Decision for dispute CAC-UDRP-100219

Case number	CAC-UDRP-100219
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Domain names	skyport.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Skyport a.s.

Complainant representative

Organization	Jansa, Mokrý, Otevřel & partneři v.o.s.

Respondent

Organization	AMERCO LLC

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

The Complainant owns the following trademark registrations in the term SKYPORT:

Community trade mark "Skyport" No. 6429741, registered on 24 July 2009, Community trade mark (figurative) "Skyport" No. 6429732, registered on 10 December 2009 and Czech national trade mark "Skyport" No. 312858 ", registered on 30 June 2010.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a cargo handling company, based in Czech Republic. It owns several trade mark rights as listed above. The Complainant owns two domain names incorporating the name SKYPORT.

The Respondent is located in United States and registered the domain name in 1995.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complaint reads as follows (exact wording as supplied by the Complainant set out below):

The complainant is a joint stock company, based in Prague 6, Laglerové 1075/4, postcode 161 00, Czech republic. It is an operator of the cargo terminal in the Prague Ruzyne airport, and is rendering its services for the important worldwide transportation and airline companies. The complainant renders as well its services on the Bratislava airport in Slovakia, through a subsidiary company Skyport s.r.o. The complainant's services are offered on the internet under several domains, based on the word element „skyport" – the company is a holder of the domains „skyport.cz" and „skyport.sk". Under these domains, the complainant operates a web presentation containing an offer of its services, contact information, some corporate information etc. (the domain "skyport.sk" is redirected to the domain "skyport.cz") (see attachment No. 1 – companies register statement relating to the complainant, attachment No. 2 – record from the whois database of the domain "skyport.cz", and "skyport.sk", attachment No. 3 - screenshot of the web page under the domain "skyport.cz" and "skyport.sk").

Because the complainant is focused primarily on the cooperation with the international clients (transportation and forwarding companies), it's important to offer its services under a generic top-level domain as well. He focused on the skyport.com domain (domain in subject) because of that necessity. This domain has been created in 1995, and since then has been registered by several domain speculators and never used by them to any purpose, and actually is being held by the respondent, company AMERCO LLC, seated at 1333 North Duval Street, Tallahassee, Florida 32303, United States, since 2007. Since the creation of the domain in 1995, the domain has never been used by the respondent, nor by his predecessors, for any web presentation, e-mail services or any other purpose. The complainant found out that the respondent acquired the domain in 2007 from a previous holder – company Essential Services, seated at New Port Richey, FL 34656, USA. After the complainant started its activity in 2007, he entered into contact with the respondent, to negotiate conditions of the domain transfer. At this negotiation the respondent expressed himself, that he registered the domain with the purpose of future sale, and offered the price, which was not acceptable for the complainant. The respondent agreed to provide the domain to the complainant on the lease basis – under the condition of paying a regular (annual) payment, the complainant was entitled to use the domain in subject for its own purposes – this solution has been found as acceptable by the complainant, fulfilling the objective pursued without the necessity of undergoing the domain dispute. The complainant has been operating its own web presentation in English language, focused on the foreign clients, under this domain, since beginning of 2008 (see attachment No. 4 – record from the whois database of the domain in subject, attachment No. 5 – screenshot of the complainant's web presentation under the domain in subject, attachment No. 6 – record from the history of the whois database from www.who.is web page, relating to the domain in subject).

At the end of the 2010, the necessity of the prolongation of the domain in subject occurred, as the domain was to expire on 20/12/2010. With the soon expiration threatening, the respondent has started to escalate his demands and claimed an increased payment for the further use of the domain by the complainant. An increase, claimed by the respondent, reached several hundreds of % of the previous payment, while the respondent conditioned a prolongation of the domain an of the existing contractual relationship with the complainant by an immediate payment of the claimed amount. The respondent expressed himself, that in case when his conditions will not be fulfilled by the complainant, he will let the domain expire, with the immediate registration by any of the automatic systems threatening. Because the respondent's request has been inacceptable for the complainant, the domain expired on 20/12/2010, and actually is in the protection period. Any requests of the domain renewal, sent by the complainant to the respondent, didn't found any answer. The complainant now faces a danger of selling the domain in an auction by the registrar "godaddy.com", or of an immediate automatic registration of the domain after the protection period terminates.

The complainant is an owner of several trademarks, based on the word element "skyport" – a Community trademark No. 6429741, a word mark „Skyport", registered on 24/07/2009 in the classes of goods and services No. 12, 39, a Community trademark No. 6429732, a figurative mark „Skyport", registered on 10/12/2009 in the classes of goods and services No. 12, 39, and a Czech national trademark No. 312858, a word mark „Skyport", registered on 30.06.2010 in the classes of goods

and services No. 12, 39. All these trademarks are based on the word element „Skyport“, which dominates even a figurative community trademark No. 6429732. With regard to the fact, that the top-level domain doesn't have any distinctive function in the assessment of the similarity with the registered trademark, it has to be concluded, that the domain in subject is 100% similar to the complainant's trademarks from all the relevant points of view (especially from the aural and conceptual points of view, while the visual point of view is identical in case of complainant's word marks). It has to be emphasised, that registration of the Community trademarks indicates the orientation of the complainant's services on the wide range of international clients, what justifies the necessity of using the generic top-level domain. (see attachments No. 7 and 8 – record from the Community trademarks register relating to the trademarks No. 6429741 and 6429732, attachment No. 9 – record from the national trademarks register relating to the trademark No. 312858).

Following the complainant's opinion, all the necessary conditions set by the par. 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy are fulfilled in this case –

1) The domain in question is based on the word element, which is 100 % similar to the complainant's trademarks, so the likelihood of confusion is evident from all the relevant points of view – it cannot be supposed, that there can be another subject with any stronger rights to the domain and to the word element, constituting the domain.

2) There is no circumstance that can be considered as forming respondent's rights to use the domain, as he never has never shown any intention to use it in any manner (nor is predecessors did), and with regard to his expressed motivation of the future selling the domain it can be supposed, that he acquired the domain after learning about filling of the complainant's community trademark applications in 10/2007.

3) Respondent's behaviour foregoing the expiration of the domain has to be considered as the prove of his bad faith, as it was motivated only by the possibility of earning a financial gain in the situation, when the danger of the expiration was eminent and direct and when the complainant had no other possibilities. Such behaviour exposed the complainant to the real danger of losing any further possibility to use the domain, as the risk of its registration by the domain speculator or by its sale in the auction immediately after the end of protection period is evident. It can be supposed, that in case when the respondent had a real interest in the domain, he wouldn't let it expire after the complainant refused to accept his financial requests. Such non-prolongation of the domain prevents complainant from using a domain, containing his registered trademarks, in the scope of the goods and services, protected by these trademarks.

In complainant's opinion, the domain in subject cannot be used by any third party without infringing complainant's rights to his trademarks. As the respondent is not commonly known under the name "Skyport", nor under any similar name, and during his existing passive use he didn't prove any intention to use the domain for any reasonable purpose, it has to be referred to the WIPO Administrative panel decision in the case No. D2002-0358 (Thaigem Global Marketing Limited v. Sanchai Aree), based on the similar factual background (ownership of the trademark by the complainant), as well as to the decision No. in the Case No. D2003-0661 (Consorzio del Formaggio Parmigiano Reggiano v. La casa del Latte di Bibulic Adriano). The above-mentioned cases have been as well marked by an offer of the domain to the complainant for an excessive price, similarly to this case, and led to the transfer of the domain to the complainants, having their claims supported by the trademark ownership. Besides the trademark ownership, the complainant's claims are based on his business name ("Skyport a.s.", while the "a.s." is the Czech expression for the join-stock company). Any use of such word element in the domain name by the third party can be considered as an action of unfair competition (abuse of the well-known business name for the purpose of getting profit from its good reputation).

The complainant has a strong interest in the domain in subject, because of the international nature of his potential clients – the respondent doesn't give any signs of such interest. Regarding to the previous contractual (and functional) relation between the parties, the respondent can be suspected from registering and using the domain in bad faith, only with a purpose of earning a monetary profit from the rights holder (complainant). Because of the lack of any communication from the respondent he has to presume, that any further cooperation in the use of the domain in subject is impossible. Because it's evident that in case of the domain acquisition by the third person any similar cooperation would be very likely impossible, the complainant has to claim his rights to the domain name by the way of UDRP proceeding, as he considers this way as the sole possibility of preventing the total loss of the domain. For the above-mentioned reasons the complainant suggests, that

the Panel orders the transfer of the domain „skyport.com“ from the respondent to the complainant.RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules states that the Panel shall decide a Complaint on the basis of the statements and documents submitted, in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, the Rules, the Panel shall draw such inferences therefore at it considers appropriate. In this case the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel is therefore obliged to make its decision on the basis of the factual statements contained in the Complaint and the documents made available by the Complainant to support its contentions.

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following:

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

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

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

Taking each of these issues in turn, the Panel decides as follows:

A. Identical or Confusingly Similar

Based on the evidence put forward by the Complainant, the Panel finds that the Complainant has trade mark rights in the term SKYPORT although it is noteworthy that they do not appear to predate the registration of the disputed domain name. However the question at this stage is only whether or not the Complainant has rights which they do. The date of those rights compared to the date of registration of the disputed domain name may be an element of consideration with regard to the element of bad faith.

The Panel considers that, as previously held in numerous Panel decisions, the generic top level domain suffix .com is without legal significance and has no effect on the issue of similarity.

On the basis of these considerations, the Panel finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The second element that the Complainant must prove is that the Respondent has no rights or legitimate interests in respect of the disputed domain name (Policy, paragraph 4(a)(ii)).

The Policy (paragraph 4(c)) sets out various ways in which a Respondent may demonstrate rights or legitimate interests in the domain name, as follows:

“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 your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(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 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 Panel has considered the evidence put forward by the Complainant and considers that the Complainant has presented a clear prima facie showing of the Respondent's lack of rights or legitimate interest in the disputed domain name. As a result of its default, the Respondent has failed to rebut that showing.

This is particularly true as Respondent is not 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 famous mark of Complainant. Respondent was not commonly known by the domain name nor has it acquired trade mark rights.

The Panel therefore finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The third element that the Complainant must prove is that the disputed domain name has been registered and is being used in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy sets out various circumstances which may be treated by the Panel as evidence of the registration and use of a domain name in bad faith, as follows:

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

On the basis of the evidence put forward by the Complainant, the Panel is satisfied that the Respondent's conduct falls within paragraph 4(b)(i) of the Policy. In particular the Panel finds that the Complainant has successfully proved that the Respondent registered the domain name for speculation purposes. The Complainant did not supply evidence of its negotiations with the Respondent where the Respondent allegedly stated that it registered the disputed domain name for future sale and where it allegedly initially offered the disputed domain name for sale at an unreasonable price or documents relating to the renting of the disputed domain name or threats by the Respondent to let the disputed domain name expire if the Complainant was not willing to pay a highly increased annual amount to rent the domain name. However, as a result of its default, the Respondent has failed to contest the Complainant's arguments and the Panel is left in the situation of only having the Complainant's unrebutted statements to consider in order to decide the Complaint. Had the Respondent replied and provided any evidence to the contrary the decision may not have been to transfer.

Under the Policy, subordinating the transfer of a domain name infringing a third party's right to the payment of an amount higher than the out-of-pocket costs directly related to the domain name is evidence of bad faith. With its behaviour, the Respondent is clearly trying to obtain the higher possible amount for the disputed domain name, which entails, under the circumstances, that the Respondent acquired and maintained the domain name in bad faith.

The Panel therefore concludes that the Complainant has succeeded in proving that the disputed domain name has been registered and used in bad faith.

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 SKYPORT.COM be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **SKYPORT.COM**: Transferred

PANELLISTS

Name	**David Taylor**

DATE OF PANEL DECISION 2011-03-02

Publish the Decision