

DISPUTE RESOLUTION SERVICE

DRS 08358

Decision of Independent Expert

Levantur SA

and

Sean Gerrity

1. The Parties:

Complainant: Levantur SA
Address: Plaza del Mediterraneo No 5

Postcode: 07014 Palma de Mallorca
Country: Spain

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

Postcode: LE12 7JF
Country: United Kingdom

3. The Domain Names:

1. granbahiapricipetulum.co.uk
2. granbahiaprincipeambar.co.uk
3. granbahiapricipesamana.co.uk
4. bahiaprincipeambar.co.uk

4. Procedural History:

- 4.1 The Complainant lodged the complaint with Nominet on 5 March 2010. On 10 March 2010 Nominet contacted the Registrant and the Complainant's representative advising that a complaint had been received and requesting the Registrant to respond. The deadline for a response was stated as 31 March 2010.
- 4.2 No response was received by Nominet before the deadline of 31 March 2010, and Nominet issued a No-Response Notice on 1 April 2010.
- 4.3 The Complainant paid the fee for expert determination and on 20 April 2010 following a conflict check Margaret Briffa was appointed from the panel of experts.
- 4.4 To the best of my knowledge, there is no outstanding formal procedure in this dispute.

5. Factual Background

- 5.1 The Complainant is a Sociedad Anonima which commenced operations on 6 June 1977. It has a share capital of €425,294.50 and is part of the Pinero Group, which includes tour operators, hotels, clubs and resorts. The Complainant states that the first "Bahia Principe" hotel was opened in 1995 in San Juan in the Dominican Republic, and that there are now 15 luxury hotels.
- 5.2 The Respondent is a UK based individual. The Respondent registered the domain name granbahiaprincipetulum.co.uk (the "First Domain Name") on 20 April 2009; the domain name granbahiaprincipeambar.co.uk (the "Second Domain Name") on 19 August 2008; the domain name granbahiaprincipesamana.co.uk (the "Third Domain Name") on 19 August 2008; and the domain name granbahiaprincipeambar.co.uk (the "Fourth Domain Name") on 20 April 2009. Together they are referred to as "the Domain Names". The Complainant has stated in its submissions that the Respondent did not have any licence or authorization from the Complainant to register the Domain Names either on the dates of registration or otherwise. The Respondent, having not made a response, has not disputed this as a fact.
- 5.3 The Complainant is the owner of trade marks which incorporate the word "BAHIA PRINCIPE" (the "Trade Marks"). The Trade Marks are comprised of:
 - 5.3.1 Registered Spanish Trade Mark 2149141 for the word mark "BAHIA PRINCIPE CLUBS & RESORTS" in class 42, filed on 10 March 1998;
 - 5.3.2 Registered US Trade Mark 76301754 for the figurative mark "BAHIA PRINCIPE CLUBS & RESORTS" in class 42, filed on 20 August 2001;
 - 5.3.3 Registered Community Trade Mark 6143259 for the figurative mark "BAHIA PRINCIPE RESIDENCIAL GOLF RESORT" in classes 16, 36 and 41, filed on 27 July 2007; and
 - 5.3.4 Registered Community Trade Mark 5938411 for the figurative mark "BAHIA PRINCIPE RESIDENCIAL GOLF RESORT" in classes 16, 38 and 43, filed on 25 May 2007.
- 5.4 The Complainant has also registered numerous domain names and in asserting its rights in this matter has referred to bahiaprincipe.info; bahiaprincipe.travel; bahiaprincipe.com; bahiaprincipe.eu; bahia_principe.info; bahia_principe.org; bahia-principe.org; bahia-principe.biz; bahiaprincipe.biz; bahiaprincipe.es; bahiaprincipe.it; bahia-principe.co.uk; bahiaprincipe.fr; bahia-principe.tv; bahia-principe.ws; bahiaprincipe.tv; bahiaprincipe.us; bahiaprincipe.cc; bahiaprincipe.de; bahia_principe.es; and bahiaprincipe.co.uk (together, the "Complainant Domain Names").

- 5.5 The Complainant and Respondent have previously disputed the domain name bahiaprincipe.co.uk through the Nominet Dispute Resolution Process (DRS 05902). The Complainant was successful in that dispute and the domain name bahiaprincipe.co.uk was transferred to the Complainant as a result.
- 5.6 The Complainant was also successful in securing the transfer of the domain name bahiaprincipesanfeliipe.com through decision D2008-0777 of the WIPO Arbitration and Mediation Centre.
- 5.7 The Complainant has also raised further decisions against the Respondent, namely decision D2009-0277 of the WIPO Arbitration and Mediation Centre in relation to the complaint brought by Starwood Hotels and Resorts Worldwide, Inc, The Sheraton LLC and Sheraton International, Inc in respect of the domain names sheratondeirahotelandtowers.com and sheratonjumeirahbeachresort.com; and Nominet decision DRS 06935 in relation to the complaint brought by Starwood Hotels and Resorts Worldwide, Inc and Societe des Hotels Meridien in respect of the domain name lemeridiandubai.co.uk.

6. Parties' Contentions

- 6.1 The Complainant claims to own Rights (as defined in the Nominet DRS Policy - "the Policy") by reason of its ownership of the Trade Marks, its trading history and its use of the Complainant Domain Names.
- 6.2 The Complainant notes that the Trade Marks were all applied for prior to the registration dates of all of the Domain Names. The Complainant claims that the words "BAHIA PRINCIPE" should be considered as especially significant in the Trade Marks, as in each of the Trade Marks those words contain the distinctive part of the mark, the other parts being non-distinctive. In support of this position, the Complainant refers to the decision of the WIPO Administrative Panel in case D2007-0829 (Starwood Hotels & Resorts Worldwide, Inc, The Sheraton LLC, Sheraton International, Inc., Weston Motel Management L.P v Services LLC where it was held that:
- "The addition of geographic indicators, non-distinctive words or misspellings to said trademarks are not enough to avoid internet users' confusion between the Complainant's widely-known services and the disputed domain names"*
- 6.3 As indicated above the Complainant claims Rights arising from its use of the words "Bahia Principe". The Complainant makes reference to its own press releases and to its websites in support of this, as well as to prizes it has won through the provision of its services. The Complainant claims that the mark "BAHIA PRICIPE" is protected in Spain as a well known mark, as well as being so protected internationally under section 6bis of the Paris Convention.
- 6.4 The Complainant represents that it makes particular use of the Internet in marketing its hotel services and that it has invested large amounts in this regard. The Complainant also states that the term "Bahia Principe" does not refer to any geographical location and as such, it is solely entitled to license the use of the trade mark "Bahia Principe". The Complainant confirms that it has not given any authorisation for the Respondent to use the words "Bahia Principe" and makes reference to Nominet DRS decision DRS 05902 where the Respondent claimed to have a licence, but was unable to convince the expert that such claim was substantiated.

- 6.5 The Complainant also makes reference to the previous decisions of Nominet experts and the WIPO Arbitration and Mediation Centre panellists in respect of the Respondent's ownership of domain names, including decisions where domain names were transferred to the Complainant and to other hotel groups. The Complainant states that this shows a pattern of conduct by the Respondent through which the Respondent has wrongfully registered domain names in bad faith.
- 6.6 The Complainant argues that the Domain Names in the hands of the Respondent are Abusive Registrations for the purposes of the Policy. The Complainant argues that the Domain Names were registered by the Respondent in bad faith as the Respondent registered the Domain Names for the purpose of obtaining an unfair advantage by attracting confused users to the Respondent's websites. The Complainant notes that the content of the Respondent's websites at the Domain Names purport to offer hotel-related services and that, given the Complainant's reputation and use of the mark "BAHIA PRINCIPE", the use of the Domain Names by the Respondent will inevitably cause confusion.
- 6.7 The Complainant again refers to the decision in Nominet decision DRS 05902 in which the Respondent purported to be authorized by the Complainant but failed to produce evidence of the same in the form of executed agreements. The Complainant contends that this shows that the Domain Names were registered by the Respondent in bad faith. The Complainant also points to the fact that the decision in DRS D05902 was reached on 17 February 2009, with notification of the decision being made on 18 February 2009, and that the First Domain Name and the Fourth Domain Name were both registered after this on 18 April 2009. Having regard to this, and to the extensive use of the term "BAHIA PRINCIPE" in the marketing of the Complainant (including marketing online), the Complainant says it is difficult to imagine that the Respondent could not have known about the Complainant's use of the term "BAHIA PRINCIPE" when it registered the Domain Names.
- 6.8 The Complainant again makes reference to the previous decisions of Nominet and the WIPO Arbitration and Mediation Centre as evidence that the Respondent is engaged in a pattern of wrongfully registering domain names which the Complainant contends is evidence of the Respondent's bad faith in registering the Domain Names in the present case.
- 6.9 The Complainant finally asserts that the Respondent has used the Domain Names in bad faith. The Complainant again makes reference to the websites at the Domain Names at which the Respondent offers hotel-related services similar to those of the Complainant. The Complainant contends that such use is likely to confuse users and also to damage the reputation of the Complainant as (the Complainant contends) it is not possible to book a room using the Respondent's website and the telephone number given on the website does not yield a response when called.
- 6.10 The Respondent made no representations in response to the Complainant's claim.

7. Discussions and Findings

- 7.1 Paragraph 2a of the Policy states that a Respondent must submit to proceedings where a Complainant uses the Nominet DRS Procedure to assert that it has Rights in respect of a name or mark which is identical or similar to the Domain Name and the Domain Name in the hands of the Respondent is an Abusive Registration.
- 7.2 The term "Rights" is defined in paragraph 1 the Policy as rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.

7.3 Having regard to the submissions of the Complainant, including in particular its ownership of the Trade Marks and its evidence showing its use and goodwill in the mark "BAHIA PRINCIPE", I am satisfied that the Complainant owns such enforceable rights in the term "BAHIA PRINCIPE". I accept the argument of the Complainant that the term "BAHIA PRINCIPE" is the most distinctive verbal element of the Trade Marks and that accordingly the Domain Names, all of which contain the term "BAHIA PRINCIPE", would be perceived as similar by users of the websites at the Domain Names. I would also make reference to the Complainant's trading history, its marketing material showing use of the term "BAHIA PRINCIPE" and to the awards it has won as evidence that it is indeed well known for its use of the mark "BAHIA PRINCIPE" and that it owns rights as a result of such use.

7.4 The Policy defines abusive registration as follows:

Abusive Registration means 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

7.5 This definition is elaborated upon in paragraph 3 of the Policy which sets out factors which may be taken as evidence of an abusive registration. In this case, the provisions of paragraphs 3a.i.C (circumstances indicating that the Domain Names were acquired for the purposes of unfairly disrupting the business of the Complainant); 3a.ii (circumstances indicating that the Respondent is using the Domain Names in a way which is likely to confuse people into believing that the Domain Names are registered, operated or authorised by or otherwise connected with the Complainant); and 3a.iii (where the Complainant may demonstrate that the Respondent registered the Domain Names as part of a pattern of registrations where the Respondent is registrant of domain names corresponding to well known trade names or trade names in which the Respondent has no apparent rights) are all useful reference points in assessing whether the Domain Names are abusive registrations in the hands of the Respondent.

7.6 Having regard to the Complainant's submissions and to the decision in DRS 05902, it is clear that the Respondent was not authorised by the Complainant to make use of the term "BAHIA PRINCIPE" or to register the Domain Names. Having regard to the contents of the Respondent's websites at the Domain Names and to the history of the parties, it is clear that the Respondent is aware of the Complainant's use of the term "BAHIA PRINCIPE".

7.7 Having regard to the Rights of the Complainant, there is a clear risk that persons seeking the Complainant's services may do so by reference to the term "BAHIA PRINCIPE". Such persons, upon viewing the Domain Names themselves which all include the term "BAHIA PRINCIPE" as their most distinctive element, would assume that such websites are at the very least authorised by or connected to the Complainant. Accordingly, it is my view given the history of the parties that the Respondent is likely to have known at the time of the registration of Domain Names that such registration would cause disruption to the Complainant's business. It is also my view that such knowledge would have contributed greatly to the Respondent's purpose for registering the Domain Names which, given the circumstances I find was to cause disruption to the Complainant's business and to profit from confusion caused by such registration. Accordingly, I also find that by registering the Domain Names the Respondent created Abusive Registrations and the Domain Names being in the hands of the Respondent are Abusive Registrations.

7.8 It is also my view that at the time of the registration of the Domain Names there was, having regard to the Complainant's Rights, a likelihood of confusion arising from the Respondent's use of the Domain Names, with such confusion causing people to believe that there is a link between the websites at the Domain Names and the Complainant.

7.9 Finally, while the Complainant has not raised the presumption of an Abusive Registration by showing that the Respondent has been found to have made Abusive Registrations in 3 or more Nominet DRS cases in the 2 years preceding the date of filing this complaint, the Complainant has shown that the Respondent has been active in registering domains in which the Respondent has no apparent rights, with the Respondent's focus being particularly engaged with the hotel and catering industry. Accordingly, I am satisfied from the Complainant's submissions that the Domain Names were registered by the Respondent as part of a pattern of registrations where the Respondent registered domain names reflecting well known trade marks and trade names without the authorisation of the proper owner of such names and marks.

8. Decision

8.1 In light of the above, I find that the Domain Names in the hands of the Respondent amount to Abusive Registrations. I therefore determine that the Domain Names are to be transferred to the Complainant.

Margaret Briffa
May 2010