

ADMINISTRATIVE PANEL DECISION

Jetgo Australia Holdings Pty Limited v. Name Administration Inc. (BVI)
Case No. D2013-1339

1. The Parties

The Complainant is Jetgo Australia Holdings Pty Limited of Queensland, Australia, represented by Sparke Helmore Lawyers, Australia.

The Respondent is Name Administration Inc. (BVI) of Grand Cayman, Cayman Islands, Overseas Territory of the United Kingdom of Great Britain and Northern Ireland, represented by John Berryhill, Ph.d. esq., United States of America.

2. The Domain Name and Registrar

The disputed domain name <jetgo.com> is registered with iRegistry Corp. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 25, 2013. On July 25, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 25, 2013, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced August 1, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response August 21, 2013. The Response was filed with the Center August 2, 2013.

On August 20, 2013, the Complainant submitted an unsolicited supplemental filing in reply to the Response. On September 10, 2013, the Respondent submitted an unsolicited supplemental filing in reply to the Complainant's unsolicited supplemental filing.

The Center appointed Andrew F. Christie, Alan L. Limbury and M. Scott Donahey as panelists in this matter on August 23, 2013. The Panel finds that it was properly constituted. Each member of 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

On January 25, 2010, Jason Ryder, the Director of the Complainant incorporated a company in Queensland, Australia, named J & JC Ryder Investments Pty Ltd. On August 3, 2011, J & JC Ryder Investments Pty Ltd changed its name to Jetgo Australia Holdings Pty Ltd, the current name of the Complainant. In May 2012, the Complainant was granted an air operator's certificate from the Civil Aviation Safety Authority and launched its charter airline business in Australia using the name "Jetgo". On April 10, 2013, the Complainant registered the domain name <jetgoaustralia.com.au>, which currently resolves to a website used to market and sell its charter airline services.

The Complainant filed Australian trademark applications to register the trademark JETGO (word only) on July 10, 2013, and July 17, 2013, and the trademark JETGO (word and image) on July 17, 2013, in classes 12, 35 and 39. These applications were accepted for registration on August 1, 2013 and August 14, 2013.¹

The Respondent is a company in the field of search advertising, holding a large portfolio of domain names, many of which comprise dictionary words and phrases. The disputed domain name was registered on July 24, 2010. It currently resolves to a generic website providing a search function and links to other websites, the majority of which are concerned with air travel.

Between January 6, 2013 and July 11, 2013, various communications occurred between the Complainant and a representative of the Respondent regarding possible purchase of the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant contends that from about August 2011 to May 2012 it "took steps to launch its airline charter operation service in Australia, including preparation for market under the "Jetgo" name and brand, and that from August 2011 to the date of filing the Complaint it has expended a substantial amount of money in marketing its JETGO business and thereby has acquired an unregistered trademark right in the trademark JETGO.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name because there is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services, and the Respondent has not been commonly known by the disputed domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith because the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of the trademark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the disputed domain name. By an email dated July 16, 2013, a representative of the Respondent

¹ The Panel visited IP Australia's trademark online database in order to determine the status of the Complainant's trademark applications.

offered to sell or transfer the disputed domain name to the Complainant for a down payment of USD 7,750 and 24 monthly payments of USD 1,937 – a sum of USD 54,238.

B. Respondent

The Respondent contends that: (i) all of the Complainant's claims relating to a trademark or service mark are dated well after the Complainant's 2011 name change; (ii) demonstration of a trademark or service mark is a standing requirement of the Policy, and also a standing requirement of trademark misuse; and (iii) the Complainant alleges evidence of a trademark or service mark which is wholly irrelevant to the resolution of this claim under the Policy, in view of the Respondent's senior status in the trademark or service mark.

The Respondent contends that: (i) the Complainant has provided neither evidence nor argument in relation to its claim that the Respondent lacks legitimate rights or interests; (ii) the Respondent acquired the disputed domain name in July 2010 and is thus the senior party in this dispute, and the Complainant's evidence demonstrates the Respondent's senior status and right of priority; (iii) the disputed domain name consists of the common words "jet" and "go" and has been used since registration by the Respondent to advertise subjects prominently including things relating to going places on jets; and (iv) the Respondent is in business to maximize its revenue return from paid search links on the primary meanings of words and phrases, and it would be foolish not to use a domain name containing the words "jet" and "go" to advertise travel offerings.

The Respondent contends that: (i) at the time that the Respondent acquired the disputed domain name in July 2010 the Complainant was called J & JC Ryder Investments Pty Ltd, and it was not until a year later that it changed its name to a term which the Complainant could not have failed to know was already registered to another in ".com"; (ii) notwithstanding the Respondent's adoption and use of the disputed domain name since 2010, the Complainant deliberately selected and used the name "Jetgo", and now claims that this decision of the Complainant is somehow the fault of the Respondent; (iii) the Complainant claims that the disputed domain name was registered in July 2010 primarily for the purpose of selling it to the Complainant, who admits not even having begun preparation to use JETGO as a trademark or service mark until 2011, and who has not provided any evidence of actually possessing trademark or service marks until much later than that; and (iv) the Complainant makes no attempt to explain how a domain name registered in 2010 and then paid through to 2016 can possibly have been registered for the purpose of selling it to the Complainant who did not have a relevant trademark in 2010.

The Respondent contends that the Complainant engaged in "active misbehavior" in framing the Complaint and deliberately omitted material evidence from the Complaint. The Respondent provides copies of correspondence between a person identifying himself as "Jason" and, later, "Jason Ryder" on the one hand, and the Respondent and, later, the Respondent's broker and, later still, the Respondent's legal representative on the other hand, commencing on January 6, 2013 and concluding on August 1, 2013. This correspondence details the Complainant's offers to purchase the disputed domain name for various sums of money, beginning with USD 500 and ending with agreeing to pay USD 31,000. In the correspondence, the Complainant does not mention any claim of trademark or service mark rights that would entitle it to the disputed domain name. The Respondent contends that the Complainant brought this proceeding in the full knowledge of the Respondent's senior status, did not address that fact at all, and deliberately concealed material evidence relating to its claim of bad faith, and that this proceeding constitutes Reverse Domain Name Hijacking, being a misuse of the Policy after failed price negotiation.

6. Supplemental Filings by Complainant and Respondent

The Panel declines to admit into the case record the unsolicited supplemental filings of the Complainant and the Respondent. With one exception that is of no substance to the determination of the case, there was nothing in the Complainant's supplemental filing that could not have been included in its Complaint (such as, e.g., because it relates to material that could not reasonably have been expected to be contained in the Response). Because the Complainant's unsolicited supplemental submission is not admitted into the case

record, there is no reason for the Panel to admit the Respondent's unsolicited supplemental submission into the case record.

7. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name comprises the phrase "jetgo" and the Top Level Domain ("TLD") ".com". In this case, ".com" operates simply as a TLD identifier, and so it can be ignored for the purpose of determining if the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. When the TLD identifier is ignored, the disputed domain name consists of the phrase "jetgo", which is identical to: (i) the JETGO (word) trademark and the word component of the JETGO (word and image) trademark that are the subject of the Complainant's accepted Australian trademark applications; and (ii) the JETGO trademark in which the Complainant claims to have an unregistered trademark right.

The two questions that arise are: (i) whether an accepted Australian trademark application that has not yet proceeded to grant at the time the Complaint is filed gives rise to "a trademark in which the Complainant has rights" for the purposes of the Policy; and (ii) whether the Complainant has established that it has an unregistered trademark right in the trademark JETGO. In relation to the first question, the Panel is inclined to the view that an accepted trademark application that has not yet proceeded to grant does not give rise to trademark rights for the purposes of the Policy, for the reasons given in the case *Fashiontv.com GmbH v. Mr. Chris Olic*, WIPO Case No. D2005-0994, and in the various subsequent decisions under the Policy that have followed this approach. In relation to the second question, the Panel is inclined to the view that the evidence currently in the case record does not establish that the Complainant has an unregistered trademark right in the trademark JETGO. The Panel does not find it necessary to reach a concluded view on either of these matters, however, because of its finding that the Complainant has failed to satisfy the requirement of paragraph 4(a)(iii) of the Policy, discussed below.

B. Rights or Legitimate Interests

Because of this Panel's finding that the Complainant has failed to satisfy the requirement of paragraph 4(a)(iii) of the Policy, discussed below, it is not necessary for the Panel to consider if the Complainant has satisfied the requirement of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant provided no evidence that shows the Respondent has engaged in any activity of the type specified in paragraph 4(b) of the Policy or that otherwise demonstrates registration and use of the disputed domain name in bad faith. The fact that the Respondent registered the disputed domain name prior to the Complainant's use of its trademark, and prior to the Complainant's acquisition of trademark rights (registered or unregistered) in its trademark, makes it clear that the Respondent did not seek to take advantage of the goodwill in the Complainant's trademark when the Respondent registered the disputed domain name. Furthermore, there is nothing in the use to which the Respondent has put the disputed domain name since registration of it to indicate that the Respondent has sought to take advantage of the goodwill in the Complainant's trademark. In particular, the Respondent's offer to sell the disputed domain name to the Complainant for a substantial sum, in the situation where the offer was a result of unsolicited and persistent approaches from the Complainant offering to buy the domain name, does not evidence registration and use of the disputed domain name in bad faith.

Accordingly, the Panel finds that the Complainant has not established that the disputed domain name has been registered and is being used in bad faith.

D. Abuse of Administrative Proceeding

Paragraph 15(e) of the Rules provides that, if “after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”.

The Panel considers that the Complaint filed in this case was brought in bad faith, and constitutes an abuse of the administrative proceeding, on the basis that it is seriously misleading. In particular, the Complaint fails to set out fully facts that were fundamental to the Complainant’s case and of which the Complainant had knowledge – namely, the Complainant’s unsolicited initiation and renewal of communications with the Respondent regarding possible purchase of the disputed domain name. By failing to state these facts, the Complaint makes an implied assertion that is false – namely, that the Respondent’s offer to sell the disputed domain name to the Complainant for a substantial sum was unsolicited by the Complainant. This false assertion might have misled the Panel had not the Respondent provided the evidence, readily available to the Complainant, that refuted this implied assertion. To knowingly make a false implied assertion on a material issue is evidence that the Complaint was brought in bad faith. Furthermore, it is simply not fair to require the Respondent to provide evidence establishing that the Complainant’s case on a material issue is without basis when the Complainant must have known this fact.

Having regard to all the circumstances of the filing of this Complaint, the Panel is of the view that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding that is provided by the Policy.

8. Decision

For the foregoing reasons, the Complaint is denied.

Andrew F. Christie
Presiding Panelist

Alan L. Limbury
Panelist

M. Scott Donahey
Panelist

Date: September 17, 2013