



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

WHM L.L.C. v. Northpoint, Inc.

Case No. D2005-1134

1. The Parties

The Complainant is WHM L.L.C., Florida, United States of America, represented by Lydecker & Wadsworth, L.L.C., United States of America.

The Respondent is Northpoint, Inc., c/o D. Taylor, Florida, United States of America.

2. The Domain Names and Registrar

The disputed domain names <elconquistadorresort.com> and <elsanjuanhotel.com> are both registered with eNom.

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999, (the "Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in email form on October 31, 2005, and in hard copy form on November 3, 2005, along with Annexes 1-10.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a three member panel.

After receiving the Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether that Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on November 1, 2005, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to each of the disputed domain names; specifically, contact and registrant information for those domain names, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to the disputed domain names, (b) whether the registrant has submitted, in its registration agreements, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the domain names, (c) the language of the registration agreements, and (d) whether the domain names will remain “locked” during the proceeding.

On November 4, 2005, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain names, to the extent present in its WhoIs database, confirmed that Enom is the registrar of the names and stated that: the Policy applied to the disputed domain names, the language of the underlying registration agreements for the names is English and both names were then held in a “locked” status. The Registrar also informed the Center that the Respondent, through the registration agreement, had submitted to the jurisdiction at the location of the principal office of the Registrar for court adjudication of disputes concerning or arising from the use of the disputed domain names.

On November 7, 2005, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, by courier and email (the latter being without the Annexes), to the Respondent. Specifically, the Center separately provided its notice along with the Complaint, by email, to the Respondent’s domain name registrant, technical, administrative and zone contacts as set forth in the Whois record for each of the disputed domain names. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on November 7, 2005, under paragraph 4(c) of the Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all preceding and succeeding correspondence between the Center and the Registrar in detail, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on November 27, 2005, to file its Response with the Center and serve a copy of the Response on the Complainant.

On November 7 and 8, 2005, the Complainant filed with the Center, by email and hardcopy, respectively, a Supplemental Filing for its Complaint, specifically being Annex 11 and an Amended Annex List.

As of November 27, 2005, the Center had not received a Response to the Complaint from the Respondent; hence, the Center, in an email letter dated November 28, 2005, notified the Complainant and Respondent of the default of the Respondent.

Subsequently, the Respondent filed its Response with the Center by email on November 28, 2005, and in hard-copy form on December 1, 2005.

Thereafter, the Complainant filed a motion captioned “Motion to Strike and/or Dismiss the Respondent’s Response for Failure to Comply with the Rules and Policy” with the Center by email on December 1, 2005, and in hard-copy form on December 6, 2005.

On December 13, 2005, the Respondent then filed a Supplemental Filing captioned “Supplemental Response” by email with the Center.

Pursuant to the Rules and Supplemental Rules, by email letter dated December 16, 2005, the Center appointed the Panel formed of Mr. Peter L. Michaelson as Presiding Panelist, and Ms. Michelle Brownlee and Mr. Thomas Webster as Co-Panelists. The Panel finds that it was properly constituted. Each member of the Panel has submitted an executed Statement of Acceptance and Declaration of Impartiality and Independence to the Center, as required to ensure compliance with paragraph 7 of the Rules.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before December 30, 2005. However, due to the Panel’s need for additional time to fully complete its efforts – which constituted exceptional circumstances, the Center, upon the Panel’s request and on December 29, 2005, extended the due date to January 13, 2006, and, on the Panel’s subsequent request of January 12, 2006, further extended the due date to January 27, 2006.

This dispute concerns two domain names, specifically: <elconquistadorresort.com> and <elsanjuanhotel.com>

The language of this proceeding is English.

4. Factual Background

A copy of the WhoIS registration records for the disputed domain names appears in Annex 2 to the Complaint. As indicated on these records, the Respondent registered the disputed domain name <elconquistadorresort.com> on January 23, 1999, and renewed that registration on September 7, 2004, and registered the disputed domain name <elsanjuanhotel.com> on February 12, 1999, and renewed the registration for that name on January 12, 2005.

A. Complainant’s activities

The Complainant owns the “El Conquistador Resort” located in Fajardo, Puerto Rico and the “El San Juan Hotel” located in Carolina, Puerto Rico. As reported in copies of press releases provided in Annex 1 to the Complaint, the Complainant is the operating company for the current owner, The Blackstone Group, of both properties. Prior to these properties, among 12 others, being sold in mid-August 2005 to the Blackstone Group, both properties were owned and operated by Wyndham International and

apparently also referred to as the “Wyndham El San Juan Hotel and Casino” and “Wyndham El Conquistador Resort & Golden Door Spa”, respectively.

This “El San Juan Hotel” and the “El Conquistador Resort” have been in operation, under these names or variants that have included these names, since approximately 1943 and 1993, respectively. In that regard, the Complainant has provided, in Annex 11 to the Complaint (actually filed as part of its Supplemental Filing), a copy of a use permit issued by the Regulations and Permits Office of the Puerto Rican government on December 9, 1993, for the then newly constructed El Conquistador Resort and a copy of a renewal of a use permit issued by the same office but dated September 24, 1984 for the El San Juan Hotel.

The Complainant has not registered either of the terms “El San Juan Hotel” and “El Conquistador Resort” as a trademark in Puerto Rico or federally with the United States Patent and Trademark Office.

1. El San Juan Hotel

The Complainant has provided in Annexes 6 and 10 to the Complaint, as evidence of advertising and widespread reputation of this hotel, hard-copy printouts of web pages, from various different travel-related websites, that specify the name of the El San Juan Hotel and describe and depict its facilities, describe its location and amenities, provide reviews of the hotel and other related information, including rates, and/or take reservations. These sites are “lodging.com”, “classicvacations.com”, “puertorico.wheretostay.com”, “islandresorttours.com” and “wyndham.com”.

Specifically, the web page from “lodging.com” describes this hotel, in pertinent part as follows:

“El San Juan Hotel & Casino conveniently located in the fashionable Isla Verde area, is the ‘Heart and Soul of Puerto Rico’. The hotel’s location provides a perfect backdrop for the exciting vibrant nightlife of the city of San Juan. As reported in Travel & Leisure, ‘The most happening, exciting resort in the Caribbean, reminiscent of Havana in it’s heyday’ and New York Magazine’s ‘Best Hotel in Puerto Rico’. A convenient distance from the Luis Muñoz Marin International Airport, El San Juan Hotel & Casino is nestled on Puerto Rico’s most beautiful white sand beach and blends the glamorous nightlife of Monte Carlo, the magical charm of Old World Europe, with the relaxing atmosphere of an elegant Caribbean Resort. The hotel offers visitors an experience that is unmatched in the Caribbean. Privately and quietly situated, the hotel occupies 15 landscaped acres, of which 5 acres are a Registered Botanical Garden. The magnificent tropical plantings; trees, shrubs, and blooms are all native to Puerto Rico. El San Juan is known all over the world for tasteful elegance, superlative, friendly hospitality, and a superior beach front location.”

The web page from “classvacations.com” states, in pertinent part:

“The resort serves as one of the San Juan metropolitan area’s most popular after dark gathering places”.

The web page from the “wheretostay.com” website states, in pertinent part:

“The Wyndham El San Juan Hotel & Casino is simply spectacular. ... From the moment you arrive, you’ll know that this is how a luxury resort is meant to be glamorous, elegant, and unforgettable.

The renowned Palm Court lobby of this hotel blends the glamorous nightlife of Monte Carlo with the charm of Old World Europe. ...

Noted for its elegance and warmth, the Wyndham El San Juan’s guest rooms provide all the ingredients for a long relaxing escape ...”

The web page from the “islandresorttours.com” website states, in pertinent part:

“Once acclaimed ‘the best hotel in Puerto Rico’ by New York magazine, it offers all the typical resort activities and excitement ‘reminiscent of Havana in its heyday...”

Lastly, the web page from “wyndham.com” website states, in pertinent part:

“Come to the El San Juan Hotel & Casino, and experience for yourself what has been called the most exciting hotel in the Caribbean.”

2. El Conquistador Resort

The Complainant has provided in Annexes 6 and 10 to the Complaint, as evidence of advertising and the widespread reputation of the resort, hard-copy printouts of web pages, from various different travel-related websites, that specify the name of the El Conquistador Resort and describe and depict its facilities, describe its location and amenities, provide reviews of the hotel and other related information, including rates, and/or take reservations. These sites are: “openworldhotels.com”, “where2stay.com”, “travelimpressions.com”, “avidari.com”, “classicvacations.com”, “islandresorttours.com”, “Icifl.net” (L’Concierge International), “puertoricoisfun.com”, “resortvacationstogo.com” and “wyndham.com”.

Specifically, the web page from the “where2stay.com” website states, in pertinent part:

“This spectacular resort, considered one of the best in its class in the Caribbean, features a wide range of water sports, six swimming pools, seven tennis courts, a private 25 slip marina and an 18-hole Arthur Hills championship golf course, as well as a casino, elegant shopping in 22 luxury retail shops, a supervised children’s program and business center services.”

The web page from the “avidari.com” website states, in pertinent part:

“With 751 lavish guest rooms and suites, exciting nighttime entertainment, circular casino, Arthur Hills golf course, top-of-the-line tennis facilities, 35-slip marina, six swimming pools, deluxe fitness center and private island, the El Conquistador located high above the deep blue waters of the Atlantic Ocean and the turquoise waters of the Caribbean Sea is known as the Caribbean’s most complete destination resort.”

The web page from “islandresorttours.com” states, in describing this resort and in pertinent part:

“It is the Caribbean’s most complete destination resort featuring a lush, private island Palomino, a Golden Door Spa, a 18-hole-par 72 Arthur Hills championship gold course, “Camp Coqui” for kids, tennis, water sports, 6 pools w/1 swim-up bar, 11 restaurants, 7 cocktail bars, 35-slip marina for boat and yacht charters, Marina Village with an array of shops & boutiques, an action-packed casino and numerous activities.”

The web page from the “puertoricoisfun.com” states:

“The elegant Wyndham El Conquistador Resort & Country Club is world-famous for its gourmet cuisine, luxurious rooms, and exciting nightlife. With a lush, private island, Golden Door Spa, championship golf course, tennis facilities, outstanding service, Camp Coqui for kids, and numerous activities and water sports, it is the Caribbean’s most complete destination resort.”

Lastly, the web page from “wyndham.com” website states, in pertinent part:

“Welcome to the world’s most comprehensive resort: El Conquistador Resort & Golden Door Spa. Perched on top of cliffs overlooking the Atlantic Ocean and Caribbean Sea, this majestic paradise is the perfect Puerto Rico destination for outdoor recreation, championship golf and spa therapy.”

An Internet search for the term “El Conquistador”, performed by the Complainant on September 14, 2005, through the Google website - a search printout listing the highest 10 results of the search is provided in Annex 9 to the Complaint, returned links to the Complainant’s El Conquistador Resort as its highest ranked links, followed by links to the “Hilton El Conquistador Golf and Tennis Resort” (which apparently has no relationship to the Complainant) located in Tucson, Arizona.

B. Respondent’s activities

The Respondent is in the Internet advertising business. It acquires generic domain names for their keyword relevance to selected search terms. In that regard, the Respondent has registered a portfolio of domain names which incorporate common words, generic and short terms, and phrases. The Respondent employs these domain names in conjunction with an advertising subscription database, operated by a third party advertising consolidator, to return search results from the database on the basis of correspondence, particularly relevance, between terms in the domain names and search terms for which advertisers have paid subscriptions on a performance basis. Specifically, as best understood from the Response, whenever an Internet user enters any such name into his(her) browser, a home web page appears from an addressed, corresponding one of the Respondent’s websites and depicts both a list of links, organized into categories, to third-party websites offering goods and services along with other associated information pertinent to that name. Should the user then enter a keyword into a search box on the Respondent’s site, then, that site automatically accesses the advertising database on the basis of the domain name of that site and the keyword, and returns and displays those categories and associated links, as stored in the database, which are most relevant to both the name and the keyword. Hence, the Respondent’s websites function as web portals to third-party sites. The Respondent shares in a commission paid by advertisers to the consolidator - as indicated by copies, in Annex 4 to the Response, of recent checks which the Respondent received from its consolidator.

With respect to the disputed domain names, the Respondent has been operating websites resolvable through those names for over 6 years prior to the Complaint.

The links include sites which provide travel-related services worldwide. The Respondent does not offer its own goods or services through either of these sites, but only goods and services provided by third-party advertisers.

With respect to hotels, through the Respondent's websites, Internet users can compare rate information across different hotels and resorts, including those of the Complainant and more specifically the El San Juan Hotel and the El Conquistador Resort, and book reservations at those facilities. Pages displayed through the Respondent's websites provide links directly to the Complainant's websites for these specific facilities. Annex 7 to the Complaint contains copies of printouts of pages from the hotels portion of the Respondent's websites, and specifically those pages that include the Complainant's El San Juan Hotel and El Conquistador Resort.

Upon registering the disputed domain names, according to the Respondent it was and still is Respondent's plan to develop an Internet advertising business with travel related web portals for travel bookings worldwide. In that regard, the Respondent plans to eventually develop independent travel booking sites for all of its acquired domain names, including the disputed domain names. The Respondent currently operates several independent travel booking sites, including: "paradiseislandbahamas.com", "lasvegasgetaway.com", "bahamasbest.com" and "caribbeansbest.com".

When the Respondent registered the disputed domain names, the Respondent was unaware of the Complainant or any other entity that might have had any rights to either of the disputed domain names. Prior to registration, the Respondent performed an Internet search for both disputed names and nothing resulted that, in the Respondent's view, would create a conflict with or even referenced those names.

A history search, as performed by the Respondent (through "web.archive.org/web/*/wyndham.com"), of the site "wyndham.com", reveals that this site was created on December 12, 1998 as a one-page site but without having any reference to either of the disputed domain names. It was not until after the Respondent registered the disputed domain names that Wyndham had a six-page website, but the Respondent does not know if, at that time, the El San Juan Hotel and El Conquistador Resort were even listed on the Wyndham website.

An Internet search performed by the Respondent on November 28, 2005, through the Google website, yielded approximately 273,000 results for the term "El Conquistador Resort" and approximately 5,590,000 results for the term "El San Juan Hotel". A copy of a print-out listing the first 10 results appears in Annex 2 to the Response. Those results indicate various third-party users of the term "El Conquistador" (which translates, in English, to the "conqueror") in connection with hotel and resort services, including the following hotels and resorts and their respective locations:

Hilton El Conquistador Resort	Arizona, United States
Hotel El Conquistador	Córdoba, Spain
El Conquistador Hotel & Resorts	Mérida, México
El Conquistador Hotel	Arequipa, Perú
El Conquistador Hotel	Buenos Aires, Argentina.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

While the Complainant has not federally registered the marks "EL SAN JUAN HOTEL" and the "EL CONQUISTADOR RESORT", it asserts that, by virtue of its use of these marks in connection with its corresponding hotel and resort facilities, it has acquired common law trademark rights in each of these marks sufficient to establish rights under paragraph 4(a)(i) of the Policy.

In light of those rights, the Complainant contends that the disputed domain names <elsanjuanhotel.com> and <elconquistadorresort.com>, which fully include its respective marks, are confusingly similar to those marks.

Furthermore, the Complainant states that its use of its marks "EL SAN JUAN HOTEL" and "EL SAN JUAN HOTEL" marks commenced in 1943 and 1993, respectively, both of which predated the Respondent's registration of the disputed domain names in 1999 as well as their subsequent renewal in 2004 and 2005.

Moreover, the Complainant contends that its services and those of the Respondent are in the same or similar channels of trade and accordingly create confusion as to whether the Complainant is affiliated with or sponsors the Respondent, or whether the parties are otherwise related in some fashion -- when, in fact, they are not. In addition, the Complainant asserts that it is likely that Internet users who look for the Complainant's website for hotel/resort accommodations are likely to encounter the Respondent's websites instead. Also, confusion is also likely to arise once those users reach either of the Respondent's websites and encounter one of the Complainant's marks being used, in the address of that website, to advertise other hotels.

Hence, the Complainant believes that, with respect to both disputed domain names, it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant principally contends that, for two reasons, the Respondent has no rights or legitimate interests in either of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant contends that the Respondent's websites, to which the disputed domain names resolve, advertise both the Complainant's El San Juan Hotel and its El Conquistador Resort as well as hotels and resorts of competitors, allows Internet users to comparison shop between those competing hotels and those of the Complainant, and also provides a vehicle through which those users can make hotel reservations at either the Complainant's or any of the other competitive hotels. As such, the Complainant contends, citing to *Hancock Fabrics, Inc. v. Forum LLC*, Claim No. FA 447259 (Nat. Arb. Forum May 3, 2005), that these uses, being directly competitive with the Complainant's activities, can not constitute a *bona fide* offering of goods and services under paragraph 4(a)(ii).

Second, the Complainant contends that the Respondent has registered and for the past six years is using the disputed domain names to capitalize upon the confusing similarity

of the names to the Complainant's marks and, by doing so, divert Internet users away from the Complainant's websites. Such use, from its inception, is illegitimate and also does not constitute fair use.

(iii) Registered and Used in Bad Faith

The Complainant contends that, for several reasons, the Respondent has registered and is now using both disputed domain names in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Complainant contends that the Respondent registered both domain names, which include the Complainant's marks, to intentionally prevent the Complainant from reflecting each of its marks in a corresponding domain name. Since these domain names completely include the marks, the Complainant asserts that the Respondent knew of the Complainant's rights, and, in spite of that knowledge, then proceeded to register both names.

Second, the Complainant contends that, inasmuch as the Respondent's websites, to which the disputed names resolve, directly compete with the Complainant, the Respondent has registered and is using both domain names to capitalize on the confusingly similarity of those names with the Complainant's marks and, through doing so, divert Internet users from the Complainant's sites to those of the Respondent ultimately damaging the Complainant's goodwill in its marks and to its financial detriment.

Third, the Complainant contends that the Respondent, in registering both names, did so to prevent the Complainant, as owner of its marks, from reflecting those marks in corresponding domain names, and by virtue of having registered two such names, has engaged in a pattern of such conduct. In that regard, the Complainant points to the fact that the Respondent registered both domain names within a few weeks of each other, thus constituting more than just a coincidence.

Fourth, the Complainant contends that not only did the Respondent, in registering both names, seek to disrupt the Complainant's business, it also intentionally attempted to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of those marks -- when, in actuality, no relationship at all existed between the parties.

Lastly, the Complainant contends that the Respondent's use of both names, over the past 6 years, as addresses for web portals, which provide links to hotels and resorts competitive with those of the Complainant, does not constitute "active use" of both names but rather passive holding and thus further reflects bad faith.

B. Respondent

(i) Identical or Confusingly Similar

The Respondent argues that, for several reasons, the Complainant has failed to meet its burden under paragraph 4(a)(1) of the Policy.

First, the Respondent argues, contrary to the Complainant's view, that the Complainant has not established common law trademark rights in either "EL SAN JUAN HOTEL"

or “EL SAN JUAN HOTEL” and thus has no trademark rights sufficient to invoke paragraph 4(a)(i) of the Policy.

Specifically, as to the asserted mark “EL SAN JUAN HOTEL”, the Respondent asserts that the term is formed of a designation “San Juan” that is primarily geographically descriptive, followed by a generic word “Hotel”, both of which collectively form a term that, at best, constitutes a descriptive mark for which proof of acquired distinctiveness is missing from the record.

As to the asserted mark “EL CONQUISTADOR RESORT”, the Respondent contends that the words “el conquistador” - which in English translation means “conqueror” - and “resort” are generic, in widespread use and are not exclusively associated with the Complainant. In that regard, the Respondent further contends that the Complainant provided no proof of acquired distinctiveness of its use of that mark in the marketplace, such as by showing a period and extent of exclusive use, and thus the Complainant has no superior rights to either the generic words in dispute or the domain name <elconquistadorresort.com>.

Second, the Respondent contends that the Complainant lacks any trademark rights in the term “EL SAN JUAN HOTEL” due to what the Respondent believes is significant third-party concurrent use of that term for hotel and/or resort services. In that regard, the Respondent points to the results, as noted above, of its Google search which yielded approximately 273,000 hits for the search terms “El Conquistador Resort” and approximately 5,590,000 for the search terms “El San Juan Hotel”.

Last, the Respondent contends that, if the Complainant has any common law trademark rights, those rights are not in the generic terms “El San Juan Hotel” and “El Conquistador Resort” but rather in the terms “Wyndham El San Juan Hotel” and “Wyndham El Conquistador Resort”, respectively, as the latter two appear to be the forms through which the Complainant, in the evidence it submitted in its Complaint, has actually used its marks. Internet users would simply not easily confuse such marks with the Respondent’s web portals, since those portals “offer access to other relevant links for their keyword relevance to selected search terms”.

(ii) Rights or Legitimate Interests

Contrary to the Complainant’s view, the Respondent contends that it has rights and legitimate interests in both disputed domain names under paragraphs 4(a)(ii) and 4(c) of the Policy.

In particular, the Respondent contends that, before any notice to it of the dispute, it began using the disputed names in connection with a *bona fide* offering of goods or services, and that is also making a legitimate non-commercial or fair use of the domain names without intent, for commercial gain, to misleadingly divert consumers or tarnish the Complainant’s marks.

Specifically, the Respondent acquires generic domain names for their keyword relevance to selected search terms. In furthering its business, the Respondent has registered a portfolio of such domain names that include common words, generic terms, short terms and useful phrases. The Respondent employs those names in conjunction with an advertising subscription database operated by Northpoint, the Respondent’s third party advertising consolidator, to return targeted search results to an Internet user on the basis of correspondence between terms in the domain name of one of the Respondent’s sites which that user is then visiting and search terms then entered by that

user into a search function provided through that site. The resulting list of links, produced through database look-up, varies based on relevance to keywords which Internet users enter as search terms. The Respondent uses each of the disputed domain names no differently than any of its other domain names, to provide, in the context of a web portal, a list of links to third-party (advertiser) sites that contain relevant, targeted material and informational content.

The Respondent does not use the disputed domains to offer its goods or services but rather lists of links to third-party sites. Respondent's advertisers pay performance-based "pay-per-click" commissions which are shared between the Respondent and Northpoint.

The Respondent contends it does not register any domain name for resale and is clearly not using the disputed domain names to tarnish the Complainant's alleged marks.

Such use of the disputed domain names, as web portals, reflects *bona fide* services which signifies the Respondent's legitimate right and interest in each of the disputed domain names.

(iii) Registered and Used in Bad Faith

The Respondent alleges that, for various reasons, it did not register and has not used either of the disputed domain names in bad faith under paragraphs 4(a)(iii) and 4(b) of the Policy.

First, the Respondent never intended to deceive Internet users, to cause confusion with the Complainant's websites or alleged mark, or, as part of any pattern of conduct, to prevent the Complainant from reflecting either of its marks in a corresponding domain name.

Second, the Respondent did not register the disputed domain names or acquire them primarily for the purpose of selling, renting, or otherwise transferring the those names to the Complainant. Specifically, the Respondent has never attempted to sell, rent or otherwise transfer these names to the Complainant.

Last, the Respondent neither registered either of the disputed domain names nor acquired them in an intentional attempt to attract for commercial gain, Internet users to the Respondent's websites or other on-line location, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of those sites or a location or of a product or service on the Respondent's websites or location. Specifically, the Respondent's site, to which each of the disputed names resolves, provides a list of links to third-party sites which contain relevant material with travel content. The Respondent does not use either of those names to offer its own goods or services but rather to offer access to relevant third-party links.

C. Additional Submissions

Complainant's Supplemental Filing merely added Appendix 11 to the Complaint and provided an amended list of Annexes for the Complaint.

Both the Complainant's Motion and the Respondent's Supplemental Filing -- apart from the Complainant's arguments in support of its request to the Panel to strike the Response as being untimely filed and the Respondent's countervailing arguments, principally appear to amplify arguments previously made in the Complaint and

Response. Consequently, in the interests of brevity, the Panel will dispense with summarizing any of the arguments made in either the Motion or the Respondent's Supplemental Filing here, and will direct the reader to the immediately following section for a summary of the parties' argumentation related to the alleged untimely filing of the Response.

6. Discussion and Findings

A. Preliminary Matters

1. Complainant's Motion to Strike and/or Dismiss the Response

The Complainant filed a Motion to Strike and/or Dismiss the Response for the reason that the Response was filed outside the 20-day response period mandated by the Center and thus was untimely. Consequently, the Complainant moves this Panel to disregard the Response and enter a default judgment against the Respondent.

Pursuant to Rule 14(a), ICANN panels have the power to accept filings that occur outside the specified time limits upon the occurrence of what a panel finds to be "exceptional circumstances". This rule states:

"In the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint."

Furthermore, should the panel find that exceptional circumstances exist - and an ICANN panel has wide discretion to do so, then Rule 10(c) empowers the panel to extend any period of time fixed by the Rules as it sees fit, by stating:

"The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these Rules or by the Panel."

The Respondent states that, while it had intended to transmit its Response by email to the Center on its due date of November 27, 2005, the Respondent suffered a loss of its Internet connection for several hours that day. That delay frustrated the Respondent's efforts to email the Response and thus caused the Respondent to miss the November 27, 2005 deadline. However, once the connection was restored, the Respondent proceeded to send its response by email to the Center, though that occurred on the next day, Monday, November 28th. Moreover, since November 27th fell on a Sunday during which Post Offices and businesses, including Federal Express, were closed in the United States, the Respondent sent separate hard-copies of the Response by Federal Express to the Center and the Complainant on the next successive day, November 28th.

The Panel views the Respondent's loss of its Internet connection, particularly since the loss was outside its control, as an exceptional circumstance. Thus, under Rules 10(c) and 14(a), the Panel accepts the Response as timely, even though, in actuality, it was filed a few hours late. Moreover, as the slight delay did not appear to cause any prejudice to the Complainant, then, even apart from the discretion granted to the Panel under the Rules, considerations of justice and fairness mandate the Panel's acceptance of the Response.

Hence, the Complainant's motion is DENIED. The Panel accepts the Response and has fully considered it.

2. Complainant's and Respondent's Supplemental Filings

The Rules contain no provision directed at unsolicited supplemental filings; hence, the Rules neither specifically authorize nor prohibit such filings. Consequently, the Panel has wide discretion in deciding whether to accept such filings or not.

Here, again in the interests of justice and fairness, the Panel accepts the Supplemental Filings from both parties and has fully considered those filings.

B. Policy Considerations

1. Identical or Confusingly Similar

Inasmuch as each of the Complainant's marks "EL SAN JUAN HOTEL" and "EL CONQUISTADOR RESORT" is unregistered, the Complainant predicates its case on its having acquired common law trademark rights through having used its marks in commerce and specifically in connection with hotel and resort services which it provides through its specific corresponding facilities in Puerto Rico that carry those marks as their names. For the El San Juan Hotel and the El Conquistador Resort, this use started 56 years and 6 years prior to the dates, February 12, 1999 and January 23, 1999, on which the Respondent registered the disputed domain names <elsanjuanhotel.com> and <elconquistadorresort>, respectively.

Regarding any distinction in coverage between registered and unregistered marks, paragraph 4(a) of the Policy simply recites: "You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that ... (i) your domain name is identical or confusingly similar to a *trademark or service mark in which the complainant has rights*" [emphasis added]. Nowhere does the Policy contain a restriction that specifically limits its reach to only registered marks. Therefore, given the apparent inclusive nature of the Policy, whether the Complainant has rights to an unregistered mark and hence a protectable interest under the Policy, lies with national trademark law that governs the Respondent's actions that are the subject of the Complaint. Under American law, rights accrue in unregistered, so-called "common law", marks as a result of usage, though limited by geographic and product/service markets in which the mark is used. As evidence of this, one need turn no further than to §43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce *any word, term, name, symbol, or device, or any combination thereof* ... (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act." [emphasis added]

Consequently, numerous panels, when faced with unregistered marks, have upheld their protectable status in the United States under the Policy. In that regard, when faced with this issue, the panel in *Brooklyn Institute of Arts and Sciences v. Fantastic Sites, Inc.*, FA 95560 (Nat. Arb. Forum, November 2, 2000) held: "ICANN dispute resolution policy is broad in scope in that the reference to a trademark or service mark in which the complainant has rights means that ownership of a registered mark is not required, unregistered or common law trademark or service mark rights will suffice to support a

domain name complaint under the policy”. See, e.g., *True Blue Productions, Inc. v. Chris Hoffman*, WIPO Case No. D2004-0930 (December 22, 2004); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *America Online, Inc. v. John Deep d/b/a Buddy USA Inc.*, FA 96795 (Nat. Arb. Forum, May 14, 2001); *Missing Children Minnesota v. Run Yell Tell, Ltd.*, FA 95825 (Nat. Arb. Forum, November 20, 2000); *Mike Warner 2001 v. Mike Larson*, FA 95746 (Nat. Arb. Forum, November 15, 2000); *CMG Worldwide Inc. v. Naughty Page*, FA 95641 (Nat. Arb. Forum, November 8, 2000); *Home Properties v. SMSOnline*, FA 95639 (Nat. Arb. Forum, November 2, 2000); and *Bridal Rings Company v. Yemenian*, FA 95608 (Nat. Arb. Forum, October 26, 2000). Furthermore, the panel in *United States Postal Service v. Consumer Info. Org.*, FA 95757 (Nat. Arb. Forum, November 27, 2000) held: “The UDRP does not discriminate between registered and unregistered marks.” In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE*, AF-0536, (eResolution, December 11, 2000), the panel recognized: “It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark.” In that regard, also see *Sand Hill Wholesale of Ohio v. Hatton*, FA 95970 (Nat. Arb. Forum, December 18, 2000), and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, FA 95832 (Nat. Arb. Forum, November 30, 2000). Similarly, see *American Home Products Corporation v. Healthy Futures*, WIPO Case No. D2000-0454 (August 3, 2000); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case No. D2000-0229 (May 10, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood and Solo Signs*, WIPO Case No. D2000-0131 (April 13, 2000); and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company*, WIPO Case No. D2000-0014 and D2000-0015 (March 11, 2000).

Therefore, given that common law trademark rights suffice under the Policy, then, as a threshold matter, a question now arises as to whether common law trademark rights actually existed at all in each of marks, “EL SAN JUAN HOTEL” and “EL CONQUISTADOR RESORT”, as of the date on which the Respondent registered the corresponding domain names <elsanjuanhotel.com> and <elconquistadorresort.com>.

a. El San Juan Hotel

The web pages from various third-party travel-related websites that the Complainant has referenced -which the Respondent has not refuted- show the reputation which the Complainant’s “EL SAN JUAN HOTEL” mark has acquired since that mark was first used with that hotel in 1943 and has been in continuous use ever since. This use began over 56 years prior to the date on which the Respondent registered <elsanjuanhotel.com>. Clearly, the quanta of evidence which the Complainant has adduced is rather underwhelming, to say the least, but as sparse as it is, it suffices. Even though this mark contains a highly geographic descriptor, when that mark is viewed in its entirety and particularly in light of its acquired reputation and 56 years of prior continuous use, it is clear to this Panel that, over the course of that period, whatever primarily geographic descriptiveness that mark may have had at its inception in 1943 has long since dissipated and has been supplanted, in the minds of the consuming public and more specifically Internet users, by its association with the Complainant’s hotel of the same name. Hence, this Panel finds that this mark has acquired sufficient distinctiveness and secondary meaning when used in conjunction with hotel services rendered at the El San Juan Hotel and thus, at least as of February 12, 1999 (if not far earlier in time), constituted a common law trademark.

No doubt exists that the disputed domain name is, for all practical purposes, identical to the Complainant's common law mark "EL SAN JUAN HOTEL". The difference between the name and that mark is merely the appending of a generic top level domain (gTLD) ".com" to the mark. Well-established UDRP precedent holds that the addition of a gTLD is utterly de minimus, if not completely irrelevant, in assessing identity/confusing similarity and thus is totally ignored. See, e.g., *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003).

Therefore, the Panel finds that the disputed domain name <elsanjuanhotel.com> sufficiently resembles the Complainant's mark "EL SAN JUAN HOTEL" as to cause confusion; hence, the Complainant has shown identity or confusing similarity between that mark and that particular name under paragraph 4(a)(i) of the Policy.

b. El Conquistador Resort

With respect to the El Conquistador resort, two panel members were not convinced that there was a common law trademark. In this instance, as noted with the El San Juan Hotel, Complainant's evidence is underwhelming. This weak evidentiary base together with the fact that the hotel was apparently only opened in 1993 raised an issue as to whether this name had acquired sufficient distinctiveness and secondary meaning to amount to a common law trademark in which the Complainant has rights for purposes of the UDRP. See *Citigroup, Inc. v. Joseph Parvin*, WIPO Case No. D2002-0969 (May 12, 2003) (Citigroup's allegation of use of "Cititravel" since 1986 without more insufficient to support claim to common law rights in the term); and *Sustainable Forestry Management Limited v. SFM.com and James M. van Johns "Infa dot Net" Web Services*, WIPO Case No. D2002-0535 (September 13, 2002). Indeed, in this case, the Complainant apparently took no steps with respect to the Respondent's use of the domain name for some six years. As a result, for two panelists, this raises an issue as to whether the failure to act was due to the basic weakness of the claim itself.

Given the nature of these proceedings, it is sometimes difficult to decide whether a Complainant has in fact met the requirements for a common law trademark. Under the UDRP policy, the Complainant has the burden of proving its rights and, on the evidence adduced, it has failed to meet that burden.

Therefore, the Panel finds that the Complainant has not adequately demonstrated that it acquired common law rights in its mark "El Conquistador Resort" as of January 23, 1999. Therefore, the Complainant has failed to meet its burden under paragraph 4(a)(i) of the Policy with respect to that mark.

Two of the panelists have reservations about the Complainant's claim of bad faith with respect to the Respondent's registration and use of the <elconquistadorresort.com> domain name due in part to the Respondent's explanation referred to above but also to the fact that the Respondent has been using it for some six years prior to the commencement of these proceedings. However, as the issues of Rights and Legitimate Interests and Bad Faith Registration and Use are now moot with respect to the disputed domain name <elconquistadorresort.com>, the following two sections will only address those issues in connection with the other disputed domain name <elsanjuanhotel.com>.

2. Rights or Legitimate Interests

The Panel believes that the Respondent has yet to provide any basis that would legitimize any claim it has to the disputed domain name <elsanjuanhotel.com> and moreover is extremely unlikely to ever be in such a position to legitimately make such a

claim. Although the Respondent argues that its use is geographically descriptive, Respondent has not provided any evidence that it is using the site in connection with the advertisement of hotels in a place called “El San Juan”. Rather, it is clear that the disputed domain name contains the Complainant’s mark “EL SAN JUAN HOTEL” under which the Complainant provides its hotel services.

The Complainant has never authorized the Respondent to utilize the mark “EL SAN JUAN HOTEL” or a mark confusingly similar thereto in conjunction with hotel services, let alone in the Complainant’s geographic market of Puerto Rico or its environs. Furthermore, the Complainant has no any relationship or association whatsoever with the Respondent. Hence, any use to which the Respondent were to put the mark “EL SAN JUAN HOTEL” or a mark confusingly similar thereto, in connection with providing services identical or similar to that associated with the Complainant would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., *True Blue Productions*, cited supra; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); FA208576 (Nat. Arb. Forum January 27, 2004); *Leiner Health Servs. Corp. v. ESJ Nutritional Prods.*, FA 173362 (Nat. Arb. Forum September 16, 2003); and *AT&T Corp.*, *MPL Communications*, and *Treeforms*, all cited supra.

It is clear to this Panel that the Respondent use of the disputed domain name, <elsanjuanhotel.com> which includes the Complainant’s mark, to address a web portal through which Internet users can not only obtain information about competitive hotel offerings but also compare pricing of those hotels with others and make reservations at any of those hotels constitutes opportunistic use, and will not constitute *bona fide* commercial or fair use sufficient to legitimize any rights and interests the Respondent might have in any of the disputed domain names. See, e.g., *True Blue Productions*, cited supra; *Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet et al* FA208576 (Nat. Arb. Forum January 27, 2004); and *Lockheed, Leiner Health Servs. Corp.*, and *Frampton*, all cited supra.

Moreover, there is absolutely no evidence of record that the Respondent has ever been commonly known by the domain name. Nor could the Respondent ever become so known, in light the Complainant’s continuous use of its mark for the prior 56 years as having been associated with its hotel, without infringing on the exclusive trademark rights of the Complainant.

Accordingly, the Panel is not persuaded that the Respondent has any rights or legitimate interests or, based on current facts provided to the Panel, is likely to acquire any rights or legitimate interests in the disputed domain name <elsanjuanhotel.com> under any provision of paragraph 4(c) of the Policy.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name <elsanjuanhotel.com> within Paragraph 4(a)(ii) of the Policy.

3. Registered and Used in Bad Faith

The Panel believes that the Respondent’s actions constitute bad faith registration and use of the disputed domain name <elsanjuanhotel.com>.

For the panel, the overriding element is that the Complainant’s hotel had been in operation, apparently as a luxury hotel, for 56 years when the Respondent first registered its domain name. Whatever the weakness of the evidentiary filing by the Complainant, it stands to reason that the Respondent knew the reputation inherent in the

Complainant's mark "EL SAN JUAN HOTEL" at the time it registered the corresponding domain name and that confusion would likely occur should it then use that name, but, nevertheless, decided to register that name and exploit the ensuing confusion to its own pecuniary benefit. Otherwise, why would it have picked that particular name? The Respondent contends that it acquires generic domain names for their keyword relevance to selected search terms, specifically names that incorporate "common words, generic and short terms, and phrases". In that regard, it has provided examples of other names it has registered, namely: <paradiseislandbahamas.com>, <lasvegasgetaway.com>, <bahamasbest.com> and <caribbeansbest.com>. All these names, even when viewed in their totality, appear to this Panel as so highly descriptive or generic as to be completely incapable of functioning as a mark - which sharply contrasts with the mark "EL SAN JUAN HOTEL". While the Respondent may have acquired all those other names for the generic or highly descriptive connotation each imparts to its viewer, the Panel believes that the same could never have been said for <elsanjuanhotel.com> which provides neither. Hence, the Panel dismisses the Respondent's alleged justification as to why it registered <elsanjuanhotel.com> as simply implausible.

Hence, the Respondent's actions, which were intended to exploit the Complainant's goodwill in its trademark for the Respondent's own pecuniary benefit and the Complainant's detriment and, in fact, have done so for the past 6 years during which the Respondent's website, resolvable through <elsanjuanhotel.com>, has been in operation, constitute, by their very illegality, bad faith under paragraph 4(b)(iv) and under the general requirement of paragraph 4(a)(iii) of the Policy as well disruption of the Complainant's business under paragraph 4(b)(iii). See, e.g., *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004) and *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003).

Hence, the Panel views these actions as constituting bad faith registration and use of the disputed domain name <elsanjuanhotel.com> in violation of paragraph 4(a)(iii), and also paragraphs 4(b)(iii) and 4(b)(iv) of the Policy.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel now GRANTS IN PART and DENIES IN PART the relief sought by the Complainant.

Specifically, the Panel orders the disputed domain name <elsanjuanhotel.com> transferred to the Complainant, but denies the Complainant's request to transfer the disputed domain name <elconquistadorresort.com>.

Peter L. Michaelson
Presiding Panelist

Michelle Brownlee
Panelist

Thomas Webster
Panelist

Dated: January 27, 2006

PARTIAL DISSENT BY PETER L. MICHAELSON

My learned co-panelists have concluded that, based on the record before us all, there is simply insufficient evidence, in their view, to support the Complainant's claim that it has acquired common law trademark rights in the term "El Conquistador Resort".

In light of a rather scant factual record adduced by the Complainant, which all members of the Panel have recognized as underwhelming, nevertheless, assessing the sufficiency of the evidence is an issue on which reasonable minds can and often do differ, as is the case here. To me, as scant as the factual evidence is, in my mind, it suffices -- just barely. I find that, even though the term "El Conquistador Resort" has been used by the Complainant for 6 years as against 56 years for "El San Juan Hotel", the remainder of the evidence before us as to the reputation and hence distinctiveness which the Complainant acquired through its continuous use of either term is essentially the same. Hence, I see no reason to differentiate in result between the two terms. Inasmuch as we found common law trademark rights existing in the term "El San Juan Hotel", I see no reason, given the facts before us, to divert from that view with respect to the term "El Conquistador Resort". While one term contains wording ("San Juan") that is arguably geographically descriptive and the other contains a generic word ("conquistador"), I am not convinced from the record before us that when either term is viewed in its totality, in light of its use by the Complainant and with respect to the specific hotel and resort services with which each term is respectively used as an alleged mark, that either term is completely incapable of serving as a trademark.

Thus, as a threshold matter, I find that the Complainant has common law trademark rights in the term "El Conquistador Resort", thus satisfying paragraph 4(a)(1) of the Policy. Given that, I also find that the Complainant has satisfied its burden of showing that the Respondent lacks legitimate rights and interests in the disputed domain name <elconquistadorresort.com>, under paragraph 4(a)(2) of the Policy, and has demonstrated bad faith use and registration of that name, under paragraph 4(a)(3) of the Policy, for essentially the same reasons all of us have found with respect to the disputed domain name <elsanjuanhotel.com> - though I see no practical difference in result here between 6 years of use for one term and 56 years of use for the other.

Moreover, where, as here, a respondent challenges the validity of a complainant's alleged mark in instances where the complainant has submitted proof of its use of the mark in connection with its goods or services along with the resulting reputation it has acquired but where the respondent's ultimate success is not immediately and undeniably clear from the record itself, then this panelist, in light of the summary nature of an ICANN URDP proceeding and the rather limited record that results, believes that such a challenge is best left to an appropriate adjudicatory forum where a rich factual record can be developed and the underlying factual and legal issues fully analyzed and assessed. This proceeding is not such a forum.

Hence, contrary to the decision of my co-panelists to deny the relief requested by the Complainant to transfer the name <elconquistadorresort.com>, I would grant it. Consequently, I dissent-in-part from the majority decision.

Peter L. Michaelson
Presiding Panelist

Dated: January 27, 2006