

## **ADMINISTRATIVE PANEL DECISION**

Travelpro Products, Inc. v. BuyDomains.com  
Case No. D2016-1254

### **1. The Parties**

The Complainant is Travelpro Products, Inc. of Boca Raton, Florida, United States of America (“United States”), represented by Akerman LLP, United States.

The Respondent is BuyDomains.com, Waltham, Massachusetts, United States, internally-represented.

### **2. The Domain Name and Registrar**

The disputed domain name <travelpro.com> is registered with Annulet Incorporated (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2016. On June 21, 2016, the Center transmitted a request for registrar verification, by email, to the Registrar in connection with the disputed domain name. On June 24, 2016, the Registrar transmitted to the Center, by email, its verification response which confirmed that the Respondent is listed as the registrant and provided associated contact details.

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 and 4, the Center formally notified the Respondent of the Complaint, and that the proceedings commenced on June 27, 2016. In accordance with the Rules, paragraph 5, the due date for Response was set to July 17, 2016. The Response was timely filed with the Center on July 17, 2016.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on July 26, 2016. 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

As reflected in the registration record for the disputed domain name in the Whois database (a copy of the record appears in Annex A to the Complaint), the disputed domain name <itravelpro.com> was registered on January 13, 2016, and is due to expire on January 13, 2018.

##### A. The Complainant's TRAVELPRO Marks

As listed in the Complaint, the Complainant owns various United States registrations and registrations in other jurisdictions for the mark TRAVELPRO, either by itself in block letters or in conjunction with a design element, for which the Complainant has provided, in Annex H to the Complaint, either records of these registrations from publicly available databases, such as from the United States Patent and Trademark Office ("USPTO"), or copies of these registrations. Salient details of several of the Complainant's United States marks are as follows:

1. TRAVELPRO  
United States Registration No.: 1,587,822  
Registered: March 20, 1990; filed: July 17, 1989

This mark is registered for use in connection with: "Luggage; garment bags for travel; all-purpose sports bags; toiletry cases sold empty; shoulder bags; expanding tote bags; and zippered valises", all in international class 18. The registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of September 1, 1988.

2. TRAVELPRO and design
  - United States Registration No.: 2,829,620
  - Registered: April 6, 2004; filed: April 25, 2003

This mark is registered for use in connection with: "Computer carrying cases" in international class 9; and "Luggage, suitcases, garment bags for travel, all-purpose sports bags, toiletry cases sold empty, shoulder bags, carrying cases, tote bags, duffle bags, rolling duffle bags, backpacks, rolling backpacks", all in international class 18. The registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of at least August 31, 1997.

3. TRAVELPRO
  - United States Registration No.: 4,606,771
  - Registered: September 16, 2014; filed: July 20, 2012

This mark is registered for use in connection with: "Metal luggage locks; and metal padlocks" in International class 6; "Electrical accessories for traveling, namely, adapters, adapter plugs, adapter plug boards, converters, and transformers; adapter plugs for telephones, modems and faxes; voltage surge protectors; electrical power extension cords; and computer carrying cases", all in international class 9; and "Document holders; document organizers for stationery use" in international class 16. The registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of January 6, 2014.

##### B. The Complainant

In 1987, the Complainant provided luggage for airline flight crew members and began its operation when a Northwest Airlines 747 pilot invented the ORIGINAL ROLLBOARD wheeled luggage. Since then, the Complainant has expanded its line of luggage to now encompass a wide range of luggage from garment bags and suitcases to executive and computer briefs, rolling duffels, totes and backpacks, and, during the course of so doing, has supplied luggage to more than 500,000 flight crews and travelers worldwide.

As indicated by copies of various press releases provided in Annex C to the Complaint, over the years, the Complainant has garnered critical rankings and awards for its luggage, including: (a) in December 2015, a ranking of the Claimant's TRAVELPRO PLATINUM MAGNA ROLLBOARD Suiter by *WireCutter*, a source for gear testing and ranking, as the best carry-on bag in the market; (b) in 2014, the "World's Best Luggage" award from *Premier Traveler Magazine's* reader-selected "Best of 2014 list" (and similarly in 2013); and (c) ranking of certain of the Complainant's products by *Outdoor Gear Lab*, which reviews products in the outdoor gear industry, as first and third in the Travel Goods Association's Product Innovation Awards for 2012 and 2013.

Since 1988, the Complainant began extensively promoting its TRAVELPRO brand and now does so through radio, print, Internet, email, sweepstakes offerings, product placement in movies, and newsletter advertising campaigns. The Complainant annually spends approximately USD 3 million through direct and cooperative advertising in promoting its Travelpro brand to increase goodwill and overall brand awareness.

As shown by the screen shots provided in Annex I to the Complaint, the disputed domain name resolved to a web site which has a parking page containing various links to third-party websites that advertise and offer goods, including luggage, briefcases, totes and garment bags, from other manufacturers, that directly compete with the Complainant's goods sold under its TRAVELPRO mark.

### **C. The Respondent**

The Respondent registers and offers for sale to the public domain names that have expired and/or have become available to the public. The Respondent's policy is to register and maintain only generic and descriptive domain names that incorporate common letters, words, or phrases, and/or terms of semantically independent significance to which no single party has exclusive rights. The Respondent offers some of the domain names it acquires through its website "www.buydomains.com".

The Respondent acquired the disputed domain name on January 13, 2016, after its previous registrant allowed its registration of the disputed domain name to expire on October 24, 2015.

Once the Respondent became aware of the Complainant's concerns regarding the links on the parked page, the Respondent then took down the parking page in favor of posting a new page, as indicated by a screen shot which appears in Annex 6 to the Response, to its website which simply states to Internet viewers that a website at "www.itravelpro.com" cannot be reached.

The Respondent states that it did not have any prior knowledge of the third-party links on the parking page as those links resulted from algorithms of third-party search engines.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is confusingly similar to its mark TRAVELPRO.

Specifically, the disputed domain name contains the mark TRAVELPRO to which the lower-case letter "i" has been prepended, with that additional letter being incapable of adding sufficient distinctiveness whatsoever to the disputed domain name to mitigate any resulting user confusion between the disputed domain name and the mark.

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 any of several 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 Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services and thus is non-compliant with paragraph 4(c)(i) of the Policy. In that regard, the Respondent does not sell any products or services through its website, as the disputed domain name solely exists as an address for a parking page which contains third-party links to goods that directly compete with those of the Complainant and through which the Respondent earns click-through revenue.

The Respondent is also neither commonly known by the disputed domain name nor, given the Respondent's current commercial use of the disputed domain name, is it making a legitimate noncommercial or fair use of the disputed domain name under paragraphs 4(c)(ii) or 4(c)(iii) of the Policy. In that regard, the Respondent is not associated with the name "Itravelpro.com" nor could it establish, through its present use of the disputed domain name, which does not constitute a *bona fide* offering of goods or services, a legitimate association between it and the disputed domain name.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent intentionally registered the disputed domain name and uses it to resolve to a web page of click-through advertising links to products that directly compete with those of the Complainant. The Respondent did so with the goal of misleading Internet viewers into believing that its own website is sponsored or endorsed by or affiliated with the Complainant when, in actuality no such relationship exists between the Parties, with the result being that the Respondent, through exploiting inevitable user confusion resulting from its use of the disputed domain name, is diverting web traffic from the Complainant's website to its own for the Respondent's own pecuniary gain. Use of a confusingly similar domain name, as here, to intentionally attract traffic for the purpose of receiving click-through revenue constitutes bad faith under paragraph 4(b)(iv) of the Policy, citing to, *inter alia*, *St. Baldrick's Foundation Inc. v. Wan-Fu China, Ltd.*, WIPO Case No. D2007-0705; *Arizona Board of Regents on behalf of the University of Arizona v. DNS, Admin, Nevis Domains / Gee Whiz Domains Privacy Service*, WIPO Case No. D2008-1543; *Bang & Olufsen a/s v. Unasi Inc.*, WIPO Case No. D2005-0728; *Mudd, (USA) LLC v. Unasi Inc. (MUDD PRODUCTS-COM-DOM)*, WIPO Case No. D2005-0591; and *Microsoft Corporation v. Gioacchino Zerbo*, WIPO Case No. D2005-0644.

**B. Respondent**

(i) Identical or Confusingly Similar

The Respondent does not dispute that the disputed domain name fully incorporates the Complainant's mark TRAVELPRO.

However, the Respondent contends that the Complainant does not hold any exclusive trademark rights in the term "travelpro". In that regard, the Respondent views that term as a composite term consisting of two common dictionary words "travel" and "pro" which are each generic or descriptive and to which the Complainant does not have any exclusive rights. The Respondent opines that these two words can be used "to identify a variety of products and services that are unrelated to the Complainant such as dietary supplements, hairstyling tools, travel tips, travel planning or a variety of other travel products".

Accordingly, the Respondent concludes that, in the absence of having any exclusive trademark rights in the term "travelpro", the Complainant has not met its burden under paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Respondent, contrary to the Complainant's position, asserts that it has rights and legitimate interests in the disputed domain name under paragraph 4(c) of the Policy.

Specifically, the Respondent contends that inasmuch as the disputed domain name is the product of two common dictionary words "travel" and "pro" which convey no rights of exclusivity to the Complainant, then, the Respondent, by virtue of having registered the disputed domain name and having done so on a "first come, first served" basis, has rights or legitimate interests in the disputed domain name.

The Respondent also contends that, in the absence of receiving prior notice of a third-party's rights in a mark, the sale of a domain name containing that mark constitutes a *bona fide* offering of goods or services citing to, *inter alia*, *Micron Technology, Inc. v. Null International Research Center*, WIPO Case No. D2001-0608:

"Respondent replies that its sale of domain names is a *bona fide* business practice in domain name speculation. (...) The Panel agrees with the Respondent that domain name speculation can be a legitimate interest if the Respondent was not aware of Complainant's trademark rights. Here, Complainant has proffered no evidence that Respondent likely was aware of its trademark rights at the time it registered the domain name or otherwise was targeting Complainant or its mark."

and *Audiopoint, Inc. v. eCorp a/k/a Chad Folkening*, WIPO Case No. D2001-0509:

"Indeed, speculation in domain names without any intent to profit from others' trademark rights may itself constitute a *bona fide* activity under paragraph 4(c)(i)".

Further, the Respondent is in the business of reselling domain names, which involves registration of domain names and subsequent offering of those domain names for sale to the public. As such, its act of having registered the disputed domain name, subsequent to the expiration of its prior registration, and then offering the disputed domain name for sale, is itself a *bona fide* offering of a service. Since the Respondent commenced offering the disputed domain name for sale prior to its having received notice from the Complainant of the present dispute, then, at that point, the Respondent acquired rights and legitimate interests in the disputed domain name in accordance with paragraph 4(c)(i) of the Policy.

(iii) Registered and Used in Bad Faith

The Respondent, in sharp contrast to the Complainant's position, asserts that its registration and use of the disputed domain name do not exhibit bad faith under paragraph 4(b) of the Policy, and specifically under any of the conditions set forth in paragraphs 4(b)(i)-4(b)(iv).

As to paragraph 4(b)(i), the Respondent contends that it did not register or acquire the disputed domain name for the primary purpose of selling, renting or otherwise transferring it to the Complainant or its competitor. Rather, the Respondent posted the disputed domain name for sale to the general public on a web page featuring a prominent "for sale" banner (of the type and appearance shown in Annex 4 to the Response). As the disputed domain name is formed of two common dictionary words, then, since no direct proof exists that the Respondent registered or acquired the disputed domain name for purposes of profiting from the Complainant's trademark rights, there can be no finding of bad faith. Thus, the Respondent contends that its actions in registering the disputed domain name do not constitute bad faith under this paragraph of the Policy.

Regarding paragraph 4(b)(ii), the Respondent did not register the disputed domain name to prevent the Complainant from reflecting its mark in a corresponding domain name.

With respect to paragraph 4(b)(iii), as the Complainant and the Respondent do not compete, the Respondent did not register the disputed domain name to disrupt the business of a competitor.

Lastly, regarding paragraph 4(b)(iv), the Respondent did not register the disputed domain name to create any likelihood of confusion with the “Complainant’s business” and even took steps to prevent such confusion from arising. Specifically as to the latter, no confusion will likely result as a consequence of: (a) the presence of hyperlinked text at the top of each page of the Respondent’s “www.itravelpro.com” website informing every Internet visitor that the disputed domain name is for sale – such an offer being inconsistent with the visitor inferring that the Complainant sponsors, affiliates with or endorses the website; and (b) the links to various third-party websites which serve to reinforce in those visitors’ minds that an entity other than the Complainant owns the disputed domain name as it would be illogical – rather than confusing – for the Complainant to “provide unrelated links away from itself”.

## **6. Discussion and Findings**

### **A. Trademark validity**

The Respondent now raises issues of trademark validity by virtue of claiming that the term “travelpro” is not susceptible of registration as a federal trademark/service mark because the term consists of two separate common dictionary term terms, namely “travel” and “pro”, each of which is either generic or descriptive.

Such issues are not within the purview of any UDRP proceeding and thus lie outside the very limited and focused jurisdiction afforded to ICANN UDRP panels under the Policy. Consequently, such UDRP panels must, of necessity, accord significant deference to decisions of the government body, namely the USPTO, which, in the first instance not only possesses the requisite expertise to assess such issues but also the federal statutory mandate to do so and, in exercise of that mandate, has done so. A UDRP panel simply has no authority to evaluate and review the judgment of the USPTO on such issues. Hence, once the USPTO has made a determination that a mark is registrable, as it has here by issuing a registration to the Complainant for its mark TRAVELPRO, a UDRP panel is not empowered to nor should it disturb that determination.

Furthermore, and apart from a lack of jurisdiction, the summary and rather abbreviated nature of UDRP proceedings totally renders ICANN UDRP panels grossly ill-equipped to conduct extensive fact-finding inquiries which underlie the establishment of a fully developed record that typically underlies the proper determination of trademark validity.

To the extent the Respondent wishes to challenge the USPTO’s determination of the registrability of any of the Complainant’s TRAVELPRO marks, the Respondent is constrained to do so through suitable administrative and/or judicial avenues provided under United States law and procedure that may be available to it, such as by filing an action in the USPTO to oppose or cancel, as appropriate, that particular federal registration or alternatively institute federal litigation against the Complainant in a federal court of proper jurisdiction. Absent the Respondent having done so and attained a final ruling that any of the Complainant’s federally registered TRAVELPRO Marks is not susceptible of registration, this Panel will simply defer, as it must, to the USPTO’s determination implicit in its having granted a registration, *i.e.*, that each of those marks qualifies for federal trademark protection and enjoys all the rights, including exclusivity, afforded thereby. See, *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 and *Sound Unseen, Ltd.; Apple Bottoms, LLC; and Cornell Haynes p/k/a “Nelly” v. Patrick Vanderhorst*, WIPO Case No. D2005-0636.

Consequently, all arguments put forth by the Respondent questioning the validity of any of the Complainant’s TRAVELPRO Marks are rejected.

### **B. Identical or Confusingly Similar**

Given the Complainant’s existing federal registrations for its TRAVELPRO Marks, the Panel finds that the disputed domain name is confusingly similar to these marks.

From a simple comparison of the disputed domain name to the Complainant's mark TRAVELPRO, no doubt exists that the disputed domain name is confusingly similar to it. The disputed domain name consists of the addition of the single letter "i" prepended to the mark and to which the generic Top-Level Domain ("gTLD") ".com" has been appended, with the addition of the gTLD being irrelevant in this case in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It is now very well established through previous UDRP decisions, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that domain name to avoid user confusion. Here, the Respondent's addition of the letter "i" to the Complainant's mark TRAVELPRO clearly results in such a minor variation. See, e.g., *Virgin Enterprises Limited v. Juan Montes*, WIPO Case No. D2016-0679; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; and *National Association of Professional Baseball Leagues, Inc. d/b/a Minor League Baseball v. John Zuccarini*, WIPO Case No. D2002-1011.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's TRAVELPRO Marks. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

### **C. Rights or Legitimate Interests**

Based on the evidence of record here and contrary to the Respondent's position, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

As discussed above, the Complainant's federal registration of its mark TRAVELPRO is not susceptible to a validity challenge before this Panel, and thus, at least for purposes of this proceeding, the Complainant consequently enjoys federal rights of exclusivity in the mark. The Respondent argues that, solely because the disputed domain name (which incorporates the mark TRAVELPRO in its entirety) can be deconstructed into two constituent commonly used dictionary terms, namely "travel" and "pro", neither one of which has any trademark exclusivity, it has rights or legitimate interests in the disputed domain name. Given the Complainant's exclusive trademark rights in the composite term, "travelpro", the Respondent's argument is

completely misplaced

The Respondent further asserts that it has rights or legitimate interests in the disputed domain name because descriptive and common dictionary terms may be legitimately registered on a first come first served basis. The Respondent claims that the Complainant does not have exclusive rights to the words “travel” and “pro” as the two words are generic and descriptive. UDRP panels have long recognized that mere registration of a domain name, even one comprised of a dictionary word or phrase may not itself confer rights or legitimate interests in the domain name. Typically, the domain name would need to be genuinely used in connection with the relied-upon meaning and not trade off third-party rights. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”), paragraph 2.2.

The Respondent also argues that inasmuch as its business is to register and resell domain names, then its acts here of registering the disputed domain name and then offering it for sale constitute, in and of themselves, a *bona fide* offering of a service for purposes of establishing its legitimate rights or interests under paragraph 4(c)(i) of the Policy. As the Respondent registered the disputed domain name and commenced offering it for sale prior to receiving notice of this dispute, then, by so doing, it established legitimate rights and interests in the disputed domain name. This argument is misguided.

If the Respondent’s argument were accepted by this Panel, then the protection inherent in paragraph 4(c)(i) against bad faith use of a domain name would be easily circumvented and eviscerated. Any entity which claims, as its line of business (whether a sole line or one out of several), that it registers and sells domain names could simply point to its acts of merely registering a domain name, that either identically incorporates a third-party mark or is confusingly similar to such a mark, and then offering it for sale, before it received any notice of an objection from the legitimate rights’ holder, as collectively constituting a *bona fide* offering, regardless of any other use which that entity made of the domain name and any ensuing injury to that rights holder. To prevent such a result, the acts of a respondent, as here, must be viewed in their totality and not deconstructed into separate acts (uses) with each one analyzed in isolation under the Policy in the hope that one of them will satisfy paragraph 4(c)(i) and legitimize that respondent’s claim to the domain name.

Under the facts of record, the Respondent did more than simply register and offer the disputed domain name for sale. It went further. It used the disputed domain name as an address of its website which hosted third-party links that offers to sell goods that directly compete with those of the Complainant and through which the Respondent earned click-through revenue. While the Respondent claims that it did not populate the parking page with third-party links but rather search engine algorithms did, nevertheless, under principles of agency, the Respondent is responsible and fully culpable for content appearing on its website, to which the disputed domain name resolved, regardless of the ultimate source or placement of that content. Moreover, it simply defies reasonable credence to believe that the Respondent had no prior knowledge of the Complainant’s mark TRAVELPRO when the Respondent selected and subsequently registered the disputed domain name upon the prior expiration of the registration of that domain name – in light of the near identical nature of the disputed domain name to the Complainant’s mark, and then, without its knowledge, posted a parking page of third-party links that just happened to be to websites of suppliers which furnished goods directly competitive with those of the Complainant.

The Panel views the Respondent’s conduct not as two separate, isolated uses one of which may satisfy paragraph 4(c)(i), but rather as one collective over-arching use manifesting a single intention: selecting and registering a domain name that exploits likely confusion of Internet users and causes ensuing diversion of web traffic ultimately for the Respondent’s own pecuniary benefit and the Complainant’s detriment. Such a use is not a *bona fide* offering of goods and services under paragraph 4(c)(i).

Further, the record before the Panel is simply devoid of any evidence which proves that the Respondent actually acquired any recognition in the marketplace to become commonly known by the disputed domain name or a name similar to it. Given the exclusive trademark rights that reside in the Complainant and the reputation and recognition now inherent in its TRAVELPRO marks both through registration and prior use, the Respondent could not legitimately acquire any public association between itself and the Complainant’s marks or even any mark similar thereto, at least for the goods provided by the Complainant under its marks.



This is so in light of the Complainant's exclusive trademark rights which predate by some 28 years, the date, January 13, 2016, when the Respondent registered the disputed domain name. See, e.g., *Federation Francaise de Tennis (FFT) v. Whoisguard Protected, Whoisguard, Inc. / Sampath Reddy Case* No. D2016-0864; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; and *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787. As such, the Respondent could not likely become commonly known by the disputed domain name or any of the Complainant's marks for any of the goods which are either identical or sufficiently similar to those listed on the Complainant's trademark registrations or with which the Complainant uses its marks without interfering with the exclusive trademark rights of the Complainant. Hence, the Respondent's actions with regard to the disputed domain name do not fall within paragraph 4(c)(ii) of the Policy.

Lastly, the Panel finds that the Respondent's use of the disputed domain name clearly does not constitute either legitimate noncommercial or fair use under paragraph 4(c)(iii) of the Policy.

As such, based on the evidence presently before the Panel, the Respondent's actions do not fall within any of paragraphs 4(c)(i)-(iii) of the Policy. Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

#### **D. 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.

Contrary to the Respondent's implicit view, the bad faith factors listed in paragraph 4(b) of the Policy are not exhaustive to those illustratively delineated in paragraphs 4(b)(i)-(iv). In that regard, paragraph 4(b) states "the following circumstances, in particular *but without limitation*" (emphasis added). As such, Panel is not constrained to assess the Respondent's conduct for purposes of determining bad faith solely against the four examples set forth in paragraphs 4(b)(i)-4(b)(iv), but can focus on any conduct which, under the specific factual circumstances of record, collectively reflect bad faith registration and use.

From the totality of the circumstances, it is clear to this Panel that the Respondent was well aware of the Complainant, its reputation and its mark TRAEPRO when the Respondent registered the disputed domain name. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally chose and registered the disputed domain name containing the element "travelpro" for its potential to cause confusion with the Complainant's marks. Relying on that confusion, the Respondent used the disputed domain name to direct Internet users to its own website that contained a page of links to third parties which offered goods directly competitive with those provided by the Complainant under its mark TRAEPRO and through which the Respondent derived click-through revenue. Thus, the Respondent, through the confusion it intentionally caused, economically benefited from its unauthorized use of the Complainant's marks and their reputation to the Complainant's detriment.

Given the complete inclusion of the Complainant's mark into the disputed domain name coupled with the near identity of the disputed domain name to the mark and the Complainant's exclusive rights in its mark TRAEPRO, it stands to reason that the only likely legitimate purchaser and user of the disputed domain name – certainly in conjunction with an offer of goods either identical to those offered by or sufficiently similar to those offered by the Complainant – which avoids likely source confusion, would most likely be the Complainant itself. Therefore, even though the Respondent recently took down the parking page of third-party links from its website at "www.itravelpro.com", the Respondent could, at some point in the future if appropriate redress is not now accorded to the Complainant, once again exploit user confusion for its own pecuniary gain. For example, the Respondent, being incentivized by the prospect of receiving further click-

through revenue, could just re-post the page to its website such that the site would once again display a page of monetized third-party links to products competing with those of the Complainant. Alternatively, the Respondent could attempt to sell the disputed domain name either to the Complainant for a profit or to a party unrelated to the Complainant which, in turn, may use the disputed domain name to cause and exploit user confusion between the disputed domain name and the Complainant's mark TRAVELPRO or itself attempt to sell the disputed domain name to the Complainant at a profit.

Further, the steps which the Respondent has taken and points to as eliminating likely confusion, to wit inclusion of hyperlinked text on its parking page indicating to all visitors that the disputed domain name is for sale and inclusion of third-party links on that page, are simply insufficient, to this Panel, to negate inevitable user confusion. Confusion occurs, in the context of initial interest, prior to the time when the user reaches the page, as the user is likely to believe just from the disputed domain name itself that a relationship, whether by way of an affiliation, sponsorship or other connection, exists between the Complainant and the disputed domain name when in fact it does not. The Panel does not share the Respondent's implicit but unrealistic belief that all Internet users will spend appropriate time and effort to adequately scrutinize the page with the necessary degree of care sufficient to recognize that the disputed domain name and the Complainant are unrelated.

Hence, the Panel concludes, based on all the facts of record, that the Respondent's registration and use of the disputed domain name fall within the general bad faith provision of paragraphs 4(a)(iii) and 4(b) of the Policy, as well as the illustrative factor set forth in paragraph 4(b)(iv).

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 <itavelpro.com> is to be transferred to the Complainant.

**Peter L. Michaelson**  
Sole Panelist  
Date: August 3, 2016