

ADMINISTRATIVE PANEL DECISION

Soluxury HMC, Ennismore Hotel Management UK Limited v. Serhiy Ivahnenko

Case No. D2024-0920

1. The Parties

The Complainants are Soluxury HMC, France, and Ennismore Hotel Management UK Limited, United Kingdom (“UK”), represented by Santarelli (Société IPSIDE), France.

The Respondent is Serhiy Ivahnenko, Ukraine.

2. The Domain Names and Registrar

The disputed domain names <sofitel-so-singapore.com> and <so-singapore.com> are registered with URL Solutions, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 1, 2024. On March 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 8 and 14, 2024, the Center sent email communications to the Registrar due to the lack of response to the request for registrar verification in connection with the disputed domain names. On March 26, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Private Whois, GLOBAL DOMAIN PRIVACY SERVICES INC) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same date 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 also on March 26, 2024.

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 March 27, 2024. In accordance with the Rules, paragraph

5, the due date for Response was April 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 17, 2024.

The Center appointed Kathryn Lee as the sole panelist in this matter on April 22, 2024. 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 Complainants are companies engaged in hospitality services, both owned in part or in full by Accor. Accor is a French company operating hotels, resorts, and vacation properties with more than 40 brands, including SO and SOFITEL branded hotels.

The Complainant Soluxury HMC is a French company and operates SOFITEL branded hotels worldwide. The first Sofitel hotel was opened in Strasbourg, France in 1964, and the first overseas Sofitel hotel was opened in Minneapolis, United States of America in 1974. As of February 2024, the Complainant has 120 SOFITEL branded hotels in 45 countries. In 2006, the Complainant was voted "Best Hotel Chain in Europe" by the readers of Business Traveler Magazine. It owns SOFITEL marks worldwide, including the following: International Trademark Registration Number 406255 (registered on April 18, 1974), International Trademark Registration Number 614992 (registered on October 29, 1993), and International Trademark Registration Number 863332 (registered on August 26, 2005). The Complainant also owns the SO/SOFITEL stylized mark through International Trademark Registration Number 1255818 (registered on April 16, 2015).

The Complainant Ennismore Hotel Management UK Limited is a UK company which operates SO branded hotels. It owns an international registration for the SO/ mark (International Trademark Registration Number 1429997A-SO; registered on July 25, 2018) and the SO/SINGAPORE mark (Trademark Number 40201724159P; registered on June 28, 2018) in Singapore.

The Sofitel So brand was launched as the name of a collection of design boutique hotels in 2011. The first Sofitel So hotel was launched in Mauritius, followed by Bangkok in 2012. The Sofitel So Singapore was opened in 2014. In a 2022 press release, it was announced that Sofitel So hotels would be renamed under the SO/ brand. Consequently, the Complainant Ennismore Hotel Management UK Limited launched several So hotels such as the SO/Paris Hotel in France, So Uptown Dubai in UAE, and SO/ in Maldives.

The Respondent appears to be an individual with an address in Ukraine.

The disputed domain name <sofitel-so-singapore.com> was registered on May 27, 2022, and the disputed domain name <so-singapore.com> was registered on February 19, 2023. The disputed domain name <so-singapore.com> forwards to a website promoting a hotel named SO/ SINGAPORE as well as online casino games. For this hotel, the website gives an address same as that of the Complainants' So Sofitel Singapore Hotel, and also provides a "@sofitel.com" email address. The disputed domain name <sofitel-so-singapore.com> forwards to the website linked to the disputed domain name <so-singapore.com>.

5. Procedural Consideration – Respondent's location

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

The mailing address of the Respondent, as disclosed by the Registrar, is in Ukraine, which is subject to an international conflict at the date of this Decision, and it may impact case notification. It is therefore appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules,

whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that the current proceeding should continue for several reasons. First, although the record shows that the written notice could not be delivered to the address for the Respondent disclosed by the Registrar in its verification, it appears that the Notification of Complaint and Commencement of Administrative Proceedings sent by the Center to the Respondent via email was delivered to the Respondent's email address, which was provided by the Registrar. Therefore, there is no evidence that the case notification was not successfully delivered to the disclosed respondent's email address. Further, the Panel is of the view that the Respondent's purported mailing address in Ukraine may not be genuine because it is incomplete, specifically, lacking the street number. And lastly, the Panel finds that there is strong evidence of the Respondent's bad faith registration and use of the disputed domain names in this case.

The Panel concludes that the Respondent has been given a fair opportunity to present its case, and decides that this proceeding should continue.

6. Parties' Contentions

A. Complainant

The Complainants contend that they have satisfied each of the elements required under the Policy for transfer of the disputed domain names.

Notably, the Complainants contend that the first disputed domain name reproduces the Complainants' marks SOFITEL, SO, and SO SOFITEL SINGAPORE, and the second disputed domain name reproduces the Complainant's marks SO and SO/SINGAPORE. Also, in both disputed domain names the term "singapore" is irrelevant to avoiding a finding of confusing similarity since it indicates the geographical area where the Complainants are currently operating a Sofitel hotel.

The Complainants also contend that the Respondent has no rights or legitimate interests in the disputed domain names and confirm that they have not authorized or licensed rights to the Respondent in any respect.

Finally, the Complainants contend that the disputed domain names were registered and used in bad faith. The Complainants state that the SOFITEL, SO SOFITEL, and SO marks have been registered and used internationally for many years, and are famous among the public, and it is very unlikely for the Respondent to not have been aware of the marks. The Complainants further state that the Respondent used the disputed domain names to promote a hotel named SO/ SINGAPORE using the address of the Complainants' So Sofitel Singapore Hotel and a "@sofitel.com" email address, and also by citing the name of an individual who is general manager at Pullman Singapore Hotel, which is one of the hotels managed and operated by Accor. The Complainants contend that this way, the Respondent tried to create a link with the Complainants' activity and hotel brands, and to commercially benefit from the Complainants' reputation and goodwill in their trademarks. In addition, the Complainants assert that the disputed domain names are confusingly similar to the SOFITEL, SO SOFITEL, and SO SINGAPORE marks, which also demonstrate the Respondent's bad faith intent to attract visitors to the disputed domain names away from the Complainants' official websites.

B. Respondent

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

7. Discussion and Findings

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.

The Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the marks are reproduced within the disputed domain names. Specifically, the disputed domain name <sofitel-so-singapore.com> is composed of the SOFITEL mark of the Complainant Soluxury and the SO/SINGAPORE mark of the Complainant Ennismore, and is confusingly similar to these marks. Further, the disputed domain name <so-singapore.com> is composed of the SO/SINGAPORE mark of the Complainant Ennismore, and is therefore identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available 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 names such as those enumerated in the Policy or otherwise.

The Panel notes the composition of the disputed domain names and also that the disputed domain name <so-singapore.com> resolves to a website promoting a hotel named SO/ SINGAPORE as well as online casino games and the disputed domain name <sofitel-so-singapore.com> redirects to the website linked to the disputed domain name <so-singapore.com>. Such use indicates that the Respondent attempts to obtain undue commercial gain by misleadingly diverting Internet users to the disputed domain names due to the similarity with the Complainant's marks. This cannot confer rights or legitimate interests on the Respondent.

Further, panels have held that the use of a domain name for illegal activity – here, impersonation/passing off – can never confer rights or legitimate interests on a respondent. The [WIPO Overview 3.0](#), section 2.13.1. 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.

In the present case, the Panel notes that the Respondent registered two domain names composed of the Complainants' marks. The registration of the disputed domain names which are identical/confusingly similar to the Complainants' well-known marks by the Respondent, who is unaffiliated with the Complainants, creates a presumption of bad faith. Further, based on the reputation of the Complainants and the Complainants' mark, the Respondent, more likely than not, knew of the Complainants and their marks at the time of the registration of the disputed domain names. [WIPO Overview 3.0](#), section 3.2.2.. The Respondent has not provided any explanation for having registered the disputed domain names, and with no response to claim otherwise, the Panel finds that it is more probable that the Respondent learned of the availability of the disputed domain names and registered them in order to take unfair advantage of the similarity with the Complainants' marks.

And in fact, the Respondent linked the disputed domain names to a website passing itself off as a hotel using the name SO/ SINGAPORE and the address and telephone number of the Complainants' So Sofitel Hotel in Singapore as its own and providing a "@sofitel.com" email address. Given the promotion of online casino games on the same website as well, it appears that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainants' marks.

Further, Panels have held that the use of a domain name for illegal activity – here, impersonation/passing off – constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

8. 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 <sofitel-so-singapore.com> be transferred to Soluxury HMC and the disputed domain name <so-singapore.com> be transferred to Ennismore Hotel Management UK Limited .

/Kathryn Lee/

Kathryn Lee

Sole Panelist

Date: April 30, 2024