

ADMINISTRATIVE PANEL DECISION

Accor, SoLuxury HMC v. Registration Private, Domains By Proxy, LLC / I S, ICS Inc.

Case No. D2018-1104

1. The Parties

The Complainant is Accor, SoLuxury HMC of Issy-Les-Moulineaux, France, represented by Dreyfus & associés, France.

The Respondent is Registration Private, Domains By Proxy, LLC of Scottsdale, Arizona, United States of America ("United States") / I S, ICS Inc. of Grand Cayman, Cayman Islands, Overseas Territory of the United Kingdom of Great Britain and Northern Ireland ("United Kingdom").

2. The Domain Name and Registrar

The disputed domain name <sofitella.com> is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 16, 2018. On May 16, 2018, the Center transmitted, by email to the Registrar, a request for registrar verification in connection with the disputed domain name. On May 17, 2018, the Registrar transmitted its verification response, by email to the Center, confirming that the Respondent is listed as the registrant and providing the contact details for the registrant.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint and that this proceeding commenced on May 24, 2018. In accordance with the Rules, paragraph 5, the due date for Response was set to June 13, 2018. The Respondent did not submit any response. Accordingly on June 14, 2018, the Center notified the parties of the Respondent's default.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on June 26, 2018. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

As reflected in the registration record for the disputed domain name in the public Whois database (a copy of that record appears in Annex 1.1 to the Complaint), the disputed domain name was registered on May 29, 2017.

A. The Complainant's SOFITEL marks (collectively the "SOFITEL Marks")

As indicated in the Complaint, the Complainant owns multiple international trademark registrations for the term "SOFITEL" in block letters. The Complainant has provided, in Annexes 7.1 – 7.4 to the Complaint, copies of the registration records for four of these registrations, the pertinent details of two of them are as follows:

1. SOFITEL

International registration: 939096; Registered: August 30, 2007
Designations include the United States

This mark is registered for use in connection with: "Real estate business management services and real estate administrative management services, including the administrative management of hotels, motels, hotel complexes, flats and residential hotels; advertisement services relating to the organization and management of hotels, motels, hotel complexes, residential hotels, flats and temporary accommodation facilities" all in international class 35; "Real estate affairs; management of real estate, housing and accommodation, including hotels, motels, hotel complexes and residential hotels; accommodation agencies (real estate), management of housing and accommodation, property leasing, rental of flats, studios and rooms" all in international class 36; "Hotels, residential hotels, motels, operation of hotel complexes; hotel services, restaurant services (food and drink), services of cafeterias, tea rooms, bars (except clubs); temporary accommodation; vacation homes; services for the reservation of hotel rooms for travellers, of temporary accommodation; non-professional consultancy and advice in connection with hotel and restaurant services" all in international class 43; and "Health care institutions, medical care, hygienic and beauty care, body care services, in particular using hydrotherapy, including balneotherapy, thalassotherapy and spa treatments, beauty salons, hairdressing salons, rest and convalescent homes; providing of information and advice on dietetics" in international class 44.

2. SOFITEL

International registration: 863332; Registered: August 26, 2005
Designations include the United States

This mark is registered for use in connection with: "Administrative management of hotels and hotel complexes, advice and assistance for commercial company management and administration; business organization and administration consultancy and advice in the fields of hotel and restaurant business including services provided by a franchiser, namely assistance in running or managing a commercial venture" all in international class 35; "Tourism and travel agencies; sightseeing tours; tourist guide services (couriers); travel, excursion and cruise arrangement; reservations for sightseeing tours, seats for travel; car rental; consulting and information on organizing transport and tourism in a town and/or a region" in international class 39; and "Hotel and restaurant services (providing of food and drink), temporary accommodation, running motels, restaurants, cafeterias, cafés, tea rooms, bars (except clubs), operation of tourist homes, reservation services for hotel rooms for travellers, non-professional consultancy and advice in connection with hotel and restaurant services" in international class 43.

B. The Parties and their activities

Complainant SoLuxury HMC is a fully-owned subsidiary of Complainant Accor (as indicated in Annex 4 to the Complaint). For the sake of convenience, both Complainants and Respondents will be hereinafter collectively referred to as the “Complainant” and the “Respondent”, respectively, except where the specific context specifically indicates or implies reference to a specific entity.

Currently, Complainant Accor is a large worldwide operator of economy and mid-scale hotels, and a significant player in upscale and luxury hospitality services. Accor opened its first hotel in 1967 (approximately 51 years ago). Since then, it has expanded and evolved to now operating more than 4,100 hotels in 95 countries worldwide with over 583,000 rooms, from economy to upscale under various brand names, including: SOFITEL, PULLMAN, NOVOTEL, MERCURE and IBIS. Of those brands, SOFITEL is a French luxury hotel brand offering contemporary hotels and resorts in 121 different facilities located across 41 countries spanning 5 continents with cumulatively more than 30,000 rooms. Currently, SOFITEL is expanding its presence in Latin America, the Middle East, Africa and Asia (Screenshots of various pages from the website of Complainant Accor, at its corporate website at “www.accorhotels.group”, which describe its business history appear in Annex 5.1 to the Complaint). The Complainant operates in the United States through 28 hotels cumulatively providing 10,815 rooms, including the Hotel Sofitel Los Angeles located in the Beverly Hills suburb of Los Angeles and which itself provides 295 rooms.

The Complainant promotes its services using its registered trademarks through various marketing channels including its website at <sofitel.com>.

The disputed domain name, when entered into a user’s browser, redirects that browser to a web page that provides a browser add-on called “Personal Finder”, which may be harmful. This add-on, once installed by the user, requests that user to create a user account providing the user’s first and last name, gender, mobile telephone number or email, a password and that user’s birthday (screenshots shown in Annexes 1.2 and 1.3 to the Complaint).

Further, the Respondent has established an “MX record” for the disputed domain name which reflects that the Respondent could use the name as a domain for e-mail addresses handled by an email server, thus potentially presenting a risk that the domain name will be used as the domain for e-mail addresses used in facilitating phishing activities (screenshot of an MX record, associated with the disputed domain name provided, in Annex 1.4 to the Complaint).

Additionally, the Respondent is currently offering to sell the disputed domain name for USD 299.00 (screenshot of a search result provided in Annex 14 to the Complaint).

To amicably resolve the dispute, on September 4, 2017, the Complainant sent a cease-and-desist letter to the Respondent, via both postal mail and email, requesting, *inter alia*, that the Respondent transfer the name to the Complainant at no charge (a copy of this letter appears in Annex 6 to the Complaint), and the underlying registrant behind the privacy service be disclosed. The privacy service replied stating that it merely provides an anonymity screen for domain name registrants and identified the underlying registrant. Having this identification, on November 7, 2017, the Complainant sent a cease-and-desist letter to the underlying registrant requesting it to immediately cease use of the disputed domain name and transfer it to the Complainant. Despite several successive reminders, the Respondent never replied (copies of those reminders appear in Annex 6 to the Complaint). Consequently, the Complainant initiated the present proceeding seeking transfer of the disputed domain name.

5. Parties’ Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its mark SOFITEL.

Specifically, the disputed domain name contains this mark appended by the letters "LA" with those letters being incapable of adding sufficient distinctiveness whatsoever to the name to mitigate any resulting user confusion between the disputed domain name and the Complainant's mark. Furthermore, these letters are a very widely recognized geographic-based abbreviation for Los Angeles, California. As the Complainant operates a SOFITEL branded hotel in Los Angeles specifically called Hotel Sofitel Los Angeles, the inclusion of this abbreviation into the domain name significantly heightens a potential for confusion to occur among Internet users who seek information on that hotel as those users will likely think that the Respondent's website is affiliated with or related to the Complainant and specifically that hotel when, in fact, neither the Complainant nor its Los Angeles hotel has any affiliation with, sponsorship of or relationship with the Respondent at all.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy, and specifically does not qualify under any of paragraphs 4(c)(i)-(iii).

Specifically, the Respondent is not licensed or otherwise authorized by the Complainant to use any of its SOFITEL Marks. The Respondent has neither used nor made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy, nor it is using the name in connection with any legitimate noncommercial or fair use under paragraph 4(c)(iii) of the Policy. In that regard and at present, the Respondent uses the name to redirect Internet users to its own website at which it provides a browser add-on which, upon installation in those users' browsers, might prove harmful. Furthermore, the Respondent configured an email server with the disputed domain name in order to transmit messages from that domain name, thus presenting a serious risk that the Respondent may undertake phishing attacks. As these uses are illicit and with respect to phishing attacks particularly reflect Internet-based fraud, they are not *bona fide* within the meaning of paragraph 4(c)(i) of the Policy and present a *prima facie* case that the Respondent lacks any rights or legitimate interests in the disputed domain name, citing to *Syngenta Participations AG v. Guillaume Texier, Gobain Ltd*, WIPO Case No. D2017-1147; and *Educational Testing Service v. Ali Mohammed Ahmed, Afakcenter*, WIPO Case No. D2017-1600.

Further, with respect to paragraph 4(c)(ii) of the Policy, the Respondent has never been commonly known by any name, trade name or domain name that incorporates the term SOFITEL, nor could it be given the Complainant's exclusive trademark rights in that term which date back to at least October 29, 1993 (the earliest registration date of the Complainant's various trademark registrations it noted in the Complaint) and the worldwide fame which its SOFITEL Marks have achieved since then. Thus, it is highly unlikely that the Respondent could develop any association, relationship or connection with any of those marks without infringing the Complainant's rights and thus ever qualify under paragraph 4(c)(ii).

Lastly, the Respondent's actions, in having shielded its identity through use of a privacy shield thereby frustrating the Complainant's attempt to contact it and then failing to respond to the Complainant's cease-and-desist letter, collectively support a finding that it has no rights or legitimate interests in the disputed domain name.

(iii) Registered and Used in Bad Faith

The Complainant also contends that, for various reasons, the Respondent has registered and is using the disputed domain name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent was well aware of the exclusive rights, goodwill and reputation which the Complainant possessed in its mark SOFITEL and of the Complainant's branded SOFITEL hotel in Los Angeles, called the Hotel Sofitel Los Angeles, when it intentionally selected the disputed domain name. Yet, in spite of that knowledge and with the intent of deliberately and opportunistically exploiting the ensuing consumer confusion for its own benefit, the Respondent registered the disputed domain name which includes the Complainant's mark SOFITEL in its entirety followed by the letters "LA", the latter being a very well-known geographic abbreviation for Los Angeles, California. These acts constitute bad faith registration.

Further, the Respondent registered the domain name through a privacy screen, which, in turn, concealed its identity and contact information and thus prevented the Complainant from contacting the Respondent. This also reflects bad faith registration.

As to use, the Respondent used the disputed domain name to divert Internet users from the Complainant's website (or one associated with its Los Angeles hotel) to the Respondent's website instead at which the Respondent provides a browser add-on that, upon installation in a user's browser, might be harmful, and as an underlying e-mail domain for an email server through which the Respondent could potentially engage in email-based phishing attacks. Moreover, the Respondent is also offering to sell the domain name for a price (USD 299) that exceeds its out-of-pocket costs of registration. These acts constitute bad faith use.

Lastly, the Respondent registered the name to prevent the Complainant from using its mark in the disputed domain name, an action which further denotes bad faith use.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel decided this proceeding on the basis of the Complainant's undisputed factual allegations which the Panel finds are not inherently implausible

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's mark SOFITEL.

From a simple comparison of the disputed domain name to the Complainant's mark SOFITEL, no doubt exists that the disputed domain name is confusingly similar to it. The disputed domain name consists of the mark in its entirety appended by the letters "LA" to which the generic Top-Level Domain ("gTLD") ".com" has been appended, with the addition of the gTLD being irrelevant in this case in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as addition of a well-known geographic designator, to a mark is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, the Respondent's addition of the two letters "LA", which are a very well-known abbreviation for Los Angeles, clearly resulted in such a minor variation. See, e.g., *Calvin Klein Trademark Trust and Calvin Klein Inc. v. Abeer Ayoub*, WIPO Case No. D2018-0387; *SAP SE v. Lakshmi Reddy Bhumireddy and P. Hareesh*, WIPO Case No. D2017-0396; *Compagnie Générale des Etablissements Michelin v. Cameron Jackson*, WIPO Case No. D2016-2392; *Kumfs Brand Limited v. George*, WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case

No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; and *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148.

Moreover, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements. See section 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s mark SOFITEL. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the Complainant’s SOFITEL Marks and does not have any relationship, affiliation or connection whatsoever with the Respondent.

Further, with respect to paragraph 4(c)(i) of the Policy, the Respondent does not now use nor has it ever made any demonstrable preparations to use the disputed domain name in conjunction with a *bona fide* offering of any goods or services. As the Complaint correctly argues, the Respondent’s current use of the name: (a) as an instrumentality to redirect Internet users to its own website at which it provides a browser add-on that, may upon installation in those users’ browsers, prove harmful, and (b) through which the Respondent established an email service to potentially launch phishing attacks, is clearly not *bona fide* within the meaning of that paragraph of the Policy.

Furthermore, the Respondent’s current use of the disputed domain name, certainly in a manner that ultimately, if not illicitly, commercially benefits itself is neither noncommercial nor reflective of fair use within the meaning of paragraph 4(c)(iii) of the Policy.

Moreover, as to paragraph 4(c)(ii) of the Policy, the record is entirely devoid of any evidence which reflects that the Respondent is currently or has ever been commonly known by the disputed domain name or any of the Complainant’s SOFITEL Marks. Given that the notoriety and consequently substantial reputation that the Complainant has acquired in the mark SOFITEL since it first registered that mark on October 29, 1993 – that date being approximately 24 years prior to the date on which the Respondent registered the disputed domain name on May 29, 2017, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to any of those of the Complainant – at least for the services provided by the Complainant under any of its SOFITEL Marks – without interfering with the exclusive trademark rights of the Complainant. See, e.g., *Covestro Deutschland AG v. Kay Mone / KMN INC.*, WIPO Case No. D2018-0145; *Alstom v. Zahir Khan, Palki Event Inc.*, WIPO Case No. D2017-1124; *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID; 62520014085963*, WIPO Case No. D2015-0787; and *Calvin Klein, Compagnie Générale des Etablissements Michelin, Chicago Mercantile Exchange Inc.; Cummins; and Staatliche Porzellan-Manufaktur Meissen*, all cited *supra*.

Consequently, the Respondent does not satisfy any of paragraphs 4(c)(i), (ii) and (iii) of the Policy and thus has no rights or legitimate interests in the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

Specifically, the Panel finds, particularly in light of the lack of any response, that the Respondent was very likely well aware of the exclusive rights, goodwill and reputation which the Complainant possessed in its SOFITEL Marks when the Respondent intentionally selected the disputed domain name which totally incorporated the mark SOFITEL and then, in spite of that knowledge and without having received any authorization from the Complainant, registered the name. Not only did the Respondent incorporate the mark into the name but it also appended the letters "LA" to the mark to form the name and which are a very common geographic abbreviation for Los Angeles -- a city where the Complainant operates a SOFITEL hotel and which is named the Hotel Sofitel Los Angeles. It is simply inconceivable, given the high degree of similarity of the disputed domain name to the mark and to the name of the Complainant's hotel for the Panel to find that the Respondent: (a) was completely unaware of the potential for the disputed domain name to cause confusion with the Complainant and its hotel, and (b) had no intention whatsoever to opportunistically exploit that confusion for its own gain. This finding is all the more evident by the Respondent's acts in using the name: (a) to divert Internet users from the Complainant's website (or one associated with its Los Angeles hotel) to the Respondent's website instead at which the Respondent provides a potentially harmful browser add-on, and (b) as an e-mail domain for potentially engaging in email-based phishing attacks.

Apart from such use, the Respondent is also offering to sell the disputed domain name at a price (USD 299) which, in all likelihood, exceeds its out-of-pocket costs of registration.

This reflects bad faith registration and use under paragraphs 4(b)(i) and 4(b)(iv) of the Policy. Thus, the Panel concludes that the Complainant has provided sufficient evidence of its allegations, with respect to the disputed domain name to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name <sofitella.com> is to be transferred to the Complainant.

Peter L. Michaelson
Sole Panelist
Date: July 6, 2018