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BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

In The Matter of

LATEROOMS LIMITED

Peninsula Building
Victoria Place
Manchester
United Kingdom
M4 4 FB

Complainant

Versus.

LIN YANXIAO

Room 704 , No 63
Nanhua Road
Shiquiao Town, Panyu District
Guangzhou, Guandong
510000, China

Respondent

Harini Narayanswamy

The Parties

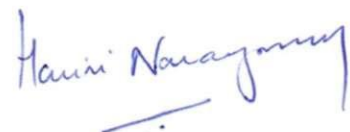
The Complainant is Laterooms Limited of Manchester United Kingdom and is represented in these proceedings by Ms. Ramya Kumar of Safenames Ltd., U.K. The Respondent is Lin Yanxiao of Guangzhou China.

1. The Domain name, Registrar and Policy

The present Arbitration proceeding pertains to a dispute regarding the domain name <laterooms.in> (hereinafter referred to as the disputed domain name). The registrar for the disputed domain name is 1APi GmbH (Registrar). The date on which the disputed domain name was registered is May 26, 2013. The Arbitration proceedings are conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy" or "Policy"), and the INDRP Rules of Procedure (the "Rules").

2. Procedural History

The Arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules. The Arbitrator received the Complaint from the .IN registry on August 24, 2016 and on August 25, 2016 and transmitted by email a notification to the Respondent, calling upon the Respondent to make a written representation in these arbitration proceedings within twenty-one days of the communication. Copies of the said notification were sent to other interested parties to the dispute under the INDRP Rules. The Respondent sent no reply to the said communication.



Factual Background

The Complainant runs an online hotel booking service and owns the trademark LATEROOMS. The Complainant has obtained trademark registrations for the said mark in various jurisdictions and has provided details of its trademark registrations:

Registration / Application No.	Country	Date of Registration	Trademark	Class
899116	International	01.08.2006	LATEROOMS (Device)	43
004880969	European Union	08.02.2007	LATEROOMS (Device)	43
00002216277	U.K	09.06.2000	LATEROOMS (Device)	42
004864955	European Union	20.04.2007	LATEROOMS	43
010492651	European Union	27.06.2012	LATEROOMS (Device)	43

The Complainant owns a number of domain names that it uses in connection with its business including the domain name <laterooms.com> that was registered in the year 1999. The Complainant has submitted as evidence, a list of its domain names.

The Respondent is located in China as per the registration record. The disputed domain name was registered on May 26, 2013. The landing page of the disputed domain name has sponsored pay per click links.

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There is not much information about the Respondent, who did not participate in these proceedings. The hard copy of the Complaint sent to the Respondent's address, was returned unserved by the courier company¹, stating the reason that the party did not accept the shipment. There was no reply or response from the Respondent to the email notification sent by the Arbitrator on August 25, 2016.

3. Parties contentions

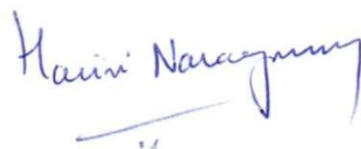
A. Complainant's Submissions

The Complainant states it is a private limited company of the United Kingdom. It was duly incorporated in the year 1999, under the name "start.co.uk PLC". Subsequently, on May 31 2000, the name was changed to "Laterooms Limited". The Complainant states its hotel online reservation business offersto its customers, discounted accommodation in the U.K, Europe, India and throughout the world. The Complainant states it operates its online business through its website www.laterooms.com, and the domain name <laterooms.com > was registered on July 23, 1999. The Complainant adds that it was set up by three brothers and it was a pioneer for online business in the U.K.

The Complainant alleges that its business was originally a directory listing of hotels. However, from the year 2002, users of its website could book hotels online. The Complainant claims that it has a listing of about 1,50,000 hotels from around the world on its website.

In December 2006, the Complainant states, it was acquired by First Choice Holidays PLC. In September 2007, First Choice Holidays PLC merged with

¹ DTDC Courier shipment number AWB No.: N97318222



TUI Travel PLC to form the TUI Travel Group. In October 2015, Cox and Kings, an Indian Company, acquired the Complainant and later sold it to Malvern Enterprises, a unit of the Cox and Kings group. Presently, it is partly owned by Cox and Kings and an unnamed private equity investor states the Complainant.

The Complainant argues that the disputed domain name is identical to its mark LATE ROOMS as the mark is used in its entirety. The Complainant states it has created the mark, coined and conceived it in 1999 and has been using it in commerce since then. Consequently, the Complainant claims it has common law rights apart from its registered rights in the mark. The Complainant has provided evidence of its registered trademark rights, that include word and device marks. One of its device marks is a combination of the words "Laterooms .com" in a colored box. The Complainant contends that its mark is well known and its trademark registrations are publicly known information. Further, the term "Laterooms" is used by the Complainant as a trade name, corporate name, business name, trading style and trademark throughout the world.

The Complainant states the Respondent has no rights or legitimate interests in the domain name for reasons that: The Respondent is not commonly known by the disputed domain name. The Respondent is an individual named Lin Yanzhao of China and the Complainant believes that the Respondent does not own or run any business by the name "Laterooms". The Complainant further states that the Respondent is a holder of a large portfolio of over thousand domain names that use well known trademarks belonging to others.

The Complainant contends that its mark is well known and has a trans border reputation and it has invested in advertising the mark. The Complainant has submitted online news articles as evidence of its reputation. The Complainant

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states there are several search features provided on its website for its customers. The Complainant states its website laterooms.com can be accessed from India and is popular in India. It contends that it has established a virtual presence in India and its Indian customers are able to view prices in Indian rupees on its website.

The Complainant relies on a recent Delhi High Court ruling in *Toyota Jidosha Kabushiki Kaisha v. Deepak Mangal and others*, dated July 8, 2016 CS (OS) No. 2490/ 2009 & I.A 14981 / 2014 in support of its contention that even if a trademark has not been first registered or used in India, but if it has been used and registered globally, it is sufficient to prove it is a well known trademark. The Complainant contends its mark is a well known mark as defined under 2 (1) (zg) of the Trademark Act 1999, as the Complainant has used the mark for almost eighteen years and the mark is a coined word that has been used only the Complainant worldwide. The Complainant states it is the winner of the 2012 and 2013 British Travel Awards and has provided evidence. The Complainant states it was also in the news, when it was acquired by the Indian company Cox and Kings.

The Complainant states that the Respondent has not used the disputed domain name to develop a website since its registration in 2013, but has merely placed pay per click links. The Complainant states that a search for the disputed domain name automatically diverts users to booking.com or trivago.co.uk. The Complainant argues that the Respondent is therefore making unfair commercial use of the disputed domain name by diverting users to its competitors.

The Complainant argues that the disputed domain name has been registered and is being used in bad faith and the "Whois" record shows the disputed domain name is listed for sale on the SEDO parking site. The Complainant further states

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that has since 2014 the disputed domain names has been offered for sale and provides evidence of this from the “Internet Archive Wayback Machine”.

The Complainant states that it had sent a cease and desist notice to the Respondent on November 9, 2015, to which there was no response and the disputed domain name was not delisted. The Complainant states that it has over two thousand bookings for travels to and from India since 2013 and these bookings have generated substantial revenue for the Complainant. The Complainant adds that the Respondent’s domain name causes confusion among its customers and it has prevented the Complainant from registering its domain name in the “.in” space. The use of pay per click links by the Respondent and redirecting Internet users to the Complainant’s competitors, demonstrates the Respondent’s bad faith and the Complainant requests for the transfer of the disputed domain name.

Respondent’s Submissions

The Respondent did not respond in these proceedings.

Discussion and Findings

The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, and
- (ii) The Respondent has no rights or legitimate interests in respect of the domain name; and

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- (iii) The Respondent's domain name has been registered or is being used in bad faith.

Identical or Confusingly Similar

The first element requires a two step analysis: First, whether the Complainant has rights in the trademark in question and second, whether the disputed domain name is identical or confusingly similar to the mark in which the Complainant has rights.

Taking up the first part, whether the Complainant has rights in the LATEROOMS trademark: The Arbitrator notes that the Complainant has provided evidence of its registered trademarks and has an international trademark registration for the mark under class 43 bearing number 899116, dated August 1, 2006, a U.K. trademark registration under class 42, bearing number 00002216277, dated June 9, 2000 and three other European Union trademark registrations. It is well established that trademark registration is considered *prima facie* evidence of rights in a mark.

The Complainant has urged that an international trademark registration and international use of the mark does not deter a finding of rights in favor of the Complainant to avail remedies under the INDRP Policy. The Arbitrator finds the Complainant's argument is persuasive, as it is well recognized under the INDRP Policy, that proprietary rights in a trademark / service mark are not acquired merely on account of trademark registration in India, but on account of priority of adoption and use, even if such prior adoption and use has been in jurisdiction other than India and it can even be on account of Trans- Border Reputation spilling over to India. See *Google Inc. vs. Chen Zhaoyang*, INDRP Case No. 023, April 25, dated 2007, for a detailed discussion on trademark

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rights based on international use of the mark and Trans - Border Reputation of marks in domain name disputes under the Policy.

Trans-border reputation of a trademark was also discussed in the *Google* case [supra] with reference to Indian law. The case discussed that the Supreme Court of India has consistently extended protection under the law to trademarks based on trans border reputation, such as in the cases: *Milmet Oftho Industries and others vs. Allergan Inc.*, 2004(28) PTC 585 (SC), (2004) 12 SCC 624, (the fact that a trademark owner, not having used the mark in India, would be irrelevant, if they were the first to use it in the world market) and in *N.R. Dhongre vs. Whirlpool*, 1996 PTC 16, (the reputation of the WHIRLPOOL trademark travelled trans boarder to India, and use of the mark by someone other than the owner of the trademark in India amounted to wrongful use).

Based on the evidence on record, and all that has been discussed, it is found that the Complainant has established its registered rights in the LATEROOMS trademark. There is no dispute that the Complainant owns the trademark LATEROOMS and has the necessary rights in the mark for the purposes of seeking remedy under the Policy.

The disputed domain name incorporates the LATEROOMS mark in its entirety. A domain name that incorporates a trademark in its entirety is adequate to establish that the disputed domain name is identical to the mark. See *Indian Hotels Company Limited v. Mr. Sanjay Jha*, INDRP case 148 September 27, 2010 <gingerhotels.co.in>. (A domain name that entirely incorporates a complainant's mark is sufficient to establish the confusing similarity of the disputed domain name with the mark.)

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For the reasons discussed, it is found that the Complainant has satisfied the first element under paragraph 4 of the Policy, that it has rights in the LATEROOMS trademark, and the disputed domain name is identical or confusingly similar to the trademark in which it has rights.

Rights and Legitimate Interests

The second element requires the Complainant to make a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name.

The Complainant has averred that the Respondent has no rights or legitimate interests in the disputed domain name as the Respondent is not commonly known by the disputed domain name. The Respondent has not responded in these proceedings and rebutted the Complainant's arguments.

The disputed domain name is being used by the Respondent for displaying various pay per click links. It is well established, that hosting pay per click links, where the domain name uses the trademark of another, is exploitative use of the trademark. Such use of the Complainant's trademark in the disputed domain name is likely to mislead the Internet users. It is found based on the facts here that the use of the disputed domain name for purposes of sponsored pay per click links is not legitimate use or *bona fide* use of the domain name under the Policy, as it misleads users by incorporating the Complainant's trademark. Further, by redirecting users to competitors of the Complainant, there is no legitimate or *bona fide* use of the disputed domain name by the Respondent.

The Arbitrator finds based on the facts and circumstances discussed, that the Complainant has made a *prima facie* case that the Respondent lacks rights and

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legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

Bad Faith

The third element under the INDRP Policy requires the Complainant to establish that the Respondent has registered the disputed domain name in bad faith or uses the domain name in bad faith.

The Complainant has submitted several arguments in support of its assertions that the disputed domain name has been registered and is being used in bad faith. The Complainant has urged that: (i) it has well-established rights in the trademark LATEROOMS at the time the disputed domain name was registered (ii) the Respondent put up the disputed domain name for sale on the SEDO site (iii) the Respondent has exhibited a pattern of registration of domain names that contain trademarks of others, that is indicative of bad faith (iv) the Respondent has placed pay per click links on the landing page of the disputed domain name (v) the Respondent has used the disputed domain name to redirect users to the Complainant's competitors and has tried to divert Internet users, which is disruptive of its business and (vi) by registering the disputed domain name the Complainant, who is the owner of the trademark, has been prevented from reflecting its mark in a corresponding domain name.

The Arbitrator finds the Complainant's arguments are persuasive and are well supported by evidence. The material on record clearly demonstrates that the Complainant has established its prior adoption and use of the LATEROOMS mark for a considerable period prior to the registration of the disputed domain name on May 26, 2013. The evidence on record shows the Complainant's use of the term "laterooms" dates back to the year 1999, when it registered its

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domain name <laterooms.com>. The Complainant has several trademark registrations for LATEROOMS mark. Its U.K. trademark registration number 00002216277 under class 42, is dated June 9, 2000.

The word "Laterooms" is not a dictionary word and has no meaning except to signify the trademark of the Complainant. Given these circumstances, it can be reasonably inferred that the Respondent was aware of the Complainant's prior rights in the mark when he registered the disputed domain name.

The Registration of a domain name that is identical or confusingly similar to the Complainant's trademark LATEROOMS and similar to the Complainant's domain name <laterooms.com> is sufficient evidence of bad faith registration and use. Under the circumstances of the case it can be inferred that it was for purposes of attracting persons to its website based on the fame of the Complainant's trademark. Numerous domain name cases have found that registering a domain name with the intention of trading on the goodwill and reputation associated with another's trademark is registration and use of the domain name in bad faith.

The Complainant has further urged that the disputed domain name is being used in bad faith, as the domain name resolves to a landing page with pay-per click links. The Respondent therefore ought to have registered the disputed domain name to attract Internet users to its website for commercial gain by creating likelihood of confusion with the Complainant and its mark. Operating a website that has pay-per click links that seeks to exploit or gain from the reputation associated with another's trademark is recognized as bad faith use of a domain name. Internet users may falsely believe that the Respondent's domain name and website are being operated or endorsed by the Complainant. Registration of the disputed domain name using the trademark of the Complainant and posting

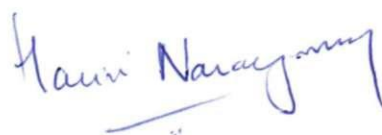
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numerous sponsored links is recognized as bad faith registration and use as envisaged under the Policy. See *F.D Management Inc. & Another vs. Song GuangXui*, INDRP Case No. 734, dated December 10, 2015 pertaining to the domain name <elizabetharden.in>.

Further evidence of registering and using the disputed domain name with the intention of trading on the goodwill and reputation associated with the Complainant's trademark, is that the disputed domain name has been offered or advertised for sale on the SEDO website. It is well-known that SEDO facilitates the selling of domain names by providing targeted advertisements for the sale of domain names. As noted in the INDRP case, *Franklin Resources Inc., and Franklin Templeton Asset Management India vs David*, INDRP Case 076, dated January 15 2009 (<franklintempleton.in>), placing a domain name for sale on SEDO, when the domain name uses another's trademark, is not a *bona fide* use of the disputed domain name. Placing such a domain name for sale, amounts to seeking to reap unfair profit from the trademark of the complainant, and is found to be evidence of bad faith registration and use under the Policy.

The Arbitrator further notes from the evidence on record, that the Respondent has a large portfolio of domain names that use trademarks of third parties. Such conduct exhibits a pattern of registration of domain names to derive undue advantage from the goodwill associated with the trademark of others, which is recognized as indicative of bad faith registration and use under the INDRP Policy.

Finally, the fact that no website has been developed by the Respondent, the Respondent has not replied the Complainant's communications and has not responded in these proceedings or given any reasons for registering the disputed


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domain name reinforces the indication of bad faith registration and use of the disputed domain name.

For all the reasons discussed, the Arbitrator finds the disputed domain name has been registered and is being used in bad faith under the Policy.

Decision

The Complainant has successfully established the three prerequisite under the INDRP Policy in these proceedings.

For the reasons discussed, it is ordered that the disputed domain name: <laterooms.in> be transferred to the Complainant.

A handwritten signature in blue ink, reading "Harini Narayanswamy". The signature is fluid and cursive, with a long horizontal stroke at the end.

Harini Narayanswamy (Arbitrator)

Date: October 7, 2016