

DISPUTE RESOLUTION SERVICE

D00008824

Decision of Independent Expert

Six Continents Hotels, Inc.

and

EDOCO LTD.

1. The Parties:

Lead Complainant: Six Continents Hotels, Inc.
Three Ravinia Drive
Suite 100
Atlanta
Georgia
30346-2149
United States

Respondent: EDOCO LTD.
1 Maple Road
Stockport, Cheshire
SK7 2DH
United Kingdom

2 The Domain Name(s):

holidayinnexpress.co.uk

3 Procedural History:

- 3.1 The Complainant lodged the complaint with Nominet on 14 July 2010. On the same day Nominet contacted the Registrant and the Complainant's representative advising that a complaint had been received and requesting the Registrant to respond. The deadline for a response was stated as 5 August 2010.
- 3.2 No response was received by Nominet before the deadline, and Nominet issued a No-Response Notice on the same day.
- 3.3 The Complainant paid the fee for expert determination and on 13 August 2010 following a conflict check Margaret Briffa was appointed from the panel of experts.
- 3.4 To the best of my knowledge, there is no outstanding formal procedure in this dispute.

4 Factual Background

- 4.1 The Complainant is part of the InterContinental Hotels Group which, the Complainant claims, is the world's largest hotel group based on the total number of rooms it has available to customers. In particular, the Complainant claims to manage, lease or franchise (through its subsidiaries) some 650,000 rooms in over 4,400 hotels in around 100 countries and territories throughout the world. The Complainant's portfolio of hotels includes the Holiday Inn Hotels and Resorts, Holiday Inn Express, InterContinental Hotels and Resorts, Crowne Plaza Hotels and Resorts, Hotel Indigo, Staybridge Suites and the Candlewood Suites. The Complainant also claims to manage the world's largest hotel loyalty program in its Priority Club Rewards scheme.
- 4.2 The Complainant claims to have used the "HOLIDAY INN" brand since 1952. The Complainant also claims that today the brand is used in connection with 3,403 hotels which collectively offer 430,359 hotel rooms.
- 4.3 The Complainant has provided a list of around 1700 registered trade marks incorporating the use of the words "HOLIDAY INN" (either alone or with other elements) in around 200 jurisdictions. For the purposes of the UK, the Complainant has provided certificates for marks registered in the UK and through the World Intellectual Property Organization (WIPO), namely:

UK Registered Trade Mark 1466520 – "HOLIDAY INN EXPRESS" word only mark registered in class 43 with a priority date of 7 June 1991;

UK Registered Trade Mark 2470586 – "H HOLIDAY INN EXPRESS" 3D mark in respect of hotel signage registered in class 43 with a priority date of 24 October 2007;

UK Registered Trade Mark 1466533 – “HOLIDAY INN EXPRESS” figurative mark registered in class 43 with a priority date of 7 June 1991;

International Mark 953050 – “H HOLIDAY INN EXPRESS” 3D mark in respect of hotel signage (rendered in black and white) registered in class 43 with a registration date of 13 December 2007; and

International Mark 952876 - “H HOLIDAY INN EXPRESS” 3D mark in respect of hotel signage (rendered in colour) registered in class 43 with a registration date of 14 December 2007

- 4.4 The Complainant claims to own a large portfolio of domain names including holidayinnexpress.com which it registered on 15 October 1996 and which it uses in connection with an e-commerce website for the Holiday Inn Express hotels. The Complainant has provided a Whois record of the domain name holidayinnexpress.com which confirms that it was first registered on 15 October 1996.
- 4.5 The Complainant has previously used the Uniform Dispute Resolution Procedure (UDRP) in the enforcement of its claimed rights. In such proceedings, the Complainant has been found to own strong rights in the “HOLIDAY INN” brand. In particular, the Complainant has cited the following claims and (where raised by the Complainant) wording from the panel decisions:

Inter-Continental Hotels Corporation, Six Continents Hotels, Inc. v. Daniel Kirchhof, WIPO Case No. D2009-1661;

Six Continents Hotels, Inc. v. TRANSLINER CONSULTANTS, WIPO Case No. D2008-0502;

Six Continents Hotels, Inc. v. Jan Pavlik, WIPO Case No. D2007-0472 (the Holiday Inn Trademarks are “entitled to a high level of protection due to [their] fame and notoriety”);

Six Continents Hotels, Inc. v. CredoNIC.com / Domain For Sale, WIPO Case No. D2005-0755 (“the [HOLIDAY INN] mark, more than famous, has become iconic”);

Six Continents Hotels, Inc. v. Asia Ventures, WIPO Case No. D2003-0659 (the Holiday Inn Trademarks “are inherently distinctive, have been used extensively for many years throughout the world in connection with its hotels and services, and are some of the most widely recognized lodging brands in the world”);

Six Continent Hotels, Inc. v. The Omnicorp, WIPO Case No. D2005-1249 (“the HOLIDAY INN name and trademark are famous, are identifiable with Complainant, and have considerable good will”).

- 4.6 The Complainant has stated that the Domain Name was registered on 30 June 2010. The Complainant has disclosed a print out of the Whois record in respect of the Domain Name confirming this.
- 4.7 The Complainant has claimed that the Respondent is using the Domain Name in connection with a website which contains links to various hotels which compete with those of the Complainant, including “Quality Inn® Saint Robert,” “Days Inn Official Site,” “Courtyard by Marriott” and “Hampton Airport Inn”. The Complainant has also provided a print out of the website at the Domain Name confirming this.
- 4.8 The Complainant has also raised various domain name disputes, including numerous disputes resolved through the Nominet Dispute Resolution Procedure, involving the Respondent where the Respondent has been the unsuccessful party. In particular, the Complainant has referred to:

Netlog NV v. EDOCO LTD., DRS Case No. D00006395 (transfer of <netlog.co.uk>);

Direct Line Insurance plc v. Edoco Ltd, DRS Case No. D00006860 (transfer of <direct-line-insurance.co.uk>);

Go Outdoors Limited v. EDOCO LTD., DRS Case No. D00006340 (transfer of <goutdoors.co.uk>);

HOB Salons Limited v. Edoco Ltd, DRS Case No. D00006268 (transfer of <hobsalons.co.uk>);

Sussex Police v. Edoco Ltd., DRS Case No. D00006379 (transfer of <sussex-police.co.uk>);

The Members of the General Committee of The Kennel Club v. EDOCO LTD, DRS Case No. D00005731 (transfer of <thekennelclub.co.uk>);

The Arsenal Football Club, PLC v. EDOCO LTD., DRS Case No. D00005681 (transfer of <arsenalfc.co.uk>);

Folli Follie (UK) Limited v. EDOCO LTD., DRS Case No. D00005652 (transfer of <follifollie.co.uk>);

ROCH VALLEY LIMITED v. EDOCO LTD, DRS Case No. D00005624 (transfer of <rochvalley.co.uk>);

AOL LLC v. EDOCO LTD., DRS Case No. D00005484 (transfer of <aolmail.co.uk>);

Beds Direct Nationwide Ltd v. EDOCO LTD., DRS Case No. D00005125 (transfer of <heli-beds.co.uk>);

PlanetDance v. EDOCO LTD, DRS Case No. D00004924 (transfer of <planetdance.co.uk>)

PJ Hayman & Company Limited v. EDOCO LTD, DRS Case No. D00004522 (transfer of <pjhayman.co.uk>);

Boels Verhuur B.V. v. Edoco LTD., WIPO Case No. DNL2010-0020 (transfer of <boelsverhuur.nl>);

De Stichting The Clash of the Coverbands v. Edoco Ltd., WIPO Case No. DNL2009-0050 (transfer of <theclashofthecoverbands.nl>);

GGD Nederland v. Edoco LTD., WIPO Case No. DNL2008-0015 (transfer of <gggd.nl>); and

Roompot Recreatie Beheer B.V. v. Edoco LTD, WIPO Case No. DNL2008-0008 (transfer of <deroompot.nl>).

5 Parties' Contentions

- 5.1 The Complainant claims to own Rights as defined by the Nominet Dispute Resolution Policy (the "Policy") be reason of the use by it and its predecessors in title of the mark "HOLIDAY INN" from 1952; the approximately 1700 registrations in approximately 200 countries or geographic regions and the UK and WIPO registrations (each of these as set out in paragraph 4.3 above). The Complainant has also made reference to its use of the domain name holidayinnexpress.com and to its success in previous domain name disputes using the UDRP and the comments made in the decisions determining those disputes. The Complainant submits that all of the above satisfies the requirement that the Complainant shows that it has rights under paragraph 2(a)(i) of the Policy, such rights being identical to the words of the Domain Name.
- 5.2 As to why the Domain Name in the hands of the Respondent is an abusive registration, the Complainant has made reference in the first instance to the links on the website at the Domain Name to hotels competing with those of the Complainant (in particular, "Quality Inn® Saint Robert," "Days Inn Official Site," "Courtyard by Marriott" and "Hampton Airport Inn"). The Complainant then makes reference to previous decisions under the Nominet Dispute Resolution Service where such use by the Respondent was held to render disputed domain names Abusive Registrations for the purposes of the Policy. In particular, the Complainant has made reference to the following decisions and (where given) the following wording:

The Members of the General Committee of The Kennel Club v. EDOCO LTD, DRS Case No. D00005731 (in which the domain name in the hands of the Respondent was held to be Abusive Registration where "some of the links are to sites that sell products which compete with the Complainant");

Folli Follie (UK) Limited v. EDOCO LTD., DRS Case No. D00005652 (in which the domain name in the hands of the Respondent was held to be Abusive Registration where the Complainant alleged that “the Respondent operates a click-through website which provides links to third party websites in the business of jewellery and watch retailers unrelated to the Complainants, from which websites such products can be purchased online, thus diverting business from the Complainants”);

Roch Valley Limited v. EDOCO LTD, DRS Case No. D00005624 in which the domain name in the hands of the Respondent was held to be Abusive Registration where “[t]he use made of the Domain Name by the Respondent is to provide links to third parties’ websites operating in the Complainant’s field of business”);

Beds Direct Nationwide Ltd v. EDOCO LTD., DRS Case No. D00005125 in which the domain name in the hands of the Respondent was held to be Abusive Registration where “[t]he current use of the Domain Name to provide links to third parties’ websites operating in the Complainant’s field of business”);

PlanetDance v. EDOCO LTD, DRS Case No. D00004924 (in which the domain name in the hands of the Respondent was held to be Abusive Registration where “the Domain Name has been used to misdirect those potentially seeking the Complainant’s website to websites with links, which, if clicked through, would in all probability simply generate ‘click-through’ income for the Respondent, with no reference to the Complainant or its business and indeed to divert potential customers to direct competitors of the Complainant”); and

PJ Hayman & Company Limited v. EDOCO LTD, DRS Case No. D00004522 (in which the domain name in the hands of the Respondent was held to be Abusive Registration where “[t]he website to which the disputed Domain Name resolves provides links to insurance products in direct competition with the Complainant”

- 5.3 The Complainant has also made reference to Roch Valley Limited v. EDOCO LTD, DRS Case No. D00005624 in support of the argument that a domain name may amount to an Abusive Registration where the Respondent’s website contains links to the Complainant’s services. In particular, the Complainant makes reference to the part of the decision where it was held that the domain name in the hands of the Respondent amounted to an Abusive Registration where the domain name contained “one link to a third party’s website promoting the Complainant’s own dancewear”.
- 5.4 The Complainant argues that the lack of any evidence of confusion should not be a reason for not finding the Domain Name to be an abusive registration in the hands of the Respondent. In particular, the Complainant has referred to PJ Hayman & Company Limited v. EDOCO LTD, DRS Case No. D00004522, in which it was found that the disputed domain name was

an Abusive Registration in the hands of the Respondent because there was “clear potential for such confusion”.

- 5.5 The Complainant has also argued that a presumption of an Abusive Registration should arise in the present case as the Respondent has been found to have made an Abusive Registration in 3 or more disputes resolved using the Nominet Dispute Resolution Service in the previous two years. In particular, the Complainant has cited Netlog NV v. Edoco Ltd (DRS Case No. D00006395), Direct Line Insurance plc v. Edoco Ltd (DRS Case No. D00006860), Go Outdoors Limited v. Edoco Ltd (DRS Case No. D00006340), HOB Salons Limited v. Edoco Ltd (DRS Case No. D00006268) and Sussex Police v. Edoco Ltd (DRS Case No. D00006379) in support of this argument.
- 5.6 As stated in paragraph 3.2 above, the Respondent has failed to make any representation in relation to this dispute.

6 Discussions and Findings

- 6.1 Paragraph 2a of the Policy states that a Respondent must submit to proceedings where a Complainant uses the Nominet DRS Procedure to assert that it owns Rights in respect of a name or mark which is identical or similar to the Domain Name and the Domain Name in the hands of the Respondent is an Abusive Registration. The term “Rights” is defined in paragraph 1 the Policy as rights enforceable by the Complainant, whether under English law or otherwise.
- 6.2 The Complainant has submitted significant evidence as to its registered and unregistered rights in the mark “HOLIDAY INN” and more particularly in the mark “HOLIDAY INN EXPRESS”. In particular, the Complainant has referred to unregistered rights in general arising from it adopting the trading name “HOLIDAY INN” in 1952 and rights arising from the use of the name “HOLIDAY INN EXPRESS”, including rights arising from its provision of services from the website holidayinnexpress.com commencing in 1996. The Complainant has been able to make reference to a comprehensive international portfolio of registrations (as stated in paragraph 4.3 above, there are approximately 1,700 registrations in around 200 jurisdictions) and registrations in the UK, including a registered UK trade mark in respect of the words “HOLIDAY INN EXPRESS” having a priority date of 7 June 1991.
- 6.3 Having regard to the representations made by the Complainant in relation to the scale of its operation it is clear that the Complainant’s marks “HOLIDAY INN” and “HOLIDAY INN EXPRESS” are well known marks. Accordingly, taking into account the well known marks of the Complainant and its registered and unregistered rights, it is in my view abundantly clear that the Complainant owns Rights (as defined in the Policy) in the mark “HOLIDAY INN EXPRESS”.
- 6.4 The Policy defines abusive registration as follows:

Abusive Registration means a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

- 6.5 Paragraph 3 of the Policy provides guidance by pointing to factors which may be referred to as evidence of an Abusive Registration. In the present case, the Complainant has alluded to the provisions of paragraphs 3a.i.C (circumstances indicating that the Domain Names were acquired for the purposes of unfairly disrupting the business of the Complainant); and 3a.ii (circumstances indicating that the Respondent is using the Domain Names in a way which is likely to confuse people into believing that the Domain Names are registered, operated or authorised by or otherwise connected with the Complainant). The Complainant has also made reference to paragraph 3(c) of the Policy, raising the presumption that the Domain Name in the hands of the Respondent amounts to an Abusive Registration as the Respondent has been found to have made an Abusive Registration in three or more DRS cases in the two years before the Complaint was filed. The Respondent has not rebutted this proposal.
- 6.6 The Domain Name was registered by the respondent on 30 June 2010. Having regard to the well known marks of the Complainant, I am satisfied that the Respondent was fully aware of the Respondent and the Respondent's business when registering the Domain Name. Accordingly, I am satisfied that the Respondent registered the Domain Name with a view to unfairly disrupting the Complainant's business.
- 6.7 Further, having regard to the Rights of the Complainant and the identical nature of the Domain Name (holidayinnexpress.co.uk) to the marks used by the Complainant, it is clear that there is a risk that the use of the Domain Name by the Respondent will cause confusion. I agree with the submission of the Complainant that the inclusion of links to the Complainant's services do not remove such risk of confusion and that actual confusion need not be shown as the potential for confusion is clear.
- 6.8 Finally, as stated above, the Respondent has not made any submissions and as such has not rebutted the presumption of an Abusive Registration raised in accordance with paragraph 3(c) of the Policy. Applying the principle set out in that paragraph, I find that the Domain Name in the hands of the Respondent is an Abusive Registration.

7 Decision

- 7.1 In light of the above, I find that the Domain Name in the hands of the Respondent amounts to an Abusive Registration. I therefore determine that the Domain Name is to be transferred to the Complainant.

Signed: Margaret Briffa

Dated : 20 August 2010