

ADMINISTRATIVE PANEL DECISION

Kayak Software Corporation v. KAYAK.travel, KAYAK.travel Corporation, Kayak Las Vegas, LLC

Case No. D2011-0425

1. The Parties

The Complainant is Kayak Software Corporation of Concord, Massachusetts, United States of America, represented by Clock Tower Law Group, United States of America.

The Respondent is collectively KAYAK.travel of Edmonton, Alberta, United States of America and Seward, Alaska, United States of America; KAYAK.travel Corporation of Beverly Hills, California, United States of America; and Kayak Las Vegas, LLC of Anchorage, Alaska and Boulder City, Nevada, United States of America. Reference hereinafter to the "Respondent" will be collectively made to all these organizations except in specific instances where reference is made to a specific one of these organizations.

2. The Domain Name and Registrar

The disputed domain name <kayak.travel> is registered with EnCirca, Inc. (the "Registrar").

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), which was adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, and approved on October 24, 1999, and also in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 30, 2009 and the World Intellectual Property Organization ("WIPO") Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 14, 2009 (the "Supplemental Rules").

The Complaint, with accompanying Annexes A-H, including sub-annexes, was filed with the WIPO Arbitration and Mediation Center (the "Center") by e-mail on March 3, 2011.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the original Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on March 4, 2011 and again on March 9, 2011, the Center requested confirmation from the Registrar as to: whether the Registrar received a copy of the Complaint from the Complainant,

contact and registrant information set forth in that Complaint relative to the disputed domain name, and whether the disputed domain name is indeed registered with the Registrar. The Center also requested the Registrar to specify: (a) the dates on which the registrant registered that domain name (or acquired the registration) and when the registration will expire, (b) whether the Policy applies to the name, (c) the language of the registration agreement, and (d) for confirmation that the domain name will remain "locked" during the proceeding.

Subsequently, on March 9, 2011, the Registrar provided its response to the Center through which it confirmed it is the registrar for the disputed domain name, and specified registrant and contact information pertinent to the domain name to the extent, as it then existed, in its Whois database. Further, the Registrar stated that it had not received a copy of the Complaint. The Registrar's response further indicated that: (a) the registration was created on October 19, 2007 and will expire on October 18, 2011, (b) the Policy applies to the name, (c) the registration agreement is in English, and (d) the name will remain locked during the proceeding.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On March 11, 2011, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its annexes, by e-mail with a separate copy of the Center's "Notification of Complaint and Commencement of Administrative Proceeding" being sent by courier. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on March 11, 2011, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on March 31, 2011 to file its Response with the Center and the Complainant.

On March 10, 2011 and again on March 11, 2011, the second Respondent KAYAK.travel Corporation, through e-mail messages to the Center, stated that it was not associated with the present matter.

On March 11, 2011, an individual associated with the website to which the disputed domain name redirected, through an e-mail message to the Center, stated that it does not own the disputed domain name, <kayak.travel>.

On March 15, 2011, the third Respondent Kayak Las Vegas, through its apparent owner in Boulder City, Nevada, sent an e-mail message to the Center stating that it did not own the disputed domain name either. Further, on March 16, 2011, an attorney in Los Angeles, California, (the "Los Angeles Attorney") informed the Center by an e-mail message that he does not represent any party in this matter. The Los Angeles Attorney's e-mail address was identified in the Complaint as being associated with the third Respondent, and was referred to by the second Respondent in its e-mail message of March 10, 2011 as unrelated to this proceeding.

On April 1, 2011, the Center, through an e-mail message, informed the Respondent that the due date for filing a Response has expired and hence the Center will proceed to appoint the administrative panel. In fact, no response, other than simply disavowing ownership in the disputed domain name, had been filed by any of the three Respondent organizations.

Pursuant to the Rules and Supplemental Rules, by e-mail letter dated April 5, 2011, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as the sole panelist for this dispute. Subsequently, on the same date, Mr. Michaelson accepted and, pursuant to the requirements of paragraph 7 of the Rules, returned, by e-mail attachment to the Center, a fully executed Statement of

Acceptance and Declaration of Impartiality and Independence. The Center, through an e-mail letter also of the same date notified the Parties of the appointment of Mr. Michaelson as sole Panelist. The Panel finds that it was properly constituted.

Based on the deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the Panel before April 19, 2011. Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Center, at the request of the Panel, extended this due date to April 29, 2011.

This dispute concerns one domain name, specifically <kayak.travel>.

4. Factual Background

As indicated in the Whois registration record appearing in Annex A to the Complaint, the disputed domain name was registered on October 19, 2007 and will expire on October 18, 2011.

A. Complainant's KAYAK Marks

The Complainant owns various United States and counterpart foreign trademark registrations, in block letters, containing, as a formative, the word "kayak". The Complainant has provided, in Annex F to the Complaint, a copy of the registration certificates for these marks. Pertinent details of certain illustrative registrations are as follows:

1. KAYAK
United States Registration No. 3,209,578
registered: February 13, 2007; filed: April 16, 2004

This mark is registered for use in connection with: "Providing on-line chat rooms and on-line bulletin boards for transmission of messages among computer users in the travel community; providing multi-user access to an interactive global computer information network in the field of travel information" all in international class 38; and "Providing on-line information, namely, schedules, listings, reviews, postings, or locations in the field of entertainment; providing online publications in the nature of guides and directories featuring schedules, listings, advertisements, reviews, postings, locations, or solicitations for use by travelers available electronically via computer networks, global information networks and wireless networks" in international class 41. The registration indicates that both first use and first use in commerce of this mark when used in conjunction with all the services in classes 38 and 41 commenced at least as of June 21, 2006 and February 23, 2006, respectively.

2. KAYAK.COM
United States Registration No. 3,129,154
registered: August 15, 2006; filed: May 31, 2005

This mark is registered for use in connection with: "Providing on-line price comparisons of travel and lodging services; online referral services in the travel community; a searchable directory of travel information for obtaining data and information from others via the Internet; providing on-line information about the goods and services of others, by way of featuring advertisements and solicitations of others", all in international class 35; "Providing online communications links that transfer the website user to others' local and global web pages and web sites" in international class 38; "Providing travel information over global computer networks, namely providing search services for travel listings, travel information and related topics, and for making reservations and bookings for transportation" in international class 39; "Providing online publications in the nature of guides and directories featuring schedules, listings, advertisements, reviews, postings, locations, or solicitations for use by travelers available electronically via computer networks, global information networks and wireless networks" in international class 41; "Providing an Internet search engine to assist travelers to locate and compare prices and ratings for travel reservations" in international class 42; and "Travel agency services, namely, making reservations and booking for temporary lodging" in

international class 43. The registration indicates that both first use and first use in commerce of this mark, when used in conjunction with all these services, commenced at least as of October 7, 2004.

3. KAYAK
United States Registration No. 3,110,651
registered: June 27, 2006; filed: April 16, 2004

This mark is registered for use in connection with: "Providing on-line price comparisons of travel and lodging services; online referral services in the travel community; a searchable directory of travel information for obtaining data and information from others via the Internet; providing on-line information to others, namely advertisements or solicitations", all in international class 35; "Providing travel information over global computer networks, namely providing search services for travel listings, travel information and related topics, and for making reservations and bookings for transportation" in international class 39; and "Providing an Internet search engine to assist travelers to locate and compare prices and ratings for travel reservations" in international class 42. The registration indicates that both first use and first use in commerce of this mark, when used in conjunction with all these services, commenced at least as of October 7, 2004.

B. The Respondent's activities

The Registrant, as listed in the Whois record, and the first Respondent is "KAYAK.travel", of 17060 100 Street, Edmonton, Alberta T5S2E7 United States. However, no such address exists inasmuch as Edmonton, Alberta is in Canada not the United States. Moreover, the telephone number of the administrative contact (listed as "+1.1111111111") is also incorrect.

The second Respondent KAYAK.travel Corporation is the applicant for United States trademark application serial no. 77/963,965 for the term WWW.KAYAK.TRAVEL and provided its address, in the application, as Beverly Hills, California. A copy of that application appears in Annex B to the Complaint. According to corporate name searches performed by the Complainant (copies of which appear in Annex C to the Complaint), no such corporation is registered under that corporate name in either California or Nevada.

The Complainant has provided in Annex D to the Complaint, copies of e-mail messages from the Los Angeles Attorney, then apparently representing the third Respondent Kayak Las Vegas of Boulder City, Nevada, who stated in one of those messages that this particular respondent owns the disputed domain name. However, the third Respondent Kayak Las Vegas, through its apparent owner Desert Adventures in Boulder City, Nevada, also informed the Center that it did not own the name either. Further, the Los Angeles Attorney informed the Center that he does not represent any party in this matter.

Prior to January 2011, the name operated to redirect Internet users to the Complainant's website at "www.kayak.com". At the time of the filing of the Complaint, the domain name operated to re-direct those users to the "www.alaskakayak.com" website (a copy of the home page appears in Annex G to the Complaint) which is a website directed to Alaskan travel and kayak adventures.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's KAYAK Marks because the name contains the formative term "kayak" and also the generic top level domain (gTLD) ".travel", with the latter signifying a website in a travel-related industry which is the same industry in which the Complainant, through its own goods and services, operates.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Complainant alleges that there is no evidence that: (a) the Respondent's use of, or demonstrable preparations to use, the name occurred in connection with a *bona fide* offering of goods or services, (b) the Respondent, as an individual, business or other organization, is commonly known by the domain name, (c) the Respondent is making a legitimate noncommercial use of the name.

Further, the Complainant alleges that direct evidence exists that the second Respondent has no legitimate rights to the name based upon its U.S. trademark application for the term "www.kayak.travel". A specimen submitted with that application appeared to be a search box for travel, but instead was a fixed image of a search box which would not allow any text entry or searching. In addition, the specimen advertised "www.kayak.travel," which at the time redirected Internet users to the Complainant's website at "www.kayak.com" thereby attempting to associate the Respondent with the Complainant's use rather than its own legitimate use of the term itself. See a letter of Protest (a copy of which appears in Annex H to the Complaint) which the Complainant filed in that application.

Moreover, from the time the first Respondent registered the name until January 2011, the name operated to divert web traffic to the Complainant's website, rather than to any website associated with any of the Respondents, and thus did not reflect legitimate use.

(iii) Registered and Used in Bad Faith

Lastly, the Complainant contends, also for various reasons, that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Since the time the first Respondent registered the name on October 19, 2007 until January 2011, the name resolved to the Complainant's website. As of the time of the filing of the Complaint, the domain name directed web traffic to another site.

Further, the second Respondent used the name to create a specimen submitted in its U.S. trademark application but which relied on the Complainant's use of its website rather than on the Respondent's legitimate use of the name.

Moreover, in an attempt to capitalize on the name, the third Respondent, through the Los Angeles Attorney, asserted its trademark rights against and to threaten the Complainant when, in fact, the Respondent had no registered marks or any verifiable trademark history and does not even own the name.

All these actions, particularly when viewed in their totality, are designed to capitalize on the Complainant's renown and success, with current activities being an attempt to interrupt the Complainant's business with baseless allegations in an apparent effort to eventually extract money from the Complainant (presumably, so the Panel infers, in exchange for their cessation). Hence, all these activities constitute bad faith use.

B. Respondent

None of the Respondent organizations filed a substantive response to the contentions raised in the Complaint.

The second and third Respondents each disavowed ownership in the disputed domain name. The first Respondent did not file any response whatsoever to the Complaint.

6. Discussion and Findings

Inasmuch as the Panel finds that no Response in compliance with the requirements of paragraph 5(b) of the Rules has been filed, this proceeding has effectively proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel has decided this administrative proceeding on the

basis of the Complainant's undisputed factual representations.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is either identical or confusingly similar to the Complainant's KAYAK Marks.

From a simple comparison of the name to the Complainant's mark KAYAK, no doubt exists that the domain name is identical to the Complainant's mark. In particular, the domain name <kayak.travel>, apart from its inclusion of the generic top level domain (gTLD) .travel, is otherwise identical to the mark. The addition of the gTLD is irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored. See *Photo Tour Books, Inc. d/b/a PhotoSecrets v. Beate Chelette*, WIPO Case No. D2010-1373.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent, were it to have made one, to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize its KAYAK Marks in conjunction with any of the products or services with which the Complainant uses those marks, nor does the Complainant apparently have any relationship, affiliation or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's marks or one confusingly similar thereto in connection with the identical or even similar goods and services to those currently provided by the Complainant, as recited in any of its trademark registrations, might likely violate the exclusive trademark rights now residing with the Complainant. See, e.g., *American Medical Software v. Belize Domain WHOIS Service Lt*, WIPO Case No. D2010-1004; *Varian Medical Systems Inc. v. Private*; WIPO Case No. D2010-0815; *Gulf Craft Inc. Co. (LLC) v. PrivacyProtect.org / Domain, Stocker*, WIPO Case No. D2010-0504; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. 173362; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Claim No. 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in the Panel's view, the Respondent could not legitimately acquire any public association between it and any of the Complainant's KAYAK Marks or one similar thereto, and certainly not for the goods and services provided by the Complainant under those marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name. Nor could the Respondent in the Panel's view likely ever become commonly known by the name, at least in the same industry (here being travel) as the Complainant, without likely infringing on the exclusive trademark rights of the Complainant. In that regard, the disputed domain name was registered on October 19, 2007, over a year after the earliest of the Complainant's KAYAK Marks, specifically 3,110,651, was registered, with first use of that mark commencing as early as October 7, 2004 evidencing the start of the Complainant's common law rights some three years prior to the date on which the disputed domain name was registered. See, e.g., *American Medical, Varian, Gulf Craft, Clearwire, Starline Publications and Treeforms, Inc.*, all cited *supra*.

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Moreover, it is beyond any credible doubt to the Panel that the Respondent had actual knowledge of the Complainant's mark KAYAK and the Complainant's exclusive rights in that mark at the time it registered the disputed domain name. Yet, in spite of that knowledge, the Respondent proceeded to register the name anyway and then intentionally use it as an instrument to divert Internet users to the Complainant's website. The name functioned in that manner for three years, apparently starting at the time the name was registered, until earlier this year when obviously the Respondent realized the Complainant was aware of the Respondent's diversion and as a consequence changed the use of the name to resolve to a third-party website. The Panel infers, from the lack of any substantive response, that the Respondent's primary motivation in doing so was to artificially increase web traffic to the Complainant's website, and then, over time, create and then eventually opportunistically exploit that increased traffic by convincing the Complainant to purchase the name from the Respondent at a substantial price (most likely well in excess of the cost of registration) in order to preserve the traffic, and possibly by so doing avoid potential injury that might otherwise arise to the Complainant's business and reputation. Such use clearly does not constitute a *bona fide* offering of goods or services, let alone one that occurred prior to receiving any notice of this dispute.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

First, the Respondent registrant registered the name using false credentials for its identity. Doing so frustrates identification of the true owner, violates the Registrant's obligations under its registration agreement and by itself constitutes bad faith registration.

Second, and as discussed in the preceding section above, the Panel infers that the Respondent was well aware of the Complainant's mark KAYAK before the Respondent registered the name. Yet, in spite of that knowledge, the Respondent proceeded to register the name anyway and then, starting at the time it registered the name, intentionally use that name as an instrument to divert Internet users to the Complainant's website for over three years. The Respondent's primary motivation in doing so, as the Panel infers, was to artificially increase web traffic to the Complainant's website, and then, over time, create and then eventually opportunistically exploit that increased traffic by convincing the Complainant to purchase the name from the Respondent at a substantial price (most likely well in excess of the costs of registration) in order to preserve the traffic, and possibly by so doing avoid potential injury, including disruption, that might otherwise arise to the Complainant's business and reputation. This too constitutes bad faith registration and also bad faith use.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy including specifically paragraphs 4(b)(i), 4(b)(iii) and 4(b)(iv) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name, <kayak.travel>, is ordered transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: April 22, 2011