

WIPO Transfers Over 1,500 Domain Names to Hotel Group in Record Ruling

By: Jeanne L. Seewald, Esq.

Using the Uniform Domain Dispute Resolution Policy (UDRP) of the World Intellectual Property Organization (WIPO), InterContinental Hotels Group (IHG) has obtained control of 1,519 domain names from German resident Daniel Kirchhof.¹ IHG used the domain name dispute resolution process to obtain control of all of the domain names via one case, as UDRP rules allow a company to bring a case against the owner of multiple domain names if the domain names are related. In its January 19, 2010 decision, WIPO stated that it was procedurally efficient to deal with all of the separate domain name matters in one proceeding since the dispute surrounding the domain names had almost identical facts, and it transferred control of the 1,519 domain names from Kirchhof to IHG.

In the UDRP action, in order to obtain transfer of the domain names, IHG was required to show that each domain name was identical or confusingly similar to a trademark for which IHG had rights, that the domain name owner had no rights to the domain name, and that the domain name owner was using the domain name in bad faith. IHG claimed that, as one of the world's largest hotel groups, it owns, manages or controls the Holiday Inn, InterContinental, Crowne Plaza, Hotel Indigo, Staybridge Suites and Candlewood Suites brands. Most of the disputed domain names contained one of IHG's trademarks plus one or more hyphens, geographic identifiers or descriptive terms, resulting in each domain name being confusingly similar to IHG's trademarks. IHG also claimed that Kirchhof had never used the disputed domain names in connection with a bona fide offering of goods or services, but had used the names in relation to websites which falsely appeared to be associated with IHG. Further, IHG claimed that such use was in bad faith as Kirchhof registered the domain names to prevent IHG from using the domain names, and pointed out that Kirchhof also owned over 22,000 domain names that contained trademarks owned by hotel companies other than IHG. Kirchhof did not file a written response to IHG's contentions.

WIPO found that "attempting to attract internet users through misuse of a well-known trademark and the provision of links which promote goods and service competitive to IHG, cannot be considered a bona fide use."² Further, WIPO found that the large number of domain names registered by Kirchhof indicated a pattern of registering domain names to prevent a trademark owner from using such domain names to promote its trademark.³ The WIPO panel stated that this was a "textbook example of the type of bulk registration strategy to which UDRP process and jurisprudence is having to adapt in order to keep pace with the broader developments and registration trends within the domain name system."⁴ The WIPO panel determined that Kirchhof demonstrated bad faith by (1) registering the domain names for the purpose of disrupting the business of IHG; and (2) registering the domain names to intentionally attempt to attract commercial gain.

This decision opens the door for trademark owners to coordinate domain name problems into one case and more efficiently and cost-effectively deal with domain name disputes.

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¹ *InterContinental Hotels Corporation, Six Continents Hotels, Inc. v. Daniel Kirchhof*, Case No. D2009-1661 (WIPO January 19, 2010).

² D2009-1661, p. 13.

³ D2009-1661, p. 14.

⁴ D2009-1661, p. 4.