purchasing services, relating to alcoholic beverages including wine in International Class 35.

The Complainant also had a corresponding application in the United States but that application was abandoned, or lapsed, on June 21, 2021 without proceeding to registration. The Complainant says this was a result of health measures during the COVID-19 pandemic.

According to the Response, the Respondent acquired the disputed domain name on February 5, 2022. Apparently, the disputed domain name was offered at auction through an online platform. The Respondent was successful with a bid of USD 79. The Respondent was the only bidder.

When the Complaint was filed, the disputed domain name resolved to the website of Vanity International, which is the Respondent’s branding website.

The Vanity International page states that Vanity International is an identity design firm, which has been operating since 1993. According to an extract from its website, Vanity International has been developing compelling brands and response strategies since then for Fortune 500 companies, large consumer businesses, and even several major telephone companies. Content on the website promotes the importance of aligning domain names, toll-free telephone numbers with the business' brand as part of a concerted marketing strategy, and offers services in connection with those activities. A significant part of the page is taken up with extolling the virtues of non-traditional domains over the generic Top-Level Domains such as ".com".

On page 12 of the 27 page Annexure 12 of the Complaint, there was a heading "Domain Portfolios For Sale" dated June 24, 2018 which included the following text:

"I'm now focused on launching my start-up, Telex Live. I'll be posting more as I sort through my holdings:

"- Dot Com/Net: The "No Stupid Shit" Collection

"Along with the portfolio sales, I will make myself available to advise on any branding and strategy Issues. What I do know is that all must do what we love. Perhaps these markets are where you thrive!"

The reference to "I" appears to be a reference to Loren Stocker. Ms. Stocker also appears to be the principal of the Respondent although the precise nature the Respondent is not clear.

According to the Response, Ms. Stocker also holds four granted patents which, according to a letter Ms. Stocker sent to the Complainant's representatives in November 2022, relate to technology for a global platform blending the phone and the Internet under the name Telex.Live.

Ms. Stocker, or Vanity International or Softline Studios, also holds a portfolio of other domain names. These include <wineflys.com>, <travelwine.com>, <vinovial.com>, <skyvinos.com> and <trawino.com>. At least some of these have been offered for sale. So for example, the website "www.wineflyers.com" is a largely blank page with a banner across the top "Domain May be For Sale! Click or call +1-800-xxx-xxxx".

On November 4, 2022, the Complainant's agents sent a cease and desist letter to the Respondent's principal, Ms. Loren Stocker. On November 14, 2022, the Respondent replied;<sup>1</sup> stating that the Respondent had registered a number of descriptive names to explain how wine lovers can travel with wine and had no intention of competing in the supply of wine, denying liability to the Complainant.

On January 18, 2023, the Complainant's lawyers sent a further cease and desist letter to the Respondent. This letter included print outs of the Complainant's trademarks and a screenshot of the results of a Google search for "The Wine Flyer". The Respondent replied on January 30, 2023; once again, denying liability.

## 5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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.

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<sup>1</sup> For ease of reference, the Panel will use "the Respondent" to refer to Ms. Stocker, Softline Studios, and Vanity International, unless the context requires more precise identification.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

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

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy, being the two registered trademarks identified in section 4 above. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.2.1

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".com" gTLD, therefore, the disputed domain name consists of the Complainant's registered trademark in its entirety only.

The Respondent points out that the Complainant's trademarks are limited to specific goods and services: essentially wine and alcoholic beverages and sales services relating to those products. As discussed further below, the Respondent further contends that she does not use, and does not intend to use, the disputed domain name in connection with those goods and services so there is no risk of confusion.

The Respondent's argument, however, misunderstands the nature of the inquiry under the Policy at this stage of the inquiry.

It is well accepted that the first element functions primarily as a standing requirement. Consequently, 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 3.0](#), section 1.7. That is, the inquiry at this stage simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the Complainant's trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

### **B. Registered and Used in Bad Faith**

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g., *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

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.

The Respondent denies knowledge of the Complainant's trademark before registering the disputed domain name. The Respondent says the first it learned of the Complainant's trademark was when she received a

letter of demand in November 2022. The Respondent further says the disputed domain name was registered in connection with a planned business or website explaining how wine lovers can travel with wine.

For the reasons discussed below, the Panel does not consider this is an appropriate case to go behind the Respondent's denial of knowledge of the Complainant's trademark when the Respondent registered the disputed domain name.

The Complainant contends both it and its trademark are widely known internationally, including in the United Kingdom and its services under the trademark have been widely publicised. It also relies on Ms. Stocker's acknowledgement, in response to the January 2023 letter of demand, of the Complainant's abandoned trademark application in the United States. In that response, the Respondent also indicated a willingness to engage in confidential settlement negotiations which the Complainant contends indicates the Respondent's intention to sell the disputed domain name for a profit. The Complainant also points out that there has been no use of the disputed domain name in connection with a wine or any other type of business. Instead, the disputed domain name resolved to a web page which the Complainant characterises shows the Respondent's primary business is the sale of domain names and telephone numbers. Finally, the Complainant contends that the Respondent's registration of the disputed domain name prevents the Complainant from reflecting its trademark in a corresponding domain name.

Plainly, the registration of the disputed domain name prevents the Complainant from registering the purest form of its trademark in the ".com" gTLD. That may be an indication of registration and use in bad faith. Whether or not it does so, however, depends on the circumstances as a whole.

The Panel also readily accepts that the Complainant's name and trademark, BRITISH AIRWAYS, is very well-known. The issue in the present proceeding, however, is whether the Respondent registered the disputed domain name to take advantage of the trademark THE WINE FLYER, not BRITISH AIRWAYS.

In addressing that question, it is important to remember that the Respondent registered the disputed domain name in February 2022. That is before the Complainant registered its current primary domain name, <thewineflyer.co.uk>, and well before the Complainant launched its current business.

As at February 2022, the Complainant did have its two registered trademarks in the European Union and the United Kingdom. It had also been operating its The Wine Flyer club through Direct Wines Ltd. and, as noted above, the Complainant had generated revenues of GBP 4.2 million in 2021. It was plainly a significant business.

However, so far as the materials in the Complaint demonstrate, the Complainant's service (at least before October 2022) appears to have been promoted only to the Complainant's Executive Club members and holders of British Airways American Express cards. There is no evidence that the Respondent, or Ms. Stocker, were members of the club or British Airways American Express cardholders. There is also no evidence that the Complainant's promotional activities, or even awareness of its trademark, extended to the United States.

The Complaint does include media reports about the Complainant's service. However, they relate to the October 2022 launch of the new service; months after the Respondent registered the disputed domain name.

Similarly, the evidence of Google search results relates to the situation when the Complaint was filed. The Google search results are not illustrative of what a search in February 2022 would have produced. That is significant in circumstances where the Complainant's current product was launched in the intervening period.

It is of course possible that the Respondent was aware of the Complainant's trademark. However, the Panel cannot readily conclude that THE WINE FLYER was so well known in February 2022 that the Respondent's denial of knowledge can be disregarded on that basis.

Further, the Panel does not infer from the Respondent's reference in January 2023 to the Complainant's abandoned trademark application in the United States that the Respondent must have been aware of the Complainant's trademark in February 2022. Even if the Respondent were aware of that application, all that would have informed the Respondent was that the application had been abandoned.

Further still, the Panel accepts that the Respondent's indication of a willingness to engage in "confidential settlement communications" could lead to an inference that the Respondent was seeking to use the disputed domain name for sale to the Complainant at a profit. On the other hand, if the Respondent genuinely had other plans for use of the disputed domain name unconnected with its significance as the Complainant's trademark, proposing negotiations of that kind would not indicate bad faith when the disputed domain name was registered.

In this connection, the Complainant contends that the Respondent is not using the disputed domain name in connection with a good faith offering of goods or services but is instead in the primary business of selling domain name portfolios and telephone numbers.

As noted above, the website to which the disputed domain name redirected did include a section "Domain Portfolios For Sale!". The page or section appears to be dated in 2018 (though the Respondent acquired the disputed domain name in 2022). However, it does state that the Respondent will be adding further domains and the page or section was still available when the Complaint was filed.

That said, the Panel would not characterise the content of the "About Us" page by itself as disclosing that the Respondent's primary business is the sale of domain names and telephone numbers. The whole annexure might be more appropriately characterized as promoting a brand consulting or development business.

The Respondent contends that, if the Complainant had clicked through the parking page links for "www.wineflys.com" to the Domain inquiry page, the text stated in part:

"Is this domain for sale?"

"Some are, but I have to tell you: I'm on a mission here.

"Over the last 7 years I've been pursuing IP on a global platform, Telex.Live, that blends the phone with the Internet. I now have patents grants on 4 continents including US, Europe, China, and Australia. In 2018-19, I'm forming a start-up to bring this Vision to life.

To fund this innovation, I'm willing to liquidate several valuable domain portfolios. These are domains that will capture value and mindshare in key mass or emerging markets—domains selected on branding and strategy, not key words alone."

In fact, the Panel has independently confirmed that Ms. Stocker is the patentee of at least an Australian patent, AU 2012240570, "Visual telephony apparatus, system and method" derived from a PCT Application, PCT/US2012/000190.

The fact that the Respondent publicly claimed to be "on a mission" to develop the Telex.Live concept may raise doubts about the Respondent's claim in this proceeding to be developing another business or website directed to wine lovers who travel. However, it is not inconsistent with such a project.

Turning to the Respondent's explanation, the Respondent claims that "the wine flyer" is a generic term. "Wine flyer" could, as the Respondent contends, be descriptive of a pamphlet or brochure promoting wine products. However, that is not what the Complainant uses the trademark for. Nor is it what the Respondent claims to be intending to use it for. The Complaint does describe the Complainant's current domain name as "generic". However, the Panel understands the Complainant's use of that expression in context to mean a trademark capable of use by multiple airlines as opposed to one branded as the "BA" or "British Airways"

service. One can readily understand why other airlines might not be attracted to using a service branded “British Airways” or “BA”.

The Panel would not characterise the expression “wine flyer” as directly descriptive of the service the Respondent claims it was seeking to develop. On the other hand, the Panel also would not characterise the expression as inapt for such a service. Accordingly, the Panel does not think the Respondent’s explanation of the intended purpose for the disputed domain name is so implausible it can be dismissed.

Further, the Respondent has submitted evidence of it procuring and taking delivery of a shipment of 100ml flasks in 2017. According to the Respondent, these flasks were designed in accordance with TSA requirements for use by travellers who wished to carry wine with them on flights. The Respondent claims that it continues to test the product although it has had “plenty of public exposure” since 2017. Those claims have not been supported by evidence.

It does not appear that the Respondent intended, or intends, to call these flasks the wine flyer. One might very well question the Respondent’s view that such a product does not impinge on the Complainant’s trademark (in jurisdictions where it is registered). However, it is some evidence supporting the Respondent’s claimed plans for a business related to wine lovers who travel.

More compellingly, the Respondent also claims to have registered <wineflys.com>, <travelwine.com>, <vinovial.com>, <skyvinos.com> and <trawino.com> as well as the disputed domain name. The Respondent has also registered the domain name <wine.events>. The Respondent subsequently offered at least some of these for sale. For present purposes (and bearing mind this is a proceeding on the papers only), the registration of these names shows some interest in the subject matter the Respondent claims to have registered the disputed domain name for and an indication that the Respondent was not targeting the Complainant.

Overall, therefore, the evidence available in this proceeding does not rise to the level where the Panel considers the Respondent must have known about the Complainant’s trademark and has attempted to take advantage of that trademark significance in the face of the Respondent’s denial.

Accordingly, the Complainant has not established that the Respondent registered the disputed domain name in bad faith. As a result, the Complainant cannot establish the third requirement under the Policy and the Complaint must fail.

### **C. Rights or Legitimate Interests**

In the circumstances, there is no value in considering whether the second requirement under the Policy has been satisfied as the Complaint must fail in any event.

### **D. Reverse Domain Name Hijacking**

The Respondent contends that the Complaint has been brought in bad faith and, accordingly, the Complainant should be sanctioned by a finding of reverse domain name hijacking.

Paragraph 15(e) of the Rules provides, in part:

“If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.”

Paragraph 1 of the Rules defines “Reverse Domain Name Hijacking” to be “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name”.

The fact that a Complaint has failed is not in itself sufficient to warrant a finding of reverse domain name hijacking.

In the present case, the Respondent contends that it put the Complainant on clear notice of the reasons why it registered the disputed domain name and why any Complaint must fail.

The Panel has found that the Complaint does fail for reasons including those advanced in the Respondent's letters in reply to the letters of demand. However, the Panel has done so in circumstances where the Respondent has submitted some independent corroborating material relating to the flasks and, further, on the narrow ground that, on the materials before the Panel and the limited procedures available under the Policy, it is not appropriate to go behind the Respondent's denial of knowledge of the Complainant's trademark when registering the disputed domain name.

It is apparent from the record that there is a genuine dispute between the Complainant and the Respondent. In those circumstances, the Panel is not prepared to sanction the Complainant with a finding of reverse domain name hijacking.

## **6. Decision**

For the foregoing reasons, the Complaint is denied.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: August 10, 2023