

## **ADMINISTRATIVE PANEL DECISION**

Orient Express v. Maximus d.o.o. (Ivica Granic)  
Case No. D2022-2871

### **1. The Parties**

The Complainant is Orient Express, France, represented by Cabinet Strato-IP, France.

The Respondent is Maximus d.o.o. (Ivica Granic), Croatia.

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

The disputed domain name <hotelorientexpress.com> is registered with Corehub S.R.L. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 4, 2022. On August 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 8, 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 August 9, 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 amended Complaint on August 10, 2022.

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 August 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 12, 2022.

The Center appointed Zoltán Takács as the sole panelist in this matter on September 19, 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, originally created by the French railway company SNCF, is an affiliate of the ACCOR Group, one of the world leading hospitality group.

The Complainant's and its predecessors activity derives from the Orient Express long-distance passenger luxury train service created in 1883 by Compagnie Internationale des Wagons-Lits ("CIWL"), whereby transportation and high-end onboard accommodation, restaurant and catering services have been offered to passengers.

With the history of nearly 140 years, the Orient Express train has been associated with the imagination of travel and refinement and has inspired world famous books and films, such as the 1934 classic novel "Murder on the Orient Express" by Agatha Christie and the 1974 movie of the same name directed by Sidney Lumet.

Among others the Complainant owns the European Union Trademark Registration ("EUTM") No. 012140893 for the mark ORIENT EXPRESS and design element with priority of September 13, 2013, registered on February 2, 2018, for multiple classes of goods and services, including accommodation services in class 43 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks.

The Complainant maintains online presence at "www.orient-express.com". The corresponding domain name was registered on February 28, 1996.

The disputed domain name was registered on September 14, 2016, and has resolved to a website used for a 3 star hotel in Zagreb, Croatia.

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

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

The Complainant contends that the disputed domain name, which incorporates its ORIENT EXPRESS trademark, is confusingly similar to it, the only difference being addition of the term "hotel" before the trademark.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant claims that the Respondent has registered and is using the disputed domain name in bad faith. The Respondent registered the disputed domain name with full knowledge of its trademark rights and is using it to intentionally attract Internet users to its competing web page for commercial gain by creating a likelihood of confusion with the Complainant and its trademark.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

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

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

## **6. Discussion and Findings**

### **6.1 Expiry of the disputed domain name**

According to the Registrar verification of August 8, 2022, the disputed domain name was set to expire on September 14, 2022.

On August 24, 2022, the Center received a confirmation from the Registrar that “the disputed domain name is locked and that its expiration date it will be automatically renewed for one year. Nothing else needs to be done at this time to ensure the renewal”.

For its part the Panel confirms that the public Whois data of September 28, 2022, indicated that the disputed domain name that was set to expire on September 14, 2022, has been renewed until September 14, 2023.

### **6.2 Language of the Proceeding**

Pursuant to paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the default language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise.

The Complaint was filed in English, but the language of the registration agreement is Croatian.

In the amended Complaint of August 10, 2022, the Complainant requested that English be the language of the proceeding, contending that administration of the proceeding in Croatian would cause delay, as well as significant translation and legal representation costs on its side.

The content of the website to which the disputed domain name pointed was in both Croatian and English language. This, in view of the Panel, demonstrates the Respondent’s level of comfort with the English language sufficient to understand the nature of the claims asserted by the Complainant and to actively participate in this proceeding if administered in English. The Respondent has been given fair opportunity to present its case, either in Croatian or English, but failed to do so.

Taking into consideration the above, observing the principles of equal treatment of the parties and procedural efficiency pursuant to paragraph 10 of the UDRP Rules, the Panel has decided that English shall be the language of the proceeding.

### **6.3 Substantive Issues**

Paragraph 15(a) of the Rules requires that the Panel’s decision be made “on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

The overriding objective of the Policy is to curb the abusive registration of domain names in cases where the registrant is seeking to profit from and exploit the trademark of another.

In order to succeed on the complaint a complainant must evidence each of the below three elements required by paragraph 4(a) of the Policy, namely that;

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (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

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where a complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for the purposes of standing to file a UDRP case.

The Complainant's trademark consist of the words ORIENT EXPRESS, followed by a design element, which does not convey any relevant information for the purpose of this proceeding. It is the word components that stand out in the Complainant's trademark, which the Respondent fully incorporated in the disputed domain name.

The disputed domain name is clearly confusingly similar to the Complainant's trademark, and the addition of the term "hotel" and the applicable ".com" Top Level Domain ("TLD") in the disputed domain name does not prevent this finding of confusing similarity (see sections 1.8 and 1.11 of the [WIPO Overview 3.0](#)).

The Complainant's EUTM Application No. 012140893 for the mark ORIENT EXPRESS and design element was filed on September 13, 2013, and it was opposed by two entities, none of which was the Respondent. The opponents withdrew their oppositions, and the application matured into registration on February 2, 2018.

The disputed domain name was registered on September 14, 2016, and the question that arises in this context is whether the Complainant has UDRP-relevant trademark rights in a mark that was registered after the registration of the disputed domain name?

The UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired its rights. Such rights must be in existence at the time of filing of the complaint and the fact that a domain name was registered before a complainant has acquired trademark rights does not by itself preclude a complainant's standing to file a UDRP case, nor a panel's finding of identity of confusing similarity under the first element (see section 1.1.3 of the [WIPO Overview 3.0](#)).

The Panel adopts this consensus view and finds that a) the Complainant's EUTM No. 012140893 for the mark ORIENT EXPRESS and design element with priority of September 13, 2013, satisfies the requirement of having trademark rights for the purpose of the Policy, and b) that the disputed domain name is confusingly similar to the Complainant's trademark and that paragraph 4(a)(i) of the Policy is satisfied.

## B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds rights in the ORIENT EXPRESS trademark; that the disputed domain name is confusingly similar to its trademark and that the Respondent is not authorized to use its trademark.

In a UDRP proceeding, it is generally understood that it is the Respondent who is in the best position to assert rights or legitimate interests in the disputed domain name (see section 2.1 of the [WIPO Overview 3.0](#)).

The Respondent has defaulted and hence not provided any evidence or circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances giving rise to rights or legitimate interests in the disputed domain name.

The disputed domain name resolves to a website where the Respondent offers accommodations in its hotel in Zagreb, Croatia. The Respondent's use of the Complainant's historic CIWL logo in the interior decorations of its hotel, on the website at the disputed domain name and in its reply to the Complainant's cease-and-desist letter are in view of the Panel indications of the Respondent's effective impersonation of the Complainant, or at least of false suggestion of its endorsement or affiliation by the Complainant.

UDRP panels have categorically held that use of a domain name for impersonation or passing off can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

While the Panel notes that the disputed domain name was registered before registration of the Complainant's trademark, the Panel finds it important to underline that:

- the filing date priority of the Complainant's trademark precedes the registration of the disputed domain name by years, and that

- the Complainant its predecessors in title have used the ORIENT EXPRESS trademark since 1883, well before the registration of the disputed domain name.

The facts of this case in view of the Panel establish that the Respondent's intent in registering the disputed domain name was to unfairly capitalize on the Complainant's unregistered trademark rights.

Furthermore, the Complainant's and its predecessors ORIENT EXPRESS luxury passenger train service used various routes through many decades and among others ran through Zagreb, Croatia, where the Respondent and its hotel is located.

The well-known status of the Complainant's ORIENT EXPRESS trademark has among others been recognized by the Judgment of the Paris Court of Appeal, 4<sup>th</sup> Chamber, Section A of February 25, 2003, and the Decision No. 2006/1388 of November 28, 2006, of the Ankara 1<sup>st</sup> Civil Court of Intellectual and Industrial Rights.

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

In addition and in particular, the Respondent's use of the Complainant's historic CIWL logo in the interior decorations of its hotel, on the website at the disputed domain name and in its reply to the Complainant's cease-and-desist letter in view of the Panel strongly suggest that the Respondent registered the disputed domain name with actual knowledge of the Complainant and its trademark rights, intending to capitalize on the goodwill of the Complainant's trademark and use it in the disputed domain name to intentionally attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of such site within the meaning of paragraph 4(b)(iv) of the Policy.

At the time of rendering of this decision the disputed domain name resolved to a website stating:

"Forbidden. You don't have permission to access this resource. Additionally, a 403 Forbidden error was encountered while trying to use an ErrorDocument to handle the request."

This forbidden error message could either mean that the Respondent is using the disputed domain name for some concealed purpose, or that it has put the disputed domain name to a passive use.

The first situation would in view of the Panel constitute a further indication of the Respondent's bad faith. If however, the forbidden message means that the Respondent has put the disputed domain name to a passive use it would not alter the Panel's conclusion either, since non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)).

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

## **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 <hotelorientexpress.com> be transferred to the Complainant.

*/Zoltán Takács/*

**Zoltán Takács**

Sole Panelist

Date: September 28, 2022