

## **ADMINISTRATIVE PANEL DECISION**

Santa Barbara Hotel Operator, Inc. v. John Bonk  
Case No. D2022-2580

### **1. The Parties**

The Complainant is Santa Barbara Hotel Operator, Inc., United States of America (“United States”), represented by Paul Hastings LLP (formerly Paul, Hastings, Janofsky & Walker LLP), United States.

The Respondent is John Bonk, United States.

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

The disputed domain name <bacaraspa.com> (the “Disputed Domain Name”) is registered with DropCatch.com LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 15, 2022. On July 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 15, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 August 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 23, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on September 1, 2022. 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 a hotel operator that manages The Ritz-Carlton Bacara, an iconic luxury resort located on the Goleta coast in Santa Barbara, California, United States. The Ritz-Carlton Bacara is well-known for its luxurious spa, which encompasses 42,000 square feet and features a full selection of amenities, including a swimming pool, redwood sauna, and eucalyptus steam room. The Ritz-Carlton Bacara is a widely-known luxury destination that has received accolades from numerous publications.

The Complainant owns active United States trademark registrations in connection with categories such as resort hotel services, restaurant services, fitness and exercise facilities, beauty salon services and health spa services, retail shop and retail store services, clothing, bags, and stationery. For example, the Complainant owns the following trademarks, among others: BACARA, United States Registration No. 2,589,271, registered on July 2, 2002; BACARA, United States Registration No. 2,589,269, registered on July 2, 2002; BACARA, United States Registration No. 2,589,268, registered on July 2, 2002; and BACARA, United States Registration No. 4,461,644, registered on January 7, 2014.

The aforementioned trademarks will hereinafter be referred to as the "BACARA Mark". The Complainant has used the BACARA Mark in commerce for over twenty years and has acquired valuable goodwill in the BACARA Mark as a result of, among other things, investing in a multi-million-dollar renovation, strategic property improvements, and significant expenditures related to branding and advertising.

The Disputed Domain Name was registered on June 19, 2022, and resolves to a website that hosts pay-per-click ("PPC") sponsored hyperlinks related to health spa services, including "Massage Services", "Manicure & Pedicure", and "Massage Packages."

#### **5. Parties' Contentions**

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

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's BACARA Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith; and
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

##### **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

#### **6. Discussion and Findings**

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

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

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

#### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the BACARA Mark.

It is uncontroverted that the Complainant has established rights in the BACARA Mark based on its several years of use as well as its registered trademarks for the BACARA Mark in the United States. The consensus view is that “registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive”. See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the BACARA Mark. Moreover, the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.2.1. Thus, the Panel finds that the Complainant has rights in the BACARA Mark.

The Disputed Domain Name consists of the BACARA Mark in its entirety followed by the term “spa”, and then followed by the generic Top-Level Domain (“gTLD”) “.com”. Thus, the Disputed Domain Name is confusingly similar to the BACARA Mark. It is well established that a domain name that wholly incorporates a trademark is deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), “where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”. For example, numerous UDRP decisions have reiterated that the addition of terms to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Further, the addition of a gTLD such as “.com” in a domain name is technically required. Thus, it is well established that, as here, such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

#### **B. Rights or Legitimate Interests**

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

There is no evidence in the record suggesting that the Respondent has rights or legitimate interests in the Disputed Domain Name. The Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the Complainant’s BACARA Mark. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name.

Further, the Complainant does not have any business relationship with the Respondent and based on the use made of the Disputed Domain Name to resolve to a website that contains PPC links, the Panel finds that the Respondent is not making a *bona fide* offering of goods or services nor making a legitimate

noncommercial or fair use of the Disputed Domain Name. Panels have found that use of a domain name to redirect a domain name to third-party websites for commercial gain does not constitute a *bona fide* offering of goods or services, nor is it a legitimate noncommercial or fair use. See *F. Hoffmann-La Roche AG v. Dean Gagnon*, WIPO Case No. [D2007-1009](#) (“The use of a domain name comprising a third party’s renown trademark to redirect to a search engine consisting of third parties’ links, most probably for profit purposes, cannot be considered a use in connection with a *bona fide* offering of goods and services.”). Applying the principles under paragraph 4(c) of the Policy, panels have found that the use of a domain to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of a complainant’s mark or otherwise mislead Internet users. See [WIPO Overview 3.0](#), section 2.9. In this instance, the Disputed Domain Name resolves to a parked landing page with hyperlinks related to health spa services, which are also related to the Complainant and the services provided by the BACARA Mark. Based on the use made of the Disputed Domain Name to resolve to a PPC landing page with links related to health spa services, the Panel finds that the Respondent was not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name. On the contrary, the Respondent purportedly uses the BACARA Mark for commercial gain as the Respondent may well have received referral fees when users clicked the hyperlinks.

Finally, the composition of the Disputed Domain Name, comprising the entirety of the BACARA Mark, except with the addition of the term “spa”, carries a risk of implied affiliation and cannot constitute fair use here, as it effectively suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

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

The Panel finds that, based on the record, the Complainant has demonstrated the existence of the Respondent’s bad faith pursuant to paragraph 4(b) of the Policy as set forth below.

First, based on the circumstances here, the Panel concludes that the Respondent registered and is using the Disputed Domain Name in bad faith in an attempt to attract Internet users to the Respondent’s landing page by creating a likelihood of confusion with the Complainant’s BACARA Mark as to the source, sponsorship, affiliation or endorsement of the Disputed Domain Name’s resolving webpage. The Respondent’s registration and use of the Disputed Domain Name indicate that such registration and use had been done for the specific purpose of trading on the name and reputation of the Complainant and its BACARA Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*, WIPO Case No. [D2000-0847](#) (“[t]he only plausible explanation for Respondent’s actions appears to be an intentional effort to trade upon the fame of Complainant’s name and mark for commercial gain”).

Second, the Respondent attracts users for commercial gain by displaying third party PPC links on the landing page to which the Disputed Domain Name resolves. The use of a confusingly similar domain name to display third party sponsored hyperlinks and allegedly collect click-through fees is evidence of bad faith under paragraph 4(b)(iv) of the Policy. As such, the Respondent was not only trading on consumer interest in the Complainant in order to generate Internet traffic and to commercially benefit from the links that appeared on the landing page, but the Respondent also purportedly derived commercial advantage in the form of referral fees. In the Panel’s view, this constitutes bad faith. See *Fox News Network, LLC v. Warren Reid*, WIPO Case No. [D2002-1085](#); *Volvo Trademark Holding AB v. Unasi, Inc.*, WIPO Case No. [D2005-0556](#); *Lewis Black v. Burke Advertising, LLC*, WIPO Case No. [D2006-1128](#). Moreover, given that the Disputed Domain Name redirected users to third-party sponsored sites, the Panel may reasonably infer that the Respondent was redirecting traffic to these third-party websites in exchange for a fee. See *Pfizer Inc. v. lipidor.com DNS Services*, WIPO Case No. [D2003-1099](#) (drawing “reasonable inference” respondent was redirecting traffic in exchange for fee).

Third, the Disputed Domain Name was registered several years after the Complainant first began using its BACARA Mark and after the Complainant registered the BACARA Mark. The Panel finds that the

Respondent had the Complainant's BACARA Mark in mind when registering the Disputed Domain Name. Moreover, based on the use made by the Respondent of the BACARA Mark to resolve to PPC links related to health spa services, it strains credulity to believe that the Respondent had not known of the Complainant or its BACARA Mark when registering the Disputed Domain Name. The Respondent's awareness of the Complainant and its BACARA Mark additionally suggests that the Respondent's decision to register the Disputed Domain Name intended to cause confusion with the Complainant's BACARA Mark. Such conduct indicates that the Respondent registered and uses the Disputed Domain Name in bad faith. Thus, the Panel finds that the Respondent had actual knowledge of the BACARA Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith.

Finally, the Respondent has engaged in a pattern of cybersquatting in registering multiple domains that infringe on the trademarks of other brand owners. Such cases demonstrate that the Respondent has engaged in a pattern of conduct designed to infringe upon the trademarks of others, indicative of bad faith. Evidence that a respondent previously registered domain names containing third-party trademarks, as here, establishes a pattern of cybersquatting, and demonstrates bad faith registration and use. See, e.g., *Comair Limited v. John Bonk*, WIPO Case No. [D2009-0094](#); *Ticketmaster v. John Bonk*, WIPO Case No. [D2008-1491](#).

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

## 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 <bacaraspa.com> be transferred to the Complainant.

*/Lynda M. Braun/*

**Lynda M. Braun**

Sole Panelist

Date: September 15, 2022