

## ADMINISTRATIVE PANEL DECISION

Six Continents Hotels, Inc. v. Name redacted

Case No. D2023-2121

### 1. The Parties

The Complainant is Six Continents Hotels, Inc., United States of America ("U.S."), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, U.S.

The Respondent is Name redacted<sup>1</sup>, represented by Gema Ayecac Jiménez.

### 2. The Domain Name and Registrar

The Disputed Domain Name <holiday-innclub.com> is registered with Dattatec.com SRL (the "Registrar").

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 12, 2023. On May 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 16, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Domain Name Privacy Protection) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 8, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on June 9, 2023.

The Center sent an email communication in English and Spanish to the Parties on June 8, 2023, regarding the language of the proceeding, as the Complaint has been submitted in English and the language of the registration agreement for the Disputed Domain Name is Spanish. The Complainant submitted a request for English to be the language of the proceeding on June 9, 2023. The Respondent did not comment on the language of the proceeding.

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<sup>1</sup> The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent's name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST 12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2023. The Respondent submitted several communications in Spanish on June 27, 2023, and on July 4 and 5, 2023, but did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on July 11, 2023.

The Center appointed Manuel Moreno-Torres as the sole panelist in this matter on July 14, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

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

The Complainant is one of a number of companies collectively known as IHG Hotels & Resorts (“IHG”), one of the world’s largest hotel groups. Companies within IHG own, manage, lease or franchise, through various subsidiaries, 6,179 hotels and 914,928 guest rooms in about 100 countries and territories around the world.

The Complainant (or its affiliates) owns a large number of trademarks registrations (approximately 1,390) in several jurisdictions for HOLIDAY INN or related marks.

The Complainant owns, *inter alia*, the following trademark registrations from the United States Patent and Trademark Office:

- HOLIDAY INN, registration No. 592,539, registered on July 13, 1954;
- HOLIDAY INN CLUB, registration No. 3,710,078, registered on November 10, 2009;
- H HOLIDAY INN CLUB VACATIONS (figurative), registration No. 3,659,246, registered on July 21, 2009.

The Complainant’s mark HOLIDAY INN is to be considered well known for UDRP purposes.

The Disputed Domain Name was registered on January 6, 2023. The record shows that the Disputed Domain Name has been used to operate a fraudulent email scheme in which the Respondent impersonates the Complainant by using the name of an apparently inexistent employee of the Complainant, also using its trademarks and logo. Currently, the Disputed Domain Name does not resolve to an active website.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant alleges that HOLIDAY INN brand was founded in 1952, and is a well-known registered trademark. The Disputed Domain Name contains both the HOLIDAY INN trademark and the HOLIDAY INN CLUB trademark in its entirety. The Complainant also refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.11, to disregard the Top-Level Domain “.com” for the comparison between the Disputed Domain Name and its trademarks. Likewise, the Complainant asserts that the inclusion of a hyphen in the Disputed Domain Name is irrelevant for purposes of the Policy.

Accordingly, and based on [WIPO Overview 3.0](#), section 1.7, the Complainant support a finding of confusingly similarity between HOLIDAY INN and HOLIDAY INN CLUB with the Disputed Domain Name.

Regarding the second requirement of the Policy, the Complainant avers not to have assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use either HOLIDAY IN or HOLIDAY INN CLUB in any manner.

Besides, the Respondent is using the Disputed Domain Name in connection with emails sent from the "[...]@holiday-innclub.com" to impersonate the Complainant, and refers to [WIPO Overview 3.0](#), section 2.13.1, to support a finding of lack of rights or legitimate interests in the Disputed Domain Name.

The Complainant also affirms that the lack of use of the Disputed Domain Name in connection with an active website precludes the Respondent from fulfilling the circumstances provided in paragraph 4(c)(i) and (iii) of the Policy.

The Complainant also notes that the Respondent is not commonly known by the Disputed Domain Name, and therefore cannot establish rights or legitimate interests in the Disputed Domain Name pursuant paragraph 4(c)(ii) of the Policy.

The Complainant submits that the registration and use of the Disputed Domain Name was in bad faith. The Complainant refers to [WIPO Overview 3.0](#), section 3.1.4, and its annexed evidence concerning the use of the disputed domain name for a fraudulent email scheme to support a finding of bad faith registration, based on the confusing similarity and famous recognition of its trademarks and the registration by an unaffiliated entity. Further, the Complainant states as inconceivable that the Respondent had chosen the Disputed Domain Name without knowledge of the Complainant's activities, name, and trademarks under which the Complainant is doing business.

The Disputed Domain Name disrupts the Complainant's business. The Complainant also notes that the use of a domain name for illegitimate activity, such as, phishing is to be considered evidence of bad faith.

The Complainant alleges that the Respondent did not use of the Disputed Domain Name in a corresponding website. Such circumstance supports the application of the "Passive Holding" doctrine and notes the [WIPO Overview 3.0](#), section 3.3.

Finally, the Complainant alleges that HOLIDAY INN first trademark registration predates the Respondent's registration of the Disputed Domain Name by almost 69 years. Thus, the Respondent's registration suggest constructive notice and awareness of the Complainant's rights.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions. However, and by email dated June 27, 2023, the Respondent's representative acknowledged receipt of written notice of the proceedings. On July 5, 2023, the Respondent denied having registered the Disputed Domain Name by himself and affirmed that he was unaware of such registration.

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the following requirements:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and

- (iii) the Disputed Domain Name was registered and is being used in bad faith.

There are no exceptional circumstances within paragraph 5(f) of the Rules to prevent the Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a Response. Under paragraph 14(a) of the Rules in the event of such a “default” the Panel is still required “to proceed with a decision on the complaint”, whilst under paragraph 14(b) it “shall draw such inferences there from as it considers appropriate”. This dispute resolution procedure is accepted by the Respondent as a condition of registration of the Disputed Domain Name.

#### **A. Language of the proceeding**

The Complainant has submitted its Complaint and amended Complaint in English, while the language of the registration agreement for the Disputed Domain Name is Spanish. The Complainant requested that the language of the proceeding should be English. Paragraph 11(a) of the Rules provides that unless otherwise agreed by the parties or specified otherwise in the registration agreement between the respondent and the registrar in relation to the disputed domain name, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances.

The Complainant contends that the Disputed Domain Name consists solely of English words, and is being used to send phishing emails in English.

The Panel accepts the Complainant’s submissions regarding the language of the proceeding. The Panel notes that the Center notified the Parties of the Complaint and the commencement of the proceeding in Spanish and English. The Respondent chose not to comment on the language of the proceeding in his informal response, which did address the registration of the Disputed Domain Name and, as such, suggested an understanding of the claims in the (English) Complaint. Moreover, the English language was used both in the composition of the Disputed Domain Name and in at least one fraudulent email sent via the Disputed Domain Name, so it could be said that the Respondent is familiar with the English language.

Therefore, having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

#### **B. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry that the Complainant has trademark rights followed by an assessment that the disputed domain name is identical or confusingly similar to that trademark.

The Complainant has established trademark rights over HOLIDAY INN and HOLIDAY INN CLUB for UDRP purposes. Accordingly, the Panel notes that applying a side-by-side comparison these marks are clearly recognizable in the Disputed Domain Name. The added hyphen does not avoid such conclusion. See [WIPO Overview 3.0](#), section 1.7.

Likewise, the Panel notes the [WIPO Overview 3.0](#), section 1.11: “The applicable Top Level Domain (“TLD”) in a domain name [...] is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”

Therefore, the Disputed Domain Name is confusingly similar to the Complainant’s marks as established in paragraph 4(a)(i) of the Policy.

#### **C. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy sets out non-exclusive examples in which the Respondent may establish rights or legitimate interests in the disputed domain name.

The record shows that there is evidence of the use of the Disputed Domain Name in attempt to impersonate the Complainant. Indeed, the Panel finds that the Disputed Domain Name was chosen by the Respondent to take advantage of the intended confusing similarity with the Complainant's trademarks. The Panel highlights that the phishing practice is an illegitimate undertaking that can never confer rights or legitimate interests on a respondent. See [WIPO Overview 3.0](#), section 2.13.1: "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent" or *ELO v. Gene Brice Christian*, WIPO Case No. [D2022-0174](#).

The Panel also notes that according to the case file, none of the examples depicted in paragraph 4(c) of the Policy are met in the present case. The Complainant has not authorized, licensed, or permitted the Respondent to register or use the Disputed Domain Name. The Complainant has rights in the HOLIDAY INN trademarks, which predates that of the registration of the Disputed Domain Name and, there is no evidence of a *bona fide* offering of goods or services nor is the Respondent making a legitimate noncommercial or fair use of the Disputed Domain Name. Lastly, the Respondent is not commonly known by the Disputed Domain Name.

Accordingly, a *prima facie* case is made out by the Complainant. Therefore, the burden of production shifts onto the Respondent and it is the Respondent who must provide evidence to rebut this finding. However, the Respondent did not formally reply to the Complaint. Thus, no evidence or allegations have been produced. As noted in the [WIPO Overview 3.0](#), section 2.1: "If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element".

The Panel finds that the second requirement is met under paragraph 4(a)(ii) of the Policy.

#### **D. Registered and Used in Bad Faith**

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the Disputed Domain Name in bad faith.

In the circumstances of the case the Disputed Domain Name was used to impersonate the Complainant by using its trademarks and logos in a corresponding fraudulent email. This leads the Panel to conclude that the registration and use of the Disputed Domain Name was in bad faith.

On balance, the Respondent knew or should have known about the Complainant. Being HOLIDAY INN a well-known trademark and being used to impersonate the Complainant in a fraudulent email, the Panel finds these are convincing evidence of such previous knowledge. That is to say, the Complainant and its trademarks have been targeted with a clear goal: to create confusion with the Complainant's mark and ultimately to take advantage of committing a fraudulent act. See *Temenos Headquarters SA v. Contact Privacy Inc. Customer 1242156699 / Philander Grabbe, Temenos Group AG*, WIPO Case No. [D2018-1057](#).

Besides, the Panel notes section 3.1.4 of [WIPO Overview 3.0](#) where: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or, widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith". The Complainant owns a strong and distinctive trademark, and the Disputed Domain Name is owned by Respondent, who is unaffiliated to the Complainant.

Similarly, the Respondent appears to have engaged in the fraudulent use of a third party's name and physical address for purposes of registering the Disputed Domain Name, which reinforces the Panel's findings on the Respondent's bad faith.

Accordingly, the Panel finds that the third requirement is met under paragraph 4(a)(iii) of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name, <holiday-innclub.com>, be transferred to the Complainant.

*/Manuel Moreno-Torres/*

**Manuel Moreno-Torres**

Sole Panelist

Date: July 28, 2023