

## DISPUTE RESOLUTION SERVICE

D00013171

### Decision of Independent Expert

ACCOR

and

Zhu Xumei

#### 1. The Parties:

Complainant: ACCOR  
110 Avenue de France  
Paris  
75013  
France

Respondent: Zhu Xumei  
Wuxing  
Huzhou  
Zhejiang  
313000  
China

#### 2. The Domain Name:

mgallery.co.uk

#### 3. Procedural History:

- 3.1 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 they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

### 3.2 Timeline:

06 August 2013 14:48 Dispute received  
06 August 2013 15:53 Complaint validated  
06 August 2013 15:54 Notification of Complaint sent to parties  
26 August 2013 02:30 Response reminder sent  
29 August 2013 08:54 No Response received  
03 September 2013 10:24 Notification of no Response sent to parties  
03 September 2013 13:16 Expert decision payment received

## 4. Factual Background

4.1 The Complainant is the owner of the following trade mark registrations, both of which are protected in the Respondent's home country of China and predate registration of the Domain Name:

4.1.1 International trade mark M GALLERY (stylised) no. 942082 protected in numerous countries including China and designating the European Community, dated 11 October 2007 and covering services in Class 43; and

4.1.2 International trade mark MGALLERY MEMORABLE HOTELS BY ACCOR (stylised) no. 1089193, protected in numerous countries including China, dated 25 July 2011 and covering services in Class 43.

4.2 The dominant elements of both of these trade marks are the letter "M" and the word "GALLERY".

4.3 The Domain Name was registered on 3 November 2012 and at the date of the Complaint it resolved to a parking website containing sponsored links (some of which referred specifically to hotels) and a notice stating that the Domain Name was listed for sale for \$1000.

4.4 Prior to submitting its Complaint, the Complainant sent a cease and desist letter dated 8 January 2013 to the Respondent, referring to its trade mark rights in the mark MGALLERY and requesting the Respondent to transfer the Domain Name to it. After a second reminder, the Respondent replied to the Complainant on 11 March 2013 stating that it would be prepared to sell the Domain Name for US\$1000. On 30 April 2013 the Complainant responded, explaining that it would not pay for the Domain Name as registration of it by the Respondent was in breach of the ICANN rules, and offered instead to reimburse the registration fees for the Domain Name. The Respondent repeated its offer to sell the Domain Name on 1 May 2013.

## 5. Parties' Contentions

5.1 The parties' contentions are summarised as follows:

## The Complainant

### Rights

- 5.2 The Complainant is a leading hotel operator, with a presence in 92 countries. It has more than 3,500 hotels and 450,000 rooms under various hotel brands including Sofitel, Pullman, MGallery, Grand Mercure, Novotel, Suite Novotel, Mercure, Adagio, ibis, ibis Styles, ibis Budget, Hotel Formule 1, hotelF1 and Thalassa sea & spa. It has operated in the hotel industry for more than 45 years.
- 5.3 The Complainant operates 58 MGallery hotels around the world, including 31 in Europe, 11 in Asia and more specifically 1 in China. These hotels are unique and well-known throughout the world. Each MGallery hotel is inspired by one of 3 themes, namely heritage (reflecting the historic nature of the building), signature (inspired by the vision of the hotel's architects) or serenity (reflecting the hotel's environment which may include the seaside, countryside, mountains or urban retreat).
- 5.4 The Complainant owns various trade mark registrations in a number of countries protecting the mark MGALLERY, which cover services in Class 43. Details of two of these trade mark registrations are set out in Section 4 above.
- 5.5 The Complainant owns many domain names reflecting its MGALLERY trade mark, including:
- <mgallery.com> registered on 27 May 2002;
  - <mgallery.fr> registered on 7 May 2008;
  - <mgalleryhotels.com> registered on 23 November 2007.
- 5.6 The Domain Name includes the Complainant's MGALLERY trade mark in its entirety, with no modifications.

### Abusive Registration

- 5.7 The Respondent is neither known under the name "MGallery" nor any similar term. It has no prior rights or legitimate interest in the Domain Name.
- 5.8 The Respondent is not affiliated with the Complainant and it has not been authorised by the Complainant to use its trade mark or register a domain name incorporating its trade mark.
- 5.9 In the absence of any licence or permission from the Complainant to incorporate the Complainant's trade mark into the Domain Name, the Respondent cannot reasonably claim that it is making any legitimate use of the Domain Name.
- 5.10 Considering the reputation and long history of the Complainant and its well established rights in the mark MGALLERY it is implausible that the

Respondent was unaware of the Complainant (and indeed impossible that the Respondent did not have this trade mark and company name in mind) when it registered the Domain Name.

- 5.11 Additionally, the word “mgallery” has no meaning in any language and it seems impossible that somebody would invent this word which is identical to a well-known trade mark. A search on Google for “MGallery” demonstrates that all of the first page results relate to the Complainant’s services or news related to the Complainant.
- 5.12 The fact that the Domain Name incorporates the Complainant’s MGALLERY trade mark in its entirety clearly proves that the Respondent was aware of the existence of the Complainant and its MGALLERY trade mark at the time of registration of the Domain Name, and acted in bad faith in registering it.
- 5.13 By registering the Domain Name the Respondent is seeking to profit from the reputation of the Complainant, to use the Domain Name as a blocking registration or to take advantage of the Complainant’s goodwill.
- 5.14 The Respondent is not making any legitimate non-commercial or fair use of the Domain Name. It currently resolves to a parking website with sponsored links and accordingly the Respondent is using it to earn revenue on a pay-per-click basis. In any event, the mere existence of the Domain Name will inevitably result in the diversion of Internet traffic from the Complainant’s website to the Respondent’s website.
- 5.15 Further, the Respondent has offered to sell the Domain Name (by including a notice on the website to which the Domain Name resolves and directly to the Complainant in the correspondence between the parties) at a price exceeding the original costs of registration.
- 5.16 In light of the above, the Respondent is taking unfair advantage of the trade mark rights of the Complainant and the Domain Name in the hands of the Respondent is an Abusive Registration.

#### The Respondent

- 5.17 The Respondent did not file a Response.

## **6. Discussions and Findings**

### General

- 6.1 The Complainant is required under paragraph 2b. of the Policy to prove to the Expert, on the balance of probabilities, that:
  - (i) the Complainant 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.

### Complainant's Rights

- 6.2 Paragraph 1 of the Policy provides that Rights means "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*". Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.
- 6.3 The Complainant is the owner of various trade mark registrations which include the letter and word elements "M" followed by "GALLERY", as well as some domain names which incorporate the mark MGALLERY. All of these registrations pre-date registration of the Domain Name. The Complainant has also provided evidence of use of the name MGallery in the course of its business. The Domain Name comprises the Complainant's trade mark in its entirety, excluding the generic top level <co.uk> suffix.
- 6.4 The Expert therefore finds that the Complainant has Rights in respect of the mark MGALLERY, which is identical to the Domain Name.

### Abusive Registration

- 6.5 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 has been unfairly detrimental to the Complainant's Rights.
- 6.6 Paragraph 3 of the Policy sets out a non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration and Paragraph 4 provides a non-exhaustive list of the factors which may evidence that the Domain Name is not an Abusive Registration.
- 6.7 The Policy provides for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.
- 6.8 In the absence of a Response, it is not possible to state with certainty what the motives of the Respondent were when it registered the Domain Name. However, the fact that the Domain Name comprises a word with no meaning, and such word corresponds directly with the Complainant's trade mark (a mark under which the Complainant has traded in numerous countries prior to registration of the Domain Name, including in the

Respondent's home country of China), together with evidence showing that the website to which the Domain Name resolves contains a notice that the Domain Name is for sale for \$1000 leads the Expert to conclude that the Respondent had the Complainant and its MGALLERY trade mark in mind when it registered the Domain Name and that the reason the Respondent registered the Domain Name was to take advantage of the Complainant's goodwill and reputation in this mark.

- 6.9 This conclusion is supported by the fact that the website to which the Domain Name resolves contains sponsored links to hotels (including one that advertises a third party hotel booking website). The Respondent will therefore be earning click through revenue through use of the Domain Name.
- 6.10 There is also a high probability, given the fact that the Domain Name matches the Complainant's MGALLERY mark with no other adornment, that Internet users searching for the Complainant and the hotels that it operates under the distinctive MGALLERY mark will land upon the Respondent's website that it operates under the Domain Name. Once there, the visitor will realise that the website has no connection with the Complainant, but by that point the visitor will already have been deceived.
- 6.11 As a result, the Expert finds that the Respondent has taken unfair advantage of the Complainant's Rights and that, on the balance of probabilities, the Domain Name, in the hands of the Respondent, is an Abusive Registration.

## **7. Decision**

- 7.1 The Expert finds that the Complainant has Rights in the mark MGALLERY which is identical to the Domain Name, and further that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name should be transferred to the Complainant.

**Signed Ravi Mohindra**

**Dated 22 September 2013**