

Nominet UK Dispute Resolution Service

DRS Number 03136

Decision of Independent Expert

1. Parties

Complainant: ACCOR S.A.
Address: 2, rue de la Mare Neuve
EVRY

Postcode: 91000
Country: FR

Respondent: www.novotel.co.uk
Respondent Name: Peter Love
Business Name: DotComBiz-AU
Address: 9 Wilton Road
Reedy Creek

Postcode: 4228
Country: AU

2. Domain Name

novotel.co.uk (the "Domain Name")

3. Procedural Background

The complaint of the Complainant was entered in the Nominet system on 16 November 2005. Nominet validated the complaint on 25 November 2005 and on the same day despatched a copy of the complaint to the Respondent. No response was received from Respondent by the due date of 19 December 2005. On 21 December Nominet wrote to both parties indicating that no response had been received. On 30 December 2005 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet UK Dispute Resolution Service Policy (the "Policy").

On 12 January 2006 Nominet invited Christopher Gibson to act as Expert in the case. The undersigned ("the Expert") confirmed to Nominet that I know of no reason why I cannot properly accept the invitation to act as Expert in this case and have further confirmed that I know of no matters which ought to be drawn to the attention of the parties, which might appear to call into question my independence and/or impartiality. The undersigned was appointed as Expert in this case on 16 January 2006.

4. Outstanding Formal/Procedural Issues (if any)

The Respondent has not submitted a Response to Nominet in compliance with paragraph 5a of the Procedure for the conduct of proceedings under the Dispute Resolution Service (the "Procedure"). Paragraph 15b of the Procedure provides, inter alia, that "*If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or the Procedure, the Expert will proceed to a Decision on the complaint.*"

There is no evidence before me to indicate the presence of exceptional circumstances. Nominet has attempted to communicate the complaint to the Respondent by email and post.

The efforts made by Nominet are in accordance with the Procedure and accordingly, I will now proceed to a Decision on the Complaint notwithstanding the absence of a Response.

Paragraph 15c of the Procedure provides that *"If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure . . . , the Expert will draw such inferences from the Party's non-compliance as he or she considers appropriate."* I am not aware of any exceptional circumstances in this case and so will draw inferences as appropriate.

5. The Facts

The Complainant is a well-known company active in travel, tourism and corporate services, owning approximately 4,000 hotels in 90 countries worldwide. The Complainant owns a number of trademarks including SOFITEL, IBIS, MOTEL 6 and NOVOTEL. Novotel is present in 61 countries around the world, with 412 hotels. The Complainant owns many hotels all over Australia, where the Respondent is located. The trademark NOVOTEL has been registered in a number of jurisdictions, including the United Kingdom and Australia (since 6 March 1992). The Complainant has submitted documentary evidence to show that the trademark "NOVOTEL" has been protected internationally since 1968. The Complainant uses the domain name novotel.com, which it registered in 1997, for most of its communications to enable users to find and book its hotels.

The Respondent is Peter Love of DotComBiz located at 9 Wilton Close, Reedy Creek, Queensland 6714 in Australia.

According to the Whois records, the Domain Name, novotel.co.uk, was registered to Respondent on 10 August 2005. At the time of the Complaint, the URL www.novotel.co.uk resolved to a blank page.

The Complainant sent a cease-and-desist letter by registered letter and email on August 22, 2005, in which it asked the Respondent to proceed with the amicable transfer of the Domain Name. By email dated August 24, 2005, Respondent responded that he was fully aware of the Novotel's trademark but had no intention of infringing Complainant's rights, indicating that *"the domain name novotel.co.uk was just recently registered and at no time, has it been 'used' by us"* and that *"[i]t appears your client either did not wish to pay the registration fee for the domain and wishes it to be handed over free of charge or your client simply does not want the name and that is why your client allowed the name to be available for the public to register."* The Respondent added: *"I take exception to the threatening and extortion like tactics adopted by your client and/or firm to force us to hand over a legally registered domain name."*

The Complainant responded that same day as follows:

"We thank you for your prompt reply.

Accor is one of the most important groups in the field of hotels and restaurant services. As such there are many people trying to take advantage of its notoriety to make easy money.

All the more, Accor manages at least a hundred domain name[s] relating to its trademarks. This company cannot register all domain names including its trademarks in order to prevent all infringement.

As said in your email, you are "fully aware of the Novotel trademark" and "have no intention of infringing" our client[s] right[s]. Thus, we should be most grateful if you could proceed with the transfer of said domain name according to the attached Whois data.

We remain at your disposal should you need any further assistance."

6. The Parties' Contentions

Complainant

The substance of the Complainant's contentions are as follows:

1. The Complainant has rights in respect of a name or mark which is identical to the Domain Name in dispute.
2. The world-wide reputation in the trademark NOVOTEL, as well as Respondent's open admission of his knowledge of the trademark, indicate that the Respondent was fully aware of this trademark. Complainant contends that the Respondent, with this knowledge, knew that it was infringing Complainant's trademarks when it recently registered the Domain Name.
3. The Respondent has no legitimate rights to use the NOVOTEL name, as evidenced by the fact that the Respondent is not known under the name "Novotel" or any similar term, Respondent owns no registered trademark corresponding to the word which comprises the Domain Name, and the Respondent does not have any connection with any identical or similar mark. Further, the Respondent is not affiliated with the Complainant in any way, nor has the Complainant authorized the Respondent to use and register its trademarks, or to seek the registration of any domain name incorporating its marks.
4. The Respondent is not making any legitimate non-commercial or fair use of the Domain Name. The Domain Name in dispute resolves to a blank page. An inactive page contributes to the dilution of the famous trademark NOVOTEL because "*it is an attempt to the seriousness of the Novotel's image.*" In fact, since the Domain Name in dispute is so identical to the famous trademark of the Complainant, the Respondent could not reasonably pretend to develop a legitimate activity. The absence of any use of the Domain Name indicates a bad faith registration.
5. The Domain Name is a blocking registration. It is identical to the Complainant's trademark and therefore is "likely to be the initial guess of an Internet user seeking the Complainant's website" (quoting Nominet UK DRS 00160, Foot Anstey Sargent v. Adrian Cameron).
6. The address which appears in the WHOIS appears to be false as the cease-and-desist letter originally sent by Complainant was returned to Complainant. Moreover, no email address was mentioned in the WHOIS. These facts could indicate the Respondent was trying to avoid any proceedings regarding the Domain Name.

Respondent

The Respondent has not responded.

7. Discussion and Findings:

General

In order to succeed in these proceedings, paragraph 2(b) of the DRS Policy requires the Complainant to prove on the balance of probabilities that both elements of the test set out in paragraph 2(a) are present:

- 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

Complainant's has established that it has extensive reputation and goodwill in its trademark NOVOTEL. The substantive part of the Domain Name contains identical letters to the Complainant's trademark. It is thus obvious that the Domain Name is identical or similar to a trademark in which the Complainant has Rights. The Complainant has established the first element of the test in paragraph 2(a) of the DRS Policy.

Abusive Registration

As to whether the Domain Name registration is abusive in the hands of the Respondent, paragraph 1 of the DRS 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 record in this case indicates that the Domain Name registered by the Respondent has not been used. The Respondent highlighted this point in his email response to the Complainant. Consistent with the decision in the Foot Anstey Sargent case cited above, which was brought to the Expert's attention by the Complainant, paragraph (ii) above does not apply because there has been no use of the Domain Name.

The Complainant therefore has to demonstrate that (i) above applies: that is, the Domain Name 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.

The DRS Policy, in paragraph 3(b) provides that *"Failure on the Respondent's part to use the Domain Name for the purposes of e-mail or a web-site is not in itself evidence that the Domain Name is an Abusive Registration."* Thus, non-use alone, at least if viewed in isolation, is not evidence of an abusive registration. However, the Complainant has alleged that NOVOTEL is a famous trademark; the Respondent has admitted that he was well-aware of this trademark; the Respondent has no legitimate rights to use the NOVOTEL name; the Respondent is not making any legitimate non-commercial or fair use of the Domain Name; and the registration should be viewed as a blocking registration against the Complainant's trademark (DRS Policy 3(a)(i)(B)).

The record in this case, including the Respondent's admission, indicates that he was aware of the Complainant's trademark NOVOTEL. The Expert thus finds that, on the balance of the probabilities, the Respondent was aware of the Complainant's trademark at the time of registration of the Domain Name and consciously chose to register that mark as a Domain Name.

Further, the Expert is instructed by the decisions in Foot Anstey Sargent (DRS 00160) and the Decision Of Appeal Panel in Thomas Cook UK Limited v Whitley Bay Uncovered (DRS 00583). In Foot Anstey Sargent the Respondent had not participated in the DRS proceedings or used the domain name that was in dispute. There, the Expert nonetheless determined that the domain name was an abusive "blocking" registration because the respondent had chosen a unique name which matched the complainant's name and the Expert could find no grounds that could support a legitimate use of the domain name. Indeed, the disputed domain name was *"likely to be the initial guess of an Internet user seeking the Complainant's website"* and the *"Respondent could at some time in the future use the Domain Name for purposes*

detrimental to the Complainant's business, or could sell it to a competitor or third party for purposes detrimental to the Complainant's business."

In Thomas Cook the Appeal Panel reasoned on relevant points as follows:

The onus is, of course, upon the Complainant to show on the balance of probabilities that the registration of the Domain Names is Abusive. However, it should not be forgotten that the Respondent has not filed a formal Response to these proceedings, nor accepted a further opportunity, in the context of the Appeal, to make submissions. If it had chosen to do so, it could have provided a fuller and more convincing explanation of its choice of the Domain Names. It has chosen not to do so.

This Panel considers that the only conceivable reason for the Respondent's conscious adoption in the circumstances of this case of a Domain Name which incorporates a well known trademark of another is to take advantage of the accrued goodwill in that name. There is no suggestion that the Respondent is authorised to use the name in any way. There is no suggestion that the Respondent intends to use the name for the purposes of criticism or other fair use (indeed, the Respondent has indicated to the contrary). On the balance of probabilities, the Respondent must have intended to gain an advantage of some kind. The question is whether the advantage is "unfair".

There is, of course, no evidence of actual use. However, the Panel has difficulty conceiving of any use which could be made by the Respondent of the Domain Names in accordance with its stated intentions which would not be "unfair".

Similarly, in this case, where the Respondent has acknowledged that it was well-aware of the Complainant's well-known and distinctive trademark NOVOTEL and nevertheless chose to register the Domain Name, where Respondent has no independent connection to the name or mark NOVOTEL, and where the Respondent has chosen not to participate in this case (even though it had previously responded to the Complainant's correspondence) to explain why it chose the Domain Name, the Expert (i) has difficulty in conceiving of any use which could have been made by the Respondent that would not have been unfair, and (ii) considers that the only conceivable reason for the Respondent's conscious adoption of the Domain Name which incorporates a well-known trademark of another is to take advantage of the accrued goodwill in that name.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the DRS Policy on the basis that it was registered in a manner which, at the time when the registration took place, took unfair advantage of the Complainant's rights.

8. Decision

The Expert finds that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the disputed Domain Name, novotel.co.uk, be transferred to the Complainant.

Christopher Gibson

24 January 2006