

DISPUTE RESOLUTION SERVICE

D00018982

Decision of Independent Expert

Victoria's Secret Stores Brand Management, Inc.

and

Maria Rosana dos Santos

1. The Parties:

Complainant:

Victoria's Secret Stores Brand Management, Inc.
Three Limited Parkway
Columbus
Ohio 43230
USA

Respondent:

Maria Rosana dos Santos
2 Dawson Place
London
W2 4TJ
UK

2. The Domain Name(s):

victoriasecretbeauty.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as might be of such a

nature as to call into question my independence in the eyes of one or both of the parties.

07 June 2017	Dispute received
08 June 2017	Complaint validated
08 June 2017	Notification of complaint sent to parties
29 June 2017	Response received
29 June 2017	Notification of response sent to parties
06 July 2017	Reply received
10 July 2017	Notification of reply sent to parties
13 July 2017	Mediator appointed
14 July 2017	Mediation started
07 August 2017	Mediation failed
18 August 2017	Expert decision payment received

4. Factual Background

The Nominet records show that the Domain Name was registered on 4 July 2014.

Based on the parties' submissions (see section 5 below) and a review of the materials annexed to those submissions, I set out below the main facts which I have accepted as being true in reaching a decision in this case:

- a. The Complainant is a worldwide retailer of intimate apparel, beauty and other products under the Victoria's Secret brand name.
- b. The Complainant has carried on business since 1977. It operates in over 1,500 stores worldwide, as well as online through its website at www.victoriassecret.com. Its annual turnover worldwide exceeds \$5 billion.
- c. The Complainant opened its first UK store in 2005 and now operates over 20 UK stores.
- d. The Victoria's Secret brand is extensively promoted.
- e. The Complainant owns a large portfolio of Victoria's Secret trade marks, including a UK registration for VICTORIA'S SECRET and an EU registration for its stylised VS VICTORIA'S SECRET logo.
- f. The Respondent provides beauty services, including manicures/pedicures and waxing, at a salon which was originally located on Victoria Street, London.
- g. The Domain Name resolves to a website for the Respondent's beauty services.
- h. At the time when the Complainant first contacted the Respondent, the Respondent was using a stylised "VSB" logo which was very similar to the stylised "VS" logo of the Complainant.

- i. The Respondent subsequently changed its logo, but continued to use the Domain Name and to trade under the name Victoria Secret Beauty.

5. Parties' Contentions

Complaint

The Complainant's submissions are set out below:

The Complainant has rights in respect of a name and mark which is identical or similar to the Domain Name:

- (1) The Complainant is a company incorporated in the state of Delaware in the United States of America. It is a subsidiary of L Brands, Inc. and is a leading US and worldwide retailer specialising in personal care products including fragrances, beauty and body care products and related accessories, intimate apparel (including lingerie and sleepwear), and athletic and loungewear. It is the owner of and operates under and by reference to its well-known brand name Victoria's Secret.
- (2) Victoria's Secret is a flagship brand of the L Brands family of companies, and was founded in 1977 in California. Victoria's Secret operates in over 1,500 stores worldwide, including in the UK, and also online at www.victoriasecret.com. Total sales of Victoria's Secret products during the first quarter of 2016 alone exceeded US\$1,740,900,000.
- (3) In November 2005, the first UK based Victoria's Secret boutique was opened at Heathrow Airport, Terminal 5. Today, Victoria's Secret operates 23 UK stores including its flagship store on New Bond Street, London and stores in leading UK shopping centres including (among others) the Westfield Shopping Centre in London, Bluewater in Kent, the Trafford Centre in Manchester, Meadowhall in Sheffield, the Bullring in Birmingham, Trinity in Leeds, Cabot Circus in Bristol and Lakeside in Essex.
- (4) Victoria's Secret also operates dedicated Beauty and Accessories stores at airports throughout the world including in the following major UK airports: Gatwick, Luton, Manchester, Birmingham and Glasgow.
- (5) Beauty and body care products are a core part of the Complainant's business. The Victoria's Secret Beauty and Accessories range includes fragrance, mists, body care, make-up, gifts and gift sets. These products are available to purchase in the Victoria's Secret full-assortment stores, at the dedicated Victoria's Secret Beauty and Accessories stores and online at www.victoriasecret.com/beauty. In 2013, Victoria's Secret launched a range of nail polishes to complement its existing beauty range.
- (6) The Victoria's Secret brand has been promoted internationally for many years and enjoys a global reputation. As a result of the quality of Victoria's Secret's goods, the volume of its customers, its extensive advertising and promotional campaigns (including the Victoria's Secret Fashion Show, which has been

described by Forbes Magazine as "the most watched fashion event on the planet", the Victoria's Secret name has acquired substantial goodwill which belongs exclusively to the Complainant and L Brands, Inc.

(7) The Complainant owns and maintains an extensive worldwide registered trade mark portfolio for the Victoria's Secret trade marks, which includes the following marks relevant to this Complaint:

- (a) UK Trade Mark No. UK00001257678 registered on 17 January 1990 for the word mark VICTORIA'S SECRET in respect of goods in class 3 which includes the following: "soaps; shampoos; perfumes; cosmetics; preparations for the hair and the skin; toilet preparations; all being non-medicated" (the "VICTORIA'S SECRET Mark"); and
- (b) European Union Trade Mark No. EU013000121 registered on 7 November 2014 for the stylised VS VICTORIA'S SECRET logo in respect of goods and services in classes 16, 18, 35 and 41 which includes: "flyers and pamphlets" in class 16 and "online retail store services and mail order services all in the field of ... cosmetics, personal care products" in class 35 (the "VS VICTORIA'S SECRET Mark")

(together the "VS Marks").

(8) The Complainant owns approximately 1,650 domain names incorporating the VICTORIA'S SECRET Mark, including for example *victoriasscretbeauty.com* which was registered on 14 April 1999.

(9) The Domain Name is identical or similar to the VS Marks in which the Complainant has Rights. The VICTORIA'S SECRET name is an unusual, distinctive and memorable name and trade mark which is known worldwide and in respect of which the Complaint owns goodwill and reputation. The only difference between the Domain Name and the VICTORIA'S SECRET Mark are the deletion of the apostrophe and letter "s" following the word "VICTORIA"; the addition of the purely descriptive word "beauty"; and the suffix ".co.uk". In this respect, the Complainant makes the following specific submissions:

- (a) The removal of the apostrophe and letter "s"

The Complainant submits that the deletion of the apostrophe and letter "s" is a minor alteration that does nothing to alleviate the confusing similarity between the Domain Name and the VICTORIA'S SECRET Mark.

The Complainant refers in this regard to the decision of the Administrative Panel decision in *Victoria's Secret Stores Brand Management, Inc., Victoria's Secret Stores, LLC, and Victoria's Secret Direct, LLC v. Sharon Brown and Kenneth Brown* Case No. D2006-0556, in respect of the following disputed domain names:

<victoriashotsecret.biz>, <victoriashotsecret.info>, <victoriashotsecret.net>, <victoriashotsecret.org> and <victoriashotsecret.com>. In this case the Panel held that:

"Although five domain names (one each in five top-level domains) are the subject of this Complaint, the important portion of each domain name for purposes of assessing whether they are identical or confusingly similar to Complainants' trademarks is the same in each. That portion identical in each is VICTORIASHOTSECRET. This grouping of letters or phrase is identical to Complainants' trademark VICTORIA'S SECRET but for the lack of the apostrophe, a space (a character that cannot be made part of a domain name) and the word "hot." For purposes of comparison, then, the Panel drops the apostrophe, the space, and the word hot... Applying these principles, the Panel therefore compares VICTORIASSECRET to VICTORIASECRET. These letter combinations are identical, except for the second "s" in Complainants' trademark. Complainants have satisfied paragraph 4(a)(i) of the Policy in that the Domain Names are confusingly similar to Complainants' trademark."

(b) The addition of the descriptive word "beauty"

The mere addition of the generic and purely descriptive word "beauty" in the Domain Name does not prevent the Domain Name from being identical or similar to the VICTORIA'S SECRET Mark. The "VICTORIA SECRET" element of the Domain Name clearly stands out as its dominant and distinctive feature, whilst the word "beauty" is generic and descriptive.

In this regard the Complainant refers the Panel to the decision Case No. D2006-0556 (referred to above) where it was held that: "In reviewing whether each of the Domain Names is identical or confusingly similar to a trademark or service mark in which Complainants have rights, the Panel is mindful of the fact that common words in the Domain Names should be eliminated for purposes of the comparison...In addition, generic terms, occurring within a domain name in conjunction with a trademark, should not be considered for purposes of comparison". See also PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.), WIPO Case No. D2003-0696

Further, or alternatively, the specific addition of the word "beauty" in the Domain Name perpetuates the likelihood of association and confusion between the Domain Name and the VICTORIA'S SECRET Mark, due to the fact that a core part of the Victoria's Secret brand is Beauty (and Accessories), as referred to above. Therefore the Domain Name is wholly descriptive of goods offered by the Complainant under the VICTORIA'S SECRET Mark.

(c) The addition of the suffix ".co.uk"

It is well established that the addition of the generic suffix ".co.uk" is to be discounted for the purposes of establishing whether a complainant has rights in a name or mark which is identical or similar to a domain name (see for example the decision of the independent experts in Nordic ID Oy v Ms Camilla Danks DRS 016948 and paragraph 2.3 of Experts' Overview).

- (10) Accordingly, the Complainant has Rights in respect of the VICTORIA'S SECRET Mark which is identical or similar to the Domain Name, for the reasons stated above.

The Domain Name, in the hands of the Respondent, is an abusive registration:

- (1) The Complainant considers that the Domain Name:
 - (a) was registered (or otherwise acquired) by the Respondent in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's aforementioned Rights; and/or
 - (b) has been subsequently used by the Respondent in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's aforementioned Rights.
- (2) The Respondent to these proceedings is Maria Rosana dos Santos of 251 Elgin Ave, London W9 1NJ. The WHOIS search for the Domain Name (attached at Annex 4) states that the Respondent is a UK Sole Trader and is trading as "Victoria secret beauty". The Domain Name was registered on 4 July 2014.
- (3) The Domain Name resolves to a website which advertises and facilitates the booking of beauty services at a salon named Victoria Secret Beauty. The salon is located in Holborn, London at 42 Lambs Conduit Street, WC1N 3LJ (in the basement of a hairdressing salon called Frankie and Cochrane). The Respondent is the owner and operator of the business. The services offered by the Respondent under the "Victoria Secret Beauty" name include manicures, pedicures, waxing and facials. Screenshots of the website as it currently appears are annexed.
- (4) The Respondent is also the registrant of the following domain name: <victoriasecretnails.com>, which was registered on 12 March 2014. Until recently this domain was used by the Respondent as a contact email address for Victoria Secret Beauty: info@victoriasecretnails.com. This no longer appears to be the case, but <victoriasecretnails.com> now also resolves to the Victoria Secret Beauty website (it previously resolved to an error message). The Complainant is submitting a separate complaint to WIPO under the ICANN UDRP in respect of this domain name.
- (5) The Complainant first became aware of the Respondent's Domain Name and business activities in May 2016, when it found an advertisement for Victoria Secret Beauty on a website called Treatwell (www.treatwell.co.uk), which

provides an online service enabling customers to locate beauty salons and book treatments online.

- (6) A representative of Burges Salmon LLP, the Complainant's legal representatives, visited the Respondent's business premises in early May 2016. During that visit the representative was provided with a copy of the pricelist for treatments at Victoria Secret Beauty. The pricelist displayed a logo on its front cover (the "VSB Logo") that was highly similar to the VS VICTORIA'S SECRET Mark. Screenshots of the Respondent's website, including the VSB Logo, as at 21 May 2016 are annexed.
- (7) The Complainant instructed Burges Salmon LLP to write to the Respondent on its behalf, on 7 June 2016. The letter outlined the Complainant's concerns regarding: the use of the VICTORIA'S SECRET Mark in the Domain Name and in <victoriasecretnails.com>; the use of 'Victoria Secret' in the name of the beauty salon and on the website at the Domain Name; and the use of the VSB Logo. The letter requested that the Respondent cease operating a business under the name Victoria Secret Beauty, cease using the VSB Logo and transfer the Domain Name (and <victoriasecretnails.com>) to the Complainant.
- (8) The letter was addressed to the Respondent and another individual: Cristiane Alves Camacho, as at the date of the letter, a WHOIS search stated that the Domain Name was owned by Ms Camacho. The WHOIS details have since been updated by the Respondent to reflect the true position, namely that the Respondent is the registrant of both the Domain Name and <victoriasecretnails.com>.
- (9) The Respondent responded by email on 20 June 2016 to request an extension of the deadline to respond, which the Complainant's solicitors agreed to by email on 21 June 2016. The Respondent replied substantively by email on 24 June 2016. She acknowledged in her response that: "the similarity between the trademarks is regrettable however", and that: "[t]he arrangement of the trademark although considerably augmented is similar and could give rise to confusion to some". The Respondent also stated that "Victoria Secret Beauty and Victoria Secret Nails were established as a business on the second floor of a building in Victoria, London...that provided beauty services." The Complainant notes that no explanation was provided for including the word 'Secret' in her domain names and business name, after the word 'Victoria'. The Respondent agreed to change the VSB Logo but refused to change the name of the business and transfer the domain names. The Respondent said that she would be happy to "consider a commercial resolution under a licensing agreement" and threatened to "leverage the maximum public relations afforded...".
- (10) The Complainant's solicitors replied to the Respondent by letter dated 20 July 2016. The letter noted the Complainant's preference to resolve the dispute amicably if possible and set out an offer from the Complainant of \$2,500 for the Respondent to change the business name, transfer the Domain Name and provide signed undertakings (a draft of which was enclosed with the letter). In

addition, the Complainant also offered to pay a reasonable sum towards changing the business signage and business stationery, provided that sum was verified with an itemised list of expenses.

- (11) On or around 23 July 2016, the Respondent changed the VSB logo on the website at the Domain Name to a pink and black and white logo under the name "VICTORIA SECRET NAILS" with "VICTORIA SECRET BEAUTY" written in stylised font below the logo.
- (12) The Respondent replied by email on 21 August 2016 rejecting the Complainant's offer, describing it as "paltry". The Respondent also listed a number of items that she wanted the Complainant to take into account to make an "appropriate offer" including among others: "New customers database due to its rebrand"; "Social media impact"; "Loss of future possible new customers due to its rebrand"; "Google loss in reviews".
- (13) The Complainant's solicitors responded by letter on 31 August 2016. The Complainant's letter noted that, whilst the Respondent appeared to have ceased using a stylised version of the VS VICTORIA'S SECRET Mark as the business logo, the Respondent was continuing to trade under the 'Victoria Secret Beauty' name. The letter stated that since the Respondent was not prepared to engage in a reasonable manner to resolve the issue, the Complainant's offer was withdrawn, the Complainant would continue to monitor the Respondent's business activities going forwards and the Complainant reserved its right to take such further steps as necessary to protect its intellectual property rights.
- (14) On 20 December 2016 the Complainant's solicitors checked the website at the Domain Name and noted that the Respondent had changed the business logo once again to a stylised arrangement of the letters V, S and B.
- (15) On 10 January 2017, the Respondent emailed the Complainant's solicitors in response to its email of 31 August 2017, strongly objecting to the Complainant's monitoring of her business activities and stating that she hoped that "Victoria's Secrets lower social media rankings do not reflect on [her] own high standings in a negative way."
- (16) The Complainant's solicitors checked the website at the Domain Name again on 29 March 2017 and noted that once again, the Respondent had changed her business logo to a different stylisation of the letters V, S and B with the words VICTORIA SECRET BEAUTY set out below.
- (17) Despite being fully aware that the Complainant was monitoring her activities, the Respondent applied to register Victoria Secret Beauty as a UK trade mark at the UKIPO for beauty services in classes 41 and 44. The application filed on 21 March 2017 and was published on 2 June 2017. The application is being opposed strongly by the Complainant.
- (18) In light of the Respondent's approach to this matter throughout, her refusal to engage with the Complainant in a constructive and amicable fashion to resolve

the issues raised, followed by the filing of her trade mark application for Victoria Secret Beauty, in full knowledge of and in flagrant disregard of the Complainant's rights, the Complainant feels it has no option but to take steps to protect and enforce its intellectual property rights against the Respondent, including the filing of this Complaint.

- (19) The Domain Name is an Abusive Registration under the DRS Policy. In particular, the Complainant submits that the Respondent registered and is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name was registered to, operated or authorised by, or otherwise connected with the Complainant (Paragraph 5.1.2 of the Policy). In this regard, the Complainant makes the following specific submissions:
- (a) Victoria's Secret has been trading since the 1970s and it is inconceivable that at the time of registration of the Domain Name, the Respondent was not aware of the existence of the Complainant's extensive reputation. It is plain that the Complainant has amassed tremendous goodwill and reputation through its intensive use of the VS Marks globally. Further, as stated above, a core part of the Complainant's business is Victoria's Secret Beauty & Accessories.
 - (b) It is reasonable to infer that the Domain Name was registered (or otherwise acquired) by the Respondent to deliberately take advantage of the Complainant's reputation in the VICTORIA'S SECRET name and the VS Marks, for the purpose of promoting her own business. The Respondent's intention at the time of registration of the Domain Name is clearly demonstrated by her choice to use both the VICTORIA'S SECRET Mark in her domain names and to adopt a business logo (the VSB Logo) that was almost identical to that of the Complainant's VS VICTORIA'S SECRET Mark. This demonstrates that the Respondent clearly had the VICTORIA'S SECRET name and brand in her mind at the time she registered the Domain Name, and was undoubtedly influenced by the Complainant's name and reputation when selecting a business name and logo.
 - (c) Further, at no point has the Respondent provided a valid reason for choosing to combine the words 'Victoria' and 'Secret' specifically as the dominant and distinctive element of the Domain Name. The Complainant submits that the Respondent's intention in this regard is clear, for the reasons stated above. The Complainant does not consider that the Respondent has any legitimate right to use the VICTORIA'S SECRET Mark in connection with the Domain Name.
 - (d) For all of the reasons stated above, the Respondent is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, which amounts to an Abusive Registration. In particular, as described above, the Respondent is operating a website at the Domain Name to promote a

beauty services business under the name 'Victoria Secret Beauty'. As stated above, the Respondent has expressly admitted in correspondence with the Complainant's solicitors, the similarity and possibility of confusion arising between the VS Marks and her choice of business name, domain names and the VSB Logo. Notwithstanding this admission, the Respondent continues to trade under a name (including using the Domain Name) which is confusingly similar to the VICTORIA'S SECRET Mark, and has provided no legitimate reason for doing so.

- (20) For the foregoing reasons, the Complainant submits that, on the balance of probabilities, the registration and use of the Domain Name is an abusive one and requests that the Domain Name be transferred to it.

Response

A summary of the Respondent's submissions is set out below:

- (1) In 2011 the Respondent started a business which offered mobile beauty services in London. As services became popular, a primary location was opened in Victoria Street, South West London and a new domain name of *victoriastreetnails.co.uk* was formed. However, this was hacked and the Respondent had no choice but to consider re-branding, despite the impact on business turnover and complaints which started to occur because sales were mostly based on voucher deals. After much careful deliberation and research, a new domain name and brand was created in the form of *victoriasecretbeauty.co.uk*.
- (2) *victoriasecretbeauty.co.uk* was chosen due to the business' location, being on Victoria Street; with the word "secret" reflecting that the location was often hard for clients to find, and also alluding to the intimate nature of some of the beauty services provided. The name also described the full range of services provided by the Respondent, which are manicures and pedicures, facial treatments and waxing.
- (3) There was no difficulty encountered in obtaining the domain name.
- (4) Research was done on a website offering free legal resources in respect of domain names, showing that the purpose of obtaining the domain name was not to create a domain name similar to any existing domain names, and no similar names were shown as restrictions - as there were dozens of other names available linked to the domain name in dispute.
- (5) The domain name derived distinctiveness through social media and Google searches, which substantiated its goodwill.
- (6) The Respondent's domain name is spelt differently from the Complainant's domain name.

- (7) The Domain Name is related to the services offered on the Respondent's website and there is no correlation, similarities or connections made to the Complainant's products, which are lingerie and also body lotions and other products. Therefore, consumers will not be diverted when searching for beauty services, as searching is direct, objective and purposeful.
- (8) There is extensive availability for domain names which incorporate the words 'victorias secret', including *victoriassecretbeauty.co.uk*, despite the fact that the Complainant states that it owns approximately 1,650 domain names incorporating the Victoria's Secret mark.
- (9) There is the addition of the descriptive word 'beauty' to the domain name, describing the services offered and the suffix '.co.uk', to establish region. The Domain Name was registered with the goodwill of delivering services from the moment it was purchased, which can be evidenced through reviews on the website. The website also describes all of the services offered, which bear no relation to the Complainant's business.
- (10) The 'VSB' logo is an abbreviation of the name Victoria Secret Beauty. The font was chosen from a standard Microsoft font, which the Complainant does not have an exclusive right to use. The design was chosen to reflect beauty treatments. The logo is not a trade mark and it was designed not to infringe any law or trade marks.
- (11) The Complainant's EUTM no. 013000121 for the stylised VS logo is not related to beauty services, the only correlation to the Respondent's business being retail store services.
- (12) The Complainant has no right under UK trade mark registrations to the exclusive use of the letters 'VSB', only to the design of the symbol and so the Respondent's use of the 'VSB' logo does not represent any similarities to the Complainant's mark.
- (13) The UKIPO stated that the Complainant's trade mark for 'VICTORIA'S SECRET' did not give the Complainant an exclusive right to use the word 'Victoria'.
- (14) Considering the optimisation of search engines, a customer searching for lingerie would not be diverted and have its mind changed and book a beauty treatment instead.
- (15) No evidence of customer confusion, either by phone call, text or email has been received.
- (16) The services that the Respondent offers via its website cannot be seen as unfairly detrimental to the Complainant's business, which does not include services at all.
- (17) The Complainant only entered the cosmetic market 21 years after the company's inception. In addition, the brand is not known worldwide as its

goods are luxury items, which are non-essential. The Complainant's brand was not known to the Respondent.

- (18) The Complainant's choice of name has no clear connection to the business, which contrasts the Respondent's choice, as set out above.
- (19) The loss of the Domain Name could equate to £15,000 for the Respondent, whereas it cannot be seen a substantial gain to the Complainant.
- (20) The legal letter which the Complainant's solicitors sent to the Respondent was intimidating, threatening and bullying. The compensation of £2,500 which it offered was paltry.

Reply

The Complainant's submissions in reply are set out below:

- (1) In respect of the Respondent's explanation for naming her business Victoria Secret Beauty, and for the incorporation of the VICTORIA'S SECRET Mark in the Domain Name, the Complainant makes the following observations:
 - (a) The Complainant notes that the Respondent's business was originally called Mobile Beauty Care and then subsequently, Victoria Street Nails. However, the Respondent has not provided any convincing reasons for then choosing to rename her business as Victoria Secret Beauty.
 - (b) In the Response, the Respondent asserts that her decision to incorporate the words 'Victoria' and 'Secret' into her business name and the Domain Name was premised on the descriptive use of these terms. In particular:
 - (i) in relation to the use of the word 'Victoria', the Respondent asserts that this was due to the location of her business being on Victoria Street, London; and
 - (ii) in relation to the use of the word 'Secret', the Respondent asserts that this was due to: (A) the fact that her business premises were apparently difficult to find; and also that (B) the term is descriptive of the beauty treatments the Respondent provides, some of which are carried out in an intimate region of the body;
 - (c) The Complainant notes that this is the first time that the Respondent has sought to justify her use of the word 'Secret' in the Domain Name and business name. Indeed, it is notable that the Respondent has not chosen to explain this to the Complainant before now, despite being engaged in correspondence with the Complainant's solicitors since June 2016. For example, the Respondent's first email dated 24 June 2016 in response to the Complainant's solicitors' first letter dated 7 June 2016 made reference to the business originally having been

established on Victoria Street, but the Respondent neither expressly confirmed this was her reason for choosing to incorporate the word 'Victoria' within the Domain Name and her business name, nor did she say anything at all about the use of the word 'Secret'.

- (d) The Response also states that the Respondent considered other names for her business such as: "victoriahiddenplace / victoriahiddenbeautymade etc." If that were the case, why did the Respondent specifically choose 'Victoria Secret Beauty' instead?
 - (e) The Complainant submits that the facts of this case strongly suggest that the Respondent deliberately chose a business name and Domain Name that incorporated (or was closely similar to) the famous VICTORIA'S SECRET Mark. This is evidenced by the fact that, at the same time, the Respondent adopted a logo for her business (the "VSB Logo") that was closely modelled on the VS VICTORIA'S SECRET Mark.
 - (f) Further, whilst the Respondent claims in her Response that the font for the VSB Logo was "chosen from a standard Microsoft font in circulation throughout the World Wide Web", this does not explain the positioning of the letters in the VSB Logo, which are clearly and deliberately arranged in such a way as to directly include the stylised combination of the letters V and S from the VS VICTORIA'S SECRET Mark at the centre of the VSB Logo.
 - (g) Although the Respondent's choice of business logo is not the subject of these proceedings, it provides clear evidence of the Respondent's real intent in registering and using a Domain Name incorporating the VICTORIA'S SECRET Mark, and that such actions amount to an Abusive Registration. The Respondent has not provided any persuasive evidence in her Response to counter the Complainant's submissions in this regard.
- (2) The Respondent in her Response makes reference to the availability of the Domain Name on a "first come first serve" basis and states that other domain names are also available which are similar to the Complainant's VICTORIA'S SECRET Mark. It is inferred from the Respondent's Response that she considers that her use of the VICTORIA'S SECRET Mark in the Domain Name is legitimised by virtue of the fact that the Domain Name was available for purchase. In this respect, the Complainant notes that when choosing a domain name it is the Respondent's responsibility to carry out checks prior to registering the name to ensure that it does not infringe the rights of any third party (in this case the intellectual property rights of the Complainant) in accordance with the Domain Name's Registrar's terms and conditions.
- (3) The Complainant does not accept the Respondent's assertion in her Response that there is "no co-relation, similarities or connections to the Complainant's products" with those goods and/or services offered by the Respondent in connection with the Domain Name. As a preliminary point, the Respondent

has expressly admitted in correspondence with the Complainant's solicitors that there is possibility of confusion arising between the VICTORIA'S SECRET Mark and her choice of business name, domain names and the VSB Logo (see Respondent's email dated 24 June 2016). As noted in the Complaint, beauty and body care products are a core part of the Complainant's business, which includes a beauty range of fragrances, mists, body care, make-up, gifts and gift sets. Screenshots of the "Beauty" section of the Complainant's Victoria's Secret online store are annexed.

- (4) Further, the fact that there is a clear "correlation" between the Complainant's Victoria's Secret Beauty and Accessories offering and the services provided by the Respondent under the 'Victoria Secret Beauty' name is clearly evidenced by the Google searches annexed. Searches for "Victoria's" + "Secret" + "Beauty" and "Victoria" + "Secret" + "Beauty" display listings predominantly consisting of the Complainant's Victoria's Secret beauty products and website, but also (for example in terms of location "hits" for the latter) the Respondent's salon.
- (5) In this respect, the Complainant refers to section 3.3 of the Expert's Overview concerning "initial interest confusion":

"Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived".

- (6) The Respondent's registration and use of the Domain Name is likely to confuse people or businesses into believing that the Domain Name was registered, operated or authorised by, or otherwise connected with the Complainant.
- (7) For completeness, the Complainant strongly refutes the Respondent's allegations of feeling threatened and bullied by the Complainant's correspondence. The Complainant is entitled to protect and enforce its intellectual property rights and was entirely reasonable in its dealings with the Respondent. Indeed, as pointed out in the Response and detailed in the Complaint, as a gesture of goodwill to resolve the dispute the Complainant

offered the Respondent \$2,500 to settle the matter, in return for signing undertakings, which included an undertaking to transfer the Domain Name to the Complainant. This offer, which was rejected by the Respondent, was made in good faith, as a genuine attempt to resolve the matter amicably between the parties.

- (8) The Complainant notes that the Respondent has not provided any persuasive evidence in her Response to support any legitimate reasons for registering the Domain Name and choosing to incorporate the VICTORIA'S SECRET Mark within it. In particular, she has been unable to provide any good explanation for choosing not only to incorporate the VICTORIA'S SECRET Mark into the Domain Name and her business name, but also at the same time deliberately incorporating the VS VICTORIA'S SECRET Mark into her VSB Logo.

2. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

In light of the factual findings set out in section 4 above, it is clear that the Complainant has Rights in the nature of both legally protectable goodwill and registered trade marks in the name VICTORIA'S SECRET.

Disregarding the generic .co.uk suffix, the only differences between the Domain Name and the Victoria's Secret name are that the former omits one "s" in the middle, which is very easy not to notice; and adds the descriptive term "beauty" at the end, a term which is directly relevant to the businesses of both the Complainant and the Respondent. Neither of these differences is accordingly significant. The Domain Name is clearly similar to the name in which the Complainant has Rights.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the Policy defines an "Abusive Registration" as:

"A Domain Name which either:

- i was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The factor under paragraph 5 on which the Complainant relies is as follows:

"5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant"

The Domain Name resolves to a website where the home page is headed "Victoria Secret Beauty". The website promotes the Respondent's beauty services at its Victoria Secret Beauty salon and allows bookings to be made. There is nothing on the home page to make clear that there is no connection with the Complainant.

There is no doubt that the Complainant's Victoria's Secret brand is very well-known, including in the UK, and has been for many years. The brand is particularly famous in relation to lingerie, but the Complainant also sells beauty products.

The Respondent claims not to have known the Victoria's Secret brand at the time when the Domain Name was registered. In my view, this is not a credible claim, particularly taking into account that the Respondent operates in field of beauty services.

My view is reinforced by the Respondent's initial form of stylised "VSB" logo having been highly similar to the form of the Complainant's "VS" logo. The level of similarity is so marked that the chances of it having been coincidental are very low, and I find that it was not coincidental.

The Respondent seeks to explain its choice of the "Victoria" element of the Victoria Secret Beauty name as referring to the original location of its salon having been on Victoria Street; and the "Secret" element to the location being hidden and the intimate nature of its services. Taking into account how well-known the Complainant's brand is, together with the very similar form of logo originally used by the Respondent, the Respondent's claim to have chosen the combined term "Victoria Secret" innocently is again not credible.

I therefore find that the Respondent was aware of the Complainant's Victoria's Secret brand at the time when the Domain Name was registered; and that the Respondent registered the Domain Name, and has subsequently used it, in order to ride on the coat-tails of that brand and thereby gain a business advantage.

The Respondent claims that the nature of its business, i.e. beauty services, bears no correlation with the Complainant's business, which it argues is limited to products, not services and is primarily for lingerie. In fact, the Complainant also sells beauty products. In any case, the Victoria's Secret brand is sufficiently unusual and famous to mean that it is very likely that the use of the name "Victoria Secret Beauty" will cause at least some people to believe that it is connected with, or authorised by, the Complainant. This fits with the Respondent's own intentions, which I have already found were to gain a business advantage. Even if the Respondent had no such intentions, the likelihood of such confusion remains and in itself would be sufficient for the finding which follows.

I therefore find that the Domain Name was registered, and has been used, in a manner which takes unfair advantage of the Complainant's Rights. The registration and use of the Domain Name in relation to a business which is not controlled by the Complainant is likewise unfairly detrimental to the Complainant's Rights.

The Domain Name is therefore an Abusive Registration.

3. Decision

Having found that the Complainant has Rights in respect of a name which is similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *victoriasecretbeauty.co.uk* be transferred to the Complainant.

Signed
Jason Rawkins

Dated: 13 September 2017