

ADMINISTRATIVE PANEL DECISION

Banyan Tree Holdings Limited v. chen shui fa
Case No. D2023-3706

1. The Parties

The Complainant is Banyan Tree Holdings Limited, Singapore, represented by Bird & Bird ATMD LLP, Singapore.

The Respondent is chen shui fa, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <banyan-group.com> (the “Domain Name”) is registered with Gname 026 Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 4, 2023. On September 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 6, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Gname.com Pte. Ltd.) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 6, 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 amendment to the Complaint on September 8, 2023.

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 September 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default October 2, 2023.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on October 4, 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 to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant was founded in 1994 in Thailand, and is today part of the Banyan Tree Group, a large global multi-brand hospitality group. As of December 2022, it operates 63 hotels and resorts in 23 different countries. The Complainant offers its goods and services from different websites, e.g., “www.banyantree.com” and “www.banyantreegroup.com”. The Complainant is also present on social media platforms.

The Complainant owns trademark registrations for BANYAN TREE in numerous jurisdictions, such as Singapore trademark number T9302788Z (registered on April 14, 1993). The Complainant has also applied for various trademarks in BANYAN GROUP (e.g., Singapore trademark application number 40202306964Q, filed on March 29, 2023), applications filed before the registration of the Domain Name.

The Domain Name was registered on April 10, 2023. At the time of the Complaint, and the time of drafting the Decision, the Domain Name resolved to a webpage in Chinese language with pornographic content.

5. Parties' Contentions

A. Complainant

The Complainant provides evidence of trademark registrations and argues that it also has unregistered common law protection. The Domain Name wholly incorporates the dominant word of the Complainant's distinctive trademark. The fact that the Domain Name is accompanied by a hyphen and the word “group” does not prevent a finding of confusing similarity.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent is not authorized, licensed, or permitted to register or use a domain name incorporating the Complainant's trademark. The Respondent's use of the Domain Name is not *bona fide*, or fair, or legitimate noncommercial use. The Domain Name resolves to a webpage with pornographic content.

The Complainant argues that the Respondent must have had knowledge of the Complainant when the Respondent registered the Domain Name, based on the fame of the Complainant's trademark. The incorporation of the “Banyan” name in the Domain Name cannot be a coincidence. The Domain Name is registered long after the Complainant had registered its trademarks. The Respondent's use of the Domain Name, to offer pornographic material, disrupts the Complainant's business and attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. It is, together with the Respondent's use of a privacy service to conceal its true identity, strong evidence of bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Domain Name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has established that it has rights in the trademark BANYAN TREE. The Domain Name incorporates a dominant feature of the BANYAN TREE trademark with the addition of a hyphen and the word "group". The additions do not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8. For the purpose of assessing the confusing similarity under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domain ("gTLD"); see [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name. While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name. Based on the record, the Respondent is not affiliated or related to the Complainant. There is no evidence that the Respondent has registered the Domain Name as a trademark or acquired trademark rights. There is no evidence of the Respondent's use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services. The Respondent's use of the Domain Name is evidence of bad faith, see below.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Based on the reputation of the Complainant, and the composition of the Domain Name, it is probable that the Respondent was aware of the Complainant and its prior rights when the Respondent registered the Domain Name. Based on the use, the Domain Name has resolved to a webpage with pornographic content, it is more probable than not that the Respondent is intentionally creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement.

For the reasons set out above, the Panel concludes that the Domain Name was registered and is being used in bad faith, within the meaning of paragraph 4(a)(iii) of the Policy.

The third element of the Policy has 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 the Domain Name <banyan-group.com> transferred to the Complainant.

/Mathias Lilleengen/

Mathias Lilleengen

Sole Panelist

Date: October 9, 2023