

NOMINET DISPUTE RESOLUTION SERVICE

DRS D05902

Decision of Independent Expert

Levantur S.A.

and

Sean Gerrity

1. Parties:

Complainant: Levantur S.A.
Address: Pza Mediterraneo, 5
Palma de Mallorca
Postcode: 07014
Country: ES

Respondent: Sean Gerrity
Address: 78 Church Hill Road
Mountsorrel
Loughborough

Postcode: LE12 7JF

Country: GB

2. Domain Name:

bahiaprincipe.co.uk

3. Procedural Background:

The Complaint was entered into the Nominet system on 24 July 2008 and was validated on 28 July 2008. Notification of the Complaint was sent to the

Respondent on 28 July 2008. The Respondent, on 14 August 2008, requested an extension of time to file a Response. A Response was received by Nominet electronically on 26 August 2008 which was sent to the Complainant that day. The Complainant lodged a Reply on 2 September 2008 which was sent that day to the Respondent. The Complaint was not settled at the mediation stage of the proceedings and the fee to obtain an independent Expert's decision under Nominet's Dispute Resolution Service Policy (the 'Policy') was paid to Nominet on or around 10 December 2008. Jon Lang was appointed as the independent Expert on 24 December 2008.

4. Outstanding Formal/Procedural Issues

Given the allegations in the Response, the Expert, through Nominet, made a Request for further information under Rule 13a of Nominet's Dispute Resolution Service Procedure. This Request was met with a number of responses all of which have been taken into account, as have the non-standard responses provided.

5. The Facts

The Complainant has, for many years, operated several hotels using the name BAHIA PRINCIPE and is the proprietor of trade marks including this name - Spanish mark BAHIA PRINCIPE CLUBS & RESORTS (no: 2149141) in Class 42 granted on 20 August 1998 and an identical US trademark (no: 76301754) also in Class 42 granted on 24 August 2003. Both trade marks therefore preceded the Respondent's registration of 'bahiaprincipe.co.uk' the disputed domain name (the 'Domain Name') on 27 July 2006.

The Complainant operates in the Spanish and International markets (under the name BAHIA PRINCIPE), for instance through its websites at www.bahia-principe.com and www.bahiaprincipe.com. It has 55 domain names incorporating the words 'bahia principe'.

The Respondent operates a booking service to the holiday and travel industry worldwide and has provided bookings for the Complainant's hotels.

6. The Parties' Contentions

The Complainant

- The Complainant's trade mark is well known and it has invested heavily in the promotion of its services through, inter alia, its websites. Many internet users find the Complainant's site by using the search words, 'bahia principe'.
- The terms 'bahia principe' is not the name of any geographical location.
- The Respondent has registered the Domain Name in bad faith with the intention of obtaining an economic advantage by attracting confused internet users who may think that the Respondent's site is the Complainant's official site.

- The Respondent must have known of the existence of the Complainant's trade mark and website.
- The Respondent has not been authorised to use the BAHIA PRINCIPE name.
- The Respondent does not have or use a name which is confusingly similar to the Domain Name.

The Respondent

- The Respondent makes a variety of points regarding geographic names, the manner of protection of trade marks, restrictions on free trade, the OFT and the Consumer Credit Act, Consumer Protection (Distance Selling) Regulations 2000 and the purchasing habits of consumers. None of these are relevant to proceedings under the Policy. What is relevant is the Respondent's contentions concerning his use of the Domain Name and the Complainant's consent to that use.
- The Respondent contends that he registered the Domain Name in good faith '*specifically in order to promote*' the Complainant's business '*as its distributor with the [Complainant's] full knowledge and consent.*'
- The Respondent states that it has been his sole purpose to promote the Complainant's business and has, to this end and at his own cost, developed a search optimisation strategy.
- The Respondent states that over the past two years he used the Domain Name without complaint and that the Complainant uses extensively internet booking services of the kind he operates.
- The Respondent's non-standard submission states '*..we were in possession of a signed contract with FULL PERMISSION to sell their product....*'

7. Discussion and Findings

General

Paragraph 2 of the Policy provides that, to be successful, a Complainant must prove on the balance of probabilities that:

- i) it 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 (as defined in paragraph 1 of the Policy).

Complainant's rights

Having reviewed the Complaint and the documentary material submitted with it, the Expert is satisfied that the Complainant has rights in the mark BAHIA PRINCIPE. Disregarding the generic '.co.uk' suffix, as of course an Expert is entitled to do, the BAHIA PRINCIPE mark is identical to the Domain Name. Moreover, the Complainant's registered trade marks which include the words 'CLUBS & RESORTS' (immediately following BAHIA PRINCIPE) are similar to the Domain Name. The Complainant has therefore satisfied the first requirement of paragraph 2 of the Policy.

Abusive Registration

Paragraph 1 of the Policy defines 'Abusive Registration' as a domain name which was either 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 which has been used in a manner which took unfair advantage of or was unfairly detrimental to the complainant's rights.

A non-exhaustive list of factors which may indicate that a domain name is an abusive registration is set out in paragraph 3 of the Policy. A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy.

The factors listed in paragraph 3 include where there are 'circumstances indicating that the Respondent is using the domain name in a way which has confused people or businesses into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant'. This is the essence of the Complaint.

The non-exhaustive list of countervailing factors set out in paragraph 4 of the Policy includes circumstances in which the domain name was registered as a result of a relationship between the parties and the respondent's holding of the domain name is consistent with an express term of a written agreement between them.

The Expert is satisfied that there is evidence to suggest that, absent an agreement between the parties, the Respondent is using the Domain Name in a way which could have confused or could likely confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant. Given that the contact details on the website to which the Domain Name resolves are to a holiday company not associated with the Complainant, there is clearly cause for concern on the part of the Complainant.

The issue that now therefore arises is the existence or otherwise of any agreement between the parties. The Respondent alleges that there is an agreement between the parties. As set out above:

- The Respondent contends that he registered the Domain Name in good faith '*specifically in order to promote*' the Complainant's business '*as its distributor with the [Complainant's] full knowledge and consent.*'
- The Respondent's non-standard submission states '*..we were in possession of a signed contract with FULL PERMISSION to sell their product....*'

(Emphasis added).

It was these allegations that led the Expert to make a Rule 13a Request under the DRS Procedure so that the Respondent would have a full opportunity to make his case. However, the Respondent has failed to produce any signed contract giving him permission to sell the Complainant's holidays (or to do anything else for that matter), or any other material that, for the purposes of Paragraph 4 of the Policy, would demonstrate that the Domain Name is not an Abusive Registration.

Accordingly the Expert finds, on a balance of probabilities, that the Respondent registered and/or has used the Domain Name for an abusive purpose and therefore that bahiaprincipe.co.uk constitutes, in the hands of the Respondent, an abusive registration.

8. Conclusion

Having found that the Complainant has rights in respect of a mark/registered mark which is identical/similar to the Domain Name and that the Domain Name in the hands of the Respondent is an abusive registration, the Expert determines that the domain name, bahiaprincipe.co.uk, should be transferred to the Complainant.

Signed
Jon Lang

Dated 17 February 2009