

Nominet UK Dispute Resolution Service

DRS 05274

ACCOR V DIGITAL ASSETS INC.

Decision of Independent Expert

1. Parties:

Complainant: ACCOR S.A.
Address: 2, rue de la Mare Neuve
EVRY CEDEX
Postcode: 91021
Country: France

Respondent: Digital Assets Inc
Address: Unit 2982C
34 Eglinton Avenue West
Toronto
Ontario
Postcode: M4R 2H6
Country: Canada

2. Domain Name:

ibishotdeals.co.uk (“the Domain Name”)

3. Procedural Background:

The complaint was entered into Nominet’s system on 23rd November 2007. Nominet validated the complaint and informed the Respondent by letter dated 4th December 2007, noting that the Dispute Resolution Service had been invoked and that the Respondent had until 28th December 2007 to submit a Response. No Response was received.

On 31st December 2007 the Complainant was invited to pay the fee to obtain an Expert Decision pursuant to paragraph 7 of the Nominet UK Dispute Resolution Service Policy Version 2 (“the Policy”). The fee was duly paid on 15th January 2008.

On 15th January 2008 Nominet invited me to provide a decision in this case and, following confirmation to Nominet that I knew of no reason why I could not properly accept the invitation to act in this case, Nominet duly appointed me as Expert with effect from 22nd January 2008.

4. Outstanding Formal/Procedural Issues (if any):

None.

5. The Facts:

The Complainant is a French Société Anonyme and leading European provider of travel, tourism and corporate services. It operates in the region of 4,000 hotels in ninety countries worldwide. It trades *inter alia* under the trading name IBIS. Under the IBIS brand it operates 750 hotels worldwide, of which 49 are in the UK. The Complainant uses more than one domain name but of particular note is the fact that since 30 March 2006 it has owned the domain name ibishotdeals.com, through which it advertises and promotes IBIS hotels in the United Kingdom.

The Complainant owns a number of trade mark registrations for IBIS or derivative terms in various different countries. By way of two examples, in the United Kingdom it owns registration number 1277519 ('IBIS') filed on 1 October 1986 in classes 43 and 44 and it also owns Community Trademark registration number 1527720 ('IBIS') filed on 2 February 2000 in classes 16, 39 and 42.

The Nominet WHOIS search with which I have been provided shows that the Domain Name, ibithotdeals.co.uk, was registered on behalf of the Respondent on 30 April 2007. The screenshot of the website accessible under the URL <http://www.ibishotdeals.co.uk> with which I have been provided is headed 'ibishotdeals.co.uk' and presents a number of hotel-themed sponsored links, which include links to rival hotel chains competing with the Complainant but do not include links to the Complainant's site(s).

6. The Complainant's Contentions:

Complainant:

The Complainant requests that the Domain Name be transferred to it on the basis of the following submissions:

"1.- Complaint's background.

A.- The Parties.

The Complainant is ACCOR, a world renowned company, which have its registered office in Evry, France. ACCOR is the European leader and one of the world's largest groups in travel, tourism and corporate services. The Complainant owns about 4,000 hotels in 90 countries worldwide. More particularly, ACCOR operates several hotels especially in the Western Europe. ACCOR has long positioned itself in many countries around the world as a provider of innovative services to meet growing demand for solutions that enable companies and public institutions to improve productivity, while responding to the legitimate aspirations of their employees and for a better quality of life. GROUPE ACCOR holds among others trademarks Sofitel, Ibis, Motel 6 and Novotel.

Complainant owns and mainly communicates on the Internet via the website *www.accorhotels.com* in order to allow the Internet users a quick and easy finding and booking of its hotels (Annex 1). IBIS is present around the world, with more than 750 hotels including 49 hotels in the United Kingdom (Annex 2). The Complainant owns and mainly communicates on the Internet via websites, and among others *www.ibishotel.com* in order to allow the Internet users a quick and easy finding and booking of its hotels (Annex 3).

According to the Whois, the Respondent is Digital Assets Inc., a company domiciled in Canada (Annex 4).

B.- Factual background.

The Complainant noticed that the domain name <*ibishotdeals.co.uk*> was registered. A WHOIS Database search revealed that the domain names were registered by the Respondent (see Annex 4). Furthermore, this domain name direct Internet users to web pages proposing commercial links for goods and services in the field of hotel business (Annex 5).

Before submitting the present Complaint, the Complainant has sent a cease-and-desist letter on August 16, 2006, **[Expert's note – the letter is actually dated 16.8.2007]** via registered letter to the Respondent and via e-mail and fax to the registrar, by which it asked the Respondent to proceed to the amicable transfer of said domain name (Annex 6). Until today, the Respondent did not answer Complainant's cease-and-desist letter. As no amicable settlement is likely to be found, this situation forces Complainants to start the present procedure in order to obtain the transfer of the domain name. However, before acting, the Complainants took care of mandating a bailiff to draw an affidavit of the whole situation (Annex 7). **[Expert's note – this Annex is entirely in French and has not been relied upon]**

The complaint is built on the following grounds.

II.- Complainant's contentions. According to Paragraph 2 of the Policy, the Complainant has to prove to the Expert on the balance of probabilities, that it has rights in respect of a name or mark identical or similar to the domain name and that the domain name in the hands of the Respondent is an abusive registration.

(i) Rights in a name or mark.

The Complainant is the owner of numerous trademark registrations throughout the world covering the name "IBIS" (Annex 8): - United Kingdom Trademark IBIS, n° 1277519 filed on October 1st, 1986 renewed and covering products and services in classes 43 and 44. - Community Trademark IBIS n° 001527720 filed on February 2, 2000 and covering products and services in classes 16, 39 and 42. - French Trademark IBIS ACCOR HOTELS + logo, n° 3258174 filed on November 20, 2003 and covering products and services in classes 39 and 43. - International Trademark IBIS + logo, n° 420862 filed on February 18, 1976 renewed and covering products and services in classes 8, 20, 21, 29, 36, 37, 39 and 42. - International Trademark HOTEL IBIS n° 431254 filed on June 17, 1977 renewed and covering products and services in classes 16, 20, 21, 39 and 42. - International Trademark IBIS n° 541432 filed on July 17, 1989 renewed and covering products and services in classes 38, 39 and 42. - International Trademark IBIS + logo, n° 623070 filed on August 22, 1994 renewed and covering products and services in classes 16, 41 and 42 - International Trademark IBIS ACCOR HOTELS + logo, n° 829736 filed on May 13, 2004 and covering products and services in class 43, protected especially in Australia. The Complainant operates many domain names reflecting its

trademark among which: - www.ibishotel.com registered on August 19, 1997 (Annex 3) - www.ibishotels.com registered on May 3, 2001 (Annex 9).

Furthermore, the Complainant already owns and operates actively the domain name ibishotdeals.com through which it deals with IBIS hotels in the United Kingdom (Annex 10). This domain name has been registered on March 30, 2006, so more than one year before the ibishotdeals.co.uk domain name.

As evidenced by the Trademark registrations attached as Annex 8, the trademark "IBIS" has been protected since 2000 in the European Union. This wide registration of the name "IBIS" shows the Respondent could not ignore the trademark owned by the Complainant.

Besides, it is well established that the adjunction of the terms "hotdeals", which is the mere summary between the two generic terms "hotel" and "deals", is insufficient to give any distinctiveness to the domain name in dispute. "hotdeals" or "hotel deals" are two generic terms that can't be considered as protected terms.

It is also well established that when considering the similarity between the trademarks and the domain name in question, the ".co.uk" suffix should not be taken into account, merely because it simply denotes the country code and is descriptive.

As a result, complying with Paragraph 2(a)(i) of the Policy, it is clearly and undoubtedly established the Complainant has rights in respect of a name or mark which is similar to the domain name.

(ii) Abusive registration.

According to paragraph 2(a)(ii) of the Policy, the Complainant has to show that the domain name, in the hands of the Respondent, is an abusive registration. All of the following grounds establish that the domain name in dispute has been registered and is being used in bad faith.

The Respondent is not affiliated with the Complainant in any way, which has not authorized the Respondent to use and register its trademarks, or to seek the registration of any domain name incorporating said marks. Similarly, the Respondent is not known under the name "Ibis" or any similar term.

The Respondent is not making any legitimate non-commercial or fair use of the domain name as the domain name directs to page proposing commercial link in the field of hotel business. It's well established that Respondent took unfair advantage of the Complainant's rights by making profits throughout the sponsored links.

In fact, since the domain name in dispute is similar to the trademarks of the Complainant and regarding the use of this domain name, the Respondent could not reasonably pretend to develop a legitimate activity. As the Respondent shows no legitimate rights to use the denomination "IBIS", the registration has been made under bad faith.

The trademark IBIS is registered in the European Community since February 18, 2000 (Annex 8), several years earlier than the registration of the domain name in dispute.

Furthermore, the Respondent didn't reply to the Complainant's cease-and-desist letter which an additional sign of bad faith.

It is well established that the domain name in dispute has been registered and used under bad faith.

For all the above reasons, in accordance with Paragraphs 2(a)(ii) of the Policy, it is well established that the disputed domain name, in the hands of the Respondent, is an abusive registration.”

Respondent:

The Respondent did not file a Response.

7. Discussion and Findings:

Requirements which must be satisfied in order for the Complaint to succeed

Paragraph 2 of the Policy requires that, in order for the Complaint to succeed, the Complainant must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

These matters must be affirmatively proven by the Complainant, notwithstanding the failure by the Respondent to file a Response. The effect of the Respondent's default, under paragraph 15(c) of the Procedure, (there being no exceptional circumstances in this case) is that I may draw such inferences from the Respondent's non-compliance as I consider appropriate.

Complainant's Rights

I must first decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

The definition of 'Rights' in the Policy *"includes, but is not limited to, rights enforceable under English law."* At the very least this encompasses UK trade mark registrations and unregistered rights in the nature of the goodwill necessary to found a passing off action in England and Wales.

In the present case the Complainant has amply demonstrated its ownership of Rights in the mark IBIS. It owns UK and Community trade mark registrations for the word-only mark IBIS pre-dating the registration of the Domain Name. Moreover from the evidence and submissions before me, it appears that the Complainant has conducted substantial business and has built up significant goodwill in the UK under and by reference to the name IBIS.

I am further persuaded that the Complainant owns (and owned at the date of registration of the Domain Name) 'Rights' to a degree in the composite phrase 'IBIS HOT DEALS'. This is because IBITHOTDEALS.COM was registered by the Complainant on 30 March 2006 and has been used in the course of trade by the Complainant to promote its hotels. I appreciate that, as the Complainant contends, the words 'HOT DEALS' may not add very much to the distinctiveness of the mark 'IBIS', but I have nevertheless taken this factor into account.

I further satisfied that the names IBIS and IBIS HOT DEALS are respectively similar to and identical to the Domain Name (ignoring, as I am required to do, the first and second level suffixes).

Abusive Registration

Paragraph 1 of the Policy defines “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. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.

The thrust of the Complaint is that:

- The Respondent is not affiliated with the Complainant and cannot credibly claim any independent goodwill in the term IBIS.
- The Respondent is taking unfair advantage of the Complainant’s Rights by earning money via sponsored links.
- The Complainant’s trademark and domain name registrations pre-date the registration of the Domain Name, leading to the inference that it was registered to ‘cash in’ on the IBIS goodwill.
- The Respondent’s lack of response to the complaint and the preceding cease-and-desist letter support the inference of bad faith.

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration are set out in Paragraph 3(a) of the Policy. A non-exhaustive list of countervailing factors are set out in Paragraph 4(a) of the Policy.

The Complaint does not explicitly invoke any of these paragraphs, but it seems to me that paragraphs 3(a)(i)(C) and 3(a)(ii) of the Policy are of principal relevance:

Under paragraph 3(a)(i)(C), it is indicative of Abusive Registration if the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant.

Under paragraph 3(a)(ii), it is indicative of Abusive Registration if the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

An Ibis is a long-legged wading bird with no obvious connection to the hotel industry. At the date of registration of the domain name, the Complainant had amassed substantial registered and unregistered rights in the UK in the field of hotel and travel services under and by reference to the word IBIS. The Complainant was using the domain name IBISHOTDEALS.com. The general public expected hotels promoted under the IBIS name to originate from the Complainant’s IBIS chain.

It seems to me that the situation was not unlike that pertaining in BT v One In A Million [1998] F.S.R. 265, where the Deputy Judge made the following observations:

“There is only one possible reason why any one who was not part of the Marks & Spencer Plc group should wish to use such a domain address, and that is to pass himself off as part of that group or his products off as theirs. Where the value of a name consists solely in its resemblance to the name or trade mark of another enterprise, the Court will normally assume that the public is likely to be deceived, for why else would the Defendants choose it? In the present case, the assumption is plainly justified. As a matter of common sense, these names were registered and are available for sale for eventual use. Some one seeking or coming upon a website called <http://marksandspencer.co.uk> would naturally assume that it was that of the Plaintiffs.”

I place any great reliance on the fact that the Respondent did not respond to the Complainant's cease and desist letter. However I am entitled to draw inferences from the Respondent's failure to submit a Response under paragraph 15(c) of the Procedure. In the absence of any innocent explanation to the contrary by the Respondent (none of which has been forthcoming), I am satisfied in the circumstances on the balance of probabilities that the Respondent did indeed register the Domain Name to 'cash in' on the Complainant's goodwill, in the hope of earning revenues from sponsored links. I rather suspect that it has earned such revenues.

Had the Respondent been using the Domain Name exclusively to resell the Complainant's hotel rooms (perhaps at a discount or part of a package) then the question of the 'fairness' of the advantage gained would be more finely balanced. But as matters stand the website at www.ibishotdeals.co.uk is earning money from the activity of directing the Complainant's potential customers to Complainant's competitors through the use of the Complainant's trade mark. I conclude that the potential for deception, confusion and disruption caused by this activity constitutes unfair advantage.

- Conclusion

The considerations set out in paragraphs 3 and 4 of the Policy are illustrative and non-exhaustive. The question for my ultimate consideration is whether, on the evidence as a whole, the Complainant has discharged the burden of proving that the Domain Name (i) was registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights or (ii) has been used in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant's Rights.

For the reasons I have given, my overall assessment on the balance of probabilities is that the Complainant has discharged its burden. I find that the Respondent registered the Domain Name in a manner which took unfair advantage of the Complainant's Rights and that the Domain Name has been used in a manner which takes unfair advantage of the Complainant's Rights.

Accordingly I conclude that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

8. Decision:

Having concluded that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert determines that the Domain Name, ibishotdeals.co.uk, should be transferred to the Complainant.

Philip Roberts

February 4th, 2008
Date