

ADMINISTRATIVE PANEL DECISION

Privilege Group DMCC v. Registration Private, Domains By Proxy, LLC / John Malkovich

Case No. D2022-1828

1. The Parties

The Complainant is Privilege Group DMCC, United Arab Emirates (“UAE”), represented internally.

The Respondent is Registration Private, Domains By Proxy, LLC, United States of America / John Malkovich, Monaco.

2. The Domain Name and Registrar

The disputed domain name <privi-lege.com> 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 May 20, 2022. On May 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 24, 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 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 amended Complaint on June 7, 2022.

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 June 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 30, 2022.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on July 5, 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 limited liability (free zone) company based in Dubai, UAE, holding a trading license for general trading from the Government of Dubai, UAE, dated June 14, 2017 (expiration date: June 13, 2022). The Complainant notes that it has engaged in general trading in the UAE market since 2013, notably selling garments and accessories from Italy. The Complainant also holds a service license from the Government of Dubai dated July 4, 2018 (expiration date: July 3, 2022) in respect of call center services, energy projects consultancy, science and technology consultancy, and project development consultancy.

The Complainant provides evidence that it holds tenancies in respect of three different properties in Liwa Heights, Jumeirah Lake Towers, Dubai amounting to a total of just under 380 square meters of commercial space, let for several periods between December 2021 and May 2024, with a total annual rent of AED 167,351.50 (around USD 45,500).

The Complainant claims that it holds a lease in Nakheel Mall, Palm Jumeirah, Dubai and produces what appears to be a branded printed business card or slip with a corresponding business address and telephone number. The card features the domain name <privilege.boutique>, which the Panel notes was registered on October 4, 2019. The Complainant produces photographs of what appear to be the doors to its office suites in Liwa Heights, Jumeirah Lake Towers, Dubai, numbered 3201, 3207, and 3803, which correspond to the above leased unit numbers, each featuring its logo and branding consisting of the capitalized word “P R I V I L E G E” in a stylized bronze-colored typeface with spaces between the letters, underlined with four irregularly-spaced lines. Another image of the interior of the Complainant’s office space, similarly-branded, is also supplied.

The Complainant asserts that it has over 10,000 followers of its “privilege.boutique” page on the Instagram social media platform. No matching evidence was supplied, however the Panel has verified this assertion by visiting the page concerned, noting that the Complainant now has 11,600 followers on such social media platform.¹ The branding on said Instagram page matches that on the Complainant’s office suites and on the Complainant’s business card or slip.

The disputed domain name was registered on October 21, 2021. Nothing is known about the Respondent, other than it appears to be an individual which has supplied an address in Monaco. It appears from the report received by the Center from the courier that attempted to deliver the Written Notice to the Respondent, (namely, “bad address”) that the Respondent has provided an incorrect or at least not up-to-date address to the Registrar. The website associated with the disputed domain name is currently inactive, although the Complainant produces screenshots of the home page of the former site, which features a “P R I V I L E G E” logo markedly similar to that of the Complainant. The site states that it is a “Design Company I Category” and refers to the Shymkent and Dostyk Plazas. The Panel notes that there are shopping malls by each of those names in Kazakhstan, although the said reference is not otherwise explained. At the bottom of the page, beneath another “P R I V I L E G E” logo similar to that of the Complainant, is the legend “© All rights reserved, PRIVILEGE GROUP DMCC Dubai.” This references the Complainant’s corporate name and registered location.

¹ The Panel conducted limited factual research into matters of public record to verify matters set out in the Complaint, notably visiting the Complainant’s Instagram page to verify the number of followers and looking up the Whois record for the Complainant’s domain names. On the topic of such limited research, see section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

5. Parties' Contentions

A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

The Respondent's company name, address, and contact number mentioned on the website associated with the disputed domain name are identical to those of the Complainant, although the goods, services, and content are different from the Complainant's business license. The Respondent uses the Complainant's logo and business name fraudulently to offer different services to the public, which damages the Complainant's business reputation.

The Complainant's trademark is unregistered. To support the basis of its claim, the Complainant proves its ownership of its three offices via corresponding photographs. The Complainant's Nakheel Mall site reported annual sales of USD 194,889 in 2021.

Rights or legitimate interests

The Complainant is licensed by the Dubai Multi Commodities Center, a Freezone Authority in the UAE. The trade name "Privilege" is an approved name for the Complainant. The Complainant has legal good standing. The Respondent's intention in using the Complainant's information is unknown. It is unauthorized and misleading. It is causing confusion among the Complainant's customers and is resulting in the loss of sales.

Registered and used in bad faith

The disputed domain name is being used in bad faith since a different email address is provided in the associated website and it offers different services. This disrupts the business of the Complainant and gives its partners, clients, and stakeholders a false impression. It leads to confusion with the Complainant's mark regarding its primary business activities, affiliations, location of a product or service, and its partners. The Complainant believes that the Respondent's use of false contact details suggests that the activities under the disputed domain name are fraudulent, which causes harm to the Complainant's business reputation and good name.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

A. Identical or Confusingly Similar

The first element analysis under the Policy is usually conducted in two parts. First, the Panel ascertains whether the Complainant has UDRP-relevant rights in a trademark, which may be registered or unregistered. Secondly, the domain name concerned is compared with such trademark, typically on a straightforward side-by-side basis, in which the Top-Level Domain (“TLD”) of said domain name (in the disputed domain name, “.com”) is usually disregarded as being only a technical requirement. Confusing similarity may be found if the trademark is recognizable within the domain name concerned, whether or not accompanied by other terms. Identity may be found if the trademark is identical to the domain name concerned (with the exception of the TLD), having disregarded any special characters or spaces which cannot be reproduced in a domain name.

In the present case, the Complainant has not put forward any registered trademark related to its brand and business name. Instead, the Complainant claims unregistered trademark rights in the mark PRIVILEGE. Section 1.3 of the [WIPO Overview 3.0](#) provides examples of what needs to be evidenced by a complainant in order to successfully assert unregistered trademark rights in cases under the Policy, namely (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

The evidence supporting the Complainant's claim to unregistered trademark rights is somewhat limited in this case. Nevertheless, it appears that the Complainant has traded as Privilege Group DMCC since at least June 2017, in other words, for five years.² The Complainant claims recent sales of USD 194,889 but does not evidence these in any way, which it could have done, for example, by reference to official filed accounts or similar. It is clear that the Complainant has made a substantial financial commitment to office premises in Dubai over the period from December 2021 to date and has branded these premises with its corporate name. This suggests that its business has a substantive and recognized market presence. Furthermore, the Panel has validated the Complainant's submission that it has a substantial social media following, in that the Complainant has garnered some 11,600 followers for its “privilege.boutique” page on Instagram.

While the evidence before the Panel is less detailed than it would have preferred, it is clear that the Complainant's business has some substance and has been trading under the name concerned for a reasonably lengthy period. What is more, it cannot be overlooked in the present case that the website associated with the disputed domain name, when it was live, reproduced the Complainant's corporate name in its entirety, in a manner suggesting that it was an official site of the Complainant. In these circumstances, the Respondent's registration of the disputed domain name seems to have been designed to take unfair advantage of the corporate name under which the Complainant trades. As section 1.3 of the [WIPO Overview 3.0](#) goes on to note, “The fact that a respondent is shown to have been targeting the complainant's mark (e.g., based on the manner in which the related website is used) may support the complainant's assertion that its mark has achieved significance as a source identifier”. That is the situation described in the present case. Accordingly, the Panel finds that the Complainant has unregistered trademark rights in its PRIVILEGE trademark.

Examining said mark alongside the disputed domain name in accordance with the typical first element comparison process described above, it may be seen that the disputed domain name is alphanumerically identical to said mark, with the exception of an inserted dash or hyphen between the elements “privi” and “lege”, which together form the Complainant's mark. The insertion of such punctuation is of no significance and would not prevent a finding of confusing similarity under the first element (see section 1.8 of the [WIPO Overview 3.0](#)).

² The Complainant claims a trading history dating back to 2013 but does not provide any evidence to support this longer period. It is possible that it traded for some time pre-incorporation but, if so, that was not the subject of any evidence.

In all of these circumstances, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights and therefore that the Complainant has carried its burden in respect of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (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.”

The consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in a domain name. In the present case, the Panel finds that the Complainant has established the requisite *prima facie* case based on its submission and related evidence that the disputed domain name and its associated website is impersonating the Complainant and providing false information to the public as to the nature of the Complainant’s licensed activities.

In the above circumstances, the burden of production shifts to the Respondent to bring forward evidence of any rights or legitimate interests which it might claim in the disputed domain name. However, the Respondent has not engaged with the administrative proceeding. The Panel therefore relies upon the Complainant’s screenshot of the website associated with the disputed domain name, together with the composition of the disputed domain name itself, for evidence of the Respondent’s activities. Such website lists the Complainant’s licensed trading name and reproduces the word “P R I V I L E G E” in what is recognizably a version of the Complainant’s logo. The Panel can conceive of no legitimate reason for the Respondent to have done this, and furthermore, the Panel has been unable to determine any potential rights or legitimate interests which the Respondent might have claimed had it chosen to participate herein.

In all of these circumstances, the Panel finds that the Respondent has failed to rebut the Complainant’s *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and therefore that the Complainant has carried its burden in terms of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- “(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; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark

from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

In the present case, the Complainant focuses upon the fact that the Respondent is using the Complainant's business name and corporate identity on a website featuring different services from those for which the Complainant's business is licensed, adding that this is disrupting the Complainant's business and conveying a false impression to its partners, clients and stakeholders. While the Respondent's actions may not necessarily fit squarely into any one of the examples of registration and use in bad faith outlined above, the Policy expresses these to be non-exclusive, such that the categories of bad faith conduct are not closed. The screenshot evidence in the present case is unambiguous as to the question of whether the Respondent registered and used the disputed domain name in the knowledge of the Complainant's rights and with intent to target these. The Respondent is clearly making reference to the Complainant's business identity by its use of the phrase "© All rights reserved, PRIVILEGE GROUP DMCC Dubai" at the foot of its home page, coupled with its reproduction of the Complainant's "P R I V I L E G E" logo in a similar typeface, spacing and bronze coloring to that of the original. Although the word "privilege" is a dictionary word, and is in widespread use by many different businesses, the specific reference to the Complainant's registered company name and particular branding demonstrates that it is the Complainant's mark in particular that is being targeted here. The Panel makes the reasonable inference that the Complainant is the only Dubai-based business which is registered under the name Privilege Group DMCC, thus ruling out any prospect of coincidental name selection on the Respondent's part (also noting the use of the Complainant's contact details by the Respondent). The Respondent's addition to the website content of a facsimile of the Complainant's logo further reinforces the notion that its adoption and use of the Complainant's PRIVILEGE unregistered mark could not be regarded as a mere chance occurrence.

The Panel does not know exactly why the disputed domain name, coupled to the website previously associated with it, appears to have been designed to usurp the Complainant's identity. However, the Panel considers that it is not unreasonable to infer that this may have been for the purposes of fraud. In any event, the Respondent's actions amount to an impersonation of the Complainant, and an unauthorized use of its mark with the apparent intent of causing confusion to consumers. Such use could not be seen on any view as a good faith activity in the particular circumstances of this case.

As noted in the preceding section, the Respondent did not engage with the administrative proceeding. The Complainant has accused the Respondent of acting fraudulently by intentionally cloaking itself in the Complainant's identity. This is a serious accusation, backed by supportive evidence. It calls for an answer from the Respondent which is lacking here, and indeed, an adverse inference can be drawn from the Respondent's silence on the topic. It should also not be overlooked that the Respondent appears to have provided false contact details, potentially in an attempt to avoid the thrust of the Policy, which can, in itself, be regarded as an indicator of bad faith in appropriate cases.

In all of these circumstances, the Panel finds that the disputed domain name was registered and is being used in bad faith, and therefore that the Complainant has carried its burden in terms of paragraph 4(a)(iii) 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 name <privi-lege.com> be cancelled.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: July 19, 2022