

DISPUTE RESOLUTION SERVICE

D00010921

Decision of Independent Expert

Accor

and

Mr Josef Novak

1. THE PARTIES:

Lead Complainant: Accor
110 avenue de France
Paris
75013
France

Respondent: Mr Josef Novak
House #28, room #601
Nan Ma Tou Lu1187
Pu Dong Zin Qu
Shanghai
200135
China

2. THE DOMAIN NAME(S):

mercure-uk.co.uk (“the Domain Name”)

3. PROCEDURAL HISTORY:

15 February 2012 16:13	Dispute received
16 February 2012 11:54	Complaint validated
17 February 2012 09:33	Notification of complaint sent to parties
12 March 2012 09:42	No Response Received
12 March 2012 09:43	Notification of no response sent to parties
19 March 2012 10:57	Expert decision payment received

4. FACTUAL BACKGROUND

- 4.1. The Complainant is a company based in France providing luxury hospitality services.
- 4.2. The Complainant has since at least 1983 run a business specialising in economic and mid-range hotels and is now a global business with over 4,200 hotels in 91 countries.
- 4.3. The Complainant is the owner of a number of trade marks worldwide including Community Trade Mark number 006277032 for a device including a stylised version of the word MERCURE, which was filed on 13 September 2007.
- 4.4. The Complainant is the owner of the domain names mercure.com, mercure.co.uk and mercure-uk.com. The domain names mercure.com, mercure.co.uk and mercure-uk.com point to a website which promotes the Complainant’s services and from which the Complainant’s services can be purchased. These domain names were registered on 16 April 1996, 26 January 2000 and 7 May 2007 respectively.
- 4.5. The Respondent is an individual who registered the Domain Name on 25 November 2009.
- 4.6. The Domain Name points to a parking page which contains sponsored links including sponsored links related to the hospitality sector.
- 4.7. The Complainant sent the Respondent a case-and-desist letter on 23 February 2010 in hard and electronic copy form requesting that the Domain

Name be cancelled but received no response despite three subsequent email reminders.

5. PARTIES' CONTENTIONS

The parties' contentions can be summarised as follows:

Complaint

5.1. The Complainant has rights in a name or mark which is similar or identical to the Domain Name because:

5.1.1. The Complainant has been using the name MERCURE since 1975 in connection with one of its hotel chains;

5.1.2. The Complainant is the owner of several trade marks around the world which include or consist of the mark MERCURE. These include Community Trade Mark number 006277032, for a device including a stylised version of the word MERCURE, which was filed on 13 September 2007;

5.1.3. The Complainant is the owner of the domain names mercure.com, mercure.co.uk and mercure-uk.com. These domain names were registered on 16 April 1996, 26 January 2000 and 7 May 2007 respectively;

5.1.4. The Domain Name incorporates the Complainant's trade mark in its entirety and differs only by the addition of ".co.uk" and "-uk".

5.2. The Domain Name is an Abusive Registration for the following reasons:

5.2.1. Due to the worldwide reputation of the Complainant's trade mark MERCURE including in China where the Respondent is located, the Respondent would have found out about the Complainant during the process of registering the Domain Name and would have been drawn to at least look at the Complainant's website;

5.2.2. The Respondent has therefore registered the Domain Name in bad faith;

- 5.2.3. Given the established goodwill and reputation that the Complainant has, both in the UK and worldwide, the Domain Name is likely to at least initially confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant;
- 5.2.4. The Respondent cannot be said to be making fair use of the Domain Name as he is not known by, affiliated with or trading under the name MERCURE or any similar name and there is no reasonable reason for the Respondent to have chosen to register the Domain Name other than to profit from the reputation and trade mark of the Complainant;
- 5.2.5. The Respondent did not respond to the Complainant's cease-and-desist letter despite several reminders. In line with the reasoning of WIPO panels it can therefore be assumed that the Respondent has no rights or legitimate interests in the Domain Name;
- 5.2.6. Given that the Domain Name is linked to a parking page which contains links to the Complainant's competitors it is self evident that the Respondent registered the Domain Name with the intention of making a profit from the Complainant's MERCURE trade mark.

Response

- 5.3. The Respondent has not submitted a Response.

6. DISCUSSIONS AND FINDINGS

Introduction

- 6.1. Paragraph 2(a) of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainant must prove, on the balance of probabilities, that:
 - i. *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
 - ii. *The Domain Name, in the hands of the Respondent, is an Abusive registration.*

6.2. As a first step I must therefore decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

6.3. The definition of Rights in the Policy is as follows:

Rights means rights enforceable by the Complainant whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.

6.4. This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.

6.5. The Complainant is the proprietor of a Community Trade Mark registration which includes the mark MERCURE and owner of the domain names mercure.com, mercure.co.uk and mercure-uk.com. These pre-date, some quite considerably, the Respondent's registration of the Domain Name.

6.6. The Complainant has also clearly used the mark MERCURE since 1975 in connection with its hotel chain.

6.7. As I have said the threshold for deciding whether or not a Complainant has Rights is a low one under Nominet's DRS and I have no doubt that, on the balance of probabilities, it is met in this case. I therefore conclude that, on the balance of probabilities, the Complainant does have Rights in the name or mark MERCURE and given that this differs from the Domain Name by only the first and second level suffix (which I must ignore) and the addition of "-uk" which is unlikely to add any real distinctive quality to the mark MERCURE I also include that, on the balance of probabilities the Complainant has Rights in a name or mark in which is identical or similar to the Domain Name.

Abusive Registration

- 6.8. Abusive Registration is defined in Paragraph 1 of the Policy as a domain name which either:
- i. *Was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
 - ii. *Has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.*
- 6.9. This definition allows me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.
- 6.10. Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may evidence that a Domain Name is an Abusive Registration and Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may evidence that the Domain Name is not an Abusive Registration.
- 6.11. The Policy provides for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.
- 6.12. In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant's Rights. In some cases where the name in which the Complainant has rights is particularly well known this will be fairly obvious and straightforward while in other cases where the name in which the Complainant has Rights is less well known and/or where there are other meanings or uses which can be made of the name this will require substantial evidence from the Complainant.
- 6.13. The position on knowledge has been summarised by Nominet's Appeal Panel in the earlier case of Verbatim Limited -v- Michael Toth DRS04331 and it is convenient to reproduce the following paragraphs from the Appeal Panel's decision here:

In this Panel's view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:

- a. *First, some knowledge of the Complainant and/or its brands/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.*
- b. *Secondly, "knowledge" and "intention" are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.*
- c. *Thirdly, "intention" is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy). The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.*
- d. *Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.*
- e. *Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.*

Accordingly, in the view of this Panel, for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name.

6.14. It is also worth referring to the decision of the Expert in Rileys.co.uk DRS04769 in this regard:

The onus is on the Complainant to make out its case. Is the Complainant so famous that the Respondent must have had the Complainant in mind when registering the Domain Name and for the abusive purposes alleged by the Complainant, namely to damage the Complainant's business or to extort money from the Complainant?

The Complainant has made no attempt to demonstrate to the Expert the fame of the Complainant's brand. There are no details of its business over the years, nothing in the way of sales figures or promotional or advertising material. Accordingly, the Expert is simply not in a position to make any inference adverse to the Respondent on that basis."

- 6.15. The first issue here is therefore one of knowledge. Did the Respondent know about the Complainant's Rights at the time it registered the Domain Name?
- 6.16. In its Complaint, the Complainant asserts that the Respondent simply must have known about it because the Complainant is internationally famous and has had a presence worldwide for more than 40 years. The Complainant operates 102 hotels in China (where the Respondent lives) of which some 12 use the brand MERCURE. It is not clear how long these have been in China but there is evidence that the Complainant has been in China (under one brand or another) for over 25 years and the Complainant's Community Trade Mark and domain names which include MERCURE certainly pre-date the Respondent's registration of the Domain Name quite comfortably.
- 6.17. Experts under Nominet's DRS have generally been willing to conclude that where the name or mark in which the complainant has Rights is very well known it is more likely than not that the respondent has registered the domain name in knowledge of that name or mark and in the absence of a good explanation to the contrary from the respondent this leads to a finding of Abusive Registration. Once such case is the decision of the Appeal Panel in the case of Thomas Cook UK Limited v. WhitleyBayUncovered (DRS00583). The relevant part of that decision is produced below.

"It seems to the Panel that, given the extent and renown of the Complainant's trade mark, it is stretching credulity beyond breaking point to suggest that the Respondent did not know of the trade mark in question when it sought registration of the Domain Names. Indeed, it is perhaps instructive that there is no suggestion in the communications from the Respondent that it was in fact,

unaware of the reputation of the Complainant's trade mark CLUB18-30. Although the Respondent is careful to suggest that the Complainant's proposed use of the Domain Names is open to question (referring to "our concept of the uncovered names") there is no suggestion that the club18-30 part of the Domain Names was chosen by it for any other reason than it was the Complainant's trade mark.

The Panel, therefore, finds that upon the balance of probabilities the Respondent was aware of the Complainant's trade mark at the time of registration of the Domain Names, and consciously chose to use that trade mark."

- 6.18. On the balance of probabilities the current case falls into this category. MERCURE is a well known mark for hotels and it is almost inconceivable that the Respondent did not know of the Complainant and its Rights generally when it acquired the Domain Name.
- 6.19. Further, it seems clear that and in the absence of any explanation to the contrary from the Respondent, that the only possible reason for the Respondent acquiring the Domain Names could be to take advantage of the substantial goodwill and reputation in the mark, MERCURE.
- 6.20. This conclusion is supported by the Respondent's current use of the Domain Name to point to a parking page listing sponsored links relating to hotels and hospitality services and in any event given this use it is clear that the Respondent has taken unfair advantage of the Complainant's Rights by deriving click through revenue through the use of the Domain Name.
- 6.21. It would normally fall to me to consider whether the Respondent has rebutted any presumption of an Abusive Registration, however there being no Response submitted there is nothing further to consider.
- 6.22. Therefore, on the balance of probabilities I am persuaded that the Domain Name is an Abusive Registration.

Remedy

- 6.23. The normal remedy which a successful complainant is granted in these cases is a transfer of the disputed domain name. The Complainant in this case has however sought the cancellation of the Domain Name. This is slightly odd

because it means the Domain Name will now be available to register by third parties albeit that such further registrations may prompt further proceedings under Nominet's DRS. However as the Complainant has asked for cancellation and that is the basis on which the case has been put to the Respondent I see no reason not to order cancellation of the Domain Name.

7. DECISION

- 7.1. For the reasons set out above I find, on the balance of probabilities, that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name, and that the Complainant has proved that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name be cancelled as requested by the Complainant.

Signed: Nick Phillips

Dated: 10 April 2012