

ADMINISTRATIVE PANEL DECISION

Mastercard International Incorporated v. PlayRage
Case Nos. D2011-2309 and D2011-2310 (Consolidated)

1. The Parties

The Complainant is Mastercard International Incorporated, of Purchase, New York, United States of America, represented by Partridge IP Law P.C., United States of America.

The Respondent is PlayRage, of Monrovia, California, United States of America, represented by John Berryhill, Ph.D., Esq., United States of America.

2. The Domain Names and Registrar

The disputed domain names <pricelesslondon.com>, <pricelessparis.com>, <pricelessnewyork.com>, <pricelesslosangeles.com> and <pricelessmexico.com> are registered with GoDaddy.com, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 29, 2011. On January 3, 2012, the Center transmitted by email to GoDaddy.com, LLC a request for registrar verification in connection with the disputed domain names. On January 3, 2012, GoDaddy.com, LLC transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on January 4, 2012, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on January 6, 2012. The Center verified that the Complaint together with the amendment to 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 January 9, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response January 29, 2012. The Response was filed with the Center January 30, 2012, requesting consolidation of WIPO Case No. D2011-2309, which concerns the disputed domain names <pricelesslondon.com> and <pricelessparis.com>, with WIPO Case No. D2011-2310, which concerns the disputed domain names <pricelesslosangeles.com>, <pricelessmexico.com>, and

<pricelessnewyork.com>. The Parties in both cases are identical.

The Complainant on February 21, 2012, forwarded to the Center an unsolicited supplemental submission (the "Complainant's Reply") for filing in both WIPO Case No. D2011-2309 and WIPO Case No. D2011-2310.

The Center appointed William R. Towns, M. Scott Donahey and Tony Willoughby as panelists in WIPO Case No. D2011-2309 on March 5, 2012. 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.

The Panel issued an Administrative Panel Procedural Order on March 6, 2012, consolidating the proceedings in WIPO Case No. D2011-2309 and WIPO Case No. D2011-2310. The Panel also accepted for filing the Complainant's Reply and invited the Respondent to submit a reply thereto no later than March 13, 2012. The Respondent submitted its reply (the "Respondent's Surreply") to Administrative Panel Procedural Order No. 1 on March 13, 2012.¹

4. Factual Background

The Complainant is a leading provider of payment cards services, including MASTERCARD credit cards and debit cards. In 1997, the Complainant launched what became a long-running marketing campaign featuring the tagline "Priceless". The Complainant's "Priceless" advertisements now have run in more than 100 countries.

The Complainant has obtained trademark registrations for PRICELESS, PRICELESS.COM, and other PRICELESS-formative designations in the United States of America ("U.S.") and in other countries around the world. The Complainant's first U.S. registration for PRICELESS was issued by the United States Patent and Trademark Office (USPTO) on July 25, 2000, for "financial services, namely, providing credit card, debit card and transaction authorization and settlement services". In 2009, the Complainant secured U.S. trademark registrations for PRICELESS.COM for promoting the goods and services of others in connection with the use of credit cards and debit cards.²

In the summer and early fall of 2011, the Complainant launched its "Priceless Cities" campaign, featuring promotions and exclusive card member offers, first in New York and then London. A spokesperson for the Complainant described the advertising campaign as follows: "MasterCard is evolving from a brand that celebrates Priceless moments to one that enables Priceless experiences, thereby bringing additional benefits to choosing to use MasterCard and building further emotional engagement with consumers." The Complainant filed an application with the USPTO to register PRICELESS for use with travel information and services on October 14, 2011.

The Respondent registered the disputed domain names <pricelesslondon.com> and <pricelessparis.com> on September 23, 2009, and registered the disputed domain names <pricelesslosangeles.com>, <pricelessmexico.com>, and <pricelessnewyork.com> on May 3, 2010. The disputed domain names are parked at websites populated with automatically generated advertising links, the majority of which appear related to travel, entertainment, or the "destinations" reflected in the disputed domain names.

¹ The Respondent's reply is entitled "Response to Procedural Order No. I", but for convenience the Panel will refer to this as the "Respondent's Surreply".

² The Complainant's PRICELESS.COM registrations (word and word plus design) claim the following services in International Class 35: "Promoting the goods and services of others by means of coupons, discounts, advertisements, rewards and incentives generated in connection with the use of credit and debit cards, electronic links to merchant and retailer web sites, and through promotional contests."

5. Parties' Contentions

A. Complainant

The Complaint

The Complainant represents that it is a leading global payment solutions company, and has provided payment card services since 1966. The Complainant states that it manages a family of famous and widely accepted payment cards under the brands Mastercard, Maestro and Cirrus, and serves financial institutions, consumers and businesses in over 210 countries and territories. The Complainant has operated under the MASTERCARD name and mark since 1980.

The Complainant further represents that it has promoted its services since 1997 using the highly successful and award winning "Priceless" advertising campaign, which has run in 105 countries in 48 languages. According to the Complainant, the "Priceless" advertisements, and the slogans and format used therein, have become exclusively associated with the Complainant.

The Complainant asserts trademark rights in PRICELESS in the United States and 66 countries worldwide in connection with its financial services and related goods and services. A list of the Complainant's U.S. registrations for PRICELESS, PRICELESS.COM, and other PRICELESS-formative marks is attached as an annex to the Complainant. The Complainant notes that it has also registered numerous domain names incorporating the PRICELESS mark, the first of which, <priceless.com>, was registered on November 3, 1997.

The Complainant contends that the PRICELESS mark symbolizes an enormous amount of goodwill, and is a famous and highly recognized mark worldwide. The Complainant also asserts that the PRICELESS mark and variants thereof have become exclusively associated with the "high quality financial services and related goods and services" offered by the Complainant.

The Complaint submits that the disputed domain names are confusingly similar to the PRICELESS mark because the domain names incorporate the Complainant's mark in its entirety. The Complainant argues that the mere addition of geographically descriptive terms does not negate the confusing similarity between the Complainant's PRICELESS and PRICELESS.COM marks and the disputed domain names.

The Complainant maintains that the Respondent has no rights or legitimate interests in the disputed domain names. The Complainant asserts that the Respondent is not related to or affiliated with the Complainant, and is not licensed or authorized to use the Complainant's PRICELESS or PRICELESS.COM marks. Further, the Complainant argues that the Respondent is not generally known by the disputed domain names, and has not acquired trademark, or service mark, rights in the disputed domain names or any other corresponding mark.

The Complainant also maintains that the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services, but instead is using the disputed domain names to provide links to external websites that offer goods and services of the Complainant's competitors. The Complainant argues that the Respondent registered and is using the disputed domain names to unlawfully divert and siphon off visitors seeking the Complainant's "www.priceless.com" website. Such use, according the Complainant, is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names under the Policy.

The Complainant submits that the Respondent registered and is using the disputed domain names in bad faith to intentionally attract for commercial gain Internet users to the Respondent's websites based on a likelihood of confusion with the Complainant's PRICELESS and PRICELESS.COM marks. The Complainant observes that the Respondent acquired and began using the disputed domain names long after the Complainant established rights in its PRICELESS and PRICELESS.COM marks through use and registration.

According to the Complainant, the widespread use and fame of the Complainant's PRICELESS and PRICELESS.COM marks and the Complainant's prior registration of its trademarks and domain names admits of no conclusion but that the Respondent had actual knowledge of the Complainant's marks when registering the disputed domain names. At a minimum, the Complainant asserts that the Respondent under U.S. law is charged with constructive notice of the Complainant's prior registered marks.

The Complainant argues that there is no plausible reason for the Respondent's selection of the disputed domain names other than a deliberate attempt to profit unfairly from the confusion with the Complainant's PRICELESS and PRICELESS.COM marks. Moreover, the Complainant asserts that the Respondent's websites provide links to third-party websites offering services directly competing with the Complainant's services, from which the Respondent is generating pay per click advertising revenues. The Complainant submits that the Respondent's use of the Complainant's marks to generate such revenue constitutes bad faith under the Policy.

The Complainant's Reply

The Complainant notes the Respondent's acknowledgement that the Complainant is well known for its "Priceless" advertisements, and given this, asserts that the Respondent's proposed use of the disputed domain names with travel advertising would be deemed an infringement of the Complainant's rights. Accordingly, the Complainant submits that the disputed domain names were registered in bad faith.

The Complainant contends that the Respondent is improperly attempting to limit the goods and services for which its PRICELESS and PRICELESS-formative marks are registered and used to "financial services". The Complainant submits evidence that it has U.S. registrations for seven PRICELESS-formative marks covering advertising, marketing, and other promotion. These include the registrations for the PRICELESS.COM mark referred to in the Complaint. The Complainant submits that it has protectable rights and legitimate interests in advertising, which the Complainant asserts is the subject matter for which the disputed domain names have been registered and used.

The Complainant also asserts that its PRICELESS mark is famous in connection with financial services, which the Complainant submits is significant in view of U.S. court decisions holding that financial and travel and entertainment products and services are complementary and thus related. The Complainant argues that travel services are in the zone of natural expansion for the Complainant's PRICELESS mark, citing U.S. court decisions defining the zone of natural expansion as a situation in which the public would expect the owner of a famous mark to compete. In support of this, the Complainant submits that: (1) the Complainant has offered travel-related services for decades; (2) several of the Complainant's major competitors (e.g., American Express, Visa, and Discover) have expanded their businesses to include travel related services; and (3) the Complainant has used PRICELESS in connection with travel offers for its card holders since as early as 2008.

For the foregoing reasons, the Complainant submits that the Respondent's registration and use of the disputed domain names for pay-per-click advertising and the proposed use for travel advertising and arrangements is in violation of the UDRP.

B. Respondent

The Response

The Respondent maintains that the disputed domain names were registered in good faith for the purposes of advertising and selling travel offers specifically targeted to a particular destination. The Respondent acknowledges that the disputed domain names thus far have been parked, but asserts that the Complainant has admitted that the advertising links are travel related. The Respondent further acknowledges that the Complainant is known for its "Priceless" ad campaign, but submits that such advertisements, no matter how well known, concern only the Complainant's credit services, and not travel services.

It is the Respondent's position that the instant disputes arise from a rebranding effort of the Complainant that began well after the Respondent's registration of the disputed domain names. The Respondent submits that the Complainant does not have prior trademark rights in PRICELESS for travel services based on use, and that the Complainant's more recent attempt to register PRICELESS for use with travel services in the U.S. has been refused by the USPTO based on likelihood of confusion with a prior third-party registration for PRICELESS RENT-A-CAR. The Respondent also asserts that the word "Priceless" appears in a variety of other compound marks registered in connection with travel agency services.³

In addressing the first element of the Policy, the Respondent addresses the scope of the Complainant's rights, a topic which the Response acknowledges has primary impact with regard to the second and third elements of the Policy. The Respondent submits that the Complainant has demonstrated trademark rights in PRICELESS only in relation to financial services, namely credit cards. The Respondent observes that the disputed domain names are comprised of the word "priceless" in combination with names of "popular tourist destinations", which the Respondent asserts are not geographically descriptive in connection with credit card services. Thus, the Respondent maintains that the disputed domain names, as a whole, are not descriptive of the Complainant's financial services and that consumers would not be led to believe that the disputed domain names were related to the Complainant's financial services.

The Respondent argues that the Complainant's position regarding its rights in PRICELESS for financial services, if accepted, would confer a monopoly in the common word "priceless" conjoined with any other term. According to the Respondent, the Complainant has been less than forthcoming about the status of its claim that the PRICELESS mark has been used with travel services. The Respondent points to a U.S. trademark application for PRICELESS filed by the Complainant for travel information and services on October 14, 2011, long after the registration of the disputed domain names. The Respondent asserts that this application represents the first effort by the Complainant to extend its rights in the PRICELESS mark to travel services.⁴ The Respondent notes that the USPTO has refused registration of the Complainant's PRICELESS mark for travel information and services on a likelihood of confusion bases in light of a prior registration of PRICELESS RENT-A-CAR for "automobile rental and leasing services", registered on January 23, 2001, by Priceless Rent-A-Car LLC.⁵

The Respondent also takes issue with the Complainant's assertion that the PRICELESS and PRICELESS.COM marks are entitled to famous mark status. The Respondent argues that while one may purchase "all sorts of things" with a credit card, the owner of a trademark for financial services may not *ipso facto* extend its rights in the mark to whatever might be purchased by card holders using its services. The Respondent further views the USPTO's refusal to register the Complainant's PRICELESS mark for travel services, in conjunction with a variety of registered marks for travel-related services including the word "priceless", renders the Complainant's assertion of famous mark status unsustainable.

The Respondent asserts that the Complainant has failed to meet its burden under the second element of the Policy to establish that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent's view regarding the limited scope of the Complainant's rights in the PRICELESS mark, as summarized above, is a predicate for this assertion.

³ In addition to PRICELESS RENT-A-CAR the Respondent offers a second example: CREATING PRICELESS MEMORIES TO LAST A LIFETIME, registered on the USPTO's principal registry on April 6, 2010.

⁴ The Panel finds that here the Response incorrectly characterizes the Complainant's pending trademark application as having been filed on an intent-to-use basis. This error was pointed out in the Complainant's Reply, and the Respondent offered a *mea culpa* in its Surreply. The Panel notes, however, that the date of first use in the Complainant's pending trademark application is May 24, 2011, more than one year after the last date on which any of the disputed domain names was registered.

⁵ The USPTO's refusal was made in a First Office Action, and therefore does not constitute a final refusal by the USPTO to register the Complainant's mark.

In addition, the Respondent relies largely on the sworn statement of Robert McClinton ("McClinton Declaration"), identified in the Whois information as the administrative contact for the disputed domain names. Mr. McClinton is sole owner of the Respondent, according to the Response. The McClinton Declaration relates that the Respondent was incorporated under Delaware law in 2000, as a vehicle for commercial Internet development of interest-specific websites, including the website developed at "www.playrage.com", focused on computer gaming and related advertising materials.

As related in the McClinton Declaration, Mr. McClinton was hired in 2007 as the Director of Internet Sales by Oversees.net, where he served until April 2011. According to Mr. McClinton, Oversees.net operates a consumer-directed travel booking site at "www.lowfares.com". During his tenure at Oversees.net, Mr. McClinton relates that he became aware of a website at "www.pricelessamsterdam.com", which advertised specific travel opportunities relating to Amsterdam.

Mr. McClinton states that he believed this concept was commercially viable, and that the word "priceless" captured the memories and experiences of travel which are not quantifiable. Thereafter, according to Mr. McClinton, he began to register domain names he believed would be useful for advertising travel opportunities related to specific destinations. Mr. McClinton acknowledges having heard of the Complainant's "PRICELESS" advertisements for credit card services, but he maintains that he had never heard of the Complainant using the term "PRICELESS" with destination specific travel advertisements, and that before receiving notice of this dispute would never have associated the Complainant's use of "PRICELESS" for marketing credit cards "with the broader use of that English word".

As related in the McClinton Declaration, the disputed domain names, since registration, have been parked in connection with advertisements primarily relating to travel offers and material relevant to the destinations. According to the Response, Oversees.net did not indicate an interest in developing destination targeted sites of the type suggested by the disputed domain names, but Mr. McClinton was permitted to retain the domain names for future development, although he was not at liberty to develop the full use of the disputed domain names until his employment with Oversees.net came to an end.

The Respondent disputes the Complainant's contention that the parked websites to which the disputed domain name resolves contain links to third-party websites offering goods or services competitive with those for which the Complainant uses the PRICELESS and PRICELESS.COM marks. The Respondent asserts that the Complainant's rights cannot be automatically extended to anything that one might purchase using the Complainant's credit card, even if the Complainant provides some ancillary purchasing services for things. Accordingly, the Respondent concludes that the Complainant has failed to establish that the Respondent's use of the disputed domain names is in any way illegitimate or infringing upon the Complainant's asserted rights in the PRICELESS and PRICELESS.COM marks.

The Respondent further contends that the Complainant has not established registration and use of the disputed domain names in bad faith. According to the Respondent, the motivation for registering the disputed domain names was not derivative of the Complainant's trademark rights, but rather of the "pricelessamsterdam.com" concept as discussed in the McClinton Declaration. The Respondent maintains it had no knowledge, at the time of the registration of the disputed domain names, of any claim by the Complainant to be using the term "PRICELESS" in connection with travel services. The Respondent asserts that the Complainant cannot credibly maintain any such use of the PRICELESS mark, if at all, prior to the launch of the Complainant's "Priceless Cities" in London in September 2011. According to the Response, it was only then that the Complainant first noticed that numerous domain names in the form of <priceless+destination.com> had long before been registered to other parties, and launched a set of UDRP proceedings.

Respondent's Surreply

The Respondent again submits that registration of the disputed domain names arose from a planned venture in destination marketing, and reiterates its position that the Complainant's interest in bringing these proceedings in relation to the disputed domain names arises from the Complainant's recent promotional

efforts tying the word “priceless” to specific destinations. The Respondent asserts that the argument in the Complainant’s Reply that travel advertising is within the zone of natural expansion for the PRICELESS mark is tantamount to admission by the Complainant that it has yet to establish any rights in PRICELESS for travel related services.

The Respondent notes that the Complainant has not on its own initiative brought to the Panel’s attention the Complainant’s pending U.S. trademark applications for PRICELESS CITIES, PRICELESS NEW YORK, and PRICELESS MIAMI, all of which are for travel information and services, and none of which reflect a first use date prior to May 2011. The Respondent notes that the Complainant’s PRICELESS CITIES application was filed with the USPTO on an intent-to-use basis. The Respondent suggests that the Complainant has been less than candid in omitting to disclose these filings in its submissions, and that the Complainant in its Reply has shifted from the question of bad faith intent to whether a court would find infringement under doctrines that the Respondent submits are well outside the limited scope of the Policy. Accordingly, the Respondent concludes that the Complainant has failed to meet its burden of establishing all three elements of the Policy.

6. Discussion and Findings

A. Scope of the Policy

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. D2002-0774. Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of “the abusive registration of domain names”, also known as “cybersquatting”. *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. D2000-0187. See *Final Report of the WIPO Internet Domain Name Process*, April 30, 1999, paragraphs 169 and 170.

Paragraph 15(a) of the Rules provides that the Panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.

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

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

Cancellation or transfer of the disputed domain name are the sole remedies provided to the Complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a disputed domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in the disputed domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily if not exclusively within the knowledge of the respondent. Thus, the consensus view is that paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of a right or legitimate interest in the disputed domain name, once the complainant has made a *prima facie* showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270.

B. Identical or Confusingly Similar

The Panel finds for purposes of paragraph 4(a)(i) of the Policy that the disputed domain names are confusingly similar to the Complainant's PRICELESS mark, in which the Complainant has demonstrated rights. In considering the question of identity or confusing similarity, the first element of the Policy stands essentially as a standing requirement.⁶ The threshold inquiry under the first element of the Policy is largely framed in terms of whether the trademark and the disputed domain name, when directly compared, are identical or confusingly similar.

There are differing views as to what is meant by "confusingly similar" in this context. In *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662, the panel applied a test which expressly disavowed any call for a likelihood of internet user confusion; by contrast in *Sanofi-Aventis v. Jason Trevenio*, WIPO Case No. D2007-0648, the panel took a diametrically opposed view. The range of views is discussed in *Apple Inc. v. Fred Bergstrom, Lotta Carlsson, Georges Chaloux and Marina Bianchi*, WIPO Case No. D2011-1388.

In this instance, each of the disputed domain names incorporates the Complainant's PRICELESS mark in its entirety, and the Panel finds that the disputed domain names are confusingly similar to the Complainant's mark, whichever test is applied. In the Panel's view, the confusing similarity of the disputed domain names to the Complainant's PRICELESS mark is not overcome merely by the addition of geographically descriptive terms such as "London", "Paris", "New York", "Los Angeles", and "Mexico".

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

As noted above, once the Complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the Respondent to come forward with evidence of rights or legitimate interests in a disputed domain name. The Panel is persuaded from the record of this case that a *prima facie* showing under paragraph 4(a)(ii) has been made. The disputed domain names are confusingly similar to the Complainant's mark. Further, the record reflects that the disputed domain names, since their registration by the Respondent, have been used with parking pages populated with automatically generated advertising links. There is no indication that the Respondent has been commonly known by the disputed domain names, nor indication that the Complainant has authorized the Respondent to use the Complainant's mark.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the disputed domain names by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

⁶ See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.2.

The Respondent appears to assert that it has established rights or legitimate interests in the disputed domain names based on the intent to make a good faith use of the domain names in connection with advertising travel opportunities related to specific destinations. The Respondent's CEO has submitted a sworn statement attesting that this was his intention when registering the disputed domain names, and that the word "priceless" was selected because it suggested memories or experiences of travel which are not quantifiable (*i.e.*, of incalculable value). Thus far, however, the disputed domain names have been used only with pay-per-click parked pages.

Nevertheless, the use of a domain name to generate paid advertising revenues is not *per se* a violation of the Policy. Further, a number of UDRP panels have concluded that a respondent has a right to register and use a domain name to attract Internet traffic based on the appeal of a commonly used descriptive phrase, even where the domain name is confusingly similar to the registered mark of a complainant, at least in circumstances indicating that the respondent was not aware of the complainant's trademark rights or believed in good faith that such use would not violate the complainant's rights. See, e.g., *National Trust for Historic Preservation v. Barry Preston*, WIPO Case No. D2005-0424. Thus, where a respondent registers a domain name consisting of "dictionary" terms because the respondent has a good faith belief that the domain name's value derives from its generic or descriptive qualities, the use of the domain name consistent with such good faith belief may establish a legitimate interest. See *Mobile Communication Service Inc. v. WebReg, RN*, WIPO Case No. D2005-1304; and *Media General Communications, Inc. v. Rarenames, WebReg*, WIPO Case No. D2006-0964.

It is evident to the Panel that the English word "priceless", when used in its commonly understood or dictionary meaning, is descriptive or laudatory in nature. It is this descriptive quality of the word "priceless" that the Respondent maintains is the reason why the disputed domain names have been registered for their proposed use with travel advertising. Indeed, it strikes the Panel that this dictionary word is one that traders in many areas of business would find attractive for marketing their respective goods and services. The Panel notes that the Policy was not intended to permit a party who elects to register or use a common term or terms as a trademark to bar others from using the common term in a domain name, unless it is clear that the use involved is seeking to capitalize on the goodwill created by the trademark owner. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230. See also *National Trust for Historic Preservation v. Barry Preston, supra*.

In view of the Panel's findings under the following heading, it is unnecessary for the Panel to decide the issue regarding the Respondent's rights or legitimate interests under paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant for valuable consideration in excess of respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a

likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding objective of the Policy is, "to curb the abusive registration of domain names in the circumstances where the registrant is seeking to profit from and exploit the trademark of another". *Match.com, LP v. Bill Zag and NWLAWS.ORG, supra*. However, it is paramount that panels decide cases based on the very limited scope of the Policy. *Id.* The Policy provides a remedy only in cases where a complainant proves that the disputed domain name has been registered and is being used in bad faith.

After careful consideration of the totality of facts and circumstances in the record, the Panel concludes that the Complainant has not satisfied its burden of demonstrating that the Respondent registered the disputed domain names in bad faith. As noted in the discussion under the preceding heading, the Respondent maintains that the disputed domain names were registered based on the descriptive quality of the common, dictionary word "priceless" in relation travel related advertising targeted to specific destinations. The Respondent's proffered explanation is plausible. The Complainant's use of PRICELESS in relation to the Complainant's goods and services does not diverge from the word's commonly understood or dictionary meaning. As mentioned earlier, it strikes the Panel that the word "priceless" when used in this sense would seem attractive for use with an array of goods and services.

The foregoing factors are directly relevant to the question of bad faith under paragraph 4(a)(iii) of the Policy. As noted above, the Policy was not intended to permit a party who elects to register or use a common term or terms as a trademark to bar others from using the common term in a domain name, unless it is clear that the use involved is seeking to capitalize on the goodwill created by the trademark owner. See *Match.com, LP v. Bill Zag and NWLAWS.ORG, supra*. See also *National Trust for Historic Preservation v. Barry Preston, supra*.

In view of the foregoing, the Panel is not persuaded that the Respondent's registration of the disputed domain names was motivated by bad faith intent to exploit or profit from the Complainant's trademark rights. There is nothing in the record to indicate that the Respondent was aware or even could have been aware at the time it registered the disputed domain names of the "Priceless Cities" advertising campaign, which was not launched by the Complainant until mid-to-late 2011. There is no evidence in the record to suggest that the Respondent has in the past engaged in a pattern of registering domain names comprised of the trademarks of third parties.

At the time of the registration of the disputed domain names, the Complainant's historic use of the PRICELESS mark appears to have been predominantly in relation to its financial services, namely, credit and debit cards. To the extent of the Complainant's use of the PRICELESS mark in promotion of the goods or services of others, including travel related services, during this time frame, the record reflects that such offers were targeted to the Complainant's card holders, and thus ultimately used to promote the Complainant's payment card services. There is no indication in the record of the Complainant's operation of any travel information or travel arrangement business independent of the promotion of its financial services.

The circumstances of this case as set forth in the record reflect, on balance, a plausible good faith basis for the Respondent's registration of the disputed domain names. The Complainant has not demonstrated to the satisfaction of the Panel that the Respondent's proffered explanation is merely a pretext, or that the Respondent's objective in registering the disputed domain names more likely than not was cybersquatting.

Accordingly, for the reasons summarized above, the Panel finds that the Complainant has failed to satisfy the requirements of paragraph 4(a)(iii) of the Policy.

7. Decision

For all the foregoing reasons, the Complaint is denied.

William R. Towns

Presiding Panelist

M. Scott Donahey

Panelist

Tony Willoughby

Panelist

Dated: March 30, 2012