Decision for dispute CAC-UDRP-101643

Case number	CAC-UDRP-101643
Time of filing	2017-08-23 09:16:49
Domain names	sofitelsolahabana.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Accor
Organization	SoLuxury HMC

Complainant representative

Organization	DREYFUS ET ASSOCIES

Respondent

Name	SOFITELSOLAHABANA.COM FOR..SALE..

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the Domain Name.

IDENTIFICATION OF RIGHTS

Second Complainant is the holder of trademark registrations consisting of or including the sign SOFITEL in multiple countries, including International trademark "SOFITEL" No. 863332, registered on August 26, 2005, duly renewed, and covering services in classes 35, 39 and 43 and US trademark "SOFITEL" No. 0995968, registered on October 15, 1974, duly renewed and covering services in class 42 (hereinafter, the “SOFITEL trademarks”).

FACTUAL BACKGROUND

Complainants are part of the Accor group of companies, a major player in hospitality services.

In 1964, Sofitel Hotels & Resorts were created as the first French international hospitality brand. Second Complainant, SOLUXURY HMC, is the holder of a number of trademarks including the sign SOFITEL, which is known in the field of hospitality services.

The Domain Name <sofitelsolahabana.com> was registered on February 20, 2017 by Respondent. The Domain Name resolves to a website offering online games.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainants consider the Domain Name to be confusingly similar to trademarks in which the Complainants have rights. The Complainants claim that the Respondent has no rights or legitimate interests in respect of the Domain Name. According to the Complainants, the Respondent does not use the Domain Name in connection with any legitimate use. Also, according to the Complainants, the Respondent has not been commonly known by the Domain Name. Finally, the Complainant considers that the Domain Name was registered and used in bad faith.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainants have, to the satisfaction of the Panel, shown that the Domain Name is confusingly similar to a trademark or service mark in which the Complainants have rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy)

BAD FAITH

The Complainants have, to the satisfaction of the Panel, shown the 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

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainants to make out their case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainants must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus for the Complainants to succeed they must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
2. The Respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain names has been registered and used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

Confusing similarity of the Domain Name with existing rights

The Complainants must first establish that there is a trademark or service mark in which they have rights. Since the second Complainant is the holder of the SOFITEL trademarks, which are used in connection with its business, it is established that there is a trademark in which Complainants have rights.

The Domain Name <sofitelsolahabana.com> incorporates the Complainants' SOFITEL trademarks in their entirety and add the terms "so" and "la habana" (Spanish name for La Havana, capital of Cuba). The Panel observes that the domain name in dispute refers to the Complainants' future hotel in construction at La Havana, named "SOFITEL SO LA HABANA". The Panel is of the opinion that the mere addition of non-distinctive text to a complainant's trademark constitutes confusing similarity, as set out in paragraph 4(a)(i) of the Policy (See Karen Millen Fashions Limited v. Akili Heidi, WIPO Case No. D2012-1395, where the domain name <karenmillenoutlet-australia.com> was held to be confusingly similar to the KAREN MILLEN trademark; Belstaff S.R.L. v. Jason Lau, Sharing, WIPO Case No. D2012-0783, where the domain name <belstaffjacken-outlet.info> was held to be confusingly similar to the BELSTAFF trademark; Lime Wire LLC v. David Da Silva/Contactprivacy.com, WIPO Case No. D2007-1168, where the domain name <downloadlimewirenow.com> was held to be confusingly similar to the LIME WIRE trademark, especially with addition of the word "download" because users typically download complainant's software.)

Accordingly, the Complainants have made out the first of the three elements that they must establish.

No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainants have the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Domain Name.

It is established case law that it is sufficient for the Complainants to make a prima facie showing that Respondent has no right or legitimate interest in the Domain Name in order to shift the burden of proof to the Respondent. (See: Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094 (championinnovation.com); Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455 (croatiaairlines.com); Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110 (belupo.com).)

The Panel notes that the Respondent has not been commonly known by the Domain Name and that the Respondent has not acquired trademark or service mark rights. Respondent's use and registration of the Domain Name was not authorized by the Complainants. There are no indications that a connection between Complainants and Respondent existed.

Based on the available record, the Panel finds that the Complainants have established a prima facie case, which was not refuted, and that the Respondent lacks rights or legitimate interests in the Domain Name. Therefore, the Complainants have satisfied the second requirement that the Respondent has no rights or legitimate interests in the Domain Name, under paragraph 4(a)(ii) of the Policy.

Bad faith

Complainants must prove on the balance of probabilities that the Domain Name was registered in bad faith and that it is being used in bad faith (See e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006 1052).

Policy Paragraph 4(b) provides a non-exclusive list of factors, any one of which may demonstrate bad faith registration and use, namely:

(i) circumstances indicating that the domain name is registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name (Policy Paragraph 4(b)(i));
(ii) the registration of a 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 Respondent has engaged in a pattern of such conduct (Policy Paragraph 4(b)(ii));
(iii) the registration of a domain name primarily for the purpose of disrupting the business of a competitor (Policy Paragraph 4(b)(iii)); and
(iv) the use of a domain name for intentionally attempting to attract, for commercial gain, Internet users to a web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location (Policy Paragraph 4(b)(iv)).

According to the Panel, the Respondent's awareness of the Complainant and/or the Complainant's trademark rights at the time of registration can evidence bad faith (See Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, supra; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, supra, where POKÉMON was held to be a well-known mark of which the use by someone without any connection or legal relationship with the complainant suggested opportunistic bad faith; BellSouth Intellectual Property Corporation v. Serena, Axel, WIPO Case No. D2006-0007, where it was held that the respondent acted in bad faith when registering the Domain Name, because widespread and long-standing advertising and marketing of goods and services under the trademarks in question, the inclusion of the entire trademark in the domain name, and the similarity of products implied by addition of telecommunications services suffix ("voip") suggested knowledge of the complainant's rights in the trademarks).

In the instant case, the Domain Name incorporates the name of a future hotel of the Complainants in its entirety Therefore, the Panel finds that the Respondent was undoubtedly aware of the Complainant's trademarks when registering the Domain Name. Moreover, the Domain Name is offered for sale, which serves as an indication that the Domain Name was registered primarily with the intention to sell the Domain Name in excess of the out-of-pocket expenses related to the Domain Name. In addition, the Panel is of the opinion that Complainants' trademark is sufficiently distinctive and well-known, which makes it difficult to conceive any plausible legitimate future use of the Domain Name by Respondent.

Considering the above, the Panel finds that the Complainants have made out the three elements that they must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SOFITELSOLAHABANA.COM**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2017-10-05

Publish the Decision