

ADMINISTRATIVE PANEL DECISION

Phoenix Life Limited v. Michael McCord, The Phoenix Group
Case No. D2024-0723

1. The Parties

The Complainant is Phoenix Life Limited, United Kingdom, represented by Pinsent Masons LLP, United Kingdom.

The Respondent is Michael McCord, The Phoenix Group, United States of America.

2. The Domain Name and Registrar

The disputed domain name <thephoenix-group.com> is registered with Wild West Domains, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 16, 2024. On February 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 19, 2024, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 20, 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 amendment to the Complaint on February 21, 2024.

The Center verified that the Complaint together with the amendment to 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 February 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 15, 2024.

The Center appointed Taras Kyslyy as the sole panelist in this matter on March 22, 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 is in long-term savings and retirement business and is known for managing and investing funds on behalf of their customers. As of 2023, the Complainant administered assets for circa 12 million customers, the total value of which was circa GBP 259 billion. The PHOENIX brand was initially founded as Phoenix Assurance, which has been trading since 1786. The PHOENIX brand has received wide exposure and is consistently the subject of press attention every year in publications with international reach. The Complainant has a number of high-profile corporate partnerships. The Complainant's PHOENIX brand has also received a number of awards and accolades.

The Complainant owns a portfolio of registered trademarks of the PHOENIX sign including, for instance, the United Kingdom trademark registration No. UK00001564248, registered on January 22, 1999.

The PHOENIX brand has presence online, both via its company websites and on social media.

The disputed domain name was registered on June 2, 2023, and does not resolve to any active website.

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 name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark. The disputed domain name wholly incorporates the Complainant's trademark at the start of it, with a minor addition of the words "the" and "group" at the end. Therefore, the disputed domain name is phonetically and visually confusingly similar with the Complainant's trademark. The disputed domain name includes the word "group" in order to exacerbate the association of the disputed domain name with the Complainant given the fact that the Complainant's parent company is "Phoenix Group" Holdings Plc. The inclusion of words such as "the", does not affect a finding of similarity between the disputed domain name and the mark. The disputed domain name suffixes do not interfere with the finding of confusing similarity between the disputed domain name and the mark.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent does not use the disputed domain name for any legitimate purposes or in connection with a bona fide offering of goods and/or services. The Complainant's trademark is associated internationally with the Complainant and its business of managing people's funds whether it be savings or retirement pots. This association and international reputation and goodwill are result of the Complainant's legitimate activities over the last 238 years. Thus, no individual would choose to register the disputed domain name other than to attract Internet users who are searching for the Complainant, thereby taking advantage of the Complainant's rights in the Complainant's trademark and goodwill. The Respondent registered the disputed domain name in full knowledge of the Complainant's activities and reputation and the fact that in doing so it was misappropriating intellectual property of the Complainant. The Respondent's registration of the disputed domain name despite the Complainant's substantial reputation in its trademark demonstrates that the Respondent did not legitimately register the disputed domain name. The Respondent has no connection with the Complainant and there is no evidence of the Respondent holding any rights in a name or a sign which is similar to or identical with the Complainant's trademark, being commonly known by the disputed domain name or having acquired any legitimate rights in respect of the disputed domain name

since its registration or prior to it. The Respondent has no authorization to use the Complainant's trademark and, therefore, the use of the disputed domain name by it constitutes an infringement of the Complainant's trademark.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. The Respondent was aware of the Complainant's trademark which enjoyed widespread international presence for over 200 years before the Respondent registered the disputed domain name. The Complainant contends that the Respondent deliberately included the Complainant's trademark in the disputed domain name for illegitimate purposes. In particular, the disputed domain name was registered and is being used to create a false impression of association with the Complainant and to use it as a means of deceiving Internet users (this is exacerbated even further by use of the words "group" in the disputed domain name by the Respondent which indicates the Complainant's parent company). By doing so, in addition to causing damage to the Complainant's business and reputation, the Respondent has also been unfairly exploiting the value of the Complainant's trademark. The inclusion of both the Complainant's trademark and the word "group" is also likely lead an average Internet user to believe that the disputed domain name is owned by the Complainant. The Complainant has legitimate interests in the disputed domain name and the registration of the disputed domain name is evidence of the Respondent's intention to disrupt and tarnish the Complainant's business and reputation. The Respondent uses a privacy shield and conceals its real identity which arguably further supports the assertion that the Respondent is intentionally abusing the disputed domain name. The Respondent will never be capable of using the disputed domain name for legitimate purposes as the notoriety and reputation of the Complainant's trademark is such that members of the public will always assume that there is an association between the Respondent and the Complainant, and/or between the Respondent and the Complainant's trademark.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "the", "group" and a hyphen, may bear on assessment of the second and third elements, the Panel finds the addition of such terms and a hyphen does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The applicable generic Top-Level Domain ("gTLD") 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. Thus, the Panel disregards the gTLD ".com" here for the purposes of the confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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

The available evidence does not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademark by the Respondent, thus no actual or contemplated bona fide or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

The Respondent has no rights or legitimate interests in the disputed domain name resolving to an inactive website (see, e.g., *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#)).

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 name, which incorporates the Complainant’s trademark and adds the term “group”, which is similar to the name of the Complainant’s parent company. This confirms that the Respondent was, or should have been, aware of the Complainant’s trademark, and targeted the Complainant, who is known in its business niche, when registering the disputed domain name, which constitutes bad faith.

Panels have 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. Having reviewed the available record, the Panel finds the non-use of the disputed domain name in this case does not prevent a finding of bad faith in the circumstances of this proceeding. Although panels will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement).

[WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes all of the above factors apply in this case, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

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 name <thephoenix-group.com> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: March 25, 2024