

ADMINISTRATIVE PANEL DECISION

Soluxury HMC v. Deepak Kumar
Case No. D2023-1853

1. The Parties

The Complainant is Soluxury HMC, France, represented by SANTARELLI, France.

The Respondent is Deepak Kumar, India.

2. The Domain Name and Registrar

The disputed domain name <clubsofitelinnandsuites.com> 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 April 25, 2023. On April 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 27, 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 (DomainsByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 2, 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 amended Complaint on May 5, 2023.

The Center verified that the Complaint together with the amended 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 May 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 26, 2023.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on June 1, 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 a subsidiary of the French company Accor, which is a world leader in hospitality with 5.400 hotels, resorts and residences in operation in more than 110 countries with a network of 802.000 rooms and 290.000 employees. Accor is engaged in all the segments of the hotel industry going from luxury to midscale and economy.

The Complainant is the French company owning and managing the SOFITEL marks and operating SOFITEL branded hotels around the world, under the control of Accor. The history of the SOFITEL mark goes back to the year 1964 when the first property was launched in Strasbourg, France. The first overseas hotel was opened in 1974 in Minneapolis, United States of America. In December 2012, the Complainant opened its first luxury hotel in India under the name "Sofitel Mumbai BKC", at Mumbai.

The Complainant owns many trademark registrations for SOFITEL in several jurisdictions around the world, including:

- International Trademark Registration Number 406.255 SOFITEL, registered on April 18, 1974 for hotel services.
- International Trademark Registration Number 614.992 SOFITEL, registered on October 29, 1993 for hotel related services.
- International Trademark Registration Number 863.332 SOFITEL, registered on August 26, 2005 in classes 35, 39, and 43.
- International Trademark Registration Number 939.096 SOFITEL, registered on August 30, 2007 in classes 35, 36, 43 and 44.

The Complainant also owns numerous domain names including its trademark SOFITEL in order to promote its services, such as <sofitel.com> registered on April 11, 1997, <sofitel.info>, <sofitel.net> and <sofitel.in> to cover the ccTLD for India.

The disputed domain name was registered on December 12, 2022 and resolves to a webpage which promotes hotel services which compete with those offered by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant is the French Company owning and managing the SOFITEL marks and operating SOFITEL branded hotels around the world, under the control of Accord. Since the year 1964, the Complainant has shown continuous and remarkable growth. In February 2023, SOFITEL is the only French brand of luxury hotels located in 5 continents with establishments in 45 countries across the world with operations in 120 SOFITEL branded hotels and 31.229 rooms (as of February 28, 2023).

In December 2012, the Complainant opened its first luxury hotel in India under the name "Sofitel Mumbai BKC", at Mumbai.

The Complainant claims that the disputed domain name is confusingly similar with the trademark SOFITEL in

which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

The Respondent is the actual registered director of the Indian company “Club Sofitel Inn & Suites Private Limited” operating the website associated with the disputed domain name.

On March 15, 2023, before commencing this administrative proceeding, the Complainant sent the Respondent a cease and desist letter, which remained unanswered.

The Complainant believes that the disputed domain name has been registered for the sole reason of commercial gain by means of misleadingly diverting consumers seeking the Complainant to the Respondent’s website.

Finally, the Complainant requests the Panel to issue an order to have the disputed domain name transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with 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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainant’s SOFITEL trademarks.

The disputed domain name incorporates the Complainant’s trademark SOFITEL in its entirety, to which the terms “club” up front and “innandsuites” in the final part have been added, which certainly do not prevent a finding of confusing similarity. Section 1.8 of [WIPO Overview 3.0](#) provides that when the relevant trademark is recognizable within the disputed domain name – as it occurs in this case – the addition of a term would not prevent a finding of confusing similarity under the first element.

The “.com” generic Top-Level Domain (“gTLD”) is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark SOFITEL in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

As established in section 2.5 of [WIPO Overview 3.0](#): "Fundamentally, a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry." Here, the nature of the disputed domain name carries a risk of implied affiliation.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name.

The Panel finds that the Respondent has no rights nor legitimate interests in the disputed domain name and that the requirements of 4(a)(ii) of the Policy are fulfilled.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent must have been aware of the Complainant and the Complainant's trademarks SOFITEL mentioned in paragraph 4 above (Factual Background) when it registered the disputed domain name on December 12, 2022.

In accordance with section 3.1.4 of [WIPO Overview 3.0](#), the Panel considers that the inclusion of the Complainant's SOFITEL trademark in the disputed domain name creates a presumption of bad faith.

The Complainant has submitted evidence to support that the trademark SOFITEL mentioned in paragraph 4 above was registered and widely used many years before the Respondent registered the disputed domain name.

The Respondent when registering the disputed domain name has targeted the Complainant's trademark SOFITEL with the intention to confuse Internet users and capitalize on the fame of the Complainant's trademark.

The addition of the terms "club" and "innandsuites" to the Complainant's trademark SOFITEL in the disputed domain name, which are usual terms in the hotel sector to designate hospitality services, only contribute to create confusion among Internet consumers which will be driven to think that the website to which the disputed domain name resolves belongs to or is sponsored by the Complainant.

The clear absence of rights or legitimate interests coupled with no explanation for the Respondent's choice of the disputed domain name is also a significant factor to consider that the disputed domain name was registered in bad faith (as stated in section 3.2.1 of [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has registered and uses the disputed domain name in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

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 <clubsofitelinnandsuites.com> be transferred to the Complainant.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

Date: June 13, 2023