Decision for dispute CAC-UDRP-101637

Case number	CAC-UDRP-101637
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Domain names	ibisjakartaharmoni.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Accor

Complainant representative

Organization	DREYFUS ET ASSOCIES

Respondent

Name	Hulmiho Ukolen

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings the Panel which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant owns a number of trademark registrations in various countries for the trademark IBIS in relation to hotel and restaurant services (e.g. International trademark "IBIS" n° 541432 registered on July 17, 1989, covering services in classes 38, 39 and 42; Indonesian Trademark “IBIS”, n° IDM000076524 registered on June 6, 2006, covering services in class 43; and European trademark "IBIS" n° 001527720 registered on June 06, 2001, covering services in classes 16, 39 and 42).

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Factual and Legal Grounds
(Policy, Paragraphs 4(a), (b), (c); Rules, Paragraph 3)

Complainant is a French multinational hotel group that has operated for more than 45 years. It operates more than 4,000 hotels in 95 countries worldwide and around 570,000 rooms, from economy to upscale. The group includes hotel chains such as PULLMAN, NOVOTEL, MERCURE and IBIS.

In particular, Complainant's IBIS brands consist of 1,800 hotels worldwide. The brands comprise of IBIS HOTELS with 1,088 hotels worldwide in 65 countries, IBIS STYLES HOTELS counts 293 hotels in 25 countries and IBIS BUDGET HOTELS with 570 addresses throughout 17 countries as of December 31, 2017. IBIS branded properties are also present in Indonesia with 58 hotels. IBIS counts approximately 16 hotels in the city of Jakarta, one of them being named "Ibis Jakarta Harmoni".

The disputed domain name <ibisjakartaharmoni.com> resolves to a pay-per-click page displaying sponsored links related to hotel services as well as goods and services in a variety of other fields.

Between March 11, 2016, and June 13, 2017, Complainant sent a number of cease-and-desist letters to the email address listed in the Whois record for the <ibisjakartaharmoni.com> domain name. The hosting company and the concerned Registrar were copied on many of these letters. As these efforts did not lead to a resolution of the dispute, the present UDRP procedure was initiated against the Respondent.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

A. The domain name is confusingly similar to a trademark or service mark in which the Complainant has rights;
(Policy, Paragraph 4(a) (i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

Complainant owns and operates several hotels under the trademark IBIS, which is a registered and well-known trademark, protected worldwide particularly in relation to hotels and restaurants services.

Indeed, the domain name in dispute reproduces Complainant's well-known trademark IBIS in its entirety. The disputed domain name <ibisjakartaharmoni.com> is extremely similar to Complainant's Hotel name "Ibis Jakarta Harmoni" and the addition of these geographic terms to the IBIS trademark enhances the likelihood of confusion since it might lead internet users into wrongly believing that the said domain name is endorsed by Complainant and is related to its hotel.
The extension ".com" is not to be taken into consideration when examining the identity or similarity between the Complainant's trademarks and the disputed domain name.

Accordingly, the <ibisjakartaharmoni.com> domain name creates a likelihood of confusion with Complainant's IBIS trademarks. It is likely that this domain name could mislead Internet users into thinking that it is, in some way, associated with Complainant and thus may heighten the risk of confusion.

B. The Respondent has no rights or legitimate interests in respect of the domain name;
(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

Respondent is not affiliated with Complainant in any way nor has he been authorised by Complainant to use and register its trademarks, or to seek registration of any domain name incorporating the aforesaid trademarks.

The registration of the IBIS trademark preceded the registration of the disputed domain name by many years. The <ibisjakartaharmoni.com> domain name is so identical to the famous IBIS trademark of Complainant, and in particular to the hotel "Ibis Jakarta Harmoni", that Respondent cannot reasonably pretend it was intending to develop a legitimate activity through the disputed domain name.

Moreover, Respondent is neither known by the name of IBIS nor in any way affiliated with Complainant, nor authorised or licensed to use the trademark IBIS, or to seek registration of any domain name incorporating the aforementioned trademark. Besides, Respondent did not demonstrate use of, or demonstrable preparations to use, the domain name in connection with

a bona fide offering of goods or services. Indeed, the <ibisjakartaharmoni.com> domain name resolves to a pay-per-click parking page displaying commercial links related to services of hotel industry, including booking services, notably. Consequently, Respondent fails to show any intention of non-commercial or fair use of the disputed domain name.
Also, it seems that Respondent registered the disputed domain name with a privacy shield service to hide his identity and prevent Complainant from contacting him. Thus, such a behavior highlights the fact that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In addition, after the present Complaint was filed, the Registrar provided the identity and contact details of the Registrant for the <ibisjakartaharmoni.com> domain name. It appears that the contact details are manifestly false. This confirms the absence of any legitimate interest of the registrant in the disputed domain name.

For all of the above-cited reasons, it is undoubtedly established that Respondent has no rights or legitimate interests in respect to the domain name in dispute under Paragraph 4(a)(ii) of the Policy.

C. The domain name was registered and is being used in bad faith.
(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

1) Registration in bad faith

It is implausible that Respondent was unaware of Complainant when he registered the disputed domain name. Bad faith can be found where respondent “knew or should have known” of Complainant’s trademark rights and, nevertheless registered a domain name in which he had no right or legitimate interest.

Firstly, Complainant and its IBIS trademark are well-known throughout the world. Secondly, in many prior UDRP decisions the Panel considered that Complainant’s IBIS trademark is also widely-known. Thirdly, the composition of the disputed domain name is too similar to Complainant’s IBIS trademarks, its own domain names and the name of its hotel “Hotel Ibis Jakarta Harmoni”. Finally, the domain name in dispute redirects towards a page with commercial links related to services of hotel industry, including booking services, notably those of Complainant and its competitors.

Therefore, it is impossible that Respondent was not aware of Complainant’s trademarks and activities at the time of the registration of the disputed domain name.

Bad faith has already been found where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith. Thus, given the reputation of the IBIS trademark, registration in bad faith can be inferred.

Furthermore, Respondent registered the domain name through a privacy shield service to hide his identity and contact details, thus, preventing Complainant from contacting him. A deliberate concealment of identity and contact information may in itself indicate registration in bad faith.

Under Section 2 of the ICANN Policy, it is established that when someone registers a domain name, he represents and warrants to the registrar that, to his knowledge, the registration of the domain name will not infringe the rights of any third party. Which means that it was Registrant’s duty to verify that the registration of the disputed domain name would not infringe the rights of any third party before registering the said domain name.

Moreover, a quick trademark search for the word IBIS would have revealed to Respondent the existence of Complainant and its trademarks. Respondent’s failure to conduct such a search is a contributory factor to its bad faith. Supposing that Respondent was not aware of the possibility of searching trademarks online before registering a domain name, a simple search via Google or any other search engine using the keyword “IBIS” or “IBIS JAKARTA HARMONI” demonstrates that all first results relate to Complainant’s field of activities or news.

In this day and age of the Internet and advancement in information technology, the reputation of brands and trademarks

transcend national borders. Taking into account the worldwide reputation of Complainant and its trademarks, as well as the strong reputation of Complainant, it is hard to believe that Respondent was unaware of the existence of Complainant and its trademarks at the time of registration of the disputed domain name. Knowledge of Complainant's intellectual property rights, including trademarks, at the time of registration of a disputed domain name proves bad faith registration.

It would have been pertinent for Respondent to provide an explanation of its choice in the disputed domain name, failing which a Panel may draw the conclusion that the disputed domain name was registered in bad faith with intent to create an impression of an association with Complainant and its products. However, Respondent neither tried to defend his rights nor stated any valid arguments to justify the registration of the domain name in response to Complainant's cease-and-desist letter.

Finally, after filing the Complaint, the Registrar provided the identity and contact details of the registrant. It appears that the contact details of the registrant are manifestly false. This is an additional element that confirms the registration of the domain name in bad faith.

Consequently, in view of the above-mentioned circumstances, it is established that Respondent registered the disputed domain name in bad faith.

2) Use in bad faith

Some elements may be put forward to support the finding that Respondent also uses the domain name in bad faith.

In the absence of any license or permission from Complainant to use its widely known trademark, no actual or contemplated bona fide or legitimate use of the domain name could reasonably be claimed.

As the <ibisjakartaharmoni.com> domain name is confusingly similar to Complainant's trademarks, a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from Complainant's site to Respondent's site.

Furthermore, directing Internet users to a webpage displaying commercial links related to Complainant's field of activities is an additional proof of bad faith.

Besides, the use of a domain name to point to a website that offers sponsored links to other websites providing services or goods which are similar to those offered by a complainant's own website is evidence of bad faith.

The clear inference to be drawn from the Respondent's operations is that he is trying to benefit from the fame of the Complainant's trademarks.

It is more likely than not, that Respondent's primary motive in registering and using the <ibisjakartaharmoni.com> domain name was to capitalize on or otherwise take advantage of Complainant's trademark rights, through the creation of initial interest of confusion.

Finally, it can be deduced that Respondent registered the <ibisjakartaharmoni.com> domain name to prevent Complainant from using its trademark in the disputed domain name. This type of conduct also constitutes evidence of Respondent's bad faith.

All aforementioned circumstances confirm that the disputed domain name is used in bad faith.

Consequently, it is established that the Respondent both registered and used the disputed domain name in bad faith in accordance with Paragraph 4(a)(iii) of the Policy.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

According to paragraph 15(a) of the Rules, the Panel is to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following three elements by a "preponderance of the evidence" (WIPO Overview 3.0, par. 4.2) in order to obtain an order that the disputed domain name be transferred:

(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.

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

IDENTICAL OR CONFUSINGLY SIMILAR:

Paragraph 4(a)(i) of the Policy is only a standing requirement which is satisfied if the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. Furthermore, it is not as extensive as the “likelihood of confusion” test for trademark infringement applied by many courts. Rather, under the Policy confusing similarity is commonly tested by comparing the complainant’s trademark and the disputed domain name in appearance, sound, meaning, and overall impression. See, e.g., Administradora de Marcas RD, S. de R.L. de C.V. v. DNS Manager / Profile Group, Case No. 101341 (CAC, November 28, 2016).

Here, Complainant has submitted evidence of its rights to the IBIS trademark, in relation to hotel and restaurant services, in the form of database screenshots from various trademark offices indicating that the mark is registered. Although it is the preferred practice in UDRP complaints to submit scans of actual trademark registration certificates, Respondent has not contested Complainant’s submissions and the Panel accepts Complainant’s claim that it owns rights to the IBIS trademark.

The next step of the inquiry under paragraph 4(a)(i) of the Policy is to compare the IBIS trademark to the <ibisjakartaharmoni.com> domain name. The Panel notes that the second level of the disputed domain name incorporates the Complainant's trademark in its entirety and merely adds the geographically descriptive terms “Jakarta” and “Harmoni” as well as the .com TLD. Ignoring the TLD, this Panel finds that the second level of the domain name is confusingly similar to the Complainant’s trademark. The fact that Complainant operates a hotel property called “Ibis Jakarta Harmoni” further supports this conclusion.

As for the .com portion of the domain, a multitude of UDRP decisions have held that merely adding a TLD to a complainant's trademark is not sufficient to distinguish the domain name from such trademark. See, e.g., ARCELORMITTAL S.A. v. Anton M Bahtin, Case. No. 100831 (CAC, August 21, 2014). This is because legacy TLDs such as .com, .net, .org, etc. most often add little further meaning to second level domains and merely act as the addressing devices they were designed to be.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the IBIS trademark and that Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS:

Pursuant to paragraph 4(a)(ii) of the Policy, a complainant has the burden of making a prima facie showing that the respondent has no rights or legitimate interests in the disputed domain name. Cephalon, Inc. v. RiskIQ, Inc., Case No. 100834 (CAC, September 12, 2014). Once this burden is met, it shifts to the respondent to demonstrate that it has rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy offers respondents several examples of how to demonstrate their rights or legitimate interests to a disputed domain name. The first, under paragraph 4(c)(i), involves an inquiry into whether the respondent is using the domain in connection with a bona fide offering of goods or services.

Based on the evidence provided by Complainant, the disputed domain name is used without Complainant's permission and resolves to a pay-per-click parking website with links to a variety of other websites. Some of these sites refer to the Complainant and others refer to, or are operated by third-parties to this dispute. Complainant claims that some of these third parties are its competitors in the hotel industry and Respondent does not contest this. The use of a pay-per-click page in this manner is not a bona fide offering of goods or services but, rather, is an improper leveraging of Complainant's trademark rights for the commercial gain of the Respondent or the third parties referenced at this page.

With respect to paragraph 4(c)(ii) of the Policy, the Respondent does not appear to be commonly known by the name "Ibis" or by a similar name. The Whois record for the <ibisjakartaharmoni.com> domain lists Respondent as "Domain Admin / Whois protection, this company does not own this domain name s.r.o." although, subsequent to the filing of the Complaint, the concerned Registrar has revealed Respondent's identity to be one "Hulmiho Ukolen". As Respondent has submitted no Response to the Complaint, it makes no claim that it is known otherwise.

Finally, paragraph 4(c)(iii) of the Policy looks at whether a respondent is "making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers." The pay-per-click website to which the <ibisjakartaharmoni.com> domain name resolves does not fit into any accepted category of "fair use" such as news reporting, comment, criticism, or the like. In any event, its use is not noncommercial or without intent for commercial gain.

For these reasons, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy and Respondent has not demonstrated that it has rights or legitimate interests in the disputed domain name.

REGISTERED AND USED IN BAD FAITH:

Complainant must demonstrate both that the disputed domain name was registered and is being used in bad faith. Further guidance on that requirement is found in paragraph 4(b) of the Policy, which sets out four examples of actions by a respondent that may satisfy this burden of proof. However, the examples of paragraph 4(b) are not exhaustive and panels are free to look beyond them for evidence of bad faith. LA POSTE v. RIVERA BERNARD, Case No. 101139 (CAC, February 10, 2016).

A threshold question here is whether, at the time it registered the disputed domain name, Respondent was aware of Complainant's IBIS trademark. Complainant has submitted uncontested evidence of the widespread notoriety of its mark and the fact that the disputed domain name actually copies the name of one of Complainant's hotel properties confirms that Respondent had actual knowledge of Complainant's trademark prior to its registration of the disputed domain name. This

Panel thus concludes that the Respondent intentionally sought to copy Complainant's trademark when it registered the disputed domain name.

Next, attention is given to Complainant's claim that the Respondent used the <ibisjakartaharmoni.com> domain in bad faith. It is well-established that resolving a domain that incorporates a complainant's trademark to a pay-per-click website featuring links to websites of the complainant or its competitors constitutes solid evidence of bad faith use with intent for commercial gain under paragraph 4(b)(iv) of the Policy. See, e.g., Enterprise Rent-a-Car Company v. Blupea c/o Janepanas, Sirinarin, Case No. 100053 (CAC, May 25, 2009); AllianceBernstein LP v. Texas International Property Associates - NA NA, Case No. D2008-1230 (WIPO October 12, 2008); Brownells, Inc. v. Texas International Property Associates, Case No. D2007-1211 (WIPO, December 12, 2007). Further, regardless of whether Respondent, its registrar, or its hosting provider selects the links that appear on its website, as the owner of the disputed domain name, Respondent is entirely and solely responsible for the content of its website, including all resulting third-party sites and advertisements which result therefrom. See, eLeader Sp. z o.o. v. Hyunjong Lee, Case No. 100364 (CAC, May 4, 2012) ("Panels have generally found that a domain name registrant is normally deemed responsible for the content appearing on its website, even if it is not exercising direct control over such content"); Disney Enterprises, Inc. v. ll, Claim No. FA 1336979 (FORUM, August 31, 2010) (Respondent acted in bad faith, despite its claimed lack of control over the content on its parked, pay-per-click website.) As in these cases, Respondent has the final say over what content appears at the <ibisjakartaharmoni.com> website and cannot avoid responsibility therefor simply because it voluntarily allowed a third-party to select pay-per-click links on its behalf.

Finally, other evidence of Respondent's bad faith may be found in its attempt to frustrate Complainant's assertion of its trademark rights. A Whois privacy shield was used and, despite Complainant's repeated attempts to contact the Respondent and resolve this dispute, such communications were either ineffective (due to the use of a privacy shield) or simply ignored by the Respondent. It should also be noted that when the concerned Registrar removed Whois privacy protection from the disputed domain name, it was revealed that Respondent lists its address as being in the city of Helsinki, Finland but it lists its postal code as "12345" and its phone number as "+1.234567890". This information is quite obviously false and the use of false Whois information is further evidence that the Respondent has acted in bad faith. ArcelorMittal (Société Anonyme) v. ANA LEONI KACHAK GONCALVES, Case No. 101550 (CAC, May 24, 2017).

Accordingly, the Panel finds that the disputed domain name was registered and used in bad faith and that Complainant has satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **IBISJAKARTAHARMONI.COM**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2017-09-04

Publish the Decision