

**DISPUTE RESOLUTION SERVICE**

**D00010976**

**Decision of Independent Expert**

**Six Continents Hotels, Inc.**

**and**

**CRWJ Company Ltd**

## **The Parties**

Complainant: Six Continents Hotels, Inc.

Online Brand Protection Coordinator

Three Ravinia Drive

Suite 100

Atlanta

Georgia

30346-2149

United States

Respondent: CRWJ Company Ltd

Suite 250 162-168 Regent Street

LONDON

LONDON CITY

W1B 5TD

United Kingdom

## **The Domain Name**

southendholidayinn.co.uk

## **Procedural History**

1. The brief chronology of the procedural history is as follows.
  - 27 February 2012 Dispute received.
  - 28 February 2012 Complaint validated.
  - 28 February 2012 Notification of complaint sent to the parties.
  - 21 March 2012 No Response Received.
  - 21 March 2012 Notification of no response sent to parties.
  - 22 March 2012 Expert decision payment received.

Stephen Bate was appointed as the Expert for the case on 23 March 2012 and on 9 April 2012 signed a written declaration that he was independent of each of the parties and that there were no facts or circumstances that were required to be disclosed in connection with that independence.

2. The Respondent has not served a Response and has not responded to any of the written communications sent to it by NOMINET.
3. I am satisfied that the Complaint including its documentary annexes was served in accordance with the requirements of the DRS Procedure.

### **Factual Background**

4. The Complainant is Six Continents Hotels, Inc. (“SCHI”). It is a member of the InterContinental Hotels Group, one of the leading hotel operators in the world, which includes those run under the well-known brand, HOLIDAY INN, which was launched in 1952. SCHI owns the domain names holidayinn.com and holidayinn.co.uk from which the online business of HOLIDAY INN is operated.
5. The Respondent registered the Domain Name on 15 September 2011. A web site is operated at that URL address, which advertises and offers for sale ‘Adult Fun Holidays’ in Southend.

### The Complaint

6. The Complaint may be summarised as follows, -
  - 6.1 SCHI is one of a number of companies collectively known as InterContinental Hotels Group, the world’s largest hotel group by number of rooms. Companies within the group own, manage, lease or franchise, through various subsidiaries, more

than 4,480 hotels and 658,000 guest rooms in nearly 100 countries and territories around the world.

- 6.2 The HOLIDAY INN brand is owned by SCHI and was founded in 1952 and is used today in connection with more than 3,300 hotels worldwide. SCHI owns approximately 1,425 registrations in approximately 185 countries or geographical regions for trade marks that consist of or contain the words HOLIDAY INN. These include the U.K. trade mark reg. no. B1,272,786 and the Community Trade Mark reg. no. 3,497,757.
- 6.3 SCHI owns the domain names holidayinn.com (registered on 21 March 1995) and holidayinn.co.uk (registered on 4 July 1997), which it uses in connection with an e-commerce website for its Holiday Inn hotels.
- 6.4 In *Six Continents Hotels, Inc. v. EDOCO LTD.*, DRS Case No. D00008824, the Expert found that “is clear that the complainant’s marks “HOLIDAY INN” and “HOLIDAY INN EXPRESS” are well known marks” and ordered the transfer of holidayinnexpress.co.uk. The HOLIDAY INN brand is world famous, as has been recognised by various UDRP decisions.
- 6.5 The Respondent registered the Domain Name on 15 September 2011 and is using it in connection with a website for an “Adult Travel Agency” advertising “adult fun holidays & short breaks” with “escorts”.
- 6.6 The only difference between the Domain Name and the HOLIDAY INN trade mark is the addition of the geographical designation “southend”. Such a difference does nothing to eliminate similarity. Thus, SCHI has Rights in respect of a name or mark which is identical or similar to the Domain Name.

- 6.7 The reference to Southend would lead people to conclude that this was a branch of Holiday Inn in that location.
- 6.8 In *Six Continents Hotels, Inc. v. GBT - Domains For Sale and Lease*, WIPO Case No. D2008-1309, there was an order for transfer of holidayinnphi.com. The Panel there found that “the combination of its trade mark with the name of the Phi Phi Islands, where one of the complainant’s hotels is located, would serve to add to such confusion rather than distinguish the mark”. In *Six Continents Hotels, Inc. v. Trasporto di Networ and Pro Intel*, WIPO Case No. D2004-0246 it was decided that geographical identifiers in a domain name “increase the likelihood of confusion between the domain names and the marks”.
- 6.9 The Domain Name is an Abusive Registration. SCHI relies on paragraph 3.a.ii. of the DRS Policy. The Respondent is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with SCHI. This is true because of the similarity of the Domain Name to SCHI’s HOLIDAY INN trade mark, even though the Respondent is offering “adult” services, which SCHI does not offer. There is clearly a potential for such confusion and the fact that SCHI has no evidence of actual confusion does not matter.
- 6.10 Further, as the Respondent is using the Domain Name to advertise hotel services (albeit “adult” hotel services), it is using the Domain Name to disrupt and/or compete with SCHI’s business. Such activity also renders the registration abusive.

6.11 Use of the Domain Name to promote services with inappropriate content strengthens the abusiveness yet further: see e.g. *InfraVision Limited v. Mike Moylan*, DRS Case No. D00006712.

6.12 SCHI sent a letter to the Respondent on 17 February 2012, requiring it to inform it by 20 February 2012 whether or not it would transfer the Domain Name. The Respondent did not respond to the letter and its failure to do so provides further evidence that the registration is abusive.

## **Discussion and Findings**

7. SCHI is required under subparagraphs 2a. and 2b. of the DRS Policy to prove to the Expert on the balance of probabilities that: -

7.1 it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

7.2 the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### Rights

8. By paragraph 1 of the Policy, -

*“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.”*

SCHI owns the UK trade mark numbered 1272786 in the words HOLIDAY INN in class 43, for catering services, hotel and motel services. It also owns the Community Trade Mark no: 003497757 for HOLIDAY INN in various classes including those concerned with hotels.

9. Addition of the place name to the Complainant's mark does not distinguish it. The rights are in a name or mark, namely HOLIDAY INN, which is similar to the Domain Name. Thus, SCHI has established that it has Rights.

#### Abusive Registration

10. Paragraph 1 of the Policy states, -

*“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 other 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.”*

Paragraph 3 of the Policy states -

#### ***“3. Evidence of Abusive Registration***

- a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:-*
  - i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
    - A....*
    - B. as a blocking registration against a name or mark in which the Complainant has Rights.; or*
    - C. for the purpose of unfairly disrupting the business of the Complainant.*

ii. *Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to, the Complainant.  
.....”*

11. The Expert makes the following findings. SCHI is one of a number of companies collectively known as InterContinental Hotels Group, the world’s largest hotel group by number of rooms. Companies within the group own, manage, lease or franchise, through various subsidiaries, more than 4,480 hotels and 658,000 guest rooms in nearly 100 countries and territories around the world.
12. SCHI owns the domain name holidayinn.com (registered on 21 March 1995) and holidayinn.co.uk (registered 4 July 1997), which it uses in connection with an e-commerce website for its Holiday Inn hotels. The HOLIDAY INN brand is owned by SCHI and was launched in 1952 and is used today in connection with more than 3,300 hotels worldwide. SCHI owns approximately 1,425 registrations in approximately 185 countries or geographical regions for trade marks that consist of or contain the words HOLIDAY INN.
13. The Respondent registered the Domain Name on 15 September 2011 and is using it in connection with a web site advertising ‘adult’ holidays or breaks in Southend. SCHI has produced three pages from the web site operated at the Domain Name, taken on 17 February 2012. The home page identifies “Southend Holiday Inn” as “part of CRWJ Company Ltd .... 162-168 Regent Street, LONDON, W1B 5TD” and features a large picture of a beach, headed by the following words, -

“SOUTHEND HOLIDAY INN  
UNITED KINGDOM  
PRESENTS ADULT FUN HOLIDAYS OR SHORT BREAKS  
SEEKING DISCREET INDIVIDUALS 18 OR OVER”,



with a drawing of an inviting blonde lady dressed in swimwear under a pair of jeans with the zip undone. Other pages of the web site feature an ‘Adult Travel Agency’ with a range of six ‘packages’ numbered ‘A’ to ‘F’ each showing a woman wearing a very short black latex dress in a provocative pose, with a range of prices. Another page of the web site features ‘package A’. For £300 the customer is offered a range of services, including one night’s stay at in a ‘luxury hotel room’, ‘a personal masseuse or escort of your choice’ and a ‘free tour round Southend if required’.

14. By letter dated 17 February 2012 addressed and sent to the Respondent by email by the GigaLaw Firm (“GigaLaw”) on behalf of SCHI, the Respondent was asked to respond by 20 February 2012 stating whether or not it was prepared to transfer the Domain Name to SCHI in view of the matters of complaint set out in that letter. One of the three email addresses to which the letter was sent was [southendholidayinn@live.co.uk](mailto:southendholidayinn@live.co.uk). There was no reply to this letter.
15. The Appeal Panel in DRS 04331 *verbatim.co.uk* determined that, for a 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 or at commencement of an objectionable use of the Domain Name.”*

I adopt this approach, noting what was observed by the Appeal Panel in DRS 03733 *mercero.co.uk*, that the requirement of prior knowledge on the part of the registrant is ordinarily required.

16. HOLIDAY INN or ‘Holiday Inn’ is a brand that is so well-known that the Respondent must have heard of it before choosing the Domain Name. Further, no reason has been put forward as to why the Respondent chose to use the words ‘holidayinn’ as part of a Domain Name used to host a web site offering

hotel services, if not to suggest a connection with the Holiday Inn brand. It is also likely that the Respondent received both the letter from GigaLaw and the complaint and chose to ignore both. In those circumstances it is appropriate to draw the inference that there is no other reason for the Respondent's choice of the Domain Name. Had there been an innocent reason for that choice, it is likely that the Respondent would have advanced it. Thus, the Respondent was aware of the brand 'Holiday Inn' at the date of registration.

17. Even though there is no evidence of actual confusion, it is likely that persons looking for a Holiday Inn in Southend will be misled into believing that the business operated at the web site [www.southendholidayinn.co.uk](http://www.southendholidayinn.co.uk) is connected to, and authorised by, the owner of the brand 'Holiday Inn'. There will be "initial interest confusion" as a result of any Google or like search using the words 'Holiday Inn' where the word "Southend" is used. Any visitor to the web site at that address would be further misled into believing that the holiday services advertised were being offered by a business, i.e. CRWJ Company Ltd, which was connected to the Holiday Inn business and brand.
18. Thus, the Respondent is using the Domain Name in a way that is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to, the Complainant for the purposes of paragraph 3.a.ii. of the DRS Policy.
19. None of the material factors in paragraph 4 of the DRS Policy (matters which may be demonstrated in the Response to show that registration is not abusive) is present. Further, the targeting and use of the Holiday Inn brand to promote the Respondent's adult breaks advertising sexual services, services which SCHI does not offer, tends to the impairment of the HOLIDAY INN brand in view of what many would regard as the disreputable nature of those services, so rendering the registration even more abusive.
20. Therefore, the Expert finds that the Domain Name in the hands of the Respondent is an Abusive Registration.

## **Decision**

21. The Complainant has Rights in a name or mark, which is similar to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert therefore determines that the Domain Name 'southendholidayinn.co.uk' be transferred to the Complainant.

**Signed .....**

**Dated 9 April 2012**

**STEPHEN BATE**