

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

CharterAuction.com, Inc. v. Pacific Luxury Air

Case No. D2003-0801

1. The Parties

The Complainant is CharterAuction....., ..., United States of America.

The Respondent is P.. L. Air, ... United States of America.

2. The Domain Name and Registrar

The disputed domain name <charteraction.com> is registered with 1stDomain.Net a division of G+D International LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 9, 2003. On October 10, 2003, the Center transmitted by email to 1stDomain.Net a division of G+D International LLC a request for registrar verification in connection with the domain name at issue. On October 11, 2003, 1stDomain.Net a division of G+D International LLC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the registrant and the administrative and technical contacts. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 14, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was November 3, 2003. The Response was filed with the Center on October 31, 2003.

The Center appointed Bradley A. Slutsky as the sole panelist in this matter on November 18, 2003. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Since March 1, 2002, Complainant has been providing "private charter aircraft procurement services" over the Internet from the domain name <charteraction.com>. From the materials attached to Complainant's Complaint, it appears that Complainant's services are in the nature of a reverse auction for private aircraft charter travel.

Complainant and Respondent entered into a business relationship in April, 2003. By June, 2003, the parties were discussing how to unfold their business relationship.

On June 11, 2003, Respondent registered the domain name <charteraction.com>. Respondent describes the service it offers from that website as a "jet charter broker service".

There is no evidence in the record indicating that either party has a registered trademark or service mark for CHARTER AUCTION, CHARTER ACTION, CHARTERAUCTION, CHARTERACTION, CHARTERAUCTION.COM, or CHARTERACTION.COM.

5. Parties' Contentions

A. Complainant

Complainant alleges that Complainant has "invested significant resources to publicize the mark CharterAuction and has widely used the CharterAuction mark in a manner designed to ensure its automatic identification in the minds of consumers with the Complainant's services." Complainant attaches articles about its business and points to a Deloitte & Touche advertisement naming Complainant as a "Rising Star" as evidence of the notoriety of Complainant's alleged mark.

Complainant alleges that the parties began a business relationship in April 2003, and broke off that business relationship in June 2003. At or around the time that the parties' business relationship was being dissolved, Respondent registered the domain name <charteraction.com> from which Respondent offers services similar to those of Complainant.

Complainant essentially alleges that Respondent is "typosquatting" -- having registered a domain name that is different by only one letter from Complainant's domain name. As further evidence of Respondent's alleged bad intent, Complainant points to 11 passages from Complainant's website that are duplicated, in whole or in part, in Respondent's website.

Complainant alleges that Respondent does not have permission from Complainant to use Complainant's alleged mark, that Respondent does not have a trademark or service mark registration for "CharterAction", and that the other circumstances (e.g., the copied website text, the parties' former business relationship) all indicate that Respondent has no rights or legitimate interests in the <charteraction.com> domain name and is not engaging in a fair use.

Complainant alleges that Respondent's actual knowledge of Complainant's alleged mark, the similarity between the marks, the similarity of the parties' businesses, and the copying of 11 passages of text from

Complainant's website all militate in favor of a finding of bad faith.

B. Respondent

Respondent alleges that Complainant's alleged trademark is either generic, or so highly descriptive of Complainant's services as to be entitled to only a very narrow scope of protection that allegedly does not encompass Respondent's use of the <charteraction.com> domain name. Respondent alleges that Complainant's failure to register Complainant's alleged trademark is further evidence that the term is generic when applied to Complainant's services. Respondent alleges that, even if Complainant's alleged mark is descriptive, Complainant's evidence of secondary meaning is insufficient to establish trademark rights.

Respondent further alleges that CHARTERACTION is not confusingly similar to CHARTERAUCTION under the *Sleekcraft* factors, and thus does not infringe Complainant's alleged mark. Respondent alleges that this is not a case of "typosquatting" because Respondent's domain name constitutes a clearly identifiable trademark presenting a commercial impression that is separate and distinct from the impression of Complainant's alleged mark, and because Respondent is using the domain name for a "legitimate, commercially viable business".

Finally, Respondent attaches an affidavit from Respondent's President indicating that Respondent chose the <charteraction.com> domain name because Respondent offers charter flights and Respondent wants its customers to take action to book a charter and to envision the action of an aircraft moving. Respondent alleges that its advertising clearly emphasizes the term action, and that there have been no instances of actual confusion. Respondent alleges that the 11 allegedly copied phrases on Respondent's website are not sufficiently original to be protected, and that there is no evidence of trade secret misappropriation. Respondent also supports these allegations with its President's affidavit.

6. Discussion and Findings

Pursuant to Rule 15, panelists in domain name disputes "shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that [they] deem[] applicable."

Under Rule 4(a), the Complainant must prove the following:

- (i) Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) Respondent's domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Under Rule 4(a)(i) the Complainant must show that the domain name at issue is "identical or confusingly similar to a trademark or service mark in which the complainant has rights". "The Policy does not require that the Complainant should have rights in a registered trademark or service mark. It is sufficient that the Complainant should satisfy the Administrative Panel that she has rights in common law trademark or sufficient rights to ground an action for passing off." *Julia Fiona Roberts v. Russell Boyd*, [WIPO Case No. D2000-0210](#) (May 29, 2000).

However, "[w]here the mark alleged is a highly descriptive term, a party seeking to establish exclusive rights carries a heavy burden of proof in removing the term from the public domain." *Snowboards-for-sale.com, Inc. v. Name Administration Inc.*, [WIPO Case No. D2002-1167](#) (February 19, 2003). See also *Bar Code Discount Warehouse, Inc. v. Barcodes, Inc. dba Barcode Discount and Dan Reynolds*, [WIPO Case No. D2001-0405](#) (July 27, 2001); *Pet Warehouse v. Pets.com, Inc.*, [WIPO Case No. D2000-0105](#) (April 13, 2000).

"Complainant must prove secondary meaning. Relevant evidence of secondary meaning includes length and amount of sales under the mark, the nature and extent of advertising, consumer surveys and media recognition." *Snowboards-for-sale.com, Inc. v. Name Administration Inc.*, [WIPO Case No. D2002-1167](#) (February 19, 2003). See also *Amsec Enterprises, L.C. v. Sharon McCall*, [WIPO Case No. D2001-0083](#) (April 3, 2001); *Philatelic.Com v. Peter I. Jeong*, NAF Case No. FA0204000112547 (July 24, 2002).

The Panel believes the term CHARTERAUCTION, when used in connection with obtaining charter aircraft flights through an auction process, is either generic or descriptive. Assuming that the term is descriptive, significant evidence of secondary meaning would be necessary to prove trademark rights, such as exclusive and continuous use in commerce for five years. See 15 U.S.C. § 1052(f). Complainant alleges that it began using the term "charterauction.com" to identify its private charter aircraft procurement services on March 1, 2002, -- less than two years ago. Complainant points to other alleged evidence of secondary meaning such as 12 articles about Complainant's business and an advertisement in which Deloitte & Touche apparently names Complainant as a "Rising Star". Complainant also alleges that it has "invested significant resources" to publicize its alleged mark and has widely used the mark in a manner "designed" to achieve recognition.

For purposes of this proceeding, Complainant's evidence is insufficient to establish protectable rights in the service mark CHARTERAUCTION or CHARTERAUCTION.COM. See, e.g., *Snowboards-for-sale.com, Inc. v. Name Administration Inc.*, [WIPO Case No. D2002-1167](#) (February 19, 2003); *Bar Code Discount Warehouse, Inc. v. Barcodes, Inc. dba Barcode Discount and Dan Reynolds*, [WIPO Case No. D2001-0405](#) (July 27, 2001); *Pet Warehouse v. Pets.com, Inc.*, [WIPO Case No. D2000-0105](#) (April 13, 2000).

While this case otherwise may have many similarities to a "typosquatting" case, in light of the sole panelist's determination concerning trademark/service mark rights the Panel need not rule upon the elements of legitimate interest or bad faith. *Bar Code Discount Warehouse, Inc. v. Barcodes, Inc. dba Barcode Discount and Dan Reynolds*, [WIPO Case No. D2001-0405](#) (July 27, 2001).

7. Decision

For all the foregoing reasons, the Complaint is denied.