



# **DISPUTE RESOLUTION SERVICE**

**D00022577**

## **Decision of Independent Expert**

Loew's Hotels, Inc.

and

Untagged Ltd

### **1. The Parties:**

Lead Complainant: Loew's Hotels, Inc.  
667 Madison Avenue  
New York  
10065  
United States

Respondent: Untagged Ltd  
Popeshead Court Offices  
Peter Lane  
York  
N Yorkshire  
YO1 8SU  
United Kingdom

### **2. The Domain Name:**

loews.co.uk

### **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 they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

The relevant procedural history is as follows:

|               |       |   |
|---------------|-------|---|
| 20 April 2020 | 19:07 | Dispute received                          |
| 21 April 2020 | 08:49 | Complaint validated                       |
| 21 April 2020 | 09:02 | Notification of complaint sent to parties |
| 28 April 2020 | 15:33 | Response received                         |
| 28 April 2020 | 15:34 | Notification of response sent to parties  |
| 01 May 2020   | 02:30 | Reply reminder sent                       |
| 05 May 2020   | 09:04 | Reply received                            |
| 05 May 2020   | 09:04 | Notification of reply sent to parties     |
| 05 May 2020   | 09:06 | Mediator appointed                        |
| 05 May 2020   | 09:54 | Mediation started                         |
| 27 May 2020   | 17:19 | Mediation failed                          |
| 27 May 2020   | 17:19 | Close of mediation documents sent         |
| 08 June 2020  | 02:30 | Complainant full fee reminder sent        |
| 09 June 2020  | 08:11 | Expert decision payment received          |

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

The Complainant, a New York corporation, operates distinctive and upscale hotels and resorts across the United States and Canada, though not in the United Kingdom. Since at least as early as 1962, Complainant has used the trademark LOEWS in connection with its hotels and related goods and services. Complainant and its affiliates are the registered holders of several Internet domain names that include the word LOEWS, including without limitation the <loews.com> and <loewshotels.com> domain names.

By its agents, the Complainant sent a “cease and desist” letter to the Respondent admin@untagged.co.uk on 11 February 2020. The letter included a screenshot taken on 5 February 2020, displaying various properties, each labelled as a “Loew’s” hotel (‘the Website’). From the landing page, the letter asserted, visitors could click on an advertised hotel and would be directed to a booking.com website where they could make room reservations. The links on the Website varied over time and displayed different hotel properties, including hotel properties having no connection to Complainant. The Complainant received no response to the letter.

The Domain Name was registered on 26 November 2015. The Domain Name currently resolves to a website advertising the Domain Name for sale for £999.

#### **5. Parties’ Contentions**

##### The Complaint

The Complaint alleges as follows. Since at least 1962, Complainant, its predecessors, and affiliated companies, have continuously used LOEWS in connection with the services they offer, in signage and other materials at its hotels, and in advertisements in print and online, including at www.loewshotels.com, as part of its company name, on its corporate letterhead, and in other promotional materials. The LOEWS mark is recognized throughout the world as signifying the high quality of Complainant’s services.

The Complainant owns a number of LOEWS trademark registrations in the United States, the European Union, and in the United Kingdom. Copies of the registration documents are annexed to the Complaint. The trademarks all pre-dated the date of registration of the Domain Name.

The Domain Name is identical to the word element of those trademarks, which itself is identical to the name of the Complainant (ignoring the apostrophe, which could not be replicated in a domain name, and the wholly descriptive elements).

The advertising hosted on the domain, at least as of February 2020, consisted in large part of links to websites offering hotel accommodations – Complainant’s core services – including images and names of actual Loews hotels. However, the Website also diverts Internet users to a booking.com website where reservations can be booked at Complainant’s hotels and also at properties of Complainant’s direct competitors.

#### The Response

The Response alleges concisely as follows. The Respondent, James Worrell, purchased the Domain Name because he enjoys Complainant’s hotels and wanted to travel to various Loew’s hotels, review them, and make his findings, reviews and photographs available on the Website.

#### The Reply

The Reply alleges as follows. First, neither Respondent or Untagged Ltd. are agents or licensees of Complainant, nor are they authorized to use the LOEWS trademarks as part of a domain name or otherwise in connection with hotel review services.

Second, Respondent’s alleged plans to use the Domain Name in connection with a tribute website does not qualify as fair use. Although Respondent’s URL now resolves to a website advertising the Domain Name for sale, the Panel should consider Respondent’s previous use of the Domain Name and not just that as at the date of the Complaint. Respondent likely profited by linking the Website to a third-party hotel booking website. This conduct does not constitute fair use and Respondent’s previous Website connected to the Domain Name cannot be considered a tribute site.

Further, “in considering whether use of a domain name is fair in context, the choice of domain name is again a key consideration” and Complainant’s rights in its marks outweigh Respondent’s purpose of hosting a tribute website. See *Zojirushi Corporation v. Easton* DRS 21382. Respondent’s domain name is identical to Complainant’s mark, but for the country code, and “previous Nominet decisions state that the use of an identical trade name will in almost all cases be considered to be an unfair use and unfairly detrimental to a complainant’s Rights.” *Rayden Engineering Ltd. v. Charlton* DRS 06284.

## **6. Discussions and Findings**

To succeed under Nominet’s Dispute Resolution Service Policy (the “Policy”), the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy) and second,

that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2 of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2.2 of the Policy).

### Rights

As shown by copies of registration certificates annexed to the Complaint, including United States Trademark Registration No. 1,601,550, the Complainant has Rights in respect of the LOEWS name or mark which is identical to the Domain Name.

### Abusive Registration

Paragraph 1 of the Policy defines “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. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

The Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration in paragraph 5.1 of the Policy.

The Complainant contends and has provided evidence that, before receiving any notice of this dispute, Respondent was using the Domain Name to advertise hotel booking services not endorsed by Complainant and that Respondent’s conduct in so doing should be the focus of enquiry in determining Abusive Registration. As the Appeal Panel found in *Hanna-Barbera Productions, Inc. v. Graeme Hay DRS 00389*, where a registrant’s usage of the domain name has varied from the date of registration, all uses of the domain name subsequent to registration may be considered by the Expert.

The Complaint alleges that Respondent’s Website diverted Internet users to a booking.com website where reservations could be booked at Complainant’s hotels and also at properties of Complainant’s direct competitors. The Respondent has not refuted the Complainant’s allegations.

The Response alleges that the Domain Name was registered with the intention of depicting on the Website findings, reviews and photographs from Respondent’s visits to Complainant’s hotels. Such a use by the Respondent might constitute “fair use” of the trademark under 8.2 of the Policy and evidence that the Domain Name is not an Abusive Registration, provided however, that such a tribute site is operated “solely” in tribute to or in criticism of a person or business.

On very similar facts as are present here, the Expert in *Zojirushi Corporation v. Neil Easton D 00021382* found that a purported tribute website was not solely one of tribute. The site included an invitation to “shop now”, with links to third-party sites where purchases could be made. The Expert found that the evidence justified the inference that the respondent had a commercial interest in the third-party website and that the use exceeded the scope of paragraph 8.2 of the Policy.

As in *Zojirushi*, the Complainant's allegations and evidence give rise to an inference of a commercial interest on the part of Respondent which precludes a finding of fair use of the Domain Name as a tribute site under paragraph 8.2 of the Policy.

Even were the Respondent's Website deemed a true tribute site within paragraph 8.2, however, the Domain Name may nonetheless be an Abusive Registration.

The Complaint alleges:

"Respondent's domain is identical to Complainant's mark and based on the content that was initially the focus of Respondent's website, namely, the booking of hotel accommodations, it is clear that Respondent deliberately chose this identical domain to induce confusion with Complainant's marks. It was an intentional action on Respondent's part to benefit from Complainant's reputation in the industry by registering this domain."

In *GuideStar UK v. Wilmington Business Information Limited* DRS 02193, the Appeal Panel observed:-

"Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is.

Rarely will it be the case that deliberate impersonation of this kind will be acceptable under the DRS Policy. Various decisions under the DRS Policy have condemned such practices [citations omitted]."

In *Rayden Engineering Ltd v. Diane Charlton* DRS 06284, a complainant's identical mark was used in a domain name linking to a protest site. Although it was common ground in *Rayden Engineering* that there was no evidence of any commercial use associated with the respondent's protest site, the Appeal Panel reversed the Expert's decision to dismiss the Complaint and ordered the transfer of the domain name to the complainant, based on the doctrine of "initial interest confusion." The Appeal Panel explained its decision in the following terms:-

"The Respondent has deliberately used the Complainant's trade mark as a designation for her protest site without adding any additional component that would identify it as such. She is thereby creating a likelihood of confusion with the Complainant and attracting Internet users who would not knowingly follow a "...sucks" link. The Respondent does not argue, and there is no scope for maintaining, that the Domain Names are intended to refer to anything or anyone but the Complainant."

The Appeal Panel summarised:-

"... [T]he majority view amongst Nominet Experts is that where a registrant registers or uses a domain name so as to take advantage of 'initial interest confusion' which causes a user to visit a website expecting it to have some connection with a well-known name comprised in or constituting the domain

name, he takes unfair advantage of the Rights in the name. By the time the user reads the disclaimer, or realises from the content of the Website that it is not what he was looking for, the damage is done and the advantage sought by the Respondent is achieved.”

It is reasonable to infer from the record that the Respondent received commercial gain in the form of ‘click-through’ payments or hotel booking commissions from the operation of the Website and that the site is not a tribute site within paragraph 8.2 of the Policy.

Further, by registering the LOEWS mark, the name of Complainant as the Domain Name, knowing it to be the name of Complainant luxury hotels and intending that it would be recognised as such and without the Complainant’s permission, the Respondent effectively “impersonated” LOEWS. The Respondent knowingly took advantage of ‘initial interest confusion’ on the part of public Internet users by registering the Domain Name to promote unfairly the Complainant’s hotels alongside those of Complainant’s competitors.

## **7. Decision**

I find that the Complainant has Rights in a name, which is identical to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

I, therefore, determine that the Domain Name be transferred to the Complainant.

**Signed**

**Dated 25 June 2020**