



NATIONAL ARBITRATION FORUM

DECISION

Holland Properties, Inc. v. Relocation Director, Inc.
Claim Number: FA0412000379669

PARTIES

Complainant is **Holland Properties, Inc.** (“Complainant”), P.O. Box 516, 751 Frederick Street, Hanover, PA 17331. Respondent is **Relocation Director, Inc.** (“Respondent”), 1643 Oak Tree Terrace, Glendora, CA 91741.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <hollandproperties.com>, registered with Dotster.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

Mr. Peter L. Michaelson, Esq. as Panelist.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), available at <icann.org/services/udrp/udrppolicy24oct99.htm>, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”) as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

Complainant submitted a Complaint to the National Arbitration Forum (the "Forum") electronically on December 10, 2004; the Forum received a hard copy of the Complaint together with Exhibits 1-4 on December 16, 2004. Complainant, on December 20, 2004, in response to the Forum's request of December 17, 2004 and within the time limit

allotted, submitted a slightly amended Complaint and the requisite filing fee to the Forum.

On December 14, 2004, the Registrar, Dotster, confirmed by e-mail to the Forum that the domain name <**hollandproperties.com**> is registered with Dotster and that the Respondent is the current registrant of the name. Dotster has verified that the Respondent is bound by the Dotster registration agreement and has thereby agreed to resolve domain name disputes brought by third parties in accordance with the Policy.

On December 20, 2004, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of January 10, 2005 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@hollandproperties.com by e-mail.

A timely Response, together with a sole exhibit, i.e., Exhibit 1, was received and determined to be complete on January 10, 2005.

Subsequently and pursuant to Supplemental Rule 7, Complainant timely filed an additional submission on January 17, 2004.

Thereafter and also pursuant to Supplemental Rule 7, Respondent timely filed an additional submission on January 18, 2004.

On January 17, 2005, pursuant to Complainant’s request to have the dispute decided by a single-member Panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as the Panelist and set a deadline of January 31, 2005 to receive the decision from the Panel. Due to exceptional circumstances experienced by the Panel, the Forum, at the Panel’s request, extended this deadline to February 14, 2005.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES’ CONTENTIONS

A. Complainant

1. Identical/Confusingly Similar

Complainant contends that since the disputed domain name incorporates Complainant's HOLLAND PROPERTIES mark in its entirety, the domain name is identical to that mark.

Consequently, Complainant believes that it has satisfied the requirements of paragraph 4(a)(i) of the Policy with respect to the disputed domain name.

2. Rights and legitimate interests

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name.

Specifically, Complainant alleges that Respondent deliberately registered the disputed domain name to capitalize on Complainant's mark, which designates Complainant as a producer of real estate services.

Moreover, Complainant also alleges that Respondent uses the disputed domain name to divert Internet users to another one of Respondent's own websites, namely <relocationdirector.com>. This site is commercial in nature and unfairly diverts Internet traffic which, in turn, increases Respondent's business at its <relocationdirector.com> website. Citing *Vapor Blast Mfg. Co. v. R & S Tech., Inc.*, FA 96577 (Nat. Arb. Forum Feb. 27, 2001) and *Big Dog Holdings, Inc. v. Day*, FA 93554 (Nat. Arb. Forum Mar. 9, 2000), Complainant argues that no rights or legitimate interests can exist in Respondent when it benefits from unauthorized use of another's mark, here Complainant's, by diverting Internet traffic to other websites.

Furthermore, Complainant alleges that Respondent has no substantial affiliation with, or is known by the disputed domain name. Rather, it is Complainant, as it alleges, which has established itself as having legitimate rights in that mark, rights which preceded the date on which Respondent registered the disputed domain name.

3. Bad faith use and registration

Complainant contends that Respondent has registered and is using the disputed domain name in bad faith, hence in violation of paragraph 4(a)(iii) of the Policy.

In that regard, Complainant specifically alleges that Respondent has placed a "for sale" pop-up advertisement on its website indicating that the name is for sale. Complainant contends that Respondent purposely acquired the name to resell it for financial gain and, by so indicating that it is for sale, has exhibited bad faith registration and use.

Furthermore, Complainant contends that Respondent has prevented Complainant from reflecting its HOLLAND PROPERTIES mark in a domain name. Specifically, Complainant alleges that Respondent has "made a pattern out of registering scores of domain names that are similar or identical to the marks of realty companies across the United States." In that regard, Complainant notes that each of those domain names redirects Internet users to Respondent's website at the <relocationdirector.com> domain name, where all those domain name registrations are advertised as being "for sale."

Citing *Gamesville.com, Inc. v. Zuccarini*, FA 95294 (Nat. Arb. Forum Aug. 30, 2000) and this Panel's prior decision in *Pep Boys Manny, Moe, & Jack v. E-Commerce Today, Ltd.*, AF-0145 (eResolution May 3, 2000), Complainant argues that "[t]he coupling of intent to prevent a rightful owner of a mark from reflecting the mark, with a pattern of such conduct is an indication of bad faith under ¶ 4(b)(ii)."

Lastly, Complainant, citing to *Mission Kwa Sizabantu v. Rost*, D2000-0279 (WIPO June 7, 2000), contends that the term "competitors" should be liberally construed. When so construed, Complainant alleges that it and Respondent are competitors and, as such, Respondent's use of the disputed domain name to intentionally divert Internet users from Complainant's website constitutes bad faith. Moreover, Complainant contends that Respondent registered the name, which is identical to Complainant's mark, to intentionally capitalize on Complainant's mark and hence its established reputation by attracting Internet users to Respondent's website for commercial gain.

B. Respondent

1. Confusing similarity/identicality

Respondent contends that, based on its investigation of the online records of the United States Patent and Trademark Office ("USPTO"), Complainant has never filed a trademark application to register either the words "Holland Properties" or the **<hollandproperties.com>** domain name.

Accordingly, Respondent concludes that Complainant does not have any valid trademark rights in its mark, and hence has failed to satisfy the requirements of paragraph 4(a)(i) of the Policy.

Moreover, Respondent points to Complainant's mark, as provided in Exhibit 4 of the Complaint, and notes that the mark, when taken in its entirety, includes various design elements and other textual wording not present in the disputed domain name. Hence, to the extent Complainant has any trademark rights, those rights can only result from the entire composite mark and not from just the two words "holland" and "properties."

2. Rights and legitimate interests; Bad faith use and registration

Respondent rebuts Complainant's contentions of bad faith registration.

Specifically, Respondent states that it registered the name because, in its mind, the name is generic by virtue of it being highly geographically descriptive and consumer-intuitive in nature, the latter reflecting its connotation as being both "Geographic-Specific", i.e., "Holland", and "Topic-Specific", i.e., "Properties." In that regard, Respondent notes that "Holland" is not only the name of a very well known country, but also is the name of

cities located in Indiana, Iowa, Kentucky, Massachusetts, Michigan, Minnesota, Missouri, New York, Ohio and Texas. Respondent cites to *Cebu Ass'n of California, Inc. v. Santo Nino De Cebu USA, Inc.*, 95 Cal.App.3d 129, 133-134 (1979) for the proposition, under California law, that "geographic and other purely descriptive words, used in a descriptive sense, are not protected as trade names or service marks" and to *In Re Nantucket, Inc.* 677 F.2d 95, 213, (CCPA 1982) for its holding that primarily geographically descriptive terms are not susceptible of being federally registered as trademarks.

Further, Respondent states that it never sought to register domain names that were similar or identical to the marks of realty companies across the United States, prevent the owner of a trademark from reflecting its mark in a corresponding domain name, hold domain names hostage, or divert Internet traffic to competitors in an unfair way. In that regard, Respondent states that its goal, from the beginning, was to register domain names that were exclusively geographic and topic-specific, as is the disputed domain name.

C. Additional Submissions

Inasmuch as both Complainant and Respondent timely filed their respective additional submission, the Panel has fully considered both of these submissions. The Panel has summarized these submissions, to the extent relevant, as follows.

1. Complainant's Additional Submission

This additional submission sets forth Complainant's principal rebuttal arguments as follows:

- (a) Respondent has failed to provide any evidence that it registered the name "Holland Properties" or operates its business under the name of "Holland Properties" in any form.
- (b) The words "development," "management," "acquisition," "investment" and "leasing," which do appear in the composite depiction shown in Exhibit 4 to the Complaint, identify the services which Complainant provides but are not part of its mark.
- (c) Though Respondent states that it did not register the disputed domain name in order to resell it, when Complainant first endeavored to obtain the domain name it was directed to the <relocationdirector.com> website and a pop-up advertisement became visible, stating that the domain name registration was for sale. Since the inception of the dispute, Respondent has discontinued the use of the pop-up. Hence, this shows an attempt to cover-up any evidence of actively selling the domain name registration.
- (d) An Internet search of Respondent uncovered that it registered thousands of domain names that end in the words "homes," "realty" and "properties." Respondent operates under none of those names. Respondent is reportedly one of the largest domain name holders in the country and held over 33,000 different domain names as of 2001.
- (e) Complainant is not attempting to restrict the use of the word "holland" but rather to gain use of a domain name in which it has a vested interest.

2. Respondent's Additional Submission

Respondent's additional submission sets forth Respondent's principal surrebuttal arguments, as follows:

- (a) Respondent registered the disputed domain name due to that name's generic and consumer-intuitive qualities, i.e., the domain name is both geographic (HOLLAND) and topic (PROPERTIES) specific. Respondent, being a relocation company, contends that its clients find its website by simply typing in a domain name that contains descriptive terms that reflect their intuitive thought patterns, *i.e.*, if that client is interested buying or selling properties in Holland, an intuitive domain name for them to enter would be **<hollandproperties.com>**.
- (b) Respondent's right to offer the disputed domain name for sale does not constitute a claim that Respondent registered that name for the purpose of selling that name. Furthermore and contrary to Complainant's view, Respondent's pop-up window, through which it provides its Internet users with various site navigation options, is still operational.
- (c) Respondent's business model, as Complainant clearly points out, includes registering domain names that contain the names of cities, states and countries followed by consumer-intuitive real estate-related terms, such as "houses," "homes," "property," "properties," "real estate" and "realty." This plan and Respondent's actions, in connection therewith, have been honest and honorable, and hence does not reflect bad faith.

FINDINGS

Respondent registered the disputed domain name on March 27, 2000.

Complainant, a Maryland corporation, has provided real estate management and development services throughout the mid-Atlantic region of the United States since 1992. Though it contends that the term "Holland Properties" is its trademark, the record is devoid of any evidence reflective of any trademark use of that term by Complainant.

Respondent is a relocation company. Its clients obtain information from one of Respondent's corresponding websites by simply entering a domain name that contains suitably descriptive and intuitive terms. Specifically, if one of Respondent's clients is interested buying or selling properties in Holland, that person would enter the disputed domain name, **<hollandproperties.com>**, and so forth for homes, realty or properties located elsewhere.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

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

Identical and/or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires that a disputed domain name be "identical or confusingly similar to a *trademark or service mark in which the complainant has rights*" (emphasis added). This devolves into two requirements that must both be met by every complainant under the Policy, namely that (a) the complainant has rights in a trademark or service mark, and (b) the disputed domain name is identical or confusingly similar to that trademark or service mark.

While the Complainant alleges it has trademark rights in the term HOLLAND PROPERTIES, based on this Panel's review, both its Complaint and its Additional Submission collectively appear utterly devoid of any proof whatsoever that Complainant has such rights -- let alone as of March 27, 2000 which is the date the disputed domain name was registered. Mere allegations do not suffice. Sufficient proof is absolutely essential as a threshold requirement in order for the Policy to apply -- whether that proof derives from a federal or state registration, or mere use of the mark at common law. Absent any proof, let alone sufficient proof, Complainant has simply failed to satisfy the requirements of paragraph 4(a)(i) of the Policy. *See, e.g., Nat'l Sports Servs. Inc. v. Global Media Res. S.A.*, FA 335580 (Nat. Arb. Forum Nov. 18, 2004); *see also Cont'l Design & Mgmt. Group v. Technet, Inc.*, FA 96564 (Nat. Arb. Forum Mar. 21, 2001).

Rights or Legitimate Interests; Registration and Use in Bad Faith

In view of the Panel's finding above that Complainant has failed to satisfy paragraph 4(a)(i) of the Policy, then all issues as to whether (a) under paragraph 4(a)(ii) of the Policy, Respondent has any rights or legitimate interests in the disputed domain name; and (b) under paragraph 4(a)(iii) of the Policy, Respondent registered and used the disputed domain name in bad faith are now moot. Consequently, the Panel has no need to consider any of these issues and thus declines to do so.

Hence, Complainant has simply failed to meet its burden under paragraph 4(a) of the Policy.

DECISION

Consequently and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules,
the relief sought by Complainant is hereby **DENIED**.

Peter L. Michaelson, Esq., Panelist
Dated: February 14, 2005