

**.nz Dispute Resolution Service**

**DRS Reference: 1305**

**Accor S.A.**

**v**

**Reva Willis**

**Key words -**

*Domain name*

novotelaucklandairport.co.nz

*Identical or similar trade mark or name*

Registered mark - unregistered mark - well-known mark - trade name - geographical identifier - similar - overall impression - mark with generic word

*Unfair registration*

Unfair registration - unfairly disrupting the business of the complainant - respondent having no connection with name or trade mark

*Procedure*

Transfer

**1. Parties**

**Complainant:**

Accor SA  
82 rue Henri Farman  
Issy-Les-Moulineaux 92130  
France

**Respondent:**

Reva Willis  
170 Kelso Court  
Papakura 2110  
New Zealand

**2. Domain Name**

novotelaucklandairport.co.nz (the "Domain Name")

### **3. Procedural history**

- 3.1. The Complaint was received on 28 May 2018 and the Domain Name Commission (“DNC”), notified the Respondent of the validated Complaint on 28 May 2018. The Domain Name was locked on 28 May 2018, preventing any changes to the record until the conclusion of these proceedings.
- 3.2. The Respondent did not file a Response.
- 3.3. The Complainant paid Domain Name Commission Limited the appropriate fee on 17 July 2018 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4. Robert Fisher QC, the undersigned, (“the Expert”) confirmed to the DNC on 1 August 2018 that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

### **4. Factual background**

- 4.1. The Complainant is a French company founded in 1967. It operates more than 3,645 hotels internationally under many brands including NOVOTEL. There are 9 Novotel hotels in New Zealand, including the hotel named “Hotel Novotel Auckland Airport” located at Auckland Airport.
- 4.2. The Complainant owns the European trade mark registration NOVOTEL No. 010429082 registered on 4 April 2012 covering services in class 43 and International trade mark NOVOTEL (logo) (designating, among other, New Zealand) No. 1246980, registered on 3 February 2015 covering services in class 43. The international trade mark is a logo with the word NOVOTEL dominating the image.
- 4.3. The Complainant also owns and operates numerous domain names for its business which use its brand name, for example <novotel.com>, which was registered 10 April 1997.
- 4.4. On 1 February 2017 the Respondent registered the Domain Name.
- 4.5. The Respondent is not affiliated with the Complainant, authorised by the Complainant to use the trade mark, or authorised to register any domain name incorporating the NOVOTEL mark.
- 4.6. The Domain Name led to an active page entitled “Auckland Airport”. The page title linked to a hotel and car travel insurance website. After the Complainant sent a cease and desist letter to the Respondent, the link was removed and substituted by the text: “Welcome to the Auckland Airport site”.
- 4.7. An email server is configured on the Domain Name. This allows the Respondent to send emails to anyone including the Complainant’s clients using an address ending with “@novotelaucklandairport.co.nz”. The Respondent’s email address according to WHOIS is “novotelaucklandairport@maildrop.cc”. This creates a phishing risk to potential and existing customers of the Complainant.

## 5. Parties' contentions

### a. Complainant

- 5.1. The Complainant submits that the Respondent registered and is using the Domain Name in bad faith. It says the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent must have been aware of the Complainant's reputation in NOVOTEL name due to its reputation.
- 5.2. The Complainant submitted that the phrase "aucklandairport" following NOVOTEL in the Domain Name was not sufficient to distinguish the Domain Name from its trade mark. There was no reason to use NOVOTEL except to benefit from the Complainant's reputation. It submitted that the Domain Name would inevitably divert internet traffic to the Domain Name away from the Complainant's websites, and may cause internet users to believe that the Domain Name is managed by or for the Complainant.

### b. Respondent

- 5.3. The Respondent has not provided a response.

## 6. Discussion and findings

- 6.1. The dispute is governed by the Policy issued by Domain Name Commission Ltd on behalf of InternetNZ. Critical portions of the Policy for present purposes are:

### 3. Definitions

...

**Rights** includes, but is not limited to, rights enforceable under New Zealand law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business;

...

**Unfair Registration** means a Domain Name which either:

- (i) 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
- (ii) has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights;

...

#### **4. Dispute Resolution Service**

4.1 This Policy and Procedure applies to Respondents when a Complainant asserts to the DNC according to the Procedure, that:

4.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

4.1.2 The Domain Name, in the hands of the Respondent, is an Unfair Registration.

4.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

...

#### **5. Evidence of Unfair Registration**

5.1. A non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration is set out in paragraphs 5.1.1 – 5.1.5:

5.1.1. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

(a) for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

(b) as a blocking registration against a name or mark in which the Complainant has Rights; or

(c) for the purpose of unfairly disrupting the business of the Complainant; or

5.1.2. Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

...

#### **6. How the Respondent may demonstrate in its Response that the Domain is not an Unfair Registration**

6.1. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration is set out in paragraphs 6.1.1 – 6.1.4:

6.1.1. Before being aware of the Complainant's cause for complaint (not necessarily the Complaint itself), the Respondent has:

...

- (c) made legitimate non-commercial or fair use of the Domain Name; or

6.1.2. The Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character;

...

6.2. It will be seen that to support a complaint of the present kind (as distinct from complaints regarding sub-domains) the Complainant must satisfy three elements:

- a) Rights in respect of a name or mark (para 4.1.1);
- b) Identity or similarity between that name or mark and the Domain Names (para 4.1.1); and
- c) Unfair registration in the hands of the Respondent (para 4.1.2).

***(a) Rights in respect of a name or mark***

6.3. The Complainant is the owner of two registered trade marks with the word NOVOTEL. The definition of Rights in the Policy includes marks that are registered overseas that are not necessarily enforceable in New Zealand.

6.4. The Complainant also has an unregistered trade mark in the name NOVOTEL enforceable in New Zealand. This arises out of the Complainant's operation and promotion of hotels in New Zealand trading under the name NOVOTEL.

6.5. This requirement is satisfied.

***(b) Identity or similarity between the name or mark and the Domain Name***

6.6. The second requirement is to show that the Complainant's name or mark is identical or similar to the Domain Name.

6.7. The Domain Name contains the word NOVOTEL and adds "Auckland Airport". Auckland Airport is a location in New Zealand. The inclusion of the geographical term is not a significant distinguishing feature. The Domain Name is sufficiently similar to the Complainant's marks.

6.8. This requirement is satisfied.

***(c) Unfair registration in the hands of the Respondent***

6.9. The third requirement is unfair registration. The Policy includes a non-exhaustive list of factors that may be evidence of unfair registration (paras 5.1.1 to 5.1.5).

6.10. I find that this element is satisfied also, on the basis that the Respondent registered the Domain Name for the primary purpose of unfairly disrupting the business of the Complainant. There is no other discernible reason for using

NOVOTEL in association with the geographic identifier of a real Novotel hotel. The respondent also set up an email server for the Domain Name using an address which includes "novotelaucklandairport". It is reasonable to infer that the primary purpose of this registration was to unfairly disrupt the business of the Complainant.

## 7. Decision

7.1. The three elements identified in para 6.2 above having been satisfied, I determine that the disputed Domain Name should be transferred to the Complainant.

**Place of decision** Auckland

**Date** 8 August 2018

**Expert Name** Hon Robert Fisher QC

**Signature**

A handwritten signature in blue ink, appearing to read "R. Fisher", written in a cursive style.