

## **ADMINISTRATIVE PANEL DECISION**

Six Continents Hotels, Inc., Six Continents Limited v. RAO XIUJUAN, HK-YINXIN

Case No. D2022-4315

### **1. The Parties**

The Complainants are Six Continents Hotels, Inc. United States of America (“United States”), and Six Continents Limited, United Kingdom, represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is RAO XIUJUAN, HK-YINXIN, China.

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

The disputed domain names <ihg-member.com> and <ihgmember.com> are registered with eNom, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 13, 2022. On November 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <ihg-member.com>. On November 14, 2022, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 15, 2022 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 November 16, 2022.

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 November 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2022. The Center received email

communications from the Respondent on November 16, 2022. On December 3, 2022 the Complainant requested the addition of the disputed domain name <ihgmember.com> to this proceeding (“the Additional Domain Name”). The Respondent sent a second email communication to the Center on December 7, 2022.

On December 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Additional Domain Name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Additional Domain Name which showed the same Respondent.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on December 15, 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.

The Panel issued the Administrative Procedural Order No. 1 on December 19, 2022 requesting that the Complainant provide an amended Complaint, including the Additional Domain Name by December 24, 2022; granting the Respondent until December 29, 2022 to comment on the amended Complaint; and extending the due date of the decision to January 8, 2023.

The Complainant submitted an amended Complaint on December 21, 2022. On December 21, 2022 the Respondent forwarded to the Center email communications received from the Registrar informing that the disputed domain names had been placed on registrar-hold to abuse activity such as spam, phishing or other violations of the terms and agreements. No further communication was received by the Center from the Respondent.

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

The Complainants are related corporate entities, collectively known as IHG Hotels & Resorts, one of the world’s largest hotel groups, including Crowne Plaza Hotels & Resorts; Holiday Inn Hotels; Holiday Inn Express Hotels; Holiday Inn Club Vacations; Hotel Indigo; InterContinental Hotels & Resorts; Staybridge Suites; Candlewood Suites; Six Senses Hotels, Resorts & Spas; Regent Hotels & Resorts; Kimpton Hotels & Restaurants; Hualuxe; Even Hotels; avid Hotels; and voco Hotels; as well as the IHG Rewards Club.

The Complainants, and its affiliates InterContinental Hotels Group PLC and Inter-Continental Hotels Corporation, are the owners of numerous domain names that contain the IHG trademark, including <ihg.com>, which was created on May 4, 1998, as well as the following, amongst 521 others in 116 countries or jurisdictions worldwide (Annex 9 to the Amended Complaint), trademark registrations:

- United States Trademark Registration No. 3544074 for the service mark IHG, in class 35, filed on November 14, 2006 and registered on December 9, 2008, subsequently renewed; and
- United States Trademark Registration No. 4921698 for the trademark and service mark IHG, in classes 9, 41 and 43, filed on April 1, 2015 and registered on March 22, 2016.

The disputed domain names <ihg-member.com> and <ihgmember.com> were registered on October 17, 2022, and have been used in connection with a website that appeared to be a website for the Complainant, reproducing the Complainant’s IHG trademark and the name “IHG HOTELS & RESORTS” along with a “sign in” form. Currently, Internet browsers display warning notices of potentially harmful links that have been available at the disputed domain names.

## 5. Parties' Contentions

### A. Complainant

The Complainants assert to be part of the IHG Hotels & Resorts group which owns, manages, leases or franchises, through various subsidiaries, 6,061 hotels and 888,147 guest rooms in about 100 countries and territories around the world.

According to the Complainants, the disputed domain names comprise the registered trademark IHG, with the addition of a hyphen (in one of the disputed domain names) and the word "member", and "[I]n cases where a domain name incorporates the entirety of a trademark... the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7

The Complainants further invoke previous panels' decisions under the Policy which have found that Complainants have rights in and to the IHG trademark (e.g., *InterContinental Hotels Group PLC, Six Continents Hotels, Inc., Six Continents Limited v. Domain Admin, Whois Privacy Corp. / Maddisyn Fernandes, Fernandes Privacy Holdings*, WIPO Case No. [D2017-1072](#) ("[t]he Complainant has provided proper evidence that it has registered trade mark rights in IHG in connection with hotel and resort services" and "[t]he Panel is therefore satisfied that the Complainant has established relevant trade mark rights"); and *Six Continents Hotels, Inc. v. ojk Jerry*, WIPO Case No. [D2015-1802](#) (transfer of <ihgcrowneplaza.com>).

Also according to the Complainants, previous panels have found that a domain name containing a complainant's trademark plus the word "member" (as here) is confusingly similar to the trademark. See, e.g., *Penske Truck Leasing Co., L.P. v. "Steven DelCorso" / "Tonya Wilson, DartsMail, LLC"*, WIPO Case No. [D2016-0521](#) (finding <penske-member.biz> and <penske-member.com> confusingly similar to PENSKE); *Desarrollo Marina Vallarta, S.A. DE C.V. v. Hector Rangel*, WIPO Case No. [D2015-2279](#) (finding <mayanmember.com> confusingly similar to trademarks that contain MAYAN); and *Microsoft Corporation v Momm Amed Ia*, WIPO Case No. [D2001-1454](#) (finding <msnmember.com> confusingly similar to MSN).

As to the absence of rights or legitimate interests, the Complainants argue that:

- (i) the Complainants have never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the IHG trademark in any manner;
- (ii) by using the disputed domain names in connection with a scam to impersonate the Complainants (Annexes 7-8 to the Amended Complaint), the Respondent clearly has not used the disputed domain names "in connection with a *bona fide* offering of goods or services" and, therefore, cannot establish rights or legitimate interests pursuant to paragraph 4(c)(i) of the Policy; and
- (iii) the Respondent has never been commonly known by the disputed domain names and has never acquired any trademark or service mark rights in the disputed domain names.

Furthermore, the Complainants point out that given that the IHG trademark is a famous trademark, protected by 523 registrations in 116 countries or jurisdictions worldwide and that the Respondent has used the disputed domain names to impersonate the Complainants, acted in bad faith, evidently aware of the Complainants and their well-known trademark.

### B. Respondent

On November 16, 2022 the Respondent sent an informal communication to the Center stating "the domain had been suspended.". On December 7, 2022, the Respondent sent a second informal email message stating: "Hello, This name is on Registrar Freeze."

On December 21, 2022 the Respondent forwarded to the Center email communications received from the Registrar informing that the disputed domain names had been placed on registrar-hold to abuse activity such as spam, phishing or other violations of the terms and agreements.

No further communication or formal reply was further submitted by the Respondent.

## **6. Discussion and Findings**

Firstly, the Panel has to address the possibility of the Additional Domain Name being object of this procedure after the initial deadline for the Response. Given that the Additional Domain Name was registered by the same Respondent, on the same date, through the same Registrar and used in connection with the same fraudulent scam to impersonate the Complainant, this Panel finds a broader interest in having the two disputed domain names dealt with at the same procedure.

Therefore, considering all the circumstances of the present case, the Panel will proceed to a decision on the merits and analyze the three requisite elements under paragraph 4(a) of the Policy which have to be met for this Panel to order the transfer of the disputed domain names to the Complainants:

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain names to the Complainants:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Complainants must prove in this administrative proceeding that each of the aforesaid three elements is present so as to have the disputed domain names transferred to them, according to paragraph 4(a) of the Policy.

In accordance with paragraph 14(b) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

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

The Complainants have established rights in the IHG trademark.

It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". ([WIPO Overview 3.0](#), section 1.7). The Complainants' mark is entirely reproduced in the disputed domain names. The addition of the term "member" in both disputed domain names and of the hyphen ("-") in the first disputed domain name, in this Panel's point of view, does not prevent a finding of confusing similarity between the disputed domain names and the Complainants' trademark.

For the reasons above, the Panel finds that the disputed domain names are confusingly similar to the Complainants' trademark.

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

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate the Respondent's rights to or legitimate interests in the disputed domain names. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain names, 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 disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainants to make a *prima facie* case against the Respondent.

In that sense, the use of the disputed domain names in connection with a scam to impersonate the Complainants (Annexes 7-8 to the Amended Complaint) clearly indicates that the Respondent has not used the disputed domain names "in connection with a *bona fide* offering of goods or services" and, therefore, cannot establish rights or legitimate interests pursuant to paragraph 4(c)(i) of the Policy.

In addition to that, the Complainants indeed state that they have never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the IHG trademark in any manner. Moreover, the lack of evidence as to whether the Respondent is commonly known by the disputed domain names or the absence of any trademarks registered by the Respondent corresponding to the disputed domain names, indicates that the Respondent does not hold rights or legitimate interests in the disputed domain names.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain names.

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

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

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

The registration and use of the disputed domain names in bad faith can be found in the present case in view of the following circumstances:

- (i) the use of the disputed domain names in connection with a fraudulent scam, having the Respondent attempted to impersonate the Complainants;
- (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain names;
- (iii) the distinctiveness and long-standing use of the Complainants' trademark and the nature of the disputed domain names, being composed of the Complainants' trademark in its entirety; and
- (iv) the indication of a false address in the Whois data and, consequently, the Center not being able to have communications fully delivered to the Respondent.

For the reasons stated above, the Panel finds that the disputed domain names were registered and are being used in bad faith.

The third element of the Policy has therefore been established.

## **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 names <ihg-member.com> and <ihgmember.com> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: January 6, 2023