

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Millennium & Copthorne Hotels Limited & another vs Millennium inn

Case No. C2021-0003

Also in PDF C2021-0003

1. The Parties

The Complainants are:

- (1) Millennium & Copthorne Hotels Limited**, a public listed company on the London Stock Exchange incorporated under the laws of England and Wales, with its registered address at Victoria House, Victoria road, Horley, Surrey RH6 7AF, United Kingdom; and
- (2) Millennium & Copthorne International Limited**, an indirect subsidiary of the 1st Complainant, with its registered address at 9 Raffles Place, #12-01 Republic Plaza, Singapore 048619.

The Respondent's name is **M/S Millennium Inn Hotel** with its address at Hong Kong Plaza Office 6 Commercial Market, Rawalpindi, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <millenniuminn.com.pk>, hereinafter referred to as the Disputed Domain Name. Vide email dated Friday 13 May 2021, PKNIC has informed DNDRC that name of the Registrant is **M/S Millennium Inn Hotel** with its address at Hong Kong Plaza Office 6 Commercial Market, Rawalpindi, Pakistan. The Agent Organization through which the registration was applied is Web OjO. Its Create Date was 2016-03-26 and its Expire Date is 2022-03-26.

3. Procedural History

DNDRC was informed of the Complaint against the Respondent as per PKNIC - Internet Domain Registration Policy, by notification from the Complainants on 10 May 2021.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 17 May 2021, informing the Respondent that if a Response was not received 10 days from the notification, the dispute would be proceeded ex parte. DNDRC awaited the submission by the Respondent of a Response as per the prescribed forms also available at www.dndrc.com/downloads. Several reminders were issued to the Respondent. The Respondent failed to respond within prescribed time and the dispute has been proceeded ex parte.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Mr. Abdul Razzak Surahio as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules.

Factual Background

The domain name upon which the Complaint is based is <millenniuminn.com.pk>.

PKNIC has confirmed via their email dated 13 May 2021 that the Disputed Domain Name has been registered by the Respondent above-named and that their registered email address is contact.sdkteam@gmail.com.

4. Parties Contentions

A. Complainant

The Complainant's contentions are submitted further below.

1. The Complainants assert the following:

- a. That the application and registration of the Disputed Domain Name is illegal, unlawful or otherwise invalid;*
- b. The Disputed Domain Name is identical with and/or confusingly similar to the Complainants' trade marks;*
- c. The Respondent has no rights to or legitimate interests in the Disputed Domain Name; and*

- d. *The Disputed Domain Name had been registered and is being used in bad faith.*

The Complainants' Hotels

2. The Complainants own, manage, and operate more than 130 hotels in 22 countries. They own "MILLENNIUM" hotel properties around the world. The Complainants' "MILLENNIUM" hotels are well known for high-quality accommodation and services, both for leisure and business. Further, having used the marks for more than two decades, the Complainants have acquired valuable and substantial goodwill in the "MILLENNIUM" mark.

3. Based on annual turnover, the Complainants are one of the top 15 hotel groups in the world. A full list of the Complainants' "MILLENNIUM" hotels is appended with the complaint:

4. The Complainants' excellence in the hospitality industry is well recognized. It receives scores of awards every year, both for its individual properties as well as the brand as a whole. In 2020, it was recognized as, amongst others, the "World's Leading Corporate Hotel Brand" and the "Middle East's Leading Business Hotel Brand" at the World Travel Awards. In 2019, it was named the "Best Hotel Group of Asia" at the Asia Travel + Hotel Awards, with its Grand Millennium Shanghai Hongqiao winning the award of "Most Preferred Hotel for Business Travelers of the Year". In the same year, the Complainants' Grand Copthorne Waterfront Singapore received five prestigious awards, including in the categories of Luxury Hotel, Luxury Convention Hotel, and International 5 Star Standard, at the International Hotel Awards. Every year, the Complainants' hotels also receive multiple "Gold Circle Awards" from Agoda; "Certificates of Excellence" from Tripadvisor, and "Awards of Excellence" from Booking.com, in recognition of their consistently stellar customer reviews.

*5. The "MILLENNIUM" brand has also attracted significant attention in the international press. It has been favourably featured in renowned publications like the Wall Street Journal, New York Times, The Independent, South China Morning Post, and The Times. Selected articles from these publications are enclosed as **Annex D** to the Complaint.*

6. Apart from traditional methods of marketing and sale, "MILLENNIUM" hotels also generate a

substantial amount of business through the internet. To that end, the Complainants invest heavily in promoting their presence online, spending around USD 17 million yearly. As the internet is a cornerstone of the Complainants' business strategy, the policing of its trade mark and domain name rights is of utmost importance.

7. Since 1995, the M&C Group has controlled the rights over the "MILLENNIUM" trade mark internationally. These rights are held in the name of the 2nd Complainant and beneficially owned by the 1st Complainant.

8. The Complainants have made extensive and prominent use of the "MILLENNIUM" marks worldwide for hospitality and related services, including food and beverage and health and fitness services. It currently owns more than 70 trade mark registrations for "MILLENNIUM", in more than 40 countries around the world, including in Pakistan **(Attached to complaint):**

9. A non-exclusive list of the Complainants' registrations consisting of, or containing, the word "MILLENNIUM" is enclosed as **Annex E to the complaint**. Other "MILLENNIUM" marks owned by other related entities, as well as other variations of "MILLENNIUM" marks, have been omitted for brevity.

10. Sample copies of the Complainants' trade mark Certificates of Registration for the "MILLENNIUM" Word Marks are provided in **Annex F to the complaint**.

11. The Complainants also own a collection of domain names containing their "MILLENNIUM" trade-mark, including:

- millenniumhotels.com
- millenniumhotels.net
- millenniumhotels.org
- millenniumhotels.cn
- millenniumhotels.ae
- millenniumhotels.biz
- millenniumhotels.co.uk
- millenniumhotels.com.cn
- millenniumhotels.com.my
- millenniumhotels.com.sg

- *millenniumhotels.de*
- *millenniumhotels.fr*
- *millenniumhotels.name*
- *millenniumhotels.us*

Therefore, the Complainants seek the following remedy:

The Complainants humbly request that the Administrative Panel appointed in this administrative proceeding issue a decision that the Disputed Domain Name be transferred to the 2nd Complainant.

B. Respondent

The complaint was duly served to the Respondent and several reminders were also served to the Respondent. There has been no response from the respondent in the duly prescribed time. Therefore, the Panel proceeded with the matter ex-parte.

5. Jurisdiction

The Panel's jurisdiction over this dispute between the Complainants and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) and the Rules.

The Respondent applied for and was granted registration of the Disputed Domain Name on the basis of these regulations, and has submitted to, the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

6. Discussion and Findings

In the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website (http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf), the Panel laid down the following four heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) and the UDRP:

1. *Illegality, unlawfulness or otherwise invalidity of the Application & Registration (a criteria in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 in addition to the criteria of the UDRP)*

2. *Identical or confusing similarity to a trademark or service mark in which the Complainant has rights (a UDRP criteria)*
3. *Legitimate interest in Domain Name (a UDRP criteria)*
4. *Registration and use in bad faith (a UDRP criteria)*

The decision of the dispute shall be addressed with respect to the following aspects:

- i. *Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) criteria).*
- ii. *Identical or confusing similarity with a trademark or service in which the Complainants have rights (a UDRP criteria).*
- iii. *Legitimate interest in the domain name (a UDRP criteria).*
- iv. *Registration and use of the domain name in bad faith (a UDRP criteria).*

I. Illegality, unlawfulness or otherwise invalidity of the Application & Registration

The PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) states that it creates an exception for, and thus excludes the registration of a domain name that:

- a. *infringes upon a registered tradename,*
- b. *is not bona fide as recognized by international best practice,*
- c. *in the opinion of PKNIC, a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,*
- d. *has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law), or*
- e. *in the opinion of PKNIC is not appropriate for registration.*

As per the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19),

If a party claims that a domain name already registered with PKNIC violates their registered tradename, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, PKNIC reserves the right to cancel, or transfer the domain to the claiming

party as per the ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.

Therefore, for the purpose of assessing illegality, unlawfulness or otherwise invalidity of the Application & Registration of the Disputed Domain Name, the application and registration of the Disputed Domain Name shall be assessed in consideration of the following criteria:

- i. Whether the Disputed Domain Name infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Disputed Domain Name is bona fide?
- iii. Whether the application and/or registration of the Disputed Domain Name contravenes the Pakistan Penal Code, 1860 (the “Penal Code”) or any applicable criminal law?

The Panel will deal with each of these sub-issues sequentially below.

i. Whether the Disputed Domain Name infringes upon, or is an obvious derivation of, a registered trade name / trade mark?

The Complainants have stated:

The Complainant notes that in Standard Chartered PLC v. Hosting Campus Domain, the DNDRC Panel has found that if a complainant simply establishes that the respondent's domain name infringes upon the complainant's registered trade name or trade mark, this renders the respondent's domain name to be illegal, unlawful and invalid and further constitutes an adequate ground for the transfer of the domain name to the complainant.

As demonstrated by the trademark registrations discussed in detail above, the Complainants own the rights to the “MILLENNIUM” trade mark.

The Disputed Domain Name incorporates the “MILLENNIUM” mark in its entirety, and is an obvious derivation of the same. In particular, the Disputed Domain Name consists of the words “millennium” followed by “inn”, and is used in the business of hotel management and operations, which is identical to the business of the Complainants. A screenshot of the website's homepage evincing the same is enclosed as Annex H of the complaint.

By such use and registration, the Respondent has infringed the exclusive rights vested in the Complainant in respect of the “MILLENNIUM” Marks, including its trade mark rights in Pakistan, and also passes off its respective business, website, domain name and/or email

address as and for the business, website, domain name and/or email address of the Complainant or its affiliated companies. In doing so, the Respondent deliberately intends to mislead the public, including consumers in Pakistan, into mistakenly believing that Complainant is affiliated with, sponsors, or otherwise authorizes Respondent, Respondent's business, Respondent's use and registration of the Disputed Domain Name, and/or Respondent's Website.

For the reasons above, the unauthorised registration and adoption of the Disputed Domain Name would thus constitute an infringement of the Complainants' trade mark registrations.

The Respondent has not submitted a response.

The panel finds that based on the documentary evidence provided by the Complainants, the Complainants enjoy trademark rights in the word/logo "MILLENNIUM" in several classes in Pakistan. However, though the Disputed Domain Name incorporates the Complainants' trademark "MILLENNIUM" in its entirety within the Disputed Domain Name, this is followed by the word "inn". The Complainants do not have trademark rights over the word "MillenniumInn" in Pakistan, and the use of this phrase collectively may not constitute an infringement of a trademark under the laws of Pakistan. The Panel therefore finds that the Disputed Domain Name does not clearly infringe upon a trademark of the Complainants.

However, the Panel finds that the Disputed Domain Name, which contains the Complainants' trademark "MILLENNIUM" in its entirety followed by the word "inn", which is descriptive of the nature of services provided by the Complainants, is an obvious derivation of a registered trademark of the Complainants.

ii. Whether the application and/or registration of Disputed Domain Name is bona fide?

The Complaints have submitted:

*The Disputed Domain Name was registered on 26 March 2016, long after the Complainants began using the "MILLENNIUM" brand and having control of the rights over the "MILLENNIUM" trade mark internationally. In fact, the Complainants have been the registered proprietor of the "MILLENNIUM" trade marks in Pakistan since as early as 2007, as evinced by the Certificates of Registration for the same found in **Annex F of the complaint.***

Further, as demonstrated above, the Complainants' "MILLENNIUM" trade mark is a well-known and distinctive trade mark that enjoys substantial and widespread international reputation. It is thus clear that the Disputed Domain Name was registered with knowledge of the Complainants' "MILLENNIUM" trade mark.

Similarly, in LEGO Juris A/S vs Muhammad Farooq, the DNDRC Panel found that given the fame of the complainant's LEGO trade mark, it was unlikely that the respondent was unaware of the complainant's mark at the time of registration of the disputed domain name, <legopricks.pk>. As such, they found that the registration of the disputed domain name was not bona fide.

The Complainants also repeat the paragraphs below in support of its assertion that the Disputed Domain Name was registered in bad faith.

For the foregoing reasons, the Complainants assert that the registration of the Disputed Domain Name was not bona fide.

The Respondent did not submit a response.

The Complainants have annexed detailed information in support of the popularity of the trademark "Millennium" and to support its contention that the registration of the Disputed Domain Name by the Respondent was not bona fide. On the other hand, the Respondent has failed to submit its defense that the registration of the Disputed Domain Name was bona fide.

The tradename/trademark of the Complainants' "MILLENNIUM" is highly recognizable and the same is commonly associated with the Complainants, who hold the intellectual property rights to the tradename/trademark and is thereby entitled to use it in all forms afforded by intellectual property rights legislations, inter alia, Trade Marks Ordinance, 2001 of Pakistan, which allows a trademark holder to use its trademark in corresponding domain name(s).

The Complainants have registered the trademark MILLENNIUM in Pakistan since as early as 2007 and even earlier in other jurisdictions. The Complainants have been using this mark for over a decade, well in time before the Respondent appears to have registered the Disputed Domain Name. The documentation/evidence provided by the Complainants depicts the recognition and goodwill associated with the trademark MILLENNIUM.

Noting that the Disputed Domain Name contains the mark of the Complainants and is being used to provide services similar to those of the Complainants, and in the absence of any information

provided by the Respondent to indicate that the registration of the Disputed Domain Name was bona fide, the Panel finds that the registration of the Disputed Domain Name by the Respondent was not bona fide.

iii. Whether the application and/or registration of the Disputed Domain Name contravene the Penal Code or any applicable criminal law?

Prior to discussing this sub-issue, it is pertinent to clarify the grounds for examining relevant Pakistani law provisions. Although Pakistani law does not apply by force of law over PKNIC's jurisdiction, by operation of the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19), it is necessary to examine provisions of the Penal Code and other applicable criminal laws. It is in this spirit and for this purpose alone that the following provisions of Pakistani law are being analyzed. The ordinances, and the sections mentioned herein below, have been discussed at length in *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001).

Trade Marks Ordinance, 2001

40. Infringement of registered trade mark.-

(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without consent of the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.

4. Domain name not to be misleading as to character or significance.- *(1) A domain name shall not be registered if the public is liable to mislead as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a domain name.*

Electronic Transactions Ordinance, 2002 ("ETO")

3. Legal recognition of electronic forms.—

No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness."

Penal Code

478. Trade mark.

A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this Code the expression “trade mark” includes any trade mark which is registered in the register of trade marks kept under the Trade Marks Act, 1940 (V of 1940)

Upon a study of the above-quoted sections of the Trade Marks Ordinance, 2001 and the Penal Code, the Panel is of the view that the infringement of Trade Marks and Trade Names have been equated with domain names under Pakistani law. Therefore, the provisions of the Penal Code dealing with Trade Mark infringement appear to apply to domain names.

Moreover, according to Section 3 of the ETO, all material, instruments that would otherwise be in writing or in physical form, if generated or made available in electronic form would attract the provisions of the same sections of the Penal Code or any other applicable law had the material been in physical, written or in printed form. The Penal Code, therefore, by the operation of Section 3 of ETO, equally applies to transactions, publications or materials including the use of any trade mark or trade name made available in any electronic form on the internet through the use of a domain name.

By continuing the registration of the Disputed Domain Name by a person who is other than the owner, holder or authorized user of the trade mark or trade name, the registrant would be an aider, abettor, encourager and co-conspirator and also liable to criminal offences.

479. Property mark.

A mark used for denoting that movable property belongs to a particular person is called a property mark.

480. Using a false trade mark.

Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.

As such, if a person other than the owner, rightful holder or authorized user of the trade mark or trade name uses the Disputed Domain Name, if possibly linked to any service or goods, it may constitute an offence under the Penal Code.

481. Using a false property mark.

Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.

482. Punishment for using a false trade-mark or property mark.

Whoever uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.

As decided in *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001), the use of a false property mark (which includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages) with the reasonable expectation that people would be misled to believe that the trade mark or trade name or domain name belongs to a person to whom it does not belong may also constitute an offence under the Penal Code.

The Panel, therefore, is of the view that the Respondent's registration of the Disputed Domain Name may attract the above-mentioned provisions of the Trade Marks Ordinance, 2001, Penal Code and ETO. The Panel may decide this Complaint on this basis alone. However, for the sake of completeness and procedural fairness, but not to create a binding precedent, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19).

II. Identical or confusing similarity to a trademark or service mark in which the Complainant has rights

The Complainants have contended the following:

Where a complainant has obtained trade mark registrations, it is a clear indication that the rights in the mark belong to its registered owner. The Policy must afford protection to such complainants.

*Several WIPO Panelists have afforded protection to the Complainants' "MILLENNIUM" mark. In *Millennium & Copthorne Hotels plc, Millennium & Copthorne International Limited v Kenneth Lim*, the Panelist found that the Complainants own rights to the "MILLENNIUM" trade mark "by virtue of its many registered trade marks as well as*

unregistered trade mark rights deriving from the extensive and worldwide use of that name” as well as its “extensive worldwide reputation in the hotel sector.”

The WIPO Panelist in Millennium & Copthorne International Ltd v Blanche McGovern also found that “MILLENNIUM” is a distinctive and well-known trade mark, and that the Complainants’ hotels enjoy “widespread international reputation.” As such, other traders are not entitled to use it at the risk of creating a misleading impression of association with the Complainants.

Further, the first UDRP element examines the status of Complainants’ trademark rights at the time the Complaint is filed. As the Complainants’ rights (accruing from 1995) clearly pre-date the creation (on 30 May 2019) of the Disputed Domain Name by more than two decades, this element is easily established.

The Disputed Domain Name is confusingly similar to the Complainants’ “MILLENNIUM” registered mark, as it incorporates the word “millennium” in its entirety. It is well-established that the incorporation of a complainant’s mark in full within a disputed domain name may be sufficient to establish confusing similarity between the mark and the disputed domain name.

Further, if a trade mark is recognizable within a disputed domain name, the addition of a descriptive term which directly refers to the Complainants’ business will not prevent a finding of confusing similarity. Thus, including the descriptor “inn” to the Complainant’s recognizable trade mark “millennium” will not detract from a finding of confusing similarity.

Similarly, in Accenture Global Services Limited. vs AccentureAnalytics.com.pk, which involved the disputed domain name <accentureanalytics.pk> and the complainant’s “ACCENTURE” trade mark, the complainant argued that adding a descriptive term to a trademark in a domain name fails to negate confusing similarity, especially when the descriptive term directly refers to complainant's business, as does the term "analytics". In this case, DNDRC Panel found that the disputed domain name was confusingly similar to the complainant’s “ACCENTURE” trade mark.

Therefore, the descriptor “inn” does not distinguish the Disputed Domain Name from the Complainants’ “MILLENNIUM” mark, especially since it directly refers to the Complainants’ business of accommodation services.

Further, for avoidance of doubt, the addition of the suffix .PK in the Disputed Domain Name is immaterial in considering the confusing similarity between the Complainants' trade mark and the Disputed Domain Name.

The Disputed Domain Name should therefore be considered confusingly similar to a trade mark in which the Complainants have rights.

On the other hand, the Respondent failed to provide any response despite being served with a copy of the complaint.

It is an established principle that the incorporation of a Complainant's trademark in full within a disputed domain name may be sufficient to establish confusing similarity between the mark and the disputed domain name. The Complainants have also referred to WIPO cases wherein it was held that domain names that incorporated a trademark in its entirety were confusingly similar to such trademark, and that the additional of a descriptive term which merely describes the kind of services that are provided, would not be sufficient to prevent a finding of confusing similarity.

The Complainants have provided sufficient information, including annexing evidence of the same, that the Complainants have rights in the trademark MILLENNIUM in Pakistan and several other jurisdictions. It is apparent that the Disputed Domain Name incorporates the entirety of the trademark owned by the Complainants, MILLENNIUM, and adds the word "inn", which is descriptive of the Complainants' hotel business, and would not prevent a finding of confusing similarity. The addition of the ccTLD ".pk" would also not prevent the finding of confusing similarity.

In the absence of any valid explanation of how the Disputed Domain Name is not confusingly similar to the trademark of the Complainants, the Panel finds confusing similarity between the Disputed Domain Name and the Complainants' trademark under paragraph 4(a)(i) of the Policy.

III. Legitimate interests in a domain name

As per paragraph 4(c), the UDRP requires the Respondent's claim to be of legitimate interest and shall be: "*proved based on all evidence presented*" that "*shall demonstrate*" the Respondent's "*rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii).*"

Paragraph 4(a)(ii) states that:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Complainants have contended:

A complainant need only make out a prima facie case that the respondent lacks rights or legitimate interests in the Disputed Domain Name. Subsequently, the respondent assumes the burden of demonstrating its rights or legitimate interests. If the respondent fails to do so, a complainant is deemed to have satisfied the second UDRP element.

Paragraph 4(C) of the Policy provides non-exclusive examples of how a respondent may establish such rights or legitimate interests:

There is nothing to indicate that the Respondent can discharge its evidential burden of demonstrating that it has rights or legitimate interests in the Disputed Domain Name. For avoidance of doubt, the Respondent is not a licensee of, or authorized to use, the Complainants’ “MILLENNIUM” mark. Only the Complainants have trade mark rights.

On the contrary, the evidence shows that the Respondent uses the Disputed Domain Name to misleadingly divert Internet consumers to its site, through which it offers services competitive to those of the Complainants. Specifically, the Disputed Domain Name is deceptively similar to the naming convention of a number of the Complainants’ “MILLENNIUM” properties, which feature the use of the phrase “Millennium” followed by a type of living accommodation. Examples of the Complainants’ hotels that make use of such a naming convention include, but are not limited to:

- a. Makkah Millennium Hotel*
- b. Millennium Executive Apartments Muscat*
- c. Millennium Resort Doha*

The Disputed Domain Name consists of the words “millennium” followed by “inn”. When used in connection with the Respondent’s business of hotel management and operation, it has the effect of suggesting an affiliation between the Respondent and the Complainants.

The use of a complainant’s trademark to attract Internet users to a website where competing goods or services are sold, for the benefit of commercial gain, does not constitute a bona fide offering for the purposes of the Policy.¹⁰ In Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. jiogabnkya jvnhyjnxh, the respondent used the domain name <drmartensjp.com> to sell products of the complainants’ competitors together with the complainants’ own products. The panel found that the respondent had used a deliberately similar version of the complainants’ trademark and complainants’ significant goodwill and reputation to attract Internet traffic to its website. Thus, the panel found that the respondent had no rights or legitimate interests in the domain name on the basis that it was employed as a means of diverting Internet customers.

Additionally, in Accor v Eren Atesmen, the website at the disputed domain name <accorreviews.com> linked to websites promoting the complainants’ competitors. The Panelist found that the respondent had used the complainants’ widely known “ACCOR” trademark to attract internet users for its own commercial purposes and that, therefore, the respondent did not have rights or legitimate interests in the disputed domain name.

Lastly, the mere addition of descriptive and geographic terms such as “inn” to a well-known trademark like “MILLENNIUM” also does not instill the Respondent with rights or legitimate interests.

The Complainants therefore submit that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

On the other hand, the Respondent has failed to provide a response.

The Complainants are required only make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. Subsequently, the Respondent assumes the burden of demonstrating its rights or legitimate interests. If the Respondent fails to do so, the Complainants are deemed to have satisfied the second UDRP element.

The Complainants’ submission that the use of mark followed by the word “inn” in the Disputed Domain Name, and the use of the Disputed Domain Name by the Respondents in connection with the business of hotel management and operation, the same business as the Complainants, would

indicate some kind of affiliation between the Respondents and the Complainants in the general public. However, the Complainants have clarified that it has not granted a license or any other form of permission to the Respondent to use its registered mark in the Disputed Domain Name.

Furthermore, the Respondent has failed to respond, and resultantly, satisfy the Panel that the Respondent is commonly known by the name of “MILLENNIUM” or has any legitimate interest in the Disputed Domain Name.

As has been previously adopted by the discussions and findings in WIPO Authorities, it is for the Respondent to rebut the allegations put forth by the Complainants. Also, with respect to proving rights or legitimate interests in the disputed domain name(s), it is for the Respondent to submit evidence pertaining to the same as it would be almost impossible, if not extremely difficult for the Complainants to prove a negative assertion. As such, in order to satisfy the Panel that it has rights or legitimate interests to the Disputed Domain Name, the Respondent was obliged to respond and submit evidence with respect to the same.

In the absence of any information provided by the Respondent in support of his legitimate interest in the Disputed Domain Name, the Panel based on the information provided by the Complainants which establishes a prima facie case, finds that the Respondent does not have rights or a legitimate interest in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

IV. Registration and use in bad faith

The Complainants have made the following submission:

The Respondent’s conduct falls within the definition of bad faith conduct per paragraph 4(i)(B)(iii) and (iv) of the Policy:

First, the registration and use of a disputed domain name to trade on the reputation of a complainant’s widely known trade mark will constitute bad faith conduct. In Accor v Eren Atesmen, the panelist imputed knowledge of the complainant’s “ACCOR” trade mark to the respondent as the “ACCOR” mark had been registered internationally and widely used for decades. He therefore found that the respondent had deliberately attempted to attract internet users to its website for commercial gain, by creating a likelihood of confusion with the “ACCOR” mark by registering the dispute domain name <accorreviews.com>. That was evidence of bad faith.

Similarly, in *Starwood Hotels & Resorts Worldwide Inc. v Media Insight a/k/a Media Insights*, the registration of the disputed domain names <sheratonnassaubeachresort.com>, <lemeridiencancun.com>, <westinresortaruba.com>, and <westinresortcancun.com> was found to be in bad faith as “the Panel entertains no doubt that the Respondent had the complainant’s actual or potential rights in mind when registering the disputed domain names, given the Respondent’s presence in and knowledge of the hotel and leisure industry.”

The Complainants repeat that the Disputed Domain Name was registered on 26 March 2016, long after the Complainants began using the “MILLENNIUM” brand and having control of the rights over the “MILLENNIUM” trademark internationally. In fact, the Complainants have been the registered proprietor of the “MILLENNIUM” trademarks in Pakistan since as early as 2007, as evinced by the Certificates of Registration for the same found in **Annex F of the complaint**. Further, as mentioned above, the WIPO Panelist in *Millennium & Copthorne International Ltd v Blanche McGovern* found that “MILLENNIUM” is a distinctive and well-known trademark, and that the Complainants’ hotels enjoy “widespread international reputation.” It is thus clear that the Disputed Domain Name was registered with knowledge of the Complainants’ “MILLENNIUM” trade mark.

Additionally, the Respondent’s use of the Disputed Domain Name to offer goods or services competitive with those of the Complainants is further evidence of the Respondent’s knowledge. It is also indicative of the Respondent’s intent to take advantage of the Complainant’s “MILLENNIUM” trademark, specifically by attracting Internet users to its website for commercial gain through the creation of a likelihood of confusion with the Complainants’ mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s hotel and its commercial website.

Such use of the Disputed Domain Name is precisely the type of bad faith conduct that the Policy seeks to curb: the “abusive registration of domain names in the circumstances where the registrant is seeking to profit from and exploit the trademark of another.

Accordingly, the Complainants submit that the Respondent has unlawfully and in bad faith appropriated the Complainants’ distinctive and well known “MILLENNIUM” trade mark. Taking into account all the circumstances of the case, the Respondent’s bad faith use of the Disputed Domain Name imbues the original act of registration with bad faith.

The Respondent on the other hand has submitted as follows:

The complaint was duly served to the Respondent, but the Respondent has not provided any information or evidence to demonstrate lack of bad faith with respect to registration and use of the Domain Name. Therefore, the Panel proceeded with the matter ex parte.

The Disputed Domain Name was registered on 26 March 2016, long after the Complainants began using the “MILLENNIUM” brand and having control of the rights over the “MILLENNIUM” trademark in Pakistan and internationally. In fact, the Complainants have been the registered proprietors of the “MILLENNIUM” trademarks in Pakistan since as early as 2007, as evidenced by the Certificates of Registration provided by the Complainants. The Complainants have cited several WIPO decisions that would that “MILLENNIUM” is a distinctive and well-known trademark, and that the Complainants’ hotels enjoy “widespread international reputation.”

The Complainants have provided ample evidence that its mark was highly popular and well-known. Given the evidence of popularity of the mark “MILLENNIUM” at the time of registration of the Disputed Domain Name, it is difficult in the absence of any proof to the contrary to ignore the contention of the Complainants that the Respondent must have known about its existence. This may indicate that the Respondent, knowing about the goodwill the Complainants have established all around the world, chose to register the Disputed Domain Name to offer competitive goods or services for commercial gain by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Respondent’s hotel and its commercial website.

The Panel therefore, in the absence of any submission to the contrary by the Respondent, finds that the Disputed Domain Name was registered and is being used in bad faith by the Respondent.

7. Decision

Analyzing the details provided by the Complainants, the Panel perceives that the MILLENNIUM mark has been registered by the Complainants, hence the Complainants reserve crucial interest in such mark. Usage of these marks by the Respondent could endanger the reputation that the Complainants have worked hard at building and maintaining and result in confusion as to the registrant of the Disputed Domain Name.

Taking all of the case law and discussion above into consideration, the Panel concludes and decides that:

1. The Respondent's registration of the Disputed Domain Name is contrary to the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19)
2. The Respondent has no legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Name is identical to the Complainant's trademark/names and registered domain names.
4. The Disputed Domain Name was registered and being used in bad faith.

Pursuant to Section 4 of the Policy, the Panel therefore recommends that PKNIC transfer the registration of the domain name in dispute < millenniuminn.com.pk > to the 2nd Complainant (Millennium & Copthorne International Limited), as prayed within 48 hours of receipt of this decision by email or its being uploaded on to DNDRC's website www.dndrc.com/cases_resolved/, whichever is earlier. The Complainants shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Abdul Razzak Surahio

Sole Panelist

Date: 19 October 2021