

DISPUTE RESOLUTION SERVICE

D00023678

Decision of Independent Expert

B&B Hotels

and

Mr Anthony Thomas-Chambers

1. The Parties:

Lead Complainant: B&B Hotels
271 rue du Général Paulet
Brest
F-29200
France

Respondent: Mr Anthony Thomas-Chambers
United Kingdom

2. The Domain Name(s):

hotelbandb.co.uk (“the Disputed Domain”)

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as being of a such a as to call in to question my independence in the eyes of one or both of the parties.

22 April 2021 14:44 Dispute received
23 April 2021 12:42 Complaint validated
23 April 2021 12:51 Notification of complaint sent to parties
13 May 2021 02:30 Response reminder sent
13 May 2021 12:49 Response received
13 May 2021 12:49 Notification of response sent to parties
18 May 2021 02:30 Reply reminder sent
21 May 2021 08:57 Reply received
21 May 2021 08:57 Notification of reply sent to parties
21 May 2021 15:01 Mediator appointed
03 June 2021 15:44 Mediation started
04 June 2021 16:56 Mediation failed
04 June 2021 16:57 Close of mediation documents sent
11 June 2021 17:57 Expert decision payment received
14 June 2021 14:09 Michael Silverleaf appointed as expert
23 June 2021 Non-standard submission received from respondent
24 June 2021 Non-standard submission sent to Expert at his request

4. The Legal Framework

4.1 The complaint is brought under the Nominet DRS Policy which applies to all .uk registrations by virtue of the terms and conditions of registration. By clause 9.1 of those terms and conditions all registrants agree to be bound by the DRS Policy and by clause 13.6 that Policy forms part of the terms and conditions of registration of a .uk domain.

4.2 The DRS Policy applicable to this dispute is Version 4 in force since 1 October 2016. Paragraph 1 defines an Abusive Registration as

“A Domain Name which either:

(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; or

(ii) is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights”.

In the same paragraph Rights are defined as:

“rights, enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

4.3 Paragraph 2 of the DRS Policy provides as follows:

“2 Dispute to which the DRS applies

2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain name, in the hands of the Respondent, is an Abusive Registration.

2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”

4.4 Paragraph 5 of the DRS Policy contains a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration. They include the following factors which are relied upon by the complainants in the present case:

“5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purpose of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

...

5.1.1.3 for the purposes of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated by, or otherwise connected with the Complainant.”

5. Factual Background

5.1 The complainant describes itself in the complaint as a well-known French company B&B Hotels SA. Whilst I have not heard of it, the material which it has supplied with the complaint appears to justify the description. It was incorporated on 28 May 1990 in France and has used the name B&B Hotels ever since. Under the name it provides hotel services, restaurant services, temporary accommodation and relating booking services including booking services provided over the internet. It currently operates more than 500 hotels with a total of more than 40,000 rooms across Europe in France, Germany, Italy, Spain, Portugal, Belgium Switzerland,

Poland, Slovenia and Czechia (also known as the Czech Republic). It also operates hotels in Brazil. 280 of the complainant's hotels are in France.

5.2 The complainant has submitted a short history of the expansion of its business since opening the first two hotels in Brest and St-Malo in 1990. By 1998 it had begun to expand into Germany and in 2009 it expanded into Italy. More recently it has opened hotels in the other countries mentioned above with its 500th hotel being opened in Palermo in Sicily in 2019.

5.3 The complainant has a number of registrations for its trade mark in logo form which looks like this:



The logo is individually registered in the EU¹, France, Denmark², Canada, Qatar, Bahrain, India, Oman, Kuwait, Tunisia, Iran, Saudi Arabia, UAE, and Brazil and there is a Madrid Protocol registration at WIPO covering Bosnia Herzegovina, Switzerland, China, Algeria, Croatia, Liechtenstein, Morocco, Norway, Serbia, Russia, Turkey and Ukraine. The earliest registration in the schedule provided to me dates from 2005 and there are registrations made up to and including 2019. Both the French and EUIPO registrations were made in 2005.

5.4 The complainant also has registrations for the word marks “bb-hotel”, “bbhotel” and “hotelbb” in France, all dating from 2002.

5.5 The complainant has had a substantial turnover for a number of years. The figures it has given, which are not challenged by the respondent, are €290 million (2019), €560 million (2018), €460 million (2017) and €425 million (2016). In May 2019 the complainant was purchased by Goldman Sachs for €1.9 billion.

5.6 The complainant has submitted with the complaint extensive evidence of advertising and promotion as well as press commentary under the name B&B Hotels and the logo depicted in paragraph 5.3 above. It has also given examples of its use of the logo on its premises and staff uniforms as signage and on a wide range of articles which are supplied to customers in the course of its business, such articles including stationery, door hangars, packaging and lanyards. The complainant has listed a number of industry awards that it has won between 2006 and 2017.

¹ Following Brexit, this has automatically generated a UK registration for the same mark. Thus, there is a UK registered trade mark in force.

² From the schedule, the logo registered in Denmark may be in a slightly different colour and omit the word “hotels”. Nothing turns on this for present purposes.

5.7 As an aside, the complainant has supplied copies of a number of UDRP decisions in which it has enforced its rights against a range of similar domain names including bbhotels.net, hotel-bb.com, hotelbb.com and others.

5.8 The Disputed Domain was registered by the respondent on 12 December 2020. On 4 February 2021 the complainant's trade mark attorneys wrote to the respondent by email to inform him that the complainant had become aware of the registration. The email explained the nature of the complainant's business, mentioned that it has registered trade marks and stated that the complainant was concerned by the registration of the Disputed Domain as it very similar to the complainant's trade mark. The email went on to explain that the attorneys were instructed to file a DRS complaint and offered him the opportunity to surrender the registration or transfer it to the complainant without the need for this to be done. Finally, it asked him whether he had any plans for the Disputed Domain and indicated that the complainant would prefer to reach an amicable settlement of the nascent dispute.

5.9 No response was received to the attorneys' email and a reminder was sent on 10 February 2021. Just over an hour after the reminder the respondent emailed back to say that he had passed the email to his "solicitors who will confirm to me if your clients complaint about my company domain name has any substance".

5.11 Nothing further was heard from the respondent or his solicitors and a further reminder was sent to him by the trade mark attorneys on 2 March 2021 reminding him of the offer to surrender or transfer the Disputed Domain. The reminder gave a deadline of 10 March, following which a DRS complaint would be filed without further notice. Approximately 90 minutes after the reminder the respondent came back by email. He said he was waiting for his solicitor to make a formal response and then said the following:

"I wish to notify you that my business knowledge in trademarking and copyright and patenting is that I am not obligated to surrender to your client or anyone my very valuable commercial domain name hotelBandB.co.uk.

However, should your client wish to make an offer to purchase my domain in the usual manner then I would be willing to receive any offers.

I hate to disappoint but bullying or harassment will not succeed in this instance and any domain name complaint will be strongly resisted, if necessary through the courts."

5.12 On 6 March 2021 the respondent wrote further by email. He stated that his solicitor had confirmed that in her opinion there was no conflict between the parties' domain names as they are "completely different" and that any DRS complaint would be resisted. He went on to say that he would consider substantial offers for the Disputed Domain along with his matching new company Hotel B and B

Ltd. He stated that web developers were in the early stages of constructing the website for the “Hotel B and B booking platform” as a result of which interest from prospective purchasers would have to be received within 14 days. He then made the following statement:

“Hotel B and B .co.uk is a premium domain with global brand potential, as I expect your client realises, thereby putting it in the same category as Air BandB.co.uk and Hotel Trivago.co.uk and as such we would only be interested in receiving substantial offers for the domain and the matching new company with a guide of £1.8 million GBP”.

Finally, he asked that any “acceptable offer” should be sent to his email address in the first instance and that he would then forward it to his “patent and trademark solicitors Pinsent Masons to complete the purchase”.

5.13 There appears to have been no further communication between the parties before the present complaint was filed. Following the filing of the complaint, the respondent did not initially respond. A response was ultimately submitted by him after a response reminder notice from Nominet. The response was brief. It reads (in full) as follows:

“Dear Sirs

Re; my domain Hotelbandb.co.uk

We completely refute this complaint and the reasons provided that we should surrender our domain name mentioned above.

B&B Hotels or their domain is nothing like ours or our company and would like to notify you that our company Hotelbandb Ltd is a registered at Companies House in the UK.

We also own the domain Hotelbandb.com through another domain provider and due to the laws of priority with registration, we, therefore, will refute any unsubstantiated attempts to use our domain names. We to put it simply were first and thereby granted the domain names as you no doubt will appreciate.

Should this company continue with its assault then we shall be instructing our solicitor to issue proceedings.

I hope this now clarifies the position and no doubt realize this is nothing other than an opportunist attempt to own our very valuable company domain names.

Yours Sincerely

Anthony Thomas-Chambers
Hotelbandb Ltd”

5.14 After I was appointed as the expert to determine this dispute but before I had written this decision, I was informed by Nominet on 18 June 2021 that the respondent had emailed to say that his solicitors, Pinsent Masons, would be submitting a further statement on 22 June 2021. I note that such a statement has to be dealt with under the provisions of Paragraph 17 of the DRS Policy. I was informed at 17.07 on Wednesday 23 June that a submission had been received. In accordance with Policy I was provided with a copy of the explanatory statement required by paragraph 17.3. This said that the respondent is a litigant in person, had taken no legal advice before submitting his response, was unaware of the legal test required to be met by the complainant or the nature of the response which should be provided and that his response was accordingly incomplete. The explanatory statement also stated that the respondent is receiving treatment for cancer which has hampered his ability to deal with the complaint. No details of the treatment or its effects on the respondent were provided. After considering the position I determined that I should ask to see the further statement and it was provided to me the following day.

5.15 The document supplied to me is on Pinsent Masons headed notepaper. It identifies two individuals both of whom are male as the relevant personnel. I draw attention to this only because the respondent had previously referred to his solicitor as “she” although in the same email (see paragraph 5.12 above) he indicated that the solicitor’s firm was Pinsent Masons.

5.16 Insofar as the submission from Pinsent Masons purports to set out facts, it says the following. The respondent registered the Disputed Domain at the same time as registering company number 13080228 under the name Hotel B&B Ltd on 14 December 2020. Both were registered with the intention of setting up a hotel and B&B booking business. He has not yet had the opportunity to finalise the branding for the business, the delay having been caused by his treatment for cancer. The submission also says that he is the proprietor of the domain hotel-bandb.com which he purchased on 12 December³. Somewhat curiously, it is suggested that this was to complement his “pre-existing and owned domain name”. Whilst the latter is not specified, it is presumably the Disputed Domain (there seems to be no other obvious candidate). That was registered on the same day, 12 December 2020, as the submission itself states. It was therefore not pre-existing but contemporaneous.

5.17 The submission says that the respondent was not aware of the complainant’s business before receiving the email of 4 February to which I have referred in paragraph 5.8 above (a copy of which is annexed to the submission). The submission then states that:

“On receipt of the Complainant’s letter, the Respondent spoke to an agent at the Domain’s registrar, GoDaddy, to enquire as to its value. The GoDaddy

³ The document produced to evidence the respondent’s ownership of the domain hotel-bandb.com is cut off at the contact details heading in the copy supplied to Nominet. It does not, therefore, actually provide the required evidence. For the purposes of this decision I proceed on the basis that had the full document been supplied it would have done so.

agent informed our client that the Domain was worth a lot of money as it was a premium domain, although did not specify how much it was worth. Further our client had seen that domain names could sell for a significant sum, including www.hotels.com which reportedly sold for US\$11,000,000 (see here: [LINK TO ONLINE REPORT]). Accordingly, the Respondent wrote to the Complainant and offered to sell the Domain for £1,800,000.”

5.18 I note for completeness that the submission is in a pdf file whose name begins with “UDRP”, that it describes the present complaint as a “UDRP complaint” and that it contains what looks like a boilerplate final paragraph which refers to the Disputed Domain not being registered in bad faith. All of these references suggest that the author(s) either thought that they were dealing with a UDRP complaint or, more likely, that the submission is taken from a UDRP pro forma.

6. Parties’ Contentions

6.1 The complainant asserts in the light of the facts outlined in the previous section of this decision that the Disputed Domain is an Abusive Registration on three distinct grounds. First that it was registered primarily for selling or transferring it to the complainant or a competitor at a price greater than its costs. The complainant points to the price demanded by the respondent and says that this is too high considering that it has not been used and has no public exposure or value beyond the cost of registration. The demand for a high price indicates in the complainant’s submission a clear intent to demand a price greater than cost and a lack of intent to use the Disputed Domain seriously for a business.

6.2 Second, the complainant says that the primary purpose of registration was unfairly to disrupt the complainant’s business. The complainant points specifically to the passages in the email of 6 March which I have quoted in paragraph 5.12 above in support of this allegation as well as the facts relied in support of the first basis for the complaint.

6.3 Third, the complainant says that the respondent intends to use the Disputed Domain in a way which confuse people into thinking that it is controlled by the Complainant. It points to his parallel incorporation of a company under the name Hotel B&B Ltd as supporting this intention. It says that the intention demonstrates a wish to take unfair advantage of the complainant’s reputation in its name and trade marks and to attract internet users who will be misled into think that they would reach the complainant’s website when they will not.

6.4 The complainant says that it and its trade marks are so well-known that the respondent must have had knowledge of the complainant and the domain name in his hands is an instrument of fraud. It says that the Disputed Domain is not descriptive and the complainant is not aware of any companies using the words HOTEL and B&B, bandb or variations thereof together in their branding in relation to the provision of the services it provides.

6.5 I have quoted the respondent's initial response in full in paragraph 5.13 above. It is largely overtaken by the late formal submission from his solicitors but it does contain one matter which is different. It asserts that the respondent is also the owner of the domain hotelbandb.com. As noted in the complainant's reply, that does not appear to be the case. That domain has been held by a third party since 2008.

6.6 The respondent's solicitor's late submission asserts that the Disputed Domain is neither identical to nor confusingly similar to the complainant's brand name B&B Hotels. The submission points to the figurative nature of the complainant's registrations. It does not address the word mark registrations noted above.

6.7 In support of the allegation of lack of confusing similarity it points out that the complainant's mark includes the word HOTELS in the plural whereas the Disputed Domain uses it in the singular. It also points out that the two halves of the name are reversed, that is B&B is followed by HOTELS in the complainant's name whilst the Disputed Domain is HOTEL followed by BANDB.

6.8 The submission then proceeds to a detailed argument derived from EU trade mark law on the approach to be taken to confusing similarity where marks are short or "wholly descriptive" of the services the proprietor offers. It argues that the complainant's trade mark registrations are invalid on this ground, pointing specifically to the CJEU decision in Case C-191/01P, the well-known "doublemint" decision.

6.9 Next the submission challenges the complainant's claim that other companies do not use "hotel" and "B&B" or "bandb" in conjunction. It attaches what it describes as an advertisement on the website travelsupermarket.com in which the two are used in conjunction. This has two headings "Compare the best bed & breakfast hotels" and "What are bed & breakfast hotels?"

6.10 In consequence it asserts that there are strong arguments that the complainant's trade mark registrations are liable to cancellation and that even if they did survive such a challenge the respondent should not be prevented from registering or using a domain name which includes two wholly descriptive terms.

6.11 Finally, it asserts that it is common in the industry for brand names closely to mirror the goods and services being offered and it points to hotels.com, booking.com and bandbdirectory.co.uk as examples of this. The first two are said to be global hotel booking platforms and the last a UK and Ireland directory of B&Bs. It follows it is argued that consumers of companies operating in the travel industry are familiar with brand names which closely relate to or identical to the goods and services that the company provides and that accordingly the Disputed Domain is not confusingly similar to the complainant's brand.

7. Discussion and Findings

Rights

7.1 The first question in any DRS dispute is whether the Complainant has “Rights” as defined under paragraph 1 of the DRS Policy. This is a threshold test and is readily satisfied. In the present case the respondent’s additional submission challenges the complainant’s claim to rights, at least implicitly, by asserting that its trade mark registrations are invalid. However, as has been said repeatedly in DRS decisions, the DRS system does not determine trade mark disputes. I could not, even if I wanted to, determine whether the complainant’s numerous trade mark registrations are valid or invalid. They are in force and they constitute Rights for the purposes of the DRS Policy. If the respondent wishes to challenge them, then he has to do so in the appropriate jurisdictions.

7.2 In any event, it seems to me that the respondent may have overlooked the fact that the complainant has been trading under the name B&B Hotels for over 30 years and has a very substantial business operating under and by reference to that name. It is to say the least improbable that it has not built up a reputation and goodwill under that name which is protected in many jurisdictions. Thus, even if the respondent’s assertions as to the invalidity of the complainant’s trade mark registrations were ultimately shown to be justified, it seems to me that it is probable that the complainant would be able to assert that it has rights in the name B&B Hotels acquired by user which would satisfy the requirements of the DRS system.

7.3 Accordingly, in my view it is clear that the complainant passes the threshold requirements of showing that it has Rights.

Confusing similarity

7.4 The next question which arises in this dispute is whether the complainant’s Rights are in a name or mark which is identical or similar to the Disputed Domain as required to be shown by paragraph 2.1.1 of the DRS Policy.

7.5 The respondent argues both on the ground of descriptiveness, because these marks are short and have the individual elements of the combination reversed and because the word “hotel” is singular in the Disputed Domain and plural in the complainant’s registrations that there are significant differences between the two which enable consumers to distinguish between them. The respondent points expressly to the fact that the complainant’s mark is one with figurative elements as well as the words incorporated. As noted above, the respondent also relies upon the fact that other traders refer to bed and breakfast hotels and that brands in this industry often closely relate to the services offered. Whilst the submission does not expressly state that the consequence is that consumers are able to distinguish between similar, descriptive brands, I infer that this is the point being made.

7.6 I take it that the argument is that the “B&B Hotels”, particularly as figuratively registered, and “hotelbandb” are not confusingly similar. As noted above, the respondent has not addressed the word registrations owned by the complainant. These include “hotelbb” registered in both France and Portugal.

7.7 I have considered the arguments advanced by the respondent in support of the proposition that the complainant’s figurative mark is not confusingly similar to the Disputed Domain. The problem with those arguments is that they are either inappropriate (these marks are not particularly short) or that they concentrate on the detailed differences between the two rather than the overall impression likely to be left in the mind of a consumer who has perhaps an imperfect recollection of the complainant’s mark. It is notorious that trade mark assessment is a matter of first impression and my first impression was clearly that the two are not merely similar (the requirement of the DRS Policy) but confusingly so. It is only too easy to imagine a consumer who has stayed at one of the complainant’s hotels seeing the website hotelbandb.co.uk advertising hotel services and think that he or she is dealing with the complainant.

7.8 Looked at from the opposite perspective and taking the approach adopted by the respondent’s submissions, how similar would the two have to be before one would reach the conclusion that there is confusing similarity. Is “bandbhotel” confusingly similar to the complainant’s logo? What about “bandbhotels”? It seems to me that the answer in the last case is self-evident. The two as remembered by an average consumer are close to identical. The figurative element of the complainant’s mark will not and cannot take away the great significance of the words in what the consumer recalls.

7.9 The courts correctly regularly treat the difference between singular and plural as insignificant. It often passes unnoticed. Consequently, the first option above is also confusingly similar to the complainant’s registered marks. Given that the only difference between that and the Disputed Domain is reversal of the individual elements which make up the composite mark, I find it impossible to conclude that that change makes all the difference. It is again only too easy to imagine a consumer with an imperfect recollection thinking that the reversed pairing in the Disputed Domain is the one with which he or she is familiar.

7.10 I have taken into account the additional points made by the respondent’s solicitors, namely the fact that the registrations are figurative and the claim that others use the terms “hotel” and “bandb” in conjunction. The first does not affect the fact that the complainant’s mark will, particularly in the context of a URL, be recalled by the words it contains rather than by reference to the figurative appearance. The second assertion is not supported by the material presented by the solicitors. Neither, therefore alters my initial assessment. I accordingly conclude that the Disputed Domain is confusingly similar to the registered mark in which the complainant has Rights.

7.11 Nor, in my view does the existence of other brands in this field which are closely descriptive of the services offered affect this conclusion. First, they are different from the names in issue here. Second, it is well-known that one of the risks taken by a trader who uses a descriptive name is that there will be some confusion with the descriptive use as a result. That is an unavoidable consequence of using a largely descriptive name. Where what is in issue is confusion between competing brands, the question is whether the confusion is descriptive with the result that the confusion should be disregarded or is really branding confusion. It seems to me in this case that the confusion can only be branding confusion. A consumer familiar with the complainant's brand is not thinking of a description of the services but of a particular trade source. If he or she is confused, it can only be because the Disputed Domain appears to be or be related to that trade source.

Abusive Registration

7.12 The complainant relies on three aspects of the DRS Policy in support of its claim that the Disputed Domain is an Abusive Registration. Although they are set out in the complaint descriptively rather than by express reference to the terms of the Policy, they raise the matters identified under paragraphs 5.1.1.1, 5.1.1.3 and 5.1.2 quoted in section 4 above. The onus is on the complainant to establish one or more of these complaints.

7.13 I will start by considering the facts as they appear to me from the parties' respective submissions. The respondent registered two domains on 12 December 2020, the Disputed Domain hotelbandb.co.uk and hotel-bandb.com. The following day he applied to register a company, Hotel B&B Ltd, which was registered on 14 December 2020. No explanation is given for the difference between the two domains and I note that the respondent wrongly claimed in his initial response to the present complaint to own the domain hotelbandb.com and to have priority in time from that registration. The complainant has shown that hotelbandb.com has in fact long been registered by a third party; and the respondent's solicitors have now identified the .com domain which actually belongs to the respondent as hotel-bandb.com and as having been registered on the same day as the Disputed Domain.

7.14 The respondent claims to have registered the Disputed Domain and the limited company to set up an online booking business. If so, it is difficult to understand why the respondent should select for his .co.uk domain a name which he knew was already taken in the .com registry if he did in fact wish to start a business. The logical approach would have been to register the same name in both registries. Registration of slightly different names is an indication of cybersquatting. The false claim to own the corresponding .com domain in the respondent's initial response to the complaint is also troubling. It may simply be a mistake. It may equally suggest an intention to mislead. Both provide grounds to have doubts about the respondent's true motives in registering the Disputed Domain.

7.15 No evidence has been produced to support the respondent's assertion that he is intending to start an online booking business. The reason given for the

business not having progressed is that the respondent has been ill. However, the respondent has claimed that web developers had started work on his website in March and it seems to me that it should have been straightforward to produce some evidence to show what had been done if this were true. At the very least the identity of the developers could have been revealed and some communications between them and the respondent produced to evidence the relationship and any work product. The complaint asserts as its primary argument that the respondent registered the Disputed Domain to sell it to the complainant for a profit. The importance of showing that the real purpose of registering the Disputed Domain was to use it is therefore obvious. In those circumstances, the complete absence of evidence supporting the claim that development work has started is a further indicator to doubt the respondent's claimed motive.

7.16 After he was approached by the complainant, the respondent offered to sell the Disputed Domain and his company to the complainant for £1.8 million. When he made the offer he claimed that it was justified because it was in the same category as airbandb.co.uk and Hotel Trivago.co.uk. His solicitors now claim that the reason for the valuation is completely different and was based upon an approach the respondent made to an agent at his registrar, GoDaddy, to enquire as to the Disputed Domain's value after he received the initial letter of complaint and being told by the agent that it was worth an unspecified "lot of money" as it was a "premium domain" as well as the fact that the respondent was aware that hotels.com had sold in 2014 for US\$11 million.

7.17 If what the respondent's solicitors now say is true, why was that not stated in his original offer on 6 March to sell the Disputed Domain? Why was a completely different explanation given? The respondent has made no attempt to explain this inconsistency. Nor has any explanation been given for the price at which the respondent offered the Disputed Domain. It seems to be a large figure plucked out of the air. The domains referred to by the complainant to justify the price in his initial offer appear to be knock-off sites trading on the reputation of the corresponding well-known businesses. To me that indicates the thinking behind the respondent's registration of the Disputed Domain. It was either to extract a large price from the complainant for the domain or to set up a website to feed off the complainant's reputation under its brand. That also explains why the justification was not repeated in the respondent's solicitors' late submission but replaced by a different one. Unfortunately, the replacement explanation is equally unsatisfactory. If the respondent did in fact approach his registrar to enquire as to the value of the Disputed Domain upon being challenged by the complainant, he clearly had in mind the possibility of selling it for a substantial price, no doubt far exceeding the costs of registration.

7.18 In the light of the above facts I find it difficult to believe that the respondent registered the Disputed Domain in order to set up an online booking business but immediately thought of selling it to the complainant for a premium price when challenged. It seems to me to be far more likely that he registered it with a view to extracting a premium price in the first place.

7.19 It is also possible that the respondent had in mind the setting up a knock-off website using the Disputed Domain to encourage the complainant to pay up if no immediate offer was forthcoming but that is speculation on my part and I do not rely on it in reaching my determination.

7.20 My doubts about the respondent's motives are increased by the inconsistencies in his claims about his state of legal knowledge and the advice available to him. When he was challenged, his first response was to say that he had referred the matter to his solicitor. He followed that up with a claim that his solicitor had confirmed his view that the complaint lacked merit. In the same communication he put a price on the Disputed Domain and identified as his solicitors the firm which has now submitted a late response to the complaint on his behalf. In the statement required under paragraph 17.3 of the DRS Policy to explain the "exceptional need" which justifies making a late response the solicitors claimed that, when the respondent initially responded to the present complaint (i.e. after he wrote saying that he had been advised by the same firm of solicitors), he had not taken legal advice. That claim appears on the face of the previous documents to be untrue. Alternatively, the respondent was not telling the complainant the truth when he said that he had received legal advice. I am not in a position to determine which is the correct explanation⁴. The inconsistency confirms, however, that the respondent's assertions cannot be relied upon.

7.21 As noted in paragraph 5.17 the late submission asserts that the respondent had not heard of the complainant's business when he registered the Disputed Domain. Whilst it is not a requirement for a finding of Abusive Registration that a respondent was aware of the complainant's Rights when the registration was sought, a registration made in ignorance of those Rights will normally not be considered abusive unless subsequently put to an improper purpose. For the reasons set out above, the respondent's assertions cannot be relied on. If my conclusion that the probable reason for registering the Disputed Domain was to extract a price for it, then it is unlikely that the respondent's assertion of ignorance is true. In the circumstances, I reject it.

7.22 Further, if we consider what might have happened if the respondent had genuinely intended to set up an online booking business, it seems to me that he must have done some initial research into the market. In that case it seems to me to be more likely than not that he would at some point have come across the complainant's brand. His failure to produce any evidence of his preparatory acts makes it impossible to give him the benefit of the doubt. I therefore conclude that the respondent was, contrary to the assertion in the late submission, aware of the complainant's business when he registered the Disputed Domain.

⁴ Not assisted by the fact that the solicitors responsible for the late submission must have been aware of the inconsistency but have failed to address it.

7.23 I accordingly conclude that the primary reason for the respondent's registration of the Disputed Domain was, on the balance of probabilities, to extract from the complainant, or possibly a competitor of the complainant, a price considerably in excess of the costs of registration. That makes the Disputed Domain an Abusive Registration under paragraph 5.1.1.1 of the DRS Policy. I do not consider that he registered the Disputed Domain with the primary purpose of unfairly disrupting the business of the complainant other than by extracting a large sum of money from the complainant. That is, however, itself disruptive of the complainant's business and I therefore find the complaint under paragraph 5.1.1.3 of the Policy is also made out. Were the respondent to use the Disputed Domain to operate an online booking business, it seems to me that it would on the balance of probabilities cause at least initial interest confusion amongst members of the public familiar with the complainant's business. Accordingly, his claimed intention to do so, whether or not it is true, is a threat to act in such a way. Consequently, the complaint under paragraph 5.1.2 of the DRS Policy is also made out.

8. Decision

8.1 For the reasons identified in paragraph 7.23 above I find that the Disputed Domain is an Abusive Registration.

8.2 I accordingly direct that the Disputed Domain be transferred to the complainant.

Signed Michael Silverleaf

Dated 27 June 2021