



WIPO Arbitration and Mediation Center

ENTSCHEIDUNG DES BESCHWERDEPANELS

vom 29. Oktober 2004

Fall Nr. D2004-0765

1. The Parties

The Complainant is Air Austral, of Sainte-Marie, Ile de la Réunion, France,
The Respondent is WWW Enterprise ..., United States of America.

2. The Domain Name and Registrar

The disputed domain name <airaustral.net> is registered with OnlineNic, Inc. d/b/a China-Channel.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 22, 2004. On September 22, 2004, the Center transmitted by email to OnlineNic, Inc. d/b/a China-Channel.com a request for registrar verification in connection with the domain name at issue. On September 23, 2004, OnlineNic, Inc. d/b/a China-Channel.com transmitted by email to the Center its verification response confirming that the Respondent was listed as the registrant and providing the contact details for the administrative, billing, and technical contact. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on September 24, 2004. The Center verified that the Complaint together with the amendment to 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 September 28, 2004. In accordance with the Rules, paragraph 5(a), the due date for Response was October 18, 2004. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 19, 2004.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on October 21, 2004. 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

The Complainant is a French company (Société Anonyme) with its principal place of business in Sainte-Marie, Ile de la Réunion, France. It is the French regional airline of the Indian Ocean, flying daily from Réunion and France to South Africa, Kenya, Comoros, Mayotte, Seychelles, Madagascar, Mauritius and Zimbabwe. It operates a website under the Uniform Resource Locator <http://www.air-austral.com>.

The Complainant is the proprietor of the French nominative trademark "AIR AUSTRAL", registered with the Institut National de la Propriété Industrielle (INPI) under number 1 681 769, originally registered by Air France on November 15, 1990, and assigned to the Complainant by assignment dated August 13, 1991, and recorded with INPI on February 24, 1992. The trademark is widely used everywhere the Complainant has business activities. The Complainant is also the proprietor of the French figurative trademark consisting of a "double A" device incorporating the words "AIR AUSTRAL" registered with INPI on May 23, 1991.

The Complainant is the registrant of two generic and two French country code top level domain names reflecting its trademark, namely:

<airaustral.com>, registered on February 27, 1999;
<air-austral.com>, registered on March 23, 1997;
<airaustral.fr>, registered on September 5, 2000; and
<air-austral.fr>, registered on September 5, 2000.

The Complainant has used the trademark AIR AUSTRAL on the Internet since 1998, both in its domain names and on its website.

In IATA year 2003/2004, the Complainant's turnover was \$127 million.

The Respondent is an entity with an address at a post office box in California, USA. It registered the disputed domain name on July 13, 2004. The Complainant discovered the registration on July 15, 2004. At that date, the domain name pointed to a directory-style website featuring a variety of hyperlinked topics including "travel", "vacations" and "airline tickets". Users clicking on these hyperlinks were provided with further hyperlinks pointing to commercial websites offering products and services from various businesses.

On July 27, 2004, the Complainant's lawyers sent a formal notice to the Respondent by registered mail and email stating *inter alia* that the web pages on the Respondent's site were generated by a program called DomainSponsor which generates revenue on a per-click basis and requesting that the Respondent cease any use of the disputed domain name and transfer it to the Complainant within ten days of the date of the letter. The email was successfully delivered, while the letter was returned undelivered by the postal authorities. The Complainant received no reply to its email but the content on the website to which the disputed domain pointed was removed and as at the date of the Complaint showed a blank page.

5. Parties' Contentions

A. Complainant

The Respondent is engaged in cybersquatting or typosquatting on famous trademarks. The holder of the administrative email address for the disputed domain name is also the administrative contact for:

<exilefilms.com>;
<exclte.com>;
<irbus.net>;
<googlw.net>;
<mtvsex.com>;
<barnesnoble.net>;
<askzeeves.com>
<auyahoo.net>;
<wwwgeocities.net>;
<wwwvisacard.com>.

These domains are registered either in the name of the Respondent or under other names such as World Wide Web2 Enterprise Inc or South East Enterprise Inc at the same address as the Respondent. South East Enterprise Inc was subject to a UDRP challenge at the instance of Infospace Inc in respect of a National Arbitration Forum case no. FA0402000231728 regarding the domain name <wwwwebcrawler.net>.

The domain name <airaustral.net> is identical to the Complainant's trademark AIR AUSTRAL. Differences between the domain name and the trademark are due to technical requirements; it is not possible to place a space into the second level domain of a domain name and the .net is a required suffix.

The Respondent has no rights or legitimate interests in the disputed domain name; while it is hard to prove a negative fact, the Complainant can make a prima facie showing on the basis that:-

To the best knowledge of the Complainant, the Respondent is not and has never been commonly known as AIRAUSTRAL. The Respondent is not related to the Complainant's business in any way; it is not an agent of the Complainant nor does it carry out any activity for it or business with it. No license or authorization has been granted by the Complainant to the Respondent to make any use of the disputed domain name.

The Complainant claims that the Respondent has not engaged in any action that shows it has rights or legitimate interests in the disputed domain name. The Respondent has been using the domain name first to confuse and divert Internet users to others' commercial websites, some of which are in the field of tourism and travel, through hyperlinks and advertising. The domain is now pointing to a blank web page. Such use is not a bona fide offering of goods or services under the Policy, para 4(c)(i) nor a legitimate non-commercial or fair use under the Policy, para 4(c)(ii).

The Respondent has registered and is using the disputed domain name in bad faith. Initially, the Respondent used the disputed domain name to divert users to a website with links to other commercial websites, some of which were competitors to the Complainant in the fields of tourism and travel (the latter being the Complainant's principal area of business). The Respondent had no other purpose but to benefit from the fame and renown of the Complainant's trademark. In such circumstances Panels in earlier cases have found this to be a use in bad faith. Respondent's only possible purpose for using the disputed domain name was to intentionally attract Internet users to the Respondent's website and profit from the traffic from Internet users seeking the Complainant's official website by creating a likelihood of confusion with the Complainant's trademark.

The domain name is now pointing to a blank web page and is therefore being passively held. The case is similar to *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#) and *Ladbroke Group Plc v. Sonoma International LDC*, [WIPO Case No. D2002-0131](#) in that there is limited information about the Respondent and its activities except in relation to its buying and selling of domain names. The Respondent did not reply to the Complainant's formal email and letter. There was bad faith use of the domain name in the first instance. Any use of the domain name by the Respondent in good faith is inconceivable. The balance of probabilities is that the Respondent knew of the Complainant's trademarks and trade name at the date of registration of the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

General

According to paragraph 4(a) of the Policy, the Complainant must prove that the following three elements are present:-

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) The domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel agrees unreservedly with the Complainant's contentions in this regard; namely that on a comparison of the disputed domain name <airaustral.net> with the Complainant's trademark AIR AUSTRAL the former is identical to the latter. As is customary in UDRP proceedings, the generic top level domain (gTLD) ".net" can be disregarded for the purposes of comparison on the basis that this is wholly generic. Likewise, the absence of the "white space" in between the words "air" and "austral" is of no consequence, given that the naming rules do not permit the use of such spaces in a second level domain name. Accordingly, the Panel finds that the Complainant has proved the first element required under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Respondent's rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii) of the Policy:

(i) before any notice to the Respondent of the dispute, the Respondent's 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) the Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial 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 Complainant asserts that the Respondent is not and has never been commonly known as AIRAUSTRAL and has no connection whatsoever to the Complainant or its trademarks. The Complainant also focuses on the fact that the domain name was used initially for a directory-based website with a pay-per-click revenue model which is likely to have confused and diverted Internet users to the commercial websites of others in a similar field to the Complainant and subsequently has been pointed to a blank web page. The Panel agrees with the Complainant that neither of these uses constitutes a bona fide offering of goods or services under the paragraph 4(c)(i) of the Policy, or a legitimate non-commercial or fair use under paragraph 4(c)(iii) of the Policy.

Consequently, the Panel considers that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the domain name in that (i) use of the domain name by the Respondent is not a bona fide offering of goods or services, (ii) the Respondent is not commonly known by the domain name, and (iii) the Respondent has in the past been using the domain for an illegitimate purpose, namely, for commercial gain to profit from the traffic from Internet users seeking the Complainant's official web site and thereby misleading consumers.

There is no evidence before the Panel that the Respondent has any legitimate interest in the disputed domain name either in terms of the criteria available under paragraph 4(c) of the Policy or otherwise. In terms of paragraph 14(b) of the Rules, the Panel is entitled to draw such inferences from the Respondent's failure to respond to the administrative proceeding as it considers appropriate. In the absence of any answer to the Complainant's contentions from the Respondent, the Panel draws the inference that the Complainant is correct in its assertion that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant first points to a variety of domain names registered either in the name of the Respondent or under other names such as World Wide Web2 Enterprise Inc or South East Enterprise Inc at the same address as the Respondent, many of which are recognizable to the Panel as typographical variants of famous trademarks. Of these, <googlw.net> (a variant of the principal domain of the famous search engine google.com); <barnesnoble.net> (a variant of the principal domain of the famous booksellers Barnes & Noble - <barnesandnoble.com>); and <askjeeves.com> (a variant of the name of the well-known search engine Ask Jeeves) are all registered directly to the Respondent. In these circumstances it is not necessary for the Panel to consider whether there is a connection between the Respondent and those other domains identified by the Complainant which share the same address and administrative contact but have different registrants.

In the view of the Panel, the evidence shows that Respondent is engaged in a strategy of registering domain names based on well-known or famous trademarks to maximize traffic to one or more directory-based websites. This fortifies the Complainant's contention that the disputed domain name in the present case was registered and has been used for this purpose. The Panel is therefore satisfied that on balance of probabilities the Respondent has engaged in intentionally attempting to attract, for commercial gain, Internet users to its web site or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site and that this constitutes registration in bad faith.

The Complainant very fairly points out that the present use of the disputed domain name is to point to a blank web page. In doing so, the Complainant is seeking to address the fact that under paragraph 4(a)(iii) of the Policy it is required to show that the domain name has been registered and *is* being used in bad faith [the Panel's emphasis]. In light of the very recent prior abusive use of the domain name by the Respondent, the Panel has little hesitation in finding that the present "passive holding" of the domain name constitutes use in bad faith. To find otherwise would simply invite any parties using a domain name in bad faith to point their domain name to a blank page on receipt of a complaint under the Policy, purely to provide the Complainant with an extra hurdle to get over.

Nevertheless, for the sake of completeness, the Panel will consider the Complainant's citation of *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. A domain name need not be used in conjunction with an active website and "passive holding" is not intrinsically offensive. But, there are cases where, taking all the circumstances together, "passive holding" can amount to bad faith registration and use. The Panelist in *Telstra* identified on five factors which were relevant on the facts of that particular case, summarized as (i) strength of trademark's reputation; (ii) no evidence by Respondent of actual or contemplated good faith use; (iii) active steps by Respondent to conceal its identity; (iv) active provision of false contact details by Respondent; and (v) lack of any plausible actual or contemplated active use of the domain name by Respondent that would not be illegitimate.

As already noted, the Panel considers that there are circumstances in the present case which satisfy the Panel that the present "passive holding" can and does amount to bad faith registration and use. These are:

(i) the Respondent's apparent traffic maximizing strategy not only with regard to this domain name but also to others which in the view of the Panel constitutes a pattern of abusive conduct designed to profit from the fame of the relative trademarks including the Complainant's trademark with significant potential for consumer confusion;

(ii) the fact that the present "passive holding" only began once the Complainant had attempted to contact the Respondent, and that it had been preceded by a clear abusive use;

(iii) the fact that the Respondent has failed to provide any explanation for its conduct or to demonstrate any legitimate interest, including any evidence of actual or contemplated good faith use of the disputed domain name, leading the Panel to the reasonable inference that there is no such explanation; and

(iv) the fact that on the evidence before the Panel, in particular the Complainant's trademark rights and business activities, it is difficult to conceive of a use of the disputed domain name by the Respondent that would not cause consumer confusion or alternatively (depending on the various jurisdictions involved) infringement of the Complainant's trademark. Again, the Respondent's failure to provide any reply on the question of use is a significant factor.

In light of the above the Panel is satisfied that the Respondent has registered and is using the disputed domain name in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <airaustral.net> be transferred to the Complainant.

(Sole Panelist)