

## **ADMINISTRATIVE PANEL DECISION**

Accor v. NOVOTEL HOLIDAYS INN PVT LTD, Novotel  
Case No. D2023-3732

### **1. The Parties**

The Complainant is Accor, France, represented by Santarelli Group, France.

The Respondent is NOVOTEL HOLIDAYS INN PVT LTD, Novotel, India.

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

The disputed domain name <novotelholidaysinn.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 September 6, 2023. On September 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 7, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 8, 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 amended Complaint on September 8, 2023.

The Center verified that the Complaint [together with the amendment to the Complaint/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 September 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 2, 2023. The Center received email communications from an entity connected to the disputed domain name on September 23, and October 2, 2023. Accordingly, the Center notified the Commencement of Panel Appointment Process on October 11, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on October 13, 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 by the Center to ensure compliance with the Rules, paragraph 7.

On October 23 and 25, 2023, the Respondent made unsolicited supplemental filings.

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

The Complainant is a French-based group operating hotels, resorts, and vacation properties on a worldwide scale. “Novotel” is the Complainant’s midscale chain of hotels, the first of which was opened in 1967 in France. Today, the Novotel chain includes 559 hotels in 65 countries, including 17 hotels in India.

The Complainant is the owner of the following trademark registrations for the sign “NOVOTEL” (the “NOVOTEL trademark”):

- the International trademark NOVOTEL with registration No. 542032, registered on July 26, 1989 for services in International Class 42;
- the French trademark NOVOTEL with registration No. 1596591, dated June 11, 1990 for goods and services in International Classes 11, 19, 20, 28, 29, 35, 36, 37, 39, 40, 41, 42, 43, 44, and 45;
- the Indian trademark NOVOTEL with registration No. 1244252, registered on October 17, 2003 for services in International Class 42; and
- the European Union trademark NOVOTEL with registration No. 010429082, registered on April 20, 2012 for services in International Class 43.

The Complainant is also the owner of the domain name <novotel.com> registered on April 10, 1997, which resolves to the Complainant’s official website for its NOVOTEL hotel chain.

The Respondent was registered in India as a company with the name NOVOTEL HOLIDAYS INN PVT LTD on March 31, 2022.

The disputed domain name was registered on April 11, 2022. At present, browsers display warning messages when an attempt is made to access the disputed domain name. At the time of filing of the Complaint, it resolved to a website offering hotel services under various brands, including Novotel, Hyatt, Mercure, Ibis, Hilton, Ramada, Marriott, etc.

#### **5. Parties’ Contentions**

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to its NOVOTEL trademark, because it reproduces the trademark in its entirety together with the dictionary words “holidays” and “inn”. The Complainant submits that the addition of these words is not sufficient to differentiate the disputed domain name from the NOVOTEL trademark and to prevent the likelihood of confusion. According to the Complainant, the words “holidays” and “inn” compound confusion, as they describe the services provided by the Complainant, and Internet users would mainly focus on “novotel”, which is the sole distinctive element within the disputed domain name.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name, because the registration of the NOVOTEL trademark preceded the registration of the disputed domain name by many years, and the Respondent does not own a trademark containing “Novotel”.

The Complainant adds that the Respondent is not commonly known by the name "Novotel", is not affiliated with the Complainant and has not been authorized by the latter to use the NOVOTEL trademark or to register any domain name incorporating this trademark.

The Complainant points out that the disputed domain name resolves to a commercial website promoting various accommodations and hotels under international brands. After several communications and meetings, the Respondent changed its logo and removed the listing of the hotels managed by the Complainant from the website at the disputed domain name, but continued to use the name "Novotel". The Complainant notes that the website at the disputed domain name did not accurately disclose its relationship with the Complainant, because it contained a statement creating the impression that the Respondent is related to it. The website also reproduced photographs of the Complainant's properties without authorization, thus reinforcing the false impression of an official commercial relationship between the website at the disputed domain name and the Complainant. The Complainant adds that when it became aware of the registration of the disputed domain name by the Respondent, it sent a cease-and-desist letter to it.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, the NOVOTEL trademark has been registered and used in France, India and internationally for years and now benefits from a high level of public awareness. Therefore, it is very unlikely that the Respondent could have been unaware of the Complainant's rights in the NOVOTEL trademark when it registered the disputed domain name. Rather, the use of the disputed domain name in relation to hotels and hospitality services by impersonating the Complainant proves that the Respondent was aware of it and of the NOVOTEL trademark when registering the disputed domain name, and sought to commercially benefit from the Complainant's reputation and the goodwill of this trademark. According to the Complainant, by using the disputed domain name, the Respondent intentionally attempted to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's NOVOTEL trademark as to the source and the affiliation of the Respondent's website.

## **B. Respondent**

The Center received communications from email addresses connected to the disputed domain name and from an entity presenting itself as the Respondent's representative. Given the assertions, the Panel will treat the contentions together as coming from the "Respondent".

In its informal communications to the Center, the Respondent maintains that its company is legally registered in India, that the disputed domain name was legally acquired from the Registrar, and that it is operating in compliance with the applicable laws and regulations.

With its supplemental filing, the Respondent explains that it operates as an agent and only books hotels on behalf of the customers against a service fee. According to the Respondent, it never offered value for money hotel accommodation under the Complainant's brands, and displayed images of the Complainant's hotels only to show that they were available to be booked through the Respondent's agent services, and not to claim ownership in them. The Respondent submits that it has conducted a thorough investigation and cannot find any basis for the Complainant's allegations of copyright infringement.

The Respondent states that it is ready to settle the dispute against compensation.

## **6. Discussion and Findings**

### **6.1. Procedural issues**

#### **A. Transfer of a domain name containing the trademark of a third party**

The disputed domain name contains, in addition to the Complainant's NOVOTEL trademark, the trademark HOLIDAY INN owned by InterContinental Hotels Group. This fact raises the issue of whether, in the event

the Complaint is successful, it would be appropriate to order the transfer of the disputed domain name to the Complainant.

In cases like the present case, where a single complainant has filed a complaint containing a domain name which is composed of a mark owned by the complainant and the mark of a third party, but without having obtained the express consent of the third-party mark holder, UDRP panels have in some cases transferred the domain name without prejudice to the rights of others (see *WhatsApp Inc. v. Private Whois <whatsappandroid.com>*, *Private Whois <whatsappipad.com>* and *Private Whois <whatsappiphone.com>*, WIPO Case No. [D2012-0674](#); *F. Hoffmann-La Roche AG v. Bob*, WIPO Case No. [D2006-0751](#)).

This Panel follows the same approach and accepts that there is no basis to deny a complainant the remedy of transfer merely because the disputed domain name contains, in addition to this complainant's trademark, a trademark owned by a third party. Neither the Policy nor the Rules contain a provision that precludes the grant of the transfer remedy in this situation. Furthermore, neither the Policy nor the Rules contain a provision that precludes the third party from bringing an action under the Policy, or under any other applicable law, against the complainant in whose favor an order of transfer is made, in the event that the third party considers the complainant's holding of the domain name to be in violation of the Policy (see *WhatsApp Inc. v. Private Whois whatsappandroid.com*, *Private Whois whatsappipad.com* and *Private Whois whatsappiphone.com*, supra).

For the above reasons – and noting that the disputed domain name includes the combination of dictionary words “holidays” and “inn”, where “holidays” is the plural of the same term in the third-party mark (i.e., it is not identical to any third party mark), this Panel sees no reason not to make an order of transfer of the disputed domain name to the Complainant if its case under the three requirements of the Policy is established.

## **B. Supplemental Filings**

On October 23, 2023, the Respondent made a supplemental filing. The Panel notes that the Rules contain no express provision for supplemental filings by either Party, except in response to a deficiency notification or if requested by the Center or the Panel, and that the Panel has sole discretion to determine the admissibility of supplemental filings. Here, the Panel has not requested such filings, and the Respondent, being properly notified of the proceeding, had a fair opportunity to present its position and respond to the Complaint within the time limit for a response under the Rules. The Respondent provided no explanation why it could not comply with this time limit and why its supplemental filing should be admitted at this late stage. In view of this, the Respondent's supplemental filing should normally not be admitted in the proceeding. Nevertheless, the Panel decided exceptionally to admit it, because it gives an additional insight about the Respondent.

On October 25, 2023, the Respondent made a second supplemental filing, again providing no explanation why it should be admitted at this late stage. The Panel decided not to accept it. In any case, the Panel notes that if this supplemental filing was accepted, this would not have changed the outcome of this proceeding.

## **6.2. Substantive issues**

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the NOVOTEL trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the NOVOTEL trademark is recognizable within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the NOVOTEL trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms (here, “holidays” and “inn”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the NOVOTEL trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Similarly, previous UDRP panels have consistently found that the inclusion of a third-party trademark in a domain name does not obviate the recognizability of (and confusing similarity to) complainant’s trademark. (See *Pfizer, Inc. v. Martin Marketing*, WIPO Case No. [D2002-0793](#); *Hoffmann-La Roche Inc. v. #1 Viagra Propecia Xenical & More Online Pharmacy*, WIPO Case No. [D2003-0793](#); *WhatsApp Inc. v. Private Whois*, supra).

The Complainant’s mark is plainly recognizable in the disputed domain name and the Panel accepts that the disputed domain name is confusingly similar to the NOVOTEL trademark.

Based on the available record, the Panel therefore finds that 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. [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 disputed 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 disputed domain name such as those enumerated in the Policy or otherwise.

As discussed in section 2.3 of the [WIPO Overview 3.0](#), panels acting under the Policy have addressed a range of cases involving claims that the domain name corresponds to the respondent’s actual name. For a respondent to demonstrate that it (as an individual, business, or other organization) has been commonly known by the domain name or a name corresponding to the domain name, it is not necessary for the respondent to have acquired corresponding trademark or service mark rights. The respondent must however be “commonly known” by the relevant moniker, such as its corporate identifier, apart from the domain name. Such rights, where legitimately held/obtained, would *prima facie* support a finding of rights or legitimate interests under the UDRP. Insofar as a respondent’s being commonly known by a domain name would give rise to a legitimate interest under the Policy, panels will carefully consider whether a respondent’s claim to be commonly known by the domain name – independent of the domain name – is legitimate. Panels will additionally typically assess whether there is a general lack of other indicia of cybersquatting.

In the present case, the Respondent was registered in India as a company under the name NOVOTEL HOLIDAYS INN PVT LTD on March 31, 2022, and the disputed domain name was registered eleven days later. Taken alone, these two facts could support a conclusion that the Respondent is commonly known under a name that corresponds to the disputed domain name and that it has registered it to reflect its own name.

The situation here is however more complicated. The Complainant registered its Indian trademark NOVOTEL for hotels and hotel reservation services in 2003 (19 years before the registration of the Respondent and of the disputed domain name), and currently operates 17 Novotel hotels in India. The Respondent does not explain why it has chosen its corporate name and the disputed domain name, both of which represent the NOVOTEL trademark of the Complainant and the HOLIDAY INN trademark of a third party or – noting that “holidays” is plural unlike the third-party mark – potentially two dictionary terms. It does not deny that it has knowledge of the Complainant, and does not maintain that it is related to the Complainant or has been authorized by the Complainant to adopt a corporate name that includes “Novotel”. At the time of filing of the Complaint, the disputed domain name resolved to a website offering hotel services, including those of a number of Novotel hotels, which shows that the Respondent actually knew of the Complainant and its distinctive NOVOTEL trademark for hotel services when it registered the disputed domain name, set up its website and started offering hotel services on it. The “About Us” section of the Respondent’s website included the text:

“[...]

THE NOVOTEL HOLIDAYS INN INDIA

The Novotel holidays inn is a wholly-owned subsidiary of the Novotel holidays inn Hotels International, one of the largest and most widespread lodging franchisors of the world with over 5,000 an above (sic) hotels across the globe.

[...]”

The website at the disputed domain name also contained the copyright notice “Copyright © 2022 All rights reserved by Novotel Holidays Inn Pvt. Ltd.”

Rather than disclosing the lack of relationship between the Parties, these notices on the Respondent’s website, together with the corporate name of the Respondent, create the misleading impression that the Respondent and its website are actually affiliated to the Complainant. These notices, and the contemporary overall content of its website, contradict the Respondent’s current allegations in its supplemental filing, whereby it claims that it acts as an agent who only books hotels on behalf of customers through the website at the disputed domain name. It seems that with the supplemental filing the Respondent tries to present itself as a *bona fide* actor. Whatever its activities, the Respondent confirms that it carries them against a fee, *i.e.*, for commercial gain.

It appears that the Respondent has adopted its corporate name and has registered and used the disputed domain name not pursuing independent business activities in good faith, but in an attempt to impersonate the Complainant and free-ride on the goodwill of its NOVOTEL trademark for commercial gain (the same may or may not also be true in respect of the HOLIDAY INN trademark and its owner). The Panel therefore regards the Respondent’s adoption of its corporate name as an illegitimate attempt to circumvent the application of the Policy or otherwise prevent the Complainant’s exercise of its rights in the NOVOTEL trademark, and declines to find the Respondent rights or legitimate interests in a domain name on the basis of its corporate registration.

The Respondent’s conduct also does not comply with the cumulative requirements of the OkiData test (see section 2.8.1 of the [WIPO Overview 3.0](#)), because it is using the website at the disputed domain name to offer the hotel services not only of the Novotel chain of hotels, but also those of third parties, and because its website does not accurately and prominently disclose the Respondent’s lack of relationship with the Complainant. For this reason as well, the Respondent cannot be regarded as carrying out a *bona fide* offering of goods and services and thus having a legitimate interest in the disputed domain name.

Based on the available record, the Panel therefore finds that 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.

As discussed above, the disputed domain name is confusingly similar to the distinctive NOVOTEL trademark and has been linked to a website that offered hotel services of various brands of the Complainant and of third parties and contained false statements that created an appearance that the operator of the website is a wholly-owned subsidiary of the Complainant, while the Respondent has adopted a corporate name that also includes the NOVOTEL trademark, which in itself reinforces the same false appearance. This trademark has been registered and used by the Complainant in India for hotel services for 19 years. The Respondent has not provided a plausible explanation why its actions should be regarded as being carried out in good faith, rather than as an attempt to impersonate the Complainant for commercial gain.

Taking the above into account, and in the lack of any contrary evidence, the Panel accepts that it is more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant and targeting its NOVOTEL trademark in an attempt to attract traffic to the disputed domain name by confusing Internet users that they are reaching an online location related to the Complainant and the hotel services it offers under the NOVOTEL trademark, and to offer them the same services of the Complainant and of third parties for commercial gain. This supports a finding of bad faith under paragraph 4(b)(iv) of the Policy. The Respondent can also be regarded as targeting the HOLIDAY INN trademark of a third party, but this does not exclude the simultaneous targeting of the Complainant and its NOVOTEL trademark with the registration and use of the disputed domain name and of the Respondent's corporate name, and does not affect the above conclusion.

Based on the available record, the Panel therefore finds that 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 that the disputed domain name, <novotelholidaysinn.com>, be transferred to the Complainant.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: October 26, 2023