

उत्तर प्रदेश UTTAR PRADESH

BR 441955

BEFORE THE SOLE ARBITRATOR, ANKUR RAHEJA MCA FCS LLB

.IN REGISTRY  
(NATIONAL INTERNET EXCHANGE OF INDIA)

.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

ARBITRATION AWARD – NOVOTEL.CO.IN

DATED: SEPTEMBER 13, 2018

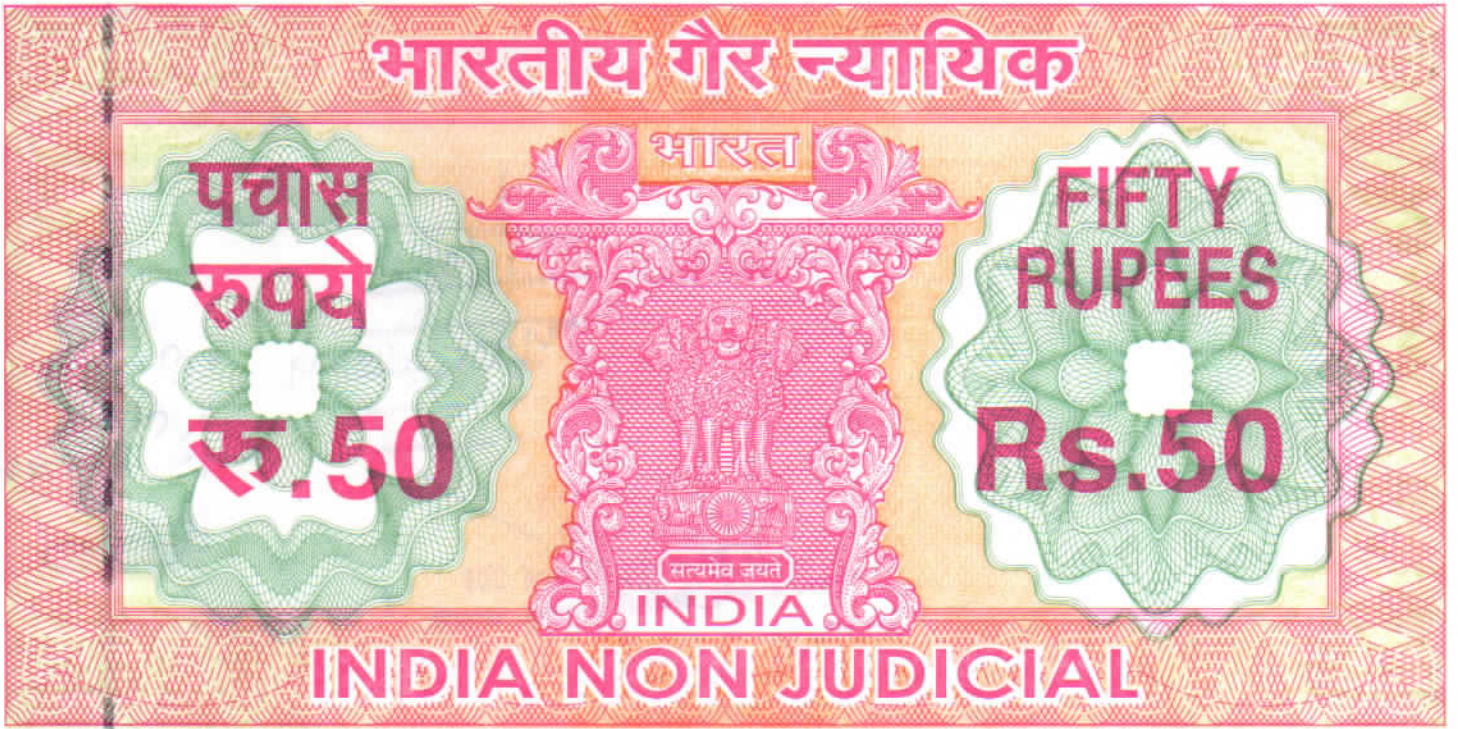
IN THE MATTER OF:

ACCOR ... Complainant

versus

ZHAO YOUNG ... Respondent

*AR*



उत्तर प्रदेश UTTAR PRADESH

BR 441956

### ARBITRATION AWARD

Dispute Domain Name: [www.novotel.co.in](http://www.novotel.co.in)

1. The Parties:

a. **Complainant:** The Complainant in this arbitration proceedings is: **Accor**, 82 rue Henri Farman, 92130 ISSY-LES-MOULINEAUX, France, represented by Dreyfus & Associates having office at 78 Avenue Raymond Poincare, 75116, Paris, France.

b. **Respondent:** The Respondent in this arbitration proceedings is **Zhao Young**, 308 Ningxia Road, Owner, Shandong 266071 Quingado, China.

## 2. The Domain Name and the Registrar:

- a. The Disputed Domain Name is www.novotel.co.in.
- b. Disputed Domain Name is registered with Tucows Domains Inc.

## 3. Procedural History [Arbitration Proceedings]

This is mandatory Arbitration proceedings in accordance with the .IN Domain Name Dispute Resolution Policy (“INDRP”), adopted by the National Internet Exchange of India (“NIXI”). The INDRP Rules of procedure (“the Rules”) were approved by NIXI on 28th June 2005 in accordance with Arbitration and Conciliation Act, 1996. By Registering the Disputed Domain Name with the NIXI Accredited Registrar, the Respondent has agreed to the resolution of the domain disputes pursuant to the IN Dispute Resolution Policy and Rules framed thereunder.

According to the information provided by the National Internet Exchange of India [“NIXI”], the history of this proceedings is as follows:

In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint, and appointed **Mr Ankur Raheja** as the Sole Arbitrator for adjudicating upon the disputed in accordance with the Arbitration and Conciliation Act, 1996 and the Rules framed thereunder, INDRP Policy and

Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the NIXI.

The arbitration proceeding in the said matter commenced on 08 August 2018, in terms of INDRP Rules. Relevant Dates are as follows:

<b>Sr No</b>	<b>Particulars</b>	<b>Date</b>
1	Date of Handover of Complaint by NIXI and service of soft copy of Complaint upon Respondent by Nixi	08 August 2018
2	Notice of Arbitration issued to the parties, also referred as date of commencement of Proceedings	08 August 2018
3	Second Notice to the Respondent	23 August 2018
4	Award Passed	13 September 2018

- In accordance with INDRP read with INDRP Rules of procedure, notice of Arbitration was sent to the Respondent on 08th August 2018, with the instructions to file his reply / response by 20th August 2018.

- That on failure of the Respondent to file any response to the complaint, another opportunity was provided to the Respondent on 23 August 2018 but he failed to comply with the same as well.

- The communication at various stages of proceedings through emails at the ID provided in the WHOIS information of the Disputed Domain was delivered successfully but the hard Copy of the Complaint could not be delivered due to false WHOIS information. On 4 September 2018, NIXI informed that consignment containing hard copy of the Complaint could not be delivered and Courier agency had sought correct address/contact information. The same day, Respondent was communicated for the information but he failed to respond. Initially, NIXI had already delivered Soft Copy of the Complaint upon Respondent on 08 August 2018.
- In the fact and circumstance of the case, an order for ex-parte proceedings was issued, as no response was received from the Respondent, though the notices were successfully delivered in accordance with Rule 2 of the INDRP Rules of Procedure.
- No personal hearing was requested / granted / held.

#### **4. Factual Background**

*According to the documentary evidence and contentions submitted:*

1. Accor S.A., using the brand name ACCORHOTELS is the world leader in economic and mid-scale hotels, and are a major player in upscale and luxury hospitality services. For more than 45 years, it has provided customers with expertise acquired in this core business.
2. Accord operates more than 4,000 hotels in 100 countries worldwide and around 570,000 rooms, from economy to upscale. The group includes notable hotel chains such as PULLMAN, NOVOTEL, MERCURE and IBIS. Accor's brands offer hotel stays tailored to the specific needs of each business and leisure customer and are recognized and appreciated around the world for their service quality.
3. ACCORHOTELS also has presence in India and counts upto 45 hotels with 8,552 rooms among which there 16 Novotel.

## **5. The Dispute**

1. Complainant noticed that the domain name <novotel.co.in> has been registered. Whois Database searches revealed that this domain name was registered by the Respondent. Complainant drew Respondent's attention to the registration of the domain name <novotel.co.in> which entirely produces its trademark NOVOTEL.

2. Previously, the disputed domain name resolved to a parking page containing commercial links which relate to complainant's field of activities. Currently, disputed domain name resolves towards an inactive page.
  
3. On May 24, 2017, Complainant sent a cease and desist letter to Respondent via registered letter and e-mail on the basis of its trademark rights. The cease and desist letter requested Respondent to transfer the disputed domain name to Complainant free of charge. In response, Respondent offered the domain name for sale at 2500 Euro, on May 31, 2017. Complainant has become aware that the domain name <novotel.co.in> was parked on the platform of SEDO's Domain Marketplace. Subsequently, on March 8 2018, Complainant sent a notification to SEDO's Domain Marketplace requesting the removal of the disputed domain name from the said platform. Henceforth, the disputed domain name was blocked manually from Sedo's website and services.
  
4. Therefore, as no amicable settlement could be found, Complainant has no other choice but to initiate an INDRP procedure against Respondent in order to obtain the transfer of the Disputed Domain Name, under the following grounds:
  - A. The Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has statutory/common law rights.

- B. The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- C. The disputed Domain Name has been registered or is being used in Bad Faith.

## **6. Parties Contentions**

### **I. Complainant contends as follows:**

1. Complainant owns and operates several hotels under the trademarks NOVOTEL, which are well known trademarks, protected worldwide particularly in relation to hotels and restaurant services. Complainants are notably the owner of the following trademark registrations:
  - International trademark "NOVOTEL" no 542032 dated July 26, 1989 renewed and covering services in class 42;
  - International trademark "NOVOTEL" no 785645 registered on June 25, 2002 (duly renewed), covering services in class 43; and
  - International trademark "NOVOTEL" no 1244249 registered on November 15, 2005 (duly renewed), covering goods in class 42;
2. In addition, Complainant operates, among others, domain names reflecting its trademarks:



- <novotel.in> registered on February 26, 2005
- <novotel.com> registered on April 10, 1997

3. The domain name <novotel.co.in> reproduces Complainant's trademark NOVOTEL in its entirety, which previous panels have considered to be very well-known (WIPO Case No D2016-0015, Accor v. Adam Smith and WIPO Case No. D2016-1160). In many decisions, Panels considered that the incorporation of a trademark in its entirety may be sufficient to establish that a domain name is identical or confusingly similar to Complainant's registered trademark (WIPO Case No D2013-0150 Swarovski Aktiengesellschaft v. mei xudong, INDRP Case No INDRP/887 <colgate.in> decided on May 26, 2017 INDRP Case No INDRP/741 <goodyear.in> decided on February 8 2016).

4. The domain name <novotel.co.in> is identical to Complainant's trademark NOVOTEL in so far that it is composed solely of the Complainant's Trademark. Thus, the trademark NOVOTEL stands out and can easily be identified as Complainant's trademark. Likewise, the disputed domain name <novotel.co.n> clearly constitutes a typosquatting variant of Complainant's domain name <novotel.in> which makes potential typing error by Internet users more likely to happen, and as result diverting the traffic from Complainant's site to the Respondent's.



5. The disputed domain name <novotel.co.in> has been registered in the TLD <.co.in>. The presence of the suffix <co.in> is not to be taken into account. Indeed, it is well established in domain name cases that the suffix to indicate the top level of the domain name has to be disregarded for the purpose of determining whether the domain name is identical or confusingly similar to Complainant's trademark (INDRP Dispute decision No 014 <Pepsico.in> decided on April 24, 2006; INDRP Dispute Decision No 061 <mothercare.in> decided on April 27, 2008; INDRP Dispute Decision No 063 <sensex.in> decided on August 17, 2008).
  
6. Complainant has used the trademarks NOVOTEL in connection with a wide variety of products and services around the world. Consequently, the public has learnt to perceive the goods and services offered under these trademarks as being those of Complainant. Therefore, the public would reasonably assume that the disputed domain name belongs to Complainant or is at least, related to Complainant.
  
7. Accordingly, with the registration of the disputed domain name, Respondent created a likelihood of confusion with Complainant's trademarks. It is likely that this domain name could mislead Internet users

into thinking that this is in some ways, associated with Complainant and thus may heighten the risk of confusion.

8. For all of the above-mentioned reasons, it clearly appears that the disputed domain name is identical to the trademarks NOVOTEL in which the Complainant has rights, and therefore the condition of Para 4(i) of the .IN Policy is fulfilled.
9. Respondent is neither affiliated with Complainant in any way nor has he been authorized / licenced by Complainant to use and register its trademarks, or to seek registration of any domain name incorporating the previously mentioned trademark. In addition, Respondent is not known by the name of NOVOTEL. Respondent has no prior rights or legitimate interests in the disputed domain name. The registration of the NOVOTEL trademarks preceded the registration of the disputed domain name for years.
10. Moreover the domain name in dispute is identical to the famous NOVOTEL trademarks of Complainant. Therefore, Respondent cannot reasonably pretend that the registration of the disputed domain name aimed to develop a legitimate activity. In previous WIPO decisions, Panels found that in absence of any licence or permission from the

Complainant to use such widely known trademarks, no actual or contemplated bonafide or legitimate use of the domain name could reasonably be claimed (WIPO Case No D2013-0188, Groupe Auchan v. Gan Yu; WIPO Case N D2010-0138, LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host Master).

11. Besides, Respondent do not demonstrate use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Indeed, the disputed domain name previously resolved to a parking page displaying commercial links for which some of them related to the hotel's industry including Complainant hotels and its competitors.

12. Consequently, Respondent fails to show that the non-commercial intention or the fair use of the disputed domain name. It is most likely to believe that Respondent has no legitimate interest or rights in the disputed domain name. Likewise, the domain name in dispute directs Internet users to a parking page with pay-per-clicks which are likely to generate revenues. Hence, as a matter of fact, it cannot be inferred that Respondent was making a legitimate non-commercial or fair use of disputed domain name (WIPO Case No D2009-1529, Societe nationale des telecommunications:

Tunisie Telecom v. Ismael Leviste, INDRP Case No INDRP/167 <lazard.in> decided on November 30, 2010).

13. Currently, the domain name resolves to an inactive page. Consequently, Respondent fails to show any intention of non-commercial or fair use of the disputed domain name. It is most likely to be believed that Respondent has no legitimate interest of rights in the said domain name.
  
14. Furthermore, a legitimate non-commercial or fair use of the domain name as per para 4(c)(iii) of the policy cannot be inferred due to Respondent clear intention for commercial gain. Indeed, considering the exchanges with Respondent and the presence of the disputed domain name is for the purpose of selling it to Complainant for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name. If respondent had real interest in the domain name, he would have done his maximum to justify his prior rights or interests in the domain name in his reply.
  
15. Subsequently, Respondent appears to be a cyber-squatter as he is associated with more than 5000 domain names, where some replicate international trademarks such as Blackberry, in which he has no interest.

This is an additional proof that Respondent lacks rights and legitimate interest in the disputed domain name.

16. For all of the above-cited reasons, it is undoubtedly established that Respondent has no rights or legitimate interests in respect to the domain name in dispute under para 4(a)(ii) of the Policy.

17. It is implausible that Respondent was unaware of Complainant when he registered the disputed domain name. Bad faith can be found where respondent "knew or should have known" of Complainant's trademark rights and, nevertheless registered a domain name in which he had no rights or legitimate interests (WIPO CASE No. D2009-0320, Research In Motion Limited v. Privacy Locked LLC/Nat Collicot; WIPO Case No. D2009-0113, The Gap Inc. v. Deng Youqian).

18. Firstly, Complainant is well-known throughout the World. Secondly, in many WIPO decisions, Panels considered that Complainant's NOVOTEL trademark is also widely-known. Thirdly, the disputed domain name reproduces entirely Complainant's trademarks namely, NOVOTEL. Finally, in view of the Respondent's immediate offer of the disputed domain name without contesting Complainant's fame or rights, shows that he was aware of Complainant's activities. Therefore, it is impossible that Respondent

was not aware of Complainant's trademarks and activities at the time of the registration of the disputed domain name.

19. Bad faith has already been found where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith (WIPO Case No. D2010-0494, LEGO Juris A/S v. ReinerStotte, WIPO Case No. D2006-0303 Sanofi- Aventis v. Nevis Domains LLC- ANNEX 13). Thus, given the reputation of the NOVOTEL trademarks, registration in bad faith can be inferred.

20. Moreover, a quick NOVOTEL trademark search would have revealed to Respondent the existence of Complainant and its trademarks. Respondent's failure to do so is a contributory factor to its bad faith (WIPO Case No. D2008-0226, Lancome Parfums et Beaute & Cie, L'Oreal v. 10 Selling).

21. Supposing that respondent was not aware of the possibility of searching trademarks online before registering a domain name, a simple search via Google or any other search engine using the keyword "NOVOTEL" demonstrates that all first results relate to Complainant's field of activities or news.

22. In this day and age of the Internet and advancement in Information Technology, the reputation of brands and trademarks transcends national borders. Taking into account the worldwide reputation of Complainant and its trademarks, it is hard to believe that Respondent was unaware of the existence of Complainant and its trademarks at the time of registration of the disputed domain name.

23. It has been held in previous cases that knowledge of a corresponding trademark at the time of registration of the domain name suggests bad faith (WIPO Case No. D2000-0270, Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2006-0464, Caixa D'Estalvis I Pensions de Barcelona ("La Caixa") v. Eric Adam).

24. Previous Panels have established that knowledge of Complainant's Intellectual Property rights, including trademark, at the time of registration of a disputed domain name proves bad faith registration (WIPO Case No. D2008-0287, Alstom v. Domain Investments LLC; WIPO Case No. D2007-0077, NBC Universal Inc. v. Szk.com).



25. Moreover, the policy, under Paragraph 6(i), states that if there are circumstances which indicate that the Registrant has registered or acquired the domain name for the purpose of selling, renting, or otherwise, transferring the domain name to Complainant or to a competitor, such registration can be considered as bad faith registration and use of the domain name. In the present case, the disputed domain name was offered for sale by Respondent and was also placed for sale on SEDO's Marketplace. It demonstrates that Respondent was aware of the disputed domain name's value and that he planned to make a profit via the offer for sale addressed to Complainant. This kind of behaviour is certainly not an evidence of good faith registration and use since the value of the domain name is only provided by the fame of the trademarks it contains (INDRP dispute decision no 018 <baccarat.in> decided on October 06, 2006, INDRP/306 <ibis.co.in> decided on March 1, 2012).

26. Previous panels have considered that in the absence of any license or permission from Complainant to use such widely known trademarks, no actual or contemplated bona fide or legitimate use of the domain name could reasonably be claimed (WIPO Case No. D2000-0055, Guerlain S.A. v. Peikang; WIPO case No. D2008-0281, Alstom, Bouygues v. Webmaster).

27. As the disputed domain name is confusingly similar to Complainant's trademarks, previous Panels have ruled that "a likelihood of confusion is presumed and such confusion will inevitably result in the diversion of Internet Traffic from complainant's site to Respondent's site" (WIPO Case No. D2012-1765, MasterCard International Incorporated ("MasterCard") v. Wavepass AS; WIPO Case No. D2006-1095, Edmunds.com, Inc. v. Triple E Holdings Limited).

28. Furthermore, the domain name previously directed towards a parking website, which is a method to derive commercial gains through the pay-per-click links present on the parking website. This does not constitute good faith use of the domain name (INDRP Dispute decision no 018 <baccarat.in> decided on October 06, 2006; INDRP/343 <lorealprofessionnel.in> decided on May 17, 2012; INDRP/181 <manulife.in> decided on January 10, 2011; INDRP/165 <lazard.co.in> decided on March 9, 2011).

29. Additionally, the domain name was also offered for sale. This clearly shows lack of interest in the domain name and Respondent's intention to derive undue advantage of Complainant's trademarks to generate profits. The use of these well-known trademarks to attract Internet users to a

website for commercial gains constitutes a use in bad faith pursuant to the policy (INDRP/344 <larocheposay.co.in> decided on June 11, 2012).

30. The clear inference to be drawn from the Respondent's operations is that he is trying to benefit from the fame of the Complainant's trademarks. Therefore, it is more likely than not, that Respondent's primary motive in registering and using the dispute domain name was to capitalise on or otherwise take advantage of Complainant's trademark rights, through the creation of initial interest of confusion.

31. The domain name <novotel.co.in> is currently inactive. Nevertheless, this state of inactivity does not mean that the domain name is used in good faith. Previous Panels have already considered that passive holding of a disputed domain name can satisfy the requirements of Paragraph 4(a)(iii), and that in such cases the Panel must give close attention to all the circumstances of Respondent's behaviour (WIPO Case no. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows). Finally, it can be deduced that Respondent registered the domain name to prevent Complainant from using its trademarks in the disputed domain name. According to former panel, this type of conduct constitutes evidence of Respondent's bad faith (WIPO Case No. D2009-0242, L'oreal v. Chenxiansheng).



**II. Respondent contends as follows:**

A. The Respondent was provided various opportunities to file his response to the Complaint by the Arbitrator by its notice dated 08 August 2018 and 23 August 2018 respectively.

B. However, Respondent is unreachable and/or failed and/or neglected to file any response to the Complaint filed by the Complainant despite being given an adequate notification and several opportunities by the Arbitrator.

C. The Arbitrator, therefore, has no other option but to proceed with the matter and to decide the complaint on the basis of the material on record and in accordance with the .IN Dispute Resolution Policy and the Rules framed thereunder.

**7. Discussion and Findings:**

**I. Procedural Aspects**

A. The Complainant, while filing the Complaint, submitted to Arbitration proceedings in accordance with the .IN Dispute Resolution Policy and the

Rules framed thereunder. The Respondent also submitted to the mandatory arbitration proceedings in terms of paragraph 4 of the INDRP Policy, while seeking registration of the disputed domain name.

B. The .IN Dispute Resolution Policy requires the Complainant, to establish the following three elements:

- (i) The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) The Registrant has no rights or legitimate interests in respect of the domain name; and
- (iii) The Registrant's domain name has been registered or is being used in bad faith.

C. Undoubtedly, the Complainant has exclusive ownership and right, title and interest to the mark '**NOVOTEL**'. The same have been protected by registration as Trademark in different countries, including India, claiming its use since almost three decades. Otherwise also, the Complainant's mark is a widely known and acquired a secondary meaning, which is quite evident through it's continuous and extensive use.

## **II. Respondent's Default**

A. Several UDRP decisions have established that once a complainant has made a prima facie case that a Respondent lacks legitimate interest or right, the burden shifts to the Respondent to prove its right or legitimate interest in the domain name (F. Hoffman-La Roche AG v. Steven Pratt, WIPO Case No. D2009-0589 and Canadian Tire Corporation Limited v. Swallowlane Holdings Ltd., WIPO Case No. D2009-0828). That is, it is well established principle that once a Complainant makes a prima facie case showing that a Respondent lacks rights to the domain name at issue; the Respondent must come forward with the proof that it has some legitimate interest in the Domain Name to rebut this presumption. But the Respondent has failed to come forward with a Response and moreover has provided false WHOIS for the domain name in violation of terms and conditions of registration of Domain Names. Therefore, in light of Complainant's unrebutted assertion that Respondent has no rights or legitimate interests in the disputed domain name, the Arbitrator may presume that no such rights or interests exist. [Pavillion Agency, Inc. v. Greenhouse Agency Ltd., WIPO Case No D2000-1221].

B. The INDRP Rules of Procedure requires under Rule 8(b) that the Arbitrator must ensure that each party is given a fair opportunity to represent its case. Further, Rule 11 (a) empowers the arbitrator to proceed with an ex-parte decision in case any party does not comply with the time limits. The

Respondent was given notice of this administrative proceeding in accordance with the Rules. The .IN Registry discharged its responsibility under Rule 2(a) of the INDRP Rules of Procedure to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint.

C. The Respondent has not filed its reply or any documentary evidence thereof and has not sought to answer the complainant's assertions, evidence or contentions in any manner. The averments made in the complaint remain unrebutted and unchallenged. There is no dispute raised to the documents relied upon by the Complainant.

D. In the matter of Taco Bell Corporation V. Webmasters Casinos Ltd [INDRP/067], it was held that the Respondent registered the disputed domain name maliciously and he shows his depraved intention, in the arbitration proceedings by his act because three notices were sent by the arbitrator but he has submitted no reply of anyone. [INDRP/067 - tacobell.co.in - May 29, 2008]. Also in the matter of Talk City, Inc. v. Robertson, WIPO Case No D2000-0009, it has been held that because Respondent failed to submit a Response, the Panel may accept all of Complainant's reasonable assertions as true.

E. The Arbitrator finds that the Respondent has been given a fair opportunity to present his case. The paragraph 12(a) of INDRP Rules of Procedure provides that the Arbitrator shall decide the Complaint on the basis of the statements and documents submitted in accordance with the INDRP and any law that the Arbitrator deems fit to be applicable. In accordance with Rules paragraph 12, the Arbitrator may draw such inferences as are appropriate from the Respondent's failure to reply to Complainant's assertions and evidence or to otherwise contest the Complaint. In the circumstances, the arbitrator's decision is based upon the Complainant's assertions, evidence and inferences drawn from the Respondent's failure to reply.

**III. Requirements of Paragraph 4 of the INDRP Policy, i.e. Issues Involved in the Dispute:**

The INDRP policy lists the following three elements that the Complainant must prove to merit the finding that the domain name of the Respondent be transferred to the Complainant or whether any other remedy in terms of the paragraph 10 of the INDRP Policy will be available or not:

**(i) Identical or confusingly similar with the Trade Mark, etc [Para 4(i) of INDRP Policy]**



- A. Complainant's mark '**NOVOTEL**' is an inventive word that has been used exclusively by the Complainant for almost last three decades. The Trademark was first registered in 1989 as an International Trademark under class 42 and also later under different classes. Complainant, inter alia, operates various websites including **Novotel.in** and **Novotel.com**. Further, the Complainant has presence in many countries including India and has a huge online presence.
- B. Due to said continuous use, the mark '**NOVOTEL**' has acquired tremendous reputation and as a result secondary meaning. The consumers and the business worldwide associate the expression '**NOVOTEL**' with quality products/services originating from the Complainant only. It was held in the matter of Perfetti Van Melle Benelux BV v. Lopuhin Ivan, IPHOSTER [WIPO Case No. D2010-0858] that trademark registration constitutes prima facie evidence of the validity of trademark rights. [See: Backstreet Productions, Inc. v. John Zuccarini, CupcakeParty, Cupcake Real Video, Cupcake-Show and Cupcakes-First Patrol, WIPO Case No: D2001-0654].
- C. Further, in the matter of Accor v. Adam Smith [WIPO Case No. D2016-0015], it was held "the Panel is satisfied, taking into account that Complainant's '**NOVOTEL**' trade mark has a strong reputation and is well known, that Respondent has provided no evidence of any actual or contemplated good

faith use of the disputed domain name and the other factors asserted by Complainant...”. The well-known status of a mark includes considerations like knowledge or recognition among relevant section of public, duration, extent and geographical area of use, promotion and publicity of mark, etc. [Yahoo! Inc. v. Jorge O. Kirovsky, D2000-0428; Kabushiki Kaisha Toshiba v Shan Computers, D2000-0325; Nike, Inc. v. B. B. de Boer, D2000-1397]. Further, it has been held in the matter of Disney Enterprises, Inc. v. John Zuccarini, Cupcake City and Cupcake Patrol [WIPO Case No. D2001-0489] that “domain names that incorporate well-known trademarks can be readily confused with those marks”.

D. The complainant asserts that Respondent has registered the Disputed Domain Name <novotel.co.in> on 14 April 2017, it entirely comprised of Complainant’s mark. Indeed, numerous courts and UDRP panels have recognized that “if a well-known trademark is incorporated in its entirety, it may be sufficient to establish that a domain name is identical or confusingly similar to Complainant’s registered mark.” While the disputed Domain Name <novotel.co.in> incorporates the said Trademark in it’s entirety, which has been held in many domain dispute matters as enough to satisfy the first condition under para 4(i) of INDRP Policy [INDRP Case No INDRP/887 <colgate.in> decided on May 26, 2017 INDRP Case No INDRP/741 <goodyear.in> decided on February 8 2016; Allied DOMEQ Spirits and

Wine Limited v Roberto Ferrari, (INDRP Case No. 071); ITC Limited V Travel India (INDRP Case No. 065); Philip Morris USA Inc. v Doug Nedwin/SRSPlus Private Registration (WIPO Case No. D2014-0339)]. Similarly, in eAuto, LLC v. Triple S Auto Parts, D2000-0047, the Panel decided that when a domain name wholly incorporates a Complainant's registered mark, that is sufficient to establish identity or confusing similarity for purposes of the Policy. Thus, the use of the disputed domain name by the Respondent is a prima facie case of trade mark/brand infringement.

E. Further, the paragraph 3 of the INDRP policy clearly states that it is the responsibility of the Respondent to find out before registration that the domain name that the registration of the domain name will not infringe upon or otherwise violate the rights of any third party. Therefore, based on Complainant's clear rights in the Marks, along with the widespread popularity of Complainant's mark '**NOVOTEL**', it is quite obviously as an Internet User would likely mistakenly believe that a website accessible by the URL <novotel.co.in> is managed or endorsed by Complainant, or enjoys the benefit of Complainant's news and information resources. And no doubt, Respondent's Infringing Domain Names are confusingly similar to Complainant's Marks. Moreover, in Living Media, Limited v. India Services, D2000-0973, it has been held that "trademark registration is itself prima-facie evidence that the mark is distinctive".

F. Besides it is also well-established that the extensions such as 'CO.IN' in a disputed domain name do not affect a finding of similarity. In the INDRP matter of The Hershey Company V. Rimi Sen, it has been held that the addition of the country top level domain ".co.in" in the disputed domain does not avoid a determination that the domain name is identical or confusingly similar to the Complainant's mark [INDRP/289 - Hersheys.co.in].

Thus, the Complainant has satisfied the requirement of paragraph 4(i) of the INDRP Policy.

**(ii) Rights or Legitimate Interests in the Domain Name [Para 4(ii) of INDRP Policy]**

The circumstances has been elaborated under Paragraph 7 of the INDRP policy as under and the Respondent need to fit in at least one circumstance under this clause in order to prove legitimate interest:

*Para 7 of the INDRP Policy: Registrant's Rights to and Legitimate Interests in the Domain Name*

*Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented,*

*shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Paragraph 4 (ii):*

*(i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or*

*(ii) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or*

*(iii) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.*

A. The Complainant has been into hospitality industry since 1945, while it started using the mark '**NOVOTEL**' in late 1980s, when no such mark was in use. Further, Complainant denies of having assigned, granted, licenced, sold, transferred or in any way authorized the Respondent to use the distinctive mark '**NOVOTEL**' or to register the domain name containing its mark. Complainant further submits that the registration of the '**NOVOTEL**' trademarks preceded the registration of the disputed domain name for years. Panels found that in absence of any licence or permission from the Complainant to use such widely known trademarks, no actual or

contemplated bonafide or legitimate use of the domain name could reasonably be claimed (WIPO Case No D2013-0188, Groupe Auchan v. Gan Yu; WIPO Case No D2010-0138, LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host Master).

B. It is well established that the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and then the burden shifts to the Respondent to come forward with concrete evidence of such rights or legitimate interests. The Arbitrator finds that the Complainant has made such showing in this case but no information has been submitted by the Respondent on what rights or legitimate interests he may have in the disputed domain name. [Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270]. Also Respondents' failure to respond can be construed as an admission that they have no legitimate interest in the domain names [Pavillion Agency, Inc. v. Greenhouse Agency Ltd., WIPO Case No D2000-1221].

C. There is no showing that before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services. Rather, the website associated with



the disputed domain name is not being used for any bonafide / legitimate purposes, but previously lead to a parking page displaying PPC (pay per click) advertising links, related to the business of Complainant only. Complainant submits that on his Complaint only the parking page was disabled by parking company and produces the screenshot of the parked page as well, evidencing the use of Complainant's mark in combination with various keywords relevant to the Complainant's business.

D. In the WIPO matter of American Home Products Corporation vs. Ben Malgioglio, [WIPO Case No. D2000-1602], it was held that the Respondent's website is not operational and the Panel infers that it never has been. The Panel simply does not see such passive use to constitute a legitimate non-commercial or fair use without any intent to misleadingly divert consumers or tarnish the trademark or service mark at issue. Further in the WIPO matter of Paris Hilton v. Deepak Kumar [WIPO Case No. D2010-1364], if the owner of the domain name is using it in order "...to unfairly capitalise upon or otherwise take advantage of a similarity with another's mark then such use would not provide the registrant with a right or legitimate interest in the domain name. The Respondent's choice of the Domain Name here seems to be a clear attempt to unfairly capitalise on or otherwise take advantage of the Complainants' trademarks and resulting goodwill."

- E. The disputed domain name, as per evidence submitted by the Complainant, very recently used to direct towards a parking page displaying sponsored links related complainant's products/services, which does not constitute a bona fide offering of goods but rather mislead the visitors as to the source/origin of the information by displaying links related to Complainant's business. Therefore, it is an indication that Respondent lacks rights or legitimate interests (National Bedding Company L.L.C. v. Back To Bed, Inc., WIPO Case No. D2010-0106 and LEGO Juris A/S v. J.h.Ryu, WIPO Case No. D2010-1156).
- F. Further, there is no evidence that the Respondent is commonly known by the disputed domain name or a corresponding name or uses a corresponding name in a business. Further, the Respondent whose name is 'Zhao Young', as per the WHOIS records, is not commonly known by the disputed Domain name, nor the Respondent actually engages in any business or commerce under the name '**NOVOTEL**'. [Relevant Decision: Etro S.p.A v. M/S Keep Guessing, INDRP/024 (June 27, 2007); Tata Sons Limited v. Jacob W., Case No. D2016-1264]. Obviously, the WHOIS does not indicate that Respondent has ever been or is commonly known by the '**NOVOTEL**' trademark. In the matter of Tercent Inc. v. Lee Yi, FA 139720 (Nat. Arb. Forum February 10, 2003) it was held: "nothing in Respondent's WHOIS information implies that



Respondent is 'commonly known by' the disputed domain name" as one factor in determining that Policy paragraph 4(c)(ii) does not apply.

G. Furthermore, the Respondent doesn't seem to have provided the correct contact information, that is, the postal address provided is incomplete and misleading as well, for the same reason, the hard copy of Complaint could not be served upon the Respondent. This clearly indicates that the Respondent does not have any legitimate rights in the disputed domain name. Moreover, by providing inaccurate and unreliable information, as Complainant rightly contends, the Respondent has violated Section 2 of the 'Terms and Conditions for Registrants' issued by the .IN Registry.

H. Complainant also submits that in the light of the uniqueness of the domain name <novotel.co.in>, which is completely identical to Complainant's trademark, it is extremely difficult to foresee any justifiable use that the Respondent may have with the disputed domain name. On the contrary, registering this domain name gives rise to the impression of an association with the Complainant, which is not based in fact [Relevant Decisions: Telstra Corporation Limited v. Nuclear Marshmallows Case No. D2000-0003; Daniel C. Marino, Jr. v. Video Images Productions, et al. Case No. D2000-0598].

- I. Further, it is quite evident from the unresolved webpage at the disputed domain name as on date and it's previously parked page that neither any legitimate, non-commercial or fair use of the disputed domain name being made, but the Respondent seems to have intentionally registered the disputed domain name, which reproduces Complainant's well-known trademark '**NOVOTEL**', in order to capitalize / profit from the goodwill associated with the famous mark. Such an act by the Respondent clearly indicates that the Respondent does not have legitimate rights or interests in the impugned domain name.
  
- J. Given the long and widespread reputation of the Complainant's trademarks, the compelling conclusion is that the Respondent, by choosing to register and use a domain name which is not only confusingly similar to the Complainant's widely known and distinctive trade mark but identical, intended to ride on the goodwill of the Complainant's trademark in an attempt to exploit, for commercial gain, Internet traffic destined for the Complainant. Potential partners and end users are led to believe that the website is either the Complainant's site, or the site of official authorized partners of the Complainant, while in fact it is neither of these [Viacom International Inc., and MTV Networks Europe v. Web Master, WIPO Case No. D2005-0321 – mtvbase.com].

K. The Complainant has adopted and used the '**NOVOTEL**' trademark for almost three decades prior to the registration of the disputed domain name and it has invested substantial amounts for publicizing its mark. Further no use of the disputed domain name as on date and PPC ADs in the past, both indicate that the Respondent does not have any rights or legitimate interests either in the '**NOVOTEL**' mark or the impugned domain name. Under the facts and circumstance of the case, it can be inferred that the similarity of the disputed domain name to the Complainant's trademark '**NOVOTEL**' is not a coincidence. The Respondent has intentionally acquired the disputed domain name for exploiting its value as a phonetically similar variant and as a misspelling of the Complainant's trademark. [Perfetti Van Melle Benelux BV v. Lopuhin Ivan, IPHOSTER, WIPO Case No. D2010-0858]. Such an act by the Respondent clearly indicates that the Respondent does not have legitimate rights or interests in the impugned domain name. A copy of the Home Page of the disputed Domain Name displaying such PPC Ads as enclosed by respondent is quite relevant to the facts of the matter and indicates no legitimate interests but rather Bad Faith on the part of Domain Registrant. [Relevant Decisions: Paris Hilton v. Deepak Kumar, D2010-1364; Express Scripts, Inc. v. Windgather Investments Ltd. / Mr. Cartwright, D2007-0267; Compart AG v. Compart.com / Vertical Axis, Inc., D2009-0462; Pardes Institute of Jewish Studies v. Hans Schultz LLC, D2008-0648].

In the circumstances, the Arbitrator concludes that the Complainant has established the requirement of paragraph 4 (ii) of the Policy.

**(iii) Registered and Used in Bad Faith [Para 4(iii) of INDRP Policy]**

The circumstances have been elaborated under Paragraph 6 of the INDRP policy as under and even single instance proved against Respondent is enough to conclude Bad Faith:

Paragraph 6 of the INDRP policy: Evidence of Registration and use of Domain Name in Bad Faith:

*For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:*

*(i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or*

*(ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or*

*(iii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.*

A. The disputed domain name was registered by Respondent on 14 April, 2017, while the Trademark has been in extensive, continuous and uninterrupted use since the year 1989 in relation to the Complainant's business. Complainant submits it is inconceivable that the Respondent was not aware about the popularity of the mark '**NOVOTEL**' at the time of registration of the impugned domain name, which is evident from the offer to sell received by the Complainant in response to the Cease and Desist notice, served upon the Respondent in May 2017.

B. Complainant submits that even if the Respondent could not do Trademark database search due to lack of knowledge but it could have simply searched on the Internet for the keywords contained in the domain name to obtain

information as to Complainant's brand/trademark. The Complainant has 45 Accor Hotels in India, out of which 16 are '**NOVOTEL**'. Otherwise operates over 4,000 hotels worldwide, with notable chains such as '**NOVOTEL**', IBIS, PULLMAN and so on. Complainant further submits bad faith can be found where respondent "knew or should have known" of Complainant's trademark rights and, nevertheless registered a domain name in which he had no rights or legitimate interests (WIPO CASE No. D2009-0320, Research In Motion Limited v. Privacy Locked LLC/Nat Collicot; WIPO Case No. D2009-0113, The Gap Inc. v. Deng Youqian)

C. Registration of Domain Name that is identical to a trademark, with actual knowledge of the trademark holder's rights, is strong evidence that the domain name was registered in bad faith [ITC Limited v Travel India, INDRP Case No 065; American International Group, Inc. v Walter Busby d/b/a AIG Mergers and Acquisitions, NAF Claim No FA030400156251]. Further, in the matter of PepsiCo, Inc. v. "null", aka Alexander Zhavoronkov, WIPO Case No. D2002-0562, it has been held that registration of a well-known trademark as a domain name may be an indication of bad faith in itself, even without considering other elements of the Policy.

D. Complainant alleges that the Respondent is a Cyber Squatter, owning over 5,000 domain names which contains keywords like Blackberry as well. Under

the Policy, it is evidence of bad faith registration and use that by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement or your web site or location of a product or service on your web-site or location. Mainly when the website recently displayed products that of Complainant, as per the evidence adduced by the Complainant.

E. It was held in the matter of L'Oréal, Biotherm, Lancôme Parfums et Beauté & Cie v. Unasi, Inc, [WIPO Case No. D2005-0623], exploitation of the reputation of trademarks to obtain click-through commissions from the diversion of internet users is a common example of use in bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous decisions: see e.g Future Brands LLC v. Mario Dolzer, WIPO Case No. D2004-0718; ACCOR v. Mr. Young Gyoon Nah, WIPO Case No. D2004-0681 and Deloitte Touche Tohmatsu v. Henry Chan, WIPO Case No. D2003-0584.

F. Respondent registered the disputed domain name on 14 April 2017, long after Complainant's Marks became well known, and long after Complainant registered its marks in India as well. And it is impossible that the Respondent was not aware of the Complainant's rights to the trademarks as the



Complainant's trademarks are famous and registered globally further they have active and official websites on various other extensions including NOVOTEL.COM, NOVOTEL.IN, which has been registered since 1997 and 2005 respectively, that is around the time when these domain extensions were widely used.. Respondent seems to have intentionally registered the disputed domain name, which reproduces Complainant's well-known trademark '**NOVOTEL**', in order to capitalize / profit from the goodwill associated with the famous mark. Only a person who is familiar with Complainant's mark could have registered a domain name that is confusingly similar [Barney's Inc. v B N Y Bulletin Board: WIPO Case No D2000-0059].

G. Given the distinctiveness of the Complainant's mark it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's marks and uses it for the purpose of misleading and diverting Internet traffic. Where a domain name is found to have been registered with an intention to attract Internet users by exploiting the fame of a well-known trademark, it constitutes bad faith registration. [LEGO Juris AS V. Robert Martin - INDRP/125 - 14 February 2010]

H. The Complainant had served the Respondent with a Cease and desist notice in May 2017, in response the Respondent demanded Euro 2500 and had the domain name parked SEDO marketplace, after being fully aware of the



Trademark rights of the Complaint, which clearly proves the bad faith in terms of INDRP as well.

- I. In the matter of HSBC Holdings plc v Hooman Esmail Zadeh, [INDRP Case No 032], it was held that non-use and passive holding are evidence of bad-faith registration. The evidence furnished by the Respondent does not give a plausible explanation as to why there was no use of the domain name for more than two years. [Bayer Aktiengesellschaft v. Henrik Monssen, Wipo Case No D2003-0275 and Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No D2000-0003]
  
- J. Also in terms of INDRP Rules of procedure, the Registrant represents that the registration of the Domain Name will not infringe upon or otherwise violates the rights of any third party. And given the above facts, Respondent is thus guilty of willful misrepresentation and providing inaccurate / incorrect information to the Registry as well. The Complainant has a long and well-established reputation in the Complainant's mark through its exclusive use in the electronics industry. By registering the disputed domain name with actual knowledge of the Complainant's trademark, the Respondent has acted in bad faith by breaching its service agreement with the Registrar because the Respondent registered a domain name that infringes upon the Intellectual Property rights of another entity, which in the present scenario is the

Complainant. [Relevant Decisions: Ray Marks Co. LLC v. Rachel Ray Techniques Pvt. Ltd., INDRP/215 (July 9th 2011); Kenneth Cole Production Inc. v. Viswas Infomedia, INDRP/93 (April 10, 2009)].

K. In the UDRP matter of Giorgio Armani S.p.A. Milan Swiss Branch Mendrisio v. Lizhen Ye [WIPO Case No. D2013-0808] the Panel found that there is beyond all doubt that the Respondent has registered the disputed domain names in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain names and that the Respondent may have engaged in a pattern of such conduct. The Panel accepts the Complainant's arguments that the worldwide fame of the trademarks leaves no question of the Respondent's awareness of those at the time of the registration of the disputed domain names which wholly incorporate the Complainant's trademarks, as even recognized by numerous previous UDRP panels (Ga Modefine, Giorgio Armani S.p.A. v. Kim Hontage, WIPO Case No. D2007-0851, etc).

L. On account of inherent and acquired distinctiveness which the well-known mark '**NOVOTEL**' is possessed of, the use of this mark or any other phonetically, visually or deceptively similar mark, by any other person malafide would result in immense confusion and deception in the trade. That any use of the impugned domain name by the Respondent would necessarily

be in bad faith. [See Xpedia Travel.com, D2000-0137 and Goodfoodguide.net, D2000-0019 wherein it was held that owing to a wide public knowledge of the Complainant's mark, the Respondent cannot be said to have a legitimate interest in the concerned mark since he ought to have known of the Complainant's mark].

M. In cases such as Guerlain S.A. v. Peikang, D2000-0055 and Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., D2000-0163 it has been held that bad faith is found where a domain name "is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith".

N. Furthermore, it would be extremely difficult, if not impossible, for the Respondent to use the disputed domain name as the name of any business, product or service for which it would be commercially useful without violating the Complainant's rights. Thus, the disputed domain name was registered in bad faith. [Relevant Decision: The Ritz Carlton Hotel Company LLC v. Nelton! Brands Inc., INDRP/250 (December 30, 2011)]

In the circumstances, the Arbitrator concludes that the Complainant has established the final requirement of paragraph 4 (iii) of the Policy also as to both registration and use of the Domain Name in bad faith.

## 8. Decision:

In the lights of the circumstances and facts discussed above, Arbitrator decides, “The disputed domain name is identical and confusingly similar to the registered trademark ‘**NOVOTEL**’ and also the trade name of the Complainant in which Complainant has rights and the Respondent has no right or legitimate interests in respect of the Domain Name and the Respondent’s Domain Name has been registered or is being used in Bad Faith”.

Consequently the Arbitrator orders that **the Domain Name <novotel.co.in> be transferred from the Respondent to the Complainant** with no orders as to costs.



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Ankur Raheja, MCA FCS LLB

Sole Arbitrator, NIXI, India

Date: 13th September 2018

Place: Agra, India