

DECISION

Accor v. Gary Weber a/k/a Gary
Claim Number: FA0707001039728

PARTIES

Complainant is **Accor**, (“Complainant”) represented by **Nathalie Dreyfus**, of **Cabinet Dreyfus et associes**, 25 rue Louis Le Grand, 75002, Paris, France. Respondent is **Gary Weber a/k/a Gary**, (“Respondent”), xxx Kandagar, Kandahar 12345, Afghanistan.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**sofitel-hotel.us**>, registered with **Estdomains, Inc.**

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on July 17, 2007; the Forum received a hard copy of the Complaint on July 25, 2007.

On August 1, 2007, Estdomains, Inc. confirmed by e-mail to the Forum that the <**sofitel-hotel.us**> domain name is registered with Estdomains, Inc. and that Respondent is the current registrant of the name. Estdomains, Inc. has verified that Respondent is bound by the Estdomains, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the U. S. Department of Commerce’s usTLD Dispute Resolution Policy (the “Policy”).

On August 10, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of August 30, 2007 by which Respondent could file a Response to the Complaint, was transmitted to Respondent in compliance with Paragraph 2(a) of the Rules for usTLD Dispute Resolution Policy (the “Rules”).

Having received no Response from Respondent, the Forum transmitted to the parties a Notification of Respondent Default.

On September 6, 2007, pursuant to Complainant’s request to have the dispute decided by a single-member Panel, the Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the “Panel”) finds that the Forum has discharged its responsibility under Paragraph 2(a) of the Rules. Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the Policy, the Rules, the Forum’s Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any Response from Respondent.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES’ CONTENTIONS

A. Complainant

Trademark/Service Mark Information: usTLD Rule 3(c) (viii).

- SOFITEL, International Trademark n° 406255, filed on April 18, 1974, renewed and covering goods and services in all classes.
- SOFITEL, International Trademark n° 614992, filed on October 29, 1993, renewed and covering goods and services in classes 35, 36 and 37.
- SOFITEL, International Trademark n° 642172, filed on August 31, 1995 and covering goods and services in classes 35, 36, 37 et 42.
- HOTEL SOFITEL EXCLUSIVE CARD, International Trademark n° 719547, filed on August 16, 1999 and covering goods and services in class 42.
- SOFITEL ACCOR HOTEL & RESORTS, International Trademark n° 779873, filed on February 5, 2002 and covering goods and services in classes 16, 35, 42 et 43
- WORLD AND WORLD BY SOFITEL, International Trademark n° 786222, filed on April 26, 2002 and covering goods and services in classes 16 and 43.
- SOFITEL, US trademark n°79015763 filed on August 26, 2005 and covering services in classes 39 and 43.
- SOFITEL ACCOR HOTELS AND RESORTS, United States trademark n°78107333 filed on February 7, 2002 and covering services in classes 35 and 43.
- HOTEL SOFITEL EXCLUSIVE CARD, United States trademark n°75597827 filed on November 30, 1998 and covering services in class 42.

FACTUAL AND LEGAL GROUNDS

This Complaint is based on the following factual and legal grounds: usTLD Rule 3(c) (ix).

The domain names are identical or confusingly similar to a trademark or service mark for which the Complainant has rights

The domain name <sofitel-hotel.us> reproduces entirely the Complainant's trademarks SOFITEL.

It is well established that the mere adjunction of the usTLD “.us” is not a distinguishing feature and does not change the likelihood of confusion merely because it is necessary for the registration of the domain name itself. The extension “.us” is not taken into consideration when examining the identity or similarity between the previous marks and the disputed domain name.

Additionally, the mere addition of the term “hotel” leads people to think that these domain names are specific to the hotels of Sofitel and are insufficient to avoid any confusion. The term ‘hotel’ actually increases the confusion because the term falls under the services provided by the Complainant. The addition of, for instance, the generic word “hotel” to a trademark only suggests that the services and goods marketed are those of the trademark holder. As a result, it is obvious that the disputed domain name <sofitel-hotel.us> is strictly identical or at least confusingly similar to the numerous trademarks registered by the Complainant, and implies a high risk of confusion, as a consumer may think that this domain directly refers to the Complainant's services.

The Respondent has no rights or legitimate interests in respect of the domain name;

The Respondent is not affiliated with the Complainant in any way. The Complainant has not authorized the Respondent to use and register its trademark and service marks, or to seek the registration of any domain name incorporating said mark.

Furthermore, the Respondent has no prior rights or legitimate interest in the domain name. The Respondent never used the term “SOFITEL” in any way before or after the Complainant started their business.

The Respondent is not known under the name “SOFITEL” or any similar term.

The conduct of the Respondent is merely a parasitical behavior. The Respondent is not making any legitimate non-commercial or fair use of the domain names, as the disputed domain names redirect internet browsers to a pornographic webpage titled ‘VIDEO PORTAL’.

Moreover, the strict reproduction of the well-known trademark “SOFITEL” constitutes an obvious intent to divert Internet browsers.

In fact, since the domain name in dispute is so identical to the famous trademarks of the Complainant, the Respondent could not reasonably pretend it was attempting to conduct a legitimate activity.

Furthermore, Respondent did not answer to the Complainant's email on July 12, 2007, and cease and desist letter on July 12, 2007 and did not demonstrate any right or legitimate interest regarding the disputed domain name (see Annex 4).

The domain name was registered and is being used in bad faith.

Registration in bad faith.

The name "SOFITEL" does not have any meaning in English. The Respondent had no reason to choose these domain names other than profiting from the reputation of the Complainant.

With regard to registration in bad faith, it seems obvious that the Respondent knew or must have known the trademark "SOFITEL" at the time it registered the domain name. It seems quite difficult to sustain that the Respondent was not aware of the existence of the Complainant at the time it registered the domain names. The Respondent had the Complainant in mind while registering the domain names in dispute because of the addition of 'hotel' to the domain names. The Respondent does not dispute having knowledge of the Complainant's trademarks.

Use in bad faith.

The Respondent is trading on the goodwill existing in Complainant's famous service mark to intentionally attract Internet users to Respondent's website for purposes of commercial gain. This constitutes evidence of bad faith use and registration. Thus, the Respondent registered and uses the disputed domain names and is perfectly aware that it infringes upon the Complainant's rights.

The fact that both disputed domain names 'click-through' to 'VIDEO PORTAL' a pornographic web page acts as evidence of use in bad faith because the Respondent is attempting to use the popularity of the Complainant in their favor.

Moreover, the letter sent by registered mail and email to the Respondent's address mentioned on the Whois database of the disputed domain name was never responded to. In addition, the address provided by Respondent is false. Even though there is no express evidence proving that invalidity of this address, a reasonable person can assume that the address 12345 Kandagar in Afghanistan is implicitly invalid. Additionally, the phone number provided by the respondent is 123456, which is obviously an invalid number.

Finally, the fact that the disputed domain names divert web browsers to a pornographic website is evidence of bad faith. Allowing the continued use of the domain names by the Respondent tarnishes the image of the Complainant and has the potential to cause serious economic damage. Additionally, the reputation of 'SOFITEL' as a classy hotel chain

suffers when the hotel chain is associated with the sale and distribution of pornographic material. Therefore, the actions of the Respondent illustrate that he knowingly uses the 'SOFITEL' trademarks to increase traffic on 'VIDEO PORTAL' a pornographic website that is in no way associated with the Complainant.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant Accor holds a trademark registration with the United States Patent and Trademark Office ("USPTO") for the SOFITEL mark (Reg. No. 3,159,101 issued October 17, 2006). Complainant also holds several international trademark registrations for the SOFITEL pursuant to the Madrid Protocol (e.g., Reg. No. 406,255 issued April 18, 1974 and Reg. No. 614,992 October 29, 1993). Complainant is using the SOFITEL mark in connection with its international chain of hotel goods and services.

Respondent registered the <sofitel-hotel.us> domain name on June 4, 2007. Respondent is using the disputed domain name to redirect Internet users to Respondent's website entitled "Video Portal," which displays adult-oriented video content.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

In view of Respondent's failure to submit a Response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to Paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to Paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and

(3) the domain name has been registered or is being used in bad faith.

Given the similarity between the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and the usTLD Policy, the Panel will draw upon UDRP precedent as applicable in rendering its decision.

Identical and/or Confusingly Similar

Complainant asserts rights in the SOFITEL mark through registration of the mark with the USPTO. Complainant also holds several international registrations pursuant to the Madrid Protocol. The Panel finds Complainant has established rights in the SOFITEL mark pursuant to Policy ¶4(a)(i). *See Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) (“Registration of the NASAL-AIRE mark with the USPTO establishes Complainant's rights in the mark.”); *see also Vapiano AG v. Sex-Escort*, FA 829126 (Nat. Arb. Forum Dec. 13, 2006) (“Complainant has registered the VAPIANO mark...with the Madrid Protocol for the International Registration of Marks. These trademark registrations sufficiently demonstrate Complainant’s rights in the mark pursuant to Policy ¶4(a)(i).”).

Respondent’s <sofitel-hotel.us> domain name is confusingly similar to Complainant’s SOFITEL mark as it uses the mark in its entirety and simply attaches the descriptive word “hotel” with a hyphen to the mark. Complainant uses the SOFITEL mark primarily in connection with its international chain of hotels, including those in the United States. Therefore, the Panel finds the addition of the descriptive word hotel and the use of a hyphen does not sufficiently alter the mark to avoid a finding of confusing similarity. The Panel finds Respondent’s <sofitel-hotel.us> domain name is confusingly similar to Complainant’s SOFITEL mark under Policy ¶4(a)(i). *See Marriott Int’l, Inc. v. Café au lait*, FA 93670, (Nat. Arb. Forum Mar. 13, 2000) (finding that the respondent’s domain name <marriott-hotel.com> is confusingly similar to the complainant’s MARRIOTT mark); *see also Sports Auth. Mich. Inc. v. Batu 5*, FA 176541 (Nat. Arb. Forum Sept. 23, 2003) (“The addition of a hyphen to Complainant's mark does not create a distinct characteristic capable of overcoming a [UDRP] Policy ¶4(a)(i) confusingly similar analysis.”).

Additionally, the addition of the country code “.us” is not a distinguishing factor. As panels have previously held, this Panel finds the addition of a country code is not sufficient to negate the confusingly similar aspect of the disputed domain name to the mark under Policy ¶4(a)(i). *See Mattel, Inc. v. Unknown*, FA 490083 (Nat. Arb. Forum July 11, 2005) (“The domain name is identical to the trademark “Barbie”, as it uses the trademark in its entirety. The only difference is the addition of the country code “us” which for this purpose is insufficient to distinguish the domain name from the trademark.”); *see also Tropar Mfg. Co. v. TSB*, FA 127701 (Nat. Arb. Forum Dec. 4, 2002) (finding that since the addition of the country-code “.us” fails to add any distinguishing characteristic to the domain name, the <tropar.us> domain name is identical to the complainant’s TROPAR mark).

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Complainant asserts Respondent does not have rights or legitimate interests in the <sofitel-hotel.us> domain name. In the instant proceeding, Complainant's submission establishes a *prima facie* case, which shifts the burden to Respondent to show he has rights or legitimate interests in the disputed domain name under Policy ¶4(a)(ii). *See Towmaster, Inc. v. Hale*, FA 973506 (Nat. Arb. Forum June 4, 2007) ("Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under [UDRP] Policy ¶4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests."); *see also Washington CeaseFire v. Private Registration*, FA 985159 (Nat. Arb. Forum June 27, 2007) ("Once Complainant makes a *prima facie* case in support of its allegations, the burden shifts to Respondent to show that it does have rights or legitimate interests pursuant to [UDRP] Policy ¶4(a)(ii).").

The Panel may assume Respondent has no rights or legitimate interests here because Respondent failed to respond to the Complaint. *See Am. Online, Inc. v. AOL Int'l*, D2000-0654 (WIPO Aug. 21, 2000) (finding no rights or legitimate interests where the respondent fails to respond); *see also Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, D2000-1221 (WIPO Dec. 4, 2000) (finding that the respondents' failure to respond can be construed as an admission that they have no legitimate interest in the domain names). However, the Panel will review all available evidence before determining whether the Respondent has rights or legitimate interests in the mark under Policy ¶4(c).

While Complainant has established rights in the SOFITEL mark, Respondent has failed to offer any evidence which demonstrates Respondent holds a service mark or trademark in the <sofitel-hotel.us> domain name. Therefore, the Panel finds Respondent has failed to establish rights in the mark under Policy ¶4(c)(i). *See Meow Media Inc. v. Basil*, FA 113280 (Nat. Arb. Forum Aug. 20, 2002) (finding that there was no evidence that the respondent was the owner or beneficiary of a mark that is identical to the <persiankitty.com> domain name); *see also Pepsico, Inc. v. Becky*, FA 117014 (Nat. Arb. Forum Sept. 3, 2002) (holding that because the respondent did not own any trademarks or service marks reflecting the <pepsicola.us> domain name, it had no rights or legitimate interests pursuant to Policy ¶4(c)(i)).

Respondent is using the <sofitel-hotel.us> domain name to redirect Internet users to Respondent's website, which displays adult-oriented video content. Such use by Respondent to display adult-oriented material is not a use in connection with a *bona fide* offering of goods or services under Policy ¶4(c)(ii), or a legitimate noncommercial or fair use under Policy ¶4(c)(iv). *See Target Brands, Inc. v. Bealo Group S.A.*, FA 128684 (Nat. Arb. Forum Dec. 17, 2002) (finding that use of the <targetstore.net> domain name to redirect Internet users to an adult-oriented website did not equate to a *bona fide*

offering of goods or services under UDRP ¶4(c)(i), or a legitimate noncommercial or fair use of a domain name under UDRP ¶4(c)(iii); *see also Dipaolo v. Genero*, FA 203168 (Nat. Arb. Forum Dec. 6, 2003) (“Diversion to [adult-oriented content] is not a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the domain name pursuant to [UDRP] Policy ¶4(c)(i) and (iii).”).

Finally, Respondent has offered no evidence and no evidence is present in the record to indicate Respondent is commonly known by the <sofitel-hotel.us> domain name. Respondent’s WHOIS information identifies Respondent as “Gary Weber a/k/a Gary.” Therefore, the Panel finds Respondent has failed to establish rights or legitimate interests in the disputed domain name under Policy ¶4(c)(iii). *See Am. W. Airlines, Inc. v. Paik*, FA 206396 (Nat. Arb. Forum Dec. 22, 2003) (“Respondent has registered the domain name under the name ‘Ilyoup Paik a/k/a David Sanders.’ Given the WHOIS domain name registration information, Respondent is not commonly known by the [<awvacations.com>] domain name.”); *see also Wells Fargo & Co. v. Onlyne Corp. Services11, Inc.*, FA 198969 (Nat. Arb. Forum Nov. 17, 2003) (“Given the WHOIS contact information for the disputed domain [name], one can infer that Respondent, Onlyne Corporate Services11, is not commonly known by the name ‘welsfargo’ in any derivation.”).

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith

Respondent has registered and is using the <sofitel-hotel.us> domain name, which is confusingly similar to Complainant’s SOFITEL mark, to redirect Internet users to Respondent’s website entitled “Video Portal,” which displays adult-oriented video content. The Panel finds Internet users seeking Complainant’s hotel goods and services under the SOFITEL mark may become confused as to Complainant’s affiliation with Respondent’s website. Presumably, Respondent is profiting from this confusion through click-through fees. Therefore, the Panel finds Respondent’s use of the <sofitel-hotel.us> domain name constitutes bad faith registration and use pursuant to Policy ¶4(b)(iv). *See Qwest Comm’ns Int’l Inc. v. Ling Shun Shing*, FA 187431 (Nat. Arb. Forum Oct. 6, 2003) (“Respondent has attempted to commercially benefit from the misleading <qwestwirless.com> domain name by linking the domain name to adult oriented websites, gambling websites, and websites in competition with Complainant. Respondent’s attempt to commercially benefit from the misleading domain name is evidence of bad faith pursuant to [UDRP] Policy ¶4(b)(iv).”); *see also Associated Newspapers Ltd. v. Domain Manager*, FA 201976 (Nat. Arb. Forum Nov. 19, 2003) (“Respondent’s prior use of the <mailonsunday.com> domain name is evidence of bad faith pursuant to [UDRP] Policy ¶4(b)(iv) because the domain name provided links to Complainant’s competitors and Respondent presumably commercially benefited from the misleading domain name by receiving ‘click-through-fees.’”).

Finally, the Panel holds Respondent's use of the <sofitel-hotel.us> domain name to redirect Internet users to an adult-oriented website is in and of itself evidence of bad faith registration and use under Policy ¶4(a)(iii). See *Wells Fargo & Co. v. Party Night Inc.*, FA 144647 (Nat. Arb. Forum Mar. 18, 2003) (finding that the respondent's tarnishing use of the disputed domain names to redirect Internet users to adult-oriented websites was evidence that the domain names were being used in bad faith); see also *Microsoft Corp. v. Horner*, D2002-0029 (WIPO Feb. 27, 2002) (holding that the respondent's use of the complainant's mark to post adult-oriented photographs and to publicize hyperlinks to additional adult-oriented websites evidenced bad faith use and registration of the domain name).

The Panel finds Policy ¶4(a)(iii) satisfied.

DECISION

Having established all three elements required under the usTLD Policy, the Panel concludes relief shall be **GRANTED**.

Accordingly, it is Ordered the <sofitel-hotel.us> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: September 17, 2007

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