

ADMINISTRATIVE PANEL DECISION

Santa Barbara Hotel Operator, Inc. v. Registration Private, Domains By Proxy, LLC / Eun Lee, duigital.com
Case No. D2022-2579

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 Registration Private, Domains By Proxy, LLC, United States of America / Eun Lee, duigital.com, Republic of Korea¹.

2. The Domain Name and Registrar

The disputed domain name <thebacara.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 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 disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 26, 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 July 29, 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

¹ The Panel notes an email from the Registrar stating that Domains by Proxy LLC is only a privacy service and that the same should not be listed as a respondent. The Complainant noted that Domains by Proxy LLC appeared in the publicly-available Whois as the registrant of the disputed domain name at the time the Complaint was filed. While the Panel understands the intention behind the Registrar’s request, it is noted that a standard UDRP practice (flowing from the definition of “Respondent” in the Rules, paragraph 1) has been to record the named privacy or proxy service in the case caption, with the substantive merits being addressed to the underlying registrant, assuming one exists and has been identified by the concerned registrar. Moreover, as discussed below, the Panel finds the retention of a privacy service relevant in the present case.

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 sent an informal communication to the Center on August 2, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the parties that it would proceed to panel appointment on August 23, 2022.

The Center appointed Adam Taylor as the sole panelist in this matter on August 31, 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 operates a luxury resort in California called “The Ritz-Carlton Bacara”, which it acquired in 2017. Previously the resort was known as “Bacara Resort & Spa”.

The Complainant owns a number of trade marks for BACARA, including United States trade mark no. 2589271, filed on February 4, 2000, registered on July 2, 2002, in class 25.

The disputed domain name was registered on June 8, 2022.

As of June 27, 2022, the disputed domain name resolved to a WordPress holding page.

5. Parties’ Contentions

A. Complainant

The following is a summary of the Complainant’s contentions.

The Complainant has built up valuable goodwill in the BACARA trade marks, including as a result of significant expenditure on branding and advertising. The Complainant’s resort is a widely-known luxury destination that has received accolades from travel and other publications.

The disputed domain name is confusingly similar to the Complainant’s mark, as the two are virtually identical, with only the insignificant addition of the word “the” in the disputed domain name.

The Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant has not authorised the Respondent to use its trade mark.

There is no evidence that the Respondent has ever been or is commonly known by the disputed domain name. Nor has the Respondent registered the disputed domain name as a trade mark. Rather, the Respondent registered the disputed domain name to trade on the reputation of the Complainant’s trade mark and divert its customers.

The disputed domain name was registered and is being used in bad faith.

When he registered the disputed domain name, the Respondent was likely aware of the Complainant’s well-known and distinctive BACARA trade marks, which had been in use for many years previously.

The fact that the disputed domain name is virtually identical to the Complainant's well-known trade mark of itself creates a presumption of bad faith.

The disputed domain name constitutes a passive holding in bad faith in light of: the fame and distinctive of the Complainant's marks; the lack of any plausible explanation for registration of the disputed domain name other than to trade on the Complainant's goodwill; the fact that "Bacara" is an invented term with no semantic value that the Respondent might have sought to use in good faith; and the Respondent's lack of any connection with any activity or trade carried out under the name "Bacara".

In the circumstances, use of a privacy service constitutes further evidence of bad faith.

B. Respondent

The Respondent did not submit a formal response. However, the Respondent did send an informal email from the Respondent to the Center on August 2, 2022, a summary of which is as follows.

The Respondent legitimately purchased the disputed domain name and will update the website in the future. There is no content on the website because the business has not yet started.

The Respondent registered the disputed domain name because it "becomes 'Baccarat', a casino game, when pronounced in Korean and 'baccara' in English". Because the Respondent did not "have a 'bacara' domain", he bought the disputed domain name on GoDaddy's recommendation.

The Respondent understands why the Complainant needs the disputed domain name and why it filed the Complaint, but he proposes to use the disputed domain name himself unless he is given a good reason otherwise.

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Preliminary Issue – Informal Response

The Response is in the form of an email to the Center, which does not comply with the formal requirements set out in paragraph 5 of the Rules. For example, there is no statement of truth. The Panel has nonetheless decided to admit the Response in accordance with its powers under paragraph 10(d) of the Rules but to bear in mind the Response's non-compliance with the Rules, including in particular the absence of a statement of truth, when weighing up the Respondent's assertions in this case.

B. Identical or Confusingly Similar

The Complainant has established registered rights in the mark BACARA.

Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") makes clear that, where the relevant trade mark is recognisable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element.

Here, the disputed domain name consists of the Complainant's distinctive trade mark, which remains readily recognisable within the disputed domain name, plus the additional term "the", which does not prevent a finding of confusing similarity as explained above.

For the above reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trade mark and that the Complainant has therefore established the first element of paragraph 4(a) of the Policy.

C. Rights or Legitimate Interests

As explained in section 2.1 of WIPO Overview 3, the consensus view is that, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Here, the Complainant has not licensed or otherwise authorised the Respondent to use its trade mark.

Paragraph 4(c) of the Policy gives examples of circumstances which, if proved, suffice to demonstrate that a respondent possesses rights or legitimate interests.

As to paragraph 4(c)(i) of the Policy, the Respondent has not actively used the disputed domain name but implies that he intends to do so in connection with the casino game "Baccarat".

As explained in section 2.2 of [WIPO Overview 3.0](#), where a respondent relies on future plans, clear contemporaneous evidence of *bona fide* pre-complaint preparations is required. While, depending on the circumstances, such evidence may not need to be particularly extensive, it must go beyond a mere statement of a claimed intention. Also, because business plans and operations can take time to develop, panels have not necessarily required evidence of intended use to be available immediately after registration of a domain name, but the passage of time may be relevant in assessing whether purported demonstrable preparations are *bona fide* or pretextual.

Here, the Respondent has indeed registered the disputed domain name relatively recently. However, not only has he provided no supporting evidence, but he has also failed to explain exactly how he proposes to use the disputed domain name beyond simply claiming that he registered the disputed domain name in connection with name of the card game. The Panel notes that the Respondent has not commented on the fact that the website at the disputed domain name is set up as a WordPress blog template.

Also, as mentioned in section 6A above, the Respondent has failed to make a statement of truth.

In these circumstances, the Panel considers that the Respondent has failed to establish demonstrable preparations for a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy apply in the circumstances of this case.

For the above reasons, the Panel concludes that the Complainant has established the second element of paragraph 4(a) of the Policy.

D. Registered and Used in Bad Faith

As mentioned above, the Respondent claims that he bought the disputed domain name in connection with the Baccarat card game. The Panel acknowledges that "Baccarat" seems to also be known as "Baccara".

However, the Panel is not entirely clear from the Respondent's explanation as to why he instead selected the word "bacara", which appears to be a misspelling of the name of the card game (be it "Baccarat" or "Baccara"). Nor is the Panel convinced by the Respondent's apparent (and unverified) claim that he

selected the name together with the prefix “the” on GoDaddy’s recommendation. This formulation (“the bacara”) makes no apparent sense in connection with the name of the card game (whether misspelt or not), whereas the combination is entirely comprehensible and recognisable as an abbreviated version of the name of the Complainant’s resort.

Section 3.3 of the [WIPO Overview 3.0](#) explains that, from the inception of the UDRP, panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding.

In this case, the Panel considers that the following cumulative circumstances are indicative of passive holding in bad faith:

1. the distinctiveness and fame of the Complainant’s mark;
2. the obvious connection between the disputed domain name and the name of the Complainant’s resort;
3. the implausibility of the Respondent’s explanation of his purpose in registering the disputed domain name, as discussed above;
4. the failure of the Respondent to provide details, let alone evidence, of his alleged contemplated good faith use of the disputed domain name;
5. the failure of the Respondent to submit a formal response supported by a statement of truth;
6. the Respondent’s use of a privacy service to mask its details in the publicly-available WhoIs; and
7. the implausibility of any good faith use to which the disputed domain name may be put.

For the above reasons, the Panel considers that the Complainant has established the third element of paragraph 4(a) of the Policy.

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, <thebacara.com>, be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: September 14, 2022