

## **ADMINISTRATIVE PANEL DECISION**

Tortuga Bay Puntacana Resort & Club v. George Alvarez  
Case No. D2024-2116

### **1. The Parties**

The Complainant is Tortuga Bay Puntacana Resort & Club, Dominican Republic, represented by DMAC Despacho Jurídico, Dominican Republic.

The Respondent is George Alvarez, United States of America (“United States”).

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

The disputed domain names <hoteltortugabay.com> and <tortugabayresort.com> are registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 22, 2024. On May 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, 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 (Domains By Proxy, LLC) and contact information in the Complaint.

The Center sent an email communication to the Complainant on May 27, 2024, 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 May 28, 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 May 30, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 19, 2024. The Response was filed with the Center on June 19, 2024.

The Complainant sent a Supplemental Filing to the Center on June 25, 2024, to which the Respondent replied on June 26, 2024.

The Center appointed Luca Barbero as the sole panelist in this matter on June 25, 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.

On July 25, 2024, the Panel issued an Administrative Panel Procedural Order No. 1 ("Panel Order"), requesting i) the Complainant to provide clarifications as to its relationship with the companies Punta Cana Beach & Golf SA and Grupo Puntacana SA in the name of which the trademarks on which the Complainant relies upon are registered; and ii) the Parties to provide comments and/or evidence regarding the circumstances surrounding the registration of the disputed domain name <tortugabayresort.com> on July 29, 2006, inviting the Parties to provide comments and/or evidence regarding the Respondent's contention that "the Complainant had been aware of the operation of the web pages, and has approved Respondent's use of the web pages". The Parties were requested to submit the requested evidence and comments by the end of July 30, 2024.

The Complainant and the Respondent submitted Supplemental Filings in response to the Panel Order on July 30, 2024, and July 26, 2024, respectively. The Respondent sent a further Supplemental Filing on July 30, 2024, to which the Complainant replied on July 31, 2024.

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

The Complainant was founded in 2005 and is part of the resort division of the Puntacana Group, which consists of hotels, resorts, and residential communities located in the surroundings of Punta Cana, Dominican Republic. The Complainant's hotel consists of 13 private seafront villas designed exclusively by the stylist Oscar de la Renta.

The company Punta Cana Beach & Golf SA, belonging to the Puntacana Group, is the owner of the following trademark registrations, as per trademark registration certificates submitted in Annex 5 to the Complaint:

- Dominican Republic trademark registration No. 155053 for TORTUGA BAY (word mark), registered on June 29, 2006, in international classes 36 and 43;
- Dominican Republic trademark registration No. 155054 for TORTUGA BAY HOTEL (word mark), registered on June 29, 2006, in international classes 36 and 42;
- Dominican Republic trademark registration No. 237484 for TORTUGA BAY (word mark), registered on February 14, 2017, in international class 34.

The company Grupo Puntacana SA is the owner of the Dominican Republic trademark registration No. 255207 for PUNTACANA RESORT TORTUGA (word mark), registered on January 3, 2019, in class 36.

The company Punta Cana Beach & Golf SA is also the owner of the Dominican Republic registered trade names No. 453496 for TORTUGA BAY PUNTACANA RESORT & CLUB (denominative), registered on October 12, 2016; and No. 453506 for TORTUGA BAY PUNTACANA RESORT & CLUB (figurative), registered on October 12, 2016.

The Complainant promotes its hospitality services via the website at <tortugabayhotel.com> – registered on October 31, 2005 – where Internet users can find information on the TORTUGA BAY hotel, dates of availability, accommodations, amenities, direct reservations, and premium airport services.

According to the documents submitted by the Complainant as Annexes B and C to the Complainant's Supplemental Filing of July 30, 2024 – which have not been challenged by the Respondent – on July 21, 2016, the Complainant sent a cease-and-desist letter to the entity mentioned at that time under the contact section of the website to which the disputed domain name <tortugabayresort.com> resolved, i.e., Vacation Store Miami, notifying the infringement of its rights through the Respondent's unauthorized use on the website at <tortugabayresort.com> of the trademarks TORTUGA BAY, PUNTACANA, and PUNTACANA RESORT & CLUB, as well as of the images and distinctive signs of Grupo Puntacana. The Complainant also submitted copy of a reply it received from Vacation Store Miami, on July 21, 2016, in which the latter denied being the owner of the disputed domain name <tortugabayresort.com> and stated that it had no intention to claim any exclusivity over the rights of the Complainant nor to act as its representative. The Complainant sent a follow-up email to Vacation Store Miami, on July 26, 2016, reiterating the request to cease and desist from the use of the images and distinctive signs, commercial denominations, names and trademarks of Grupo Puntacana, but Vacation Store Miami did not comply.

On July 21, 2016, the Respondent filed a trademark application in the United States for TORTUGABAYRESORT.COM (word mark), which was granted under registration No. 5150836 on February 28, 2017, for the following services in international class 43: "Travel services, namely, making reservations and bookings for temporary lodging; making hotel and temporary lodging reservations for individuals and groups via a global computer network."

According to the documents provided by the Respondent, the Complainant had contacts and exchanged correspondence with Vacation Store Miami in 2016 about possible collaborations for promotion of the Complainant's hotel and signed a tour operator agreement in October 2018 with Vacation Store Miami (although such contract has been formally executed with another company of the Puntacana group, Continental Travel and Tour Limited).

The disputed domain names <tortugabayresort.com>, registered on July 29, 2006, and <hoteltortugabay.com>, registered on October 18, 2018, both point to active websites displaying on the top right corner of the home page a logo "TORTUGA BAY Punta Cana Resort & Club" and promoting the Complainant's hotel services and hospitality location. The website also displays a statement "Welcome to TortugaBayResort.com® Tortuga Bay Hotel at Punta Cana Resort & Club", the Complainant's contact information under the "Contact us" section and a link "BOOK NOW" redirecting to a third-party website where users can book apartments and rooms in hotels of the Complainant's competitors in the Dominican Republic.

## **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 names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to the Complainant's trademarks.

With reference to rights or legitimate interests in respect of the disputed domain names, the Complainant states that the Respondent has in no way been licensed or otherwise authorized to use the TORTUGA BAY mark and submits that the Respondent is not commonly known by the disputed domain names.

The Complainant also states that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names, since it is attracting Internet users to websites which appear to be the official webpages of the Complainant when, in fact, this is not the case. The Complainant also points out that the Respondent is providing links to offers of hotels of the Complainant's competitors and submits that such use of the disputed domain names does not amount to a bona fide use offering of goods or services.

With reference to the circumstances evidencing bad faith, the Complainant indicates that considering the content of the websites to which the disputed domain names resolve and the fact that once entering the pages with the images and facilities of the Complainant's hotel, users are redirected – via the “BOOK NOW” link – to other offers and other hotels in the area, the Respondent was fully aware of the Complainant at the time of registering the disputed domain names and willfully took unfair advantage of the Complainant's notoriety.

The Complainant also submits that having pointed the disputed domain names to websites that are virtually identical to the Complainant's website, the Respondent has purposely created a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its websites or location or of a product or service on its websites or locations.

## **B. Respondent**

The Respondent contends that the Complainant has not satisfied any of the elements required under the Policy for a transfer of the disputed domain name, for the following reasons.

The Respondent states that it is the president of Media Insight Inc, a media division of the wholesale tour operator Vacation Store Miami, that provides tour operations and travel packages for travel to destinations outside of the United States, to retail travel agencies and/or retail customers, covering air travel, land transfers and accommodation solutions.

The Respondent explains that wholesale tour operators have contractual and business relationships with various airlines, hotels, transportation companies, and tour companies which allow them to receive favorable net rates. Wholesale tour operators are able to make a profit by putting together their services into travel packages and selling such packages to the various travel agencies at an increased rate. However, the Respondent submits that it does not own, control, operate, or otherwise have business interest in any hotels.

The Respondent states that, as a tour operator, it books rooms for the various hotels including the Complainant's resort since Vacation Store Miami and the Complainant have had a long-standing business relationship including contracts that began in 2000, which provided for reduced rates due to the large number of rooms that the Respondent has been booking for the Complainant.

The Respondent claims that the disputed domain names are not identical or confusingly similar to the Complainant's trademarks and states that the Respondent, instead, has rights in the disputed domain names in view of its ownership of a United States trademark registration for TORTUGABAYRESORT.COM, registered on February 28, 2017, and its use of the disputed domain name <tortugabayresort.com>.

With reference to rights or legitimate interests in respect of the disputed domain names, the Respondent rebuts that, contrary to the Complainant's assertions, the Complainant had indeed licensed or otherwise authorized the Respondent to use its trade names, service marks and website, since the Respondent has had business dealings with the Complainant for over 12 years, therefore the Complainant was aware of the operation of the web pages and approved the Respondent's use of the websites.

The Respondent contends that the websites in dispute do not divert users from the Complainant's business, but on the contrary, result in substantial bookings to the Complainant's business. The Respondent further submits that the Complainant has failed to provide any evidence that suggests that the Respondent was seeking to disrupt the Complainant's business. Rather, according to the Respondent, the Complainant derived a substantial economic benefit from the Respondent and the Respondent in no way intended to divert any business from the Complainant.

The Respondent also claims that, when the Respondent refused to transfer the disputed domain names to the Complainant, the latter chose to cancel its contracts, leading the Respondent to book rooms through affiliate programs with other online travel agencies, such as Skyscanner, Expedia, and Apple Vacations, the latter being a tour operator which has contracts with the Complainant and being authorized to use the

Complainant's intellectual property. Therefore, upon becoming an affiliate, Vacation Store Miami was once again authorized to use the Complainant's intellectual property.

The Respondent also states that, as an affiliate, the websites remained the same and were still used to only promote the Complainant's hotels, and that the Complainant again received all the economic benefits of the web pages and continued to accept reservations from the Respondent. The Respondent further notes that the hotel's address and telephone numbers are displayed in the top right of the webpage and in bold on the bottom of the page, so any inquiries are made directly to the hotels.

In view of the above, the Respondent submits that it has rights and legitimate interest in the disputed domain names since it has been using the disputed domain names in connection with a bona fide offering of goods and services.

With reference to the circumstances evidencing bad faith, the Respondent indicates that considering: i) the Complainant has failed to provide any proof which would contradict the arguments raised by the Respondent; ii) that the Respondent has had contracts with the actual owner of the hotel since 2006/2007 wherein the Respondent had been authorized to sell hotel rooms on behalf of the Complainant; iii) the Respondent, pursuant to the contract, had been authorized to use the Complainant's marks and logos in its web pages; iv) the Respondent was in no way intending to sell for a profit the disputed domain names but on the contrary has spent years promoting the Complainant's hotels, mainly as a reseller of the Complainant's hotel services; v) all the web pages have the Complainant's hotel contact information, not the Vacation Store Miami ones; and vi) the Respondent is in line with all OKI Data requirements, the Complainant has failed to prove that the Respondent was and is acting in bad faith.

The Respondent concludes that the proper venue to contest the Respondent's ownership of the trademark TORTUGABAYRESORT.COM is in the United States Patent and Trademark Office, not the present proceeding, and submits that the Complainant is attempting to reverse hijack the disputed domain names.

### **C. Complainant's unsolicited Supplemental Filing**

On June 25, 2024, the Complainant sent a Supplemental Filing to the Center indicating that the agreement submitted by the Respondent is in no way valid or relevant to the present dispute, since it is a tour operator contract granted to Continental Travel and Tour Limited and the Respondent has never been granted any authorization directly by the Complainant for the use of their logos, online reservations, rooms, and services related to Tortuga Bay Puntacana.

The Complainant states that in any case the agreement presented by the Respondent as part of its annexes, expressly states under the paragraph "Reservation and Literature" that "This contract will be null and void if linked to a website without Tortuga Bay's express written consent" and that "the contracted rates can't be sold directly to the public via website [...] and if the rates are being sold via websites, that same clause stipulates that the contract shall be immediately canceled".

The Complainant concludes that in view of the above, the Complainant continues to be affected by the confusion and redirection of users by means of the Respondent's malicious use of the disputed domain names.

### **D. Respondent's unsolicited Supplemental Filing**

On June 26, 2024, the Respondent sent an email communication to the Center in response to the Complainant's Supplemental Filing, stating that the Complainant or its attorneys were being deceptive considering the Complainant issues contracts through Continental Travel and Tour Limited which they use to take payment of reservations. The Respondent also states that its trademark registration for TORTUGABAYRESORT.COM is incontestable.

## **E. Complainant's Supplemental Filings in response to the Panel Order**

In its Supplemental Filing dated July 30, 2024, the Complainant states that the domain name <tortugabayhotel.com>, registered on October 31, 2005, is the sole authorized and operating domain name related to its hotel Tortuga Bay Puntacana Resort & Club, i.e., the Complainant.

The Complainant also submits copy of the cease-and-desist letter it sent on July 21, 2016, to Vacation Store Miami, notifying the infringement of its rights through the Respondent's website at "www.tortugabayresort.com" and further correspondence, including an email dated July 21, 2016, in which Vacation Store Miami denied being the owner of the disputed domain name and stated (in Spanish) that "At no time has Vacation Store of Miami's intention been to pretend to have exclusivity over the rights of its Hotel, much less to act or act as its representative".

The Complainant also submits that the images and distinctive signs, commercial denominations, names and trademarks used on the website to which the disputed domain names resolve are the sole and exclusive property of Grupo Puntacana and/or its related affiliated companies, and that the Respondent's use generates confusion with the products, services and trademarks owned by Grupo Puntacana.

The Complainant reiterates that the Respondent has not been given any authorization to register the disputed domain names and that the Respondent's conduct amounts to an abuse as it registered the disputed domain names after the registration of its domain name <tortugabayhotel.com> and used it giving the impression that the corresponding website was the homepage of the Complainant, which is the unique and exclusive property of Grupo Puntacana.

In its Supplemental Filing of July 31, 2024, the Complainant reiterates that the contract on which the Respondent relies, signed in October 2018, is an operator contract for special rates for booking offers from December 21, 2017 to December 20, 2018, and included a clause which expressly required prior written permission for the use of the Complainant's photography and to link the contract to a website as well as the prohibition to sell the contracted rates to the public via website.

## **F. Respondent's Supplemental Filings in response to the Panel Order**

In response to the Panel Order, the Respondent sent an email communication, on July 26, 2024, in which it reiterated that the Complainant was aware of the Respondent's websites, made changes to them, and provided material and links to the resort for the Respondent to use on the websites.

To substantiate its allegations, the Respondent has provided the same documents already submitted as attachments to the Response.

In its Supplemental Filing of July 30, 2024, the Respondent reiterates that the Complainant visited its offices in 2016, and that after the visit it sent follow up emails providing links to access photos and material to use on the Respondent's website. The Respondent also reiterates that the Complainant gave contracts to the Respondent from 2016 through 2019.

## **6. Discussion and Findings**

### **6.1. Preliminary procedural issues: Parties' Supplemental Filings**

Before entering into the merits of the case, the Panel addresses the issue of the supplemental filings submitted by the Parties to the Center.

No provision concerning supplemental filings are made in the Rules or Supplemental Rules, except at the request of the panel according to paragraph 12 of the Rules, which states the panel, in its sole discretion,

may request any further statements or documents from the parties it may deem necessary to decide the case.

According to paragraph 10 of the Rules, the Panel has the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition, ensuring that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

As stated in the [WIPO Overview 3.0](#), section 4.6, unsolicited supplemental filings are generally discouraged - unless specifically requested by the panel - and the party submitting an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response.

Accordingly, UDRP panels generally accept supplemental filings only when they provide material new evidence or a fair opportunity to respond to arguments that could not reasonably have been anticipated. See, along these lines, *Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc.*, WIPO Case No. [D2017-0481](#).

The Panel notes that the Complainant's initial unsolicited Supplemental Filing consists of comments on the agreement provided by the Respondent as attachment to the Response, that was formally executed between two subjects different from the named parties (Vacation Store Miami and Continental Travel and Tour Limited) and that the Complainant could not reasonably foresee that the Respondent would submit.

The Panel therefore decided to admit the Complainant's Supplemental Filing and, in order to ensure that both parties are treated with equality and fairness, has also admitted the Respondent's Supplemental Filing, which consists of comments on the Complainant's further submissions.

Since, after reviewing the submissions of the parties, the Panel deemed appropriate to request clarifications to the Parties as to: i) the relationship among the Complainant and the companies formally indicated as registrant of the trademarks on which the Complainant relies, and ii) the circumstances surrounding the registration of the first disputed domain name <tortugabayresort.com> in 2006, the Panel issued the Panel Order, to which the Parties replied on July 26 and July 30, 2024. The Parties also submitted further Supplemental Filings on July 30 and July 31, 2024. Considering the complexity of the case and the need to ensure that the Parties are given equal opportunities to present their case, the Panel has decided to admit all such Supplemental Filings, the contents of which is reflected under sections 5 E and 5 F above.

## **6.2. Substantive issues**

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint 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." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain names registered by the Respondent are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain names;  
and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

### **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 trademarks and the disputed domain names. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant relies on trademark registrations in the Dominican Republic for TORTUGA BAY, TORTUGA BAY HOTEL, and PUNTACANA RESORT TORTUGA registered in the name of the Complainant's affiliated company Punta Cana Beach & Golf SA and the parent company Grupo Puntacana SA. The Panel finds that the Complainant has shown rights in a trademark under the Policy for purposes of standing to file a Complaint. [WIPO Overview 3.0](#), sections 1.2.1 and 1.4.1.

The Panel finds the TORTUGA BAY mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the terms "hotel" and "resort" may bear on assessment of the second and third elements, the Panel finds that this do not prevent a finding of confusing similarity between the disputed domain names and the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel also finds that the disputed domain name <hoteltortugabay.com> is confusingly similar to the trademark TORTUGA BAY HOTEL as it reproduces the entirety of the trademark with the mere inversion of the terms "tortuga bay" and "hotel". The disputed domain name <tortugabayresort.com> is also confusingly similar to the trademark PUNTACANA RESORT TORTUGA, as it encompasses the core of the trademark consisting of the word "Tortuga" and the same dictionary term "resort".

Moreover, the applicable the Top-Level Domain ("TLD") in a domain name, such as ".com" in this case, is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1

Therefore, 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.

The Complainant states that the Respondent has not been authorized to use the TORTUGA BAY trademark nor to register and use the disputed domain names. The Respondent claims rights in the disputed domain names inter alia based on its United States trademark registrations for TORTUGABAYRESORT.COM, filed on July 21, 2016, and registered on February 28, 2017, for services in class 43, and states that it was authorized to use the TORTUGA BAY mark based on an agreement signed between Vacation Store Miami, a wholesale tour operator whose media division is presided by the Respondent, and the Complainant.

The Panel notes that the first page of the agreement submitted by the Respondent ("Tortuga Bay 2018-2019 F.I.T. Rate Agreement") cites the Complainant and Vacation Store Miami as parties of the contract, although in the following paragraphs of the agreement it is indicated that the agreement is executed between Vacation Store Miami and the company Continental Travel and Tour Limited. The agreement provides rates reserved



to Vacation Store Miami as a tour operator for accommodations in the Complainant's hotel and include references to the Complainant's official website "www.tortugabayhotel.com". No reference to the disputed domain names is made.

Notably, a clause in the contract "RESERVATION FORMS AND LITERATURE" reads: "Any use of Tortuga Bay photography for the purpose of promoting your product must have prior written approval from Tortuga Bay's Sales Office. Any website or printed forms or literature pertaining to reservations must be reviewed and approved in writing by Tortuga Bay. This contract will be null and void if linked to a website without Tortuga Bay's express written consent."

Having reviewed the agreement submitted by the Respondent, the Panel finds that, even assuming that it is binding the parties in this proceeding (although the Respondent has not demonstrated its actual relationship with Vacation Store Miami and the contract appears to have been executed between such company and Continental Travel and Tour Limited), from the text of the agreement it is not possible to infer any authorization granted by the Complainant to the Respondent, express or implied, to register and use the disputed domain names, nor can such authorization be inferred from the additional documents submitted by the Respondent in this proceeding. Indeed, also the information and links about the Complainant's hotel referenced in the correspondence – submitted by the Respondent – exchanged in 2016 and 2018 between the Complainant and Vacation Store Miami appear to have an illustrative purpose and contain no mention of the disputed domain names.

The Panel notes that the disputed domain names are both pointed to websites that, together with the composition of the disputed domain names, intentionally generate the impression to be visiting the Complainant's official website at "www.tortugabayahotel.com", and which moreover publish a logo "Tortuga Bay Punta Cana Resort & Club", images and descriptions of the Complainant's resort without displaying any disclaimer of non-affiliation with the Complainant nor any information on the actual website operator. Indeed, the Respondent's websites currently only include information on the Complainant and its United States toll free number. At the same time, clicking the "BOOK NOW" button on the websites, users are redirected to a third-party website where they can look for and reserve rooms in hotels of the Complainant's competitors.

The Panel further notes that both disputed domain names were registered after the Complainant registered its own authoritative, and highly similar, domain name.

In view of the above, the Panel finds that the Respondent's use of the disputed domain names supports the Complainant's case and does not amount to what could reasonably be considered fair use.

Considering the circumstances of the case, the Panel also finds that, on balance of probabilities, the Respondent registered the trademark TORTUGABAYRESORT.COM, which was filed in the United States on July 21, 2016, surreptitiously. Such conclusion is supported by the fact that the Respondent filed a trademark application for TORTUGABAYRESORT.COM in the United States on the same day it in which the Complainant sent a cease-and-desist letter to Vacation Store Miami concerning the unauthorized use of its trademarks and images on the website at <tortugabayresort.com> (Annex B to the Complainant's Supplemental Filing of July 30, 2024). Therefore, the Panel finds that the Respondent's trademark registration does not support a claim to rights or legitimate interests under the Policy. Indeed, Panels have generally declined to find respondent rights or legitimate interests in a domain name on the basis of a corresponding trademark registration where the overall circumstances demonstrate that such trademark was obtained primarily to circumvent the application of the Policy or otherwise prevent the complainant's exercise of its rights. [WIPO Overview 3.0](#), section 2.12.

Therefore, 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.

The Panel notes that the disputed domain name <tortugabayresort.com> was registered on July 29, 2006, after the Complainant was established and the trademarks TORTUGA BAY and TORTUGA BAY HOTEL were first applied for in the Dominican Republic. Moreover, the domain name <tortugabayhotel.com>, used to promote the Complainant's hotel, was registered on October 31, 2005.

The Complainant stated that it did not authorize the Respondent to register the disputed domain names. The Respondent claimed to have been authorized to use the disputed domain name <tortugabayresort.com> -- registered in 2006, and <hoteltortugabay.com>, registered in 2018 -- to promote accommodations in the Complainant's hotel. However, the Panel notes that the documents submitted by the Respondent in its Response and Supplemental Filings do not show any authorization from the Complainant -- to the Respondent or to Vacation Store Miami -- to register or use the disputed domain names or any other domain name encompassing the Complainant's marks.

Indeed, as highlighted above, the Respondent only submitted: i) an exchange of correspondence occurred between the Complainant and Vacation Store Miami in 2016, in which no reference to the disputed domain name <tortugabayresort.com> - the only one registered at that time -- was made, and ii) a contract signed in 2018 by Vacation Store Miami which does not include any clause granting direct authorization or permission to register or use the Complainant's marks as a domain name or on online websites. Indeed, one clause ("Reservation forms and literature") expressly provides that any use of images of the Complainant as well as any website or printed forms or literature pertaining to reservations must be reviewed and approved in writing by the Complainant and, according to the records, there is no evidence that any such written authorization has been ever granted to the Respondent.

Furthermore, in response to the Complainant's cease-and-desist letter dated July 21, 2016, Vacation Store Miami -- with which the Respondent in fact claims an affiliation, stating that he is the president of a company which is the media division of Vacation Store Miami -- denied being the owner of the disputed domain name <tortugabayresort.com> and stated that at no time it had intention to claim exclusivity over the rights of the Complainant nor to act as the Complainant's representative.

In view of the above-described circumstances of the case, the Panel finds that the Complainant has demonstrated that, on balance of probabilities, the disputed domain name <tortugabayresort.com> was registered in bad faith.

In view of the foregoing, the Panel also finds that the Respondent was clearly aware of the Complainant and its trademark rights when it registered the additional disputed domain name <hoteltortugabay.com> on October 18, 2018, i.e. on the same day the above-referenced contract -- which did not grant any express or implied authorization to use the TORTUGA BAY mark as a domain name -- was signed by Vacation Store Miami.

The Panel further finds that, by pointing the inherently misleading disputed domain names to websites featuring the Complainant's marks and images of the Complainant's resort, providing information on the TORTUGA BAY hotel whilst failing to accurately and prominently disclose the Respondent's lack of relationship with the trademark owner, and promoting also hotel services of third parties, the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain, by causing a likelihood of confusion with the Complainant and its marks as to the source, sponsorship, affiliation or endorsement of its websites and the services promoted therein according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainant has also established the third element of the Policy.

#### **D. Reverse Domain Name Hijacking**

Paragraph 15(e) of the Rules provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

In the case at hand, the Panel denies the finding of Reverse Domain Name Hijacking since the Complainant was successful in proving all three substantive requirements prescribed by paragraph 4(a) of the Policy, namely, the confusing similarity of the disputed domain names with trademarks in which it has established rights, the Respondent's lack of rights or legitimate interests in the disputed domain names and its bad faith registration and use of the disputed domain names.

#### **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 names <hoteltortugabay.com> and <tortugabayresort.com> be transferred to the Complainant.

*/Luca Barbero/*

**Luca Barbero**

Sole Panelist

Date: August 22, 2024