

## **ADMINISTRATIVE PANEL DECISION**

**Bowtie Hospitality LV LLC d/b/a Fontainebleau Las Vegas v.  
Greg Henderson, NM Residential LLC  
Case No. D2023-4095**

### **1. The Parties**

Complainant is Bowtie Hospitality LV LLC d/b/a Fontainebleau Las Vegas, United States of America (“United States or U.S.A”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

Respondent is Greg Henderson, NM Residential LLC, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <fontainebleaulv.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 29, 2023. On October 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 2, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Registration Private / Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email to Complainant on October 4, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on October 4, 2023.

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 Respondent of the Complaint, and the proceedings commenced on October 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2023. On October 25, 2023, Respondent requested an extension to file a Response. On October 27, 2023, the Center granted Respondent an extension of time until November 5, 2023. The Response was filed with the Center on November 6, 2023.

Complainant filed an unsolicited supplemental filing on November 7, 2023. Respondent sent an email to the Center on November 7, 2023, objecting to the Complainant's supplemental filing.

The Center appointed Robert A. Badgley as the sole panelist in this matter on November 10, 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.

In its discretion, the Panel has decided to consider Complainant's supplemental filing, as well as Respondent's objection thereto (including the substantive portion of that objection, reproduced below).

#### 4. Factual Background

Complainant alleges as follows:

"Complainant is the owner and operator of the 'Fontainebleau Las Vegas,' a hotel, casino, retail and entertainment complex in Las Vegas, Nevada United States, which is scheduled to open on December 13, 2023. Built upon a legacy of sublime beauty, unparalleled service, and timeless design, Fontainebleau Las Vegas is the newest chapter in the 70-year history of the iconic Fontainebleau brand. With its expansion to the Las Vegas Strip, Fontainebleau Las Vegas ushers in a new era of luxury hospitality defined by a stunning 150,000-square-foot casino, world-class dining, vibrant entertainment and nightlife, 3,644 exquisite hotel rooms and suites, and 550,000 square feet of customizable meeting and convention space."

Complainant owns the domain name <fontainebleaulasvegas.com> and uses that domain name to host a website promoting the forthcoming hotel resort and inviting guests to book a stay there.

According to a sworn declaration submitted by Complainant's general counsel, Complainant is an "exclusive licensee" of the trademark FONTAINEBLEAU pursuant to a licensing agreement with IP Brandco LLC, which in turn has an agreement with JS IP LLC, the actual owner of various FONTAINEBLEAU trademark registrations. JS IP LLC holds several registrations for the FONTAINEBLEAU mark with the United States Patent and Trademark Office ("USPTO"), including USPTO Reg. No. 995,958, registered on October 15, 1974 in connection with "hotel services", and USPTO Reg. No. 5,291,294, registered on September 19, 2017 in connection with "casino services".

The upcoming opening of Complainant's Law Vegas hotel has garnered media attention. For instance, in a lengthy feature article updated on September 18, 2023 article in *Travel + Leisure* states: "The long-anticipated Fontainebleau Las Vegas is set to welcome guests this winter. The \$3.7-billion project is only the second newly built resort to open on the *Las Vegas Strip* in the past decade and comes on the heels of a \$1-billion expansion of its iconic archetype, *Fontainebleau Miami Beach*."

According to Complainant:

"The Fontainebleau Miami Beach hotel opened in 1954 and became a draw for the rich and famous, serving as a playground for celebrities such as Elvis Presley, Frank Sinatra, and the Rat Pack. The hotel also became Hollywood's on-screen obsession, appearing in such films as *Goldfinger*, *Scarface*, and *The Bodyguard*. The Fontainebleau Miami Beach hotel was modernized with a \$1 billion investment in 2005, was listed on the National Registry of Historic Places, and reopened in 2008. The hotel now hosts numerous high-profile events, including fashion shows, musical performances, and film premieres."

Annexed to the Complaint are various media reports describing the Fontainebleau Miami Beach hotel as "famous" or "world famous", including a June 3, 2005 *Hotel Online* article.

The Domain Name was registered on November 8, 2021. According to a September 29, 2023 screenshot annexed to the Complaint, the Domain Name was redirected to the website of Resorts Worldwide Law Vegas, which site featured a hotel and casino in competition with Complainant's new hotel and casino resort.

As noted below (in section 5 Parties' Contentions), Respondent appears to claim ignorance of Complainant's FONTAINEBLEAU marks when registering the Domain Name. In its Response, Respondent does not offer any explanation why it opted to register the Domain Name.

In its unsolicited supplemental filing, Complainant annexed two documents, the second of which was sent after this UDRP proceeding was initiated.

The first document was described by Complainant as a December 18, 2021 email from Respondent offering to sell the Domain Name to "an apparent representative of Complainant". The second document was a November 3, 2023 email from Respondent's representative offering to sell the Domain Name to Complainant for USD 10,000.

In response to Complainant's supplemental filing, Respondent asserts:

"Complainant conflates two communications which occurred nearly two years apart without providing the Center with context. The first communication, an email dated December 18, 2021, was merely an invitation, with no monetary terms attached, to engage in a discussion around Complainant's future interest in the domain. The second, November 3, 2023, email was presented as part of a broader settlement conversation with Complainant (which began orally on October 30, 2023) as an offer to resolve this proceeding after Respondent's counsel conferred with Respondent."

## **5. Parties' Contentions**

### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name. Complainant alleges that the Domain Name is confusingly similar to its famous FONTAINEBLEAU marks, with the additional "lv" being a mere geographical term for Las Vegas, the city where Complainant's new resort is opening soon. Complainant asserts that Respondent clearly targeted its FONTAINEBLEAU mark, given the fame of the mark and the fact that the Domain Name is redirected to a competing hotel and casino in Las Vegas.

### **B. Respondent**

In its Response, Respondent contends primarily as follows:

"While Complainant makes much ado about the age of the marks it holds, it does not consider the broader, varied uses of the word, such as: the near-thousand-year-old chateau in France, the French Renaissance art movement, and the numerous cities, neighborhoods and parks around the world, all of which bear the name 'Fontainebleau.'"

"The disputed domain name may refer to any of those other 'Fontainebleaus,' and is accordingly not identical or confusingly similar to Complainant's marks."

Respondent denies having registered the Domain Name in bad faith. Specifically, Respondent avers:

“Respondent registered the disputed domain name was registered long before any of Complainant’s plans for development of a Las Vegas location were made public, or, upon Respondent’s belief, contemplated.”

“Accordingly, Respondent did not register the disputed domain name in order to prevent Complainant from reflecting its marks in a corresponding domain name, and Respondent has never engaged in a pattern of such conduct.”

## 6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark FONTAINEBLEAU through its assigned rights from the holder of the various FONTAINEBLEAU trademark registrations.

With respect to identity or confusing similarity, it is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

The Panel concludes that the Domain Name is confusingly similar to the FONTAINEBLEAU mark. The disputed domain name incorporates that mark in its entirety, and adds the letters “lv”. The Panel concludes that, notwithstanding these additional letters, Complainant’s mark is entirely reproduced in, and is clearly recognizable within, the disputed domain name. Accordingly, the disputed domain name is confusingly similar to Complainant’s mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Complainant has established Policy paragraph 4(a)(i).

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the disputed domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the disputed domain name. Respondent has not come forward to dispute plausible Complainant's allegations about the fame of the FONTAINEBLEAU mark. More importantly, despite the fact that the word Fontainebleau may have other meanings unrelated to Complainant's hotel resorts, Respondent has not articulated any actual reason why Respondent chose to register the disputed domain name. Based on the record evidence here, Respondent promptly tried to initiate discussions with Complainant seeking to sell the Domain Name, and, at some other point, Respondent redirected the disputed domain name to the website of a Las Vegas resort offering the same array of resort services as Complainant is about to offer in that same city. This undisputed evidence, on its own, smacks of trademark targeting by Respondent. Such conduct is clearly illegitimate.

Complainant has established Policy paragraph 4(a)(ii).

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

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of the disputed domain name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the disputed domain name; or
- (ii) that Respondent has registered the disputed 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the disputed domain name in bad faith. The Panel incorporates here its discussion above in the "Rights or Legitimate Interests" section. It is clear that Respondent had Complainant's mark in mind when registering the disputed domain name. The redirection of the disputed domain name to a competing website, and the unsolicited offer to sell the disputed domain name to Complainant (no doubt for profit; the USD 10,000 figure that emerged after the Complaint in this proceeding was filed provides some indication of what Respondent was looking for), constitute bad faith registration and use of the disputed domain name within the meaning of the above-quoted Policy paragraph 4(b)(i).

Complainant has established Policy paragraph 4(a)(iii).

## 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 <fontainebleaulv.com> be transferred to Complainant.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: November 24, 2023