

DISPUTE RESOLUTION SERVICE

D00011032

Decision of Independent Expert

Levantur, S.A.

and

Clear Blue Seas Limited

1. The Parties

Complainant: Levantur, S.A.
Santa Catalina, 3, 4º A
Murcia
30004
Spain

Respondent: Clear Blue Seas Limited
95 Swan Street
Loughborough
Leicestershire
LE12 7GW
United Kingdom

2. The Domain Name

bahiaprincipcostaadeje.co.uk ('the domain name')

3. Procedural History

Nominet checked that the complaint dated and received on 9 March 2012 complied with its UK Dispute Resolution Service ('DRS') Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). It then notified the Respondent of the complaint, inviting it to file a response by 30 March. No response was received so, on 2 April, Nominet wrote to both parties explaining that mediation would not be possible. It advised that, if the Complainant paid the appropriate fee by 18 April, the case would be referred to an independent expert for a decision. The fee was received on 13 April.

On 16 April 2012 I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I subsequently confirmed that I am independent of each of the parties and that there are no facts or circumstances that might call into question my independence.

4. Factual Background

I have visited the web site at the domain name as well as a web site established by the Complainant and reached through bahiaprincipecostaadeje.com. From the complaint and those visits I accept the following as facts.

The Complainant owns and runs hotels in Spain, Portugal, Mexico and the Dominican Republic. It began trading in 1977 and is now part of the Piñero group. The Complainant uses the trading name 'Bahia Principe'. The first Bahia Principe hotel was opened in 1995. There are now 15 such hotels, including the Bahia Principe Costa Adeja, in Tenerife.

The Complainant holds Spanish, US and European Union trademark registrations for the name 'Bahia Principe Clubs and Resorts'. It also holds a European Union trademark registration for the name 'Bahia Principe Residencia Golf Resort'. The earliest of the Complainant's relevant trademark applications was made in March 1998.

The Complainant has registered 55 domain names that include the words 'Bahia Principe', including bahiaprincipecostaadeje.com.

The Respondent is a UK-based holiday company. It has no part in owning or running the Complainant's hotel, the Bahia Principe Costa Adeja, nor is it an authorised booking agent for the Complainant.

The Respondent registered the domain name at issue on 21 September 2007. That domain name resolves to a web site that promotes and takes bookings for the Bahia Principe Costa Adeja. There is a rolling set of interior and exterior pictures, a glowing description of the location and a very positive overall assessment of the hotel as a place to stay on holiday:

To sum up this complex, we would say it is great for people of all ages, especially families. Fantastic, huge landscaped swimming pools which particularly the children will love and enjoy, delightful rooms, impressive restaurants and as for the food - high quality and simply unbeatable. It has a vast array of facilities as you would expect, including a range of sports, spa facilities, and activities for the children including a mini-club for children, to allow the parents a very well earned break.

If you stay at the Bahia Principe Costa Adeje, we can guarantee, you will never want to leave.

At the foot of the homepage is the following wording:

Bahiaprincipcostaadeje.co.uk is a trading name of Clear Blue Seas Limited, The Old School Rooms, Loughborough Road, Leicester, LE4 5PJ.

The 'About Us' page (reached from link at the bottom of a list of links on the homepage) says:

Clearblueseas is delighted to present www.bahiaprincipcostaadeje.co.uk, which is a dedicated site for customers specifically wishing to stay at the Bahia Principe Costa Adeje. Our reservation team have direct links with the hotel or accommodation agents supplying the hotel, providing us with great prices, and more importantly in our opinion, allowing us to provide you with a quality service second to none.

Your booking will be made with the Clearblueseas Ltd. We are a holiday company based in the UK and not the hotel itself.

5. Parties' Contentions

Complainant

The Complainant says that it has registered rights in the name 'Bahia Principe'. It also refers to the hotel it runs as the Bahia Principe Costa Adeje Hotel, and says it holds the domain name bahiaprincipcostaadeje.com, which together I take to be a claim that it also has goodwill and therefore unregistered rights in the name 'Bahia Principe Costa Adeje'.

It argues that the domain name is an abusive registration because:

- (i) the Respondent has no legitimate interest in any name that would justify the use of the domain name.
- (ii) the web site at the domain name, containing photographs of the Complainant's hotel and inviting bookings, purports to be the Complainant's own web site. Customers will be confused. The Respondent may be getting 'click-through' income as well as being able to charge customers extra for their stays at the hotel – in both cases effectively trading on the back of the Complainant's reputation.
- (iii) several domain name disputes have been resolved, through the WIPO process, by a transfer of the domain name to the Complainant in the present case, which establishes a pattern of bad faith registrations.

Respondent

There has been no response.

6. Discussions and Findings

To succeed in this complaint, the Complainant must prove, on the balance of probabilities, that

- it has rights in respect of a name or mark which is identical or similar to the domain name; and that
- the domain name, in the hands of the Respondent, is an abusive registration.

Rights

The Complainant has been trading under the 'Bahia Principe' name for at least 14 years. It has UK, US and European trademark registrations that include the words 'Bahia Principe'. It clearly has both registered and unregistered rights in the name 'Bahia Principe'. The Complainant owns and runs a hotel called the Bahia Principe Costa Adeje. Arguably, therefore, it also has unregistered rights in the full name on top of its registered and unregistered rights in relation to 'Bahia Principe'.

Ignoring the .co.uk suffixes as merely generic features of the domain name register, the domain name is bahiaprincipcostaadeje.

I accept that the Complainant has rights in a name which is identical or similar to the domain name.

Registration

As defined by the Policy, an abusive registration is a domain name which:

- 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
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights.

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is an abusive registration and two of those factors are reflected in the Complainant's case: that the Respondent is using the domain name in a way that is likely to confuse people into believing that the domain name is connected with the Complainant; and that the Respondent has been engaged in a pattern of registrations of domain names that correspond to names in which it has no apparent rights. Beyond that, the Complainant makes the wider general claim that the Respondent has no apparent rights that would justify the use of the domain name.

That general claim does not strike me as necessarily a conclusive point: the fact that rights are not apparent does not mean that they do not exist - though this is a relevant factor to be considered, in the round, alongside the other factors that may help determine the character of the registration.

Nor do I find convincing the Complainant's contention that the Respondent has been engaged in a pattern of registrations that sheds light on the domain name here – because that contention does not appear to me to be supported by the evidence that forms part of the complaint. The Complainant implies that the Respondent has been found to have made a number of abusive registrations and has been required to transfer domain names to the Complainant. But there does not appear to be any evidence that the transfers referred to involve the Respondent and on that basis I cannot see that any relevant pattern has been established.

More telling is the argument that the Respondent's use of the domain name is likely to be causing confusion. Most significantly, the domain name is the name of the Complainant's hotel. In addition, while the web site at the domain name contains a note explaining that any booking will be with the Respondent, the wording is not free from ambiguity (it leaves open the possibility that any contractual relationship will be between the customer and the Complainant, with the Respondent merely responsible for the mechanics of booking administration) and in any event the text is tucked away in an 'About Us' page which is reached through a link that is at the bottom of a list of links. This means that internet visitors may never realise that the web site is run by the Respondent, rather than by the Complainant or its authorised booking agent. Even where they do realise, they will not do so until after they arrive at the web site.

Section 3.3 of the *Experts' Overview* says:

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site 'operated or authorised by, or otherwise connected with the Complainant'. This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived.

That seems to me to cover the circumstances here.

Effectively, the Respondent is acting as a 'reseller' of the Complainant's services, but without the precise relationship between the Complainant and the Respondent being apparent either from the domain name itself or from the material on the web pages at the domain name. There is a line of DRS cases making clear that resellers of goods or services are not entitled to hold themselves out as the ultimate suppliers. From its analysis of two earlier appeal decisions, the appeal panel in *Toshiba Corporation v Power Battery Inc.* (toshiba-laptop-battery.co.uk - DRS 7991) identified four underlying principles that help determine whether a reseller's use of a domain name is, in fact, creating the false impression that it is the ultimate supplier:

1. It is not automatically unfair for a reseller to incorporate a trademark into a domain name and the question of abusive registration will depend on the facts of each particular case.
2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.
3. Such an implication may be the result of 'initial interest confusion' and is not dictated only by the content of the web site.
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's web site.

No question has here been raised of competitors' services being offered through the web site. But, on the facts of this case, it seems to me that the effect of the Respondent's use of the domain name is falsely to imply a commercial connection with the Complainant, based on initial interest confusion. In my view it does not matter that, once internet users reach the web pages at the domain name, they could conceivably become aware that the domain name is not connected with the Complainant. By then it is too late.

The inescapable conclusion is that the Respondent is attracting internet traffic by pretending to be the Complainant or an authorised booking agent for the Complainant. That must be unfair. I conclude that both registration and use of the domain name has taken unfair advantage of the Complainant's rights.

7. Decision

I find that the Complainant has rights in respect of a name which is identical or similar to the domain name and that the domain name, in the hands of the Respondent, is an abusive registration.

In the light of that, I direct that the domain name be transferred to the Complainant.

Mark de Brunner

7 May 2012