



NATIONAL ARBITRATION FORUM

DECISION

Hotwire, Inc. v. Paris Willis
Claim Number: FA0606000741912

PARTIES

Complainant is **Hotwire, Inc.** ("Complainant"), represented by **Sanjiv D. Sarwate**, of **Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP**, 311 South Wacker Drive, Suite 5000, Chicago, IL 60606. Respondent is **Paris Willis** ("Respondent"), 279 Ocean St., Pasadena, CA 33596.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**hotwi.com**>, registered with **Enom, Inc.**

PANEL

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

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on June 29, 2006; the National Arbitration Forum received a hard copy of the Complaint on July 3, 2006.

On July 4, 2006, Enom, Inc. confirmed by e-mail to the National Arbitration Forum that the <**hotwi.com**> domain name is registered with Enom, Inc. and that Respondent is the current registrant of the name. Enom, Inc. has verified that Respondent is bound by the Enom, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On July 7, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of July 27, 2006 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@hotwi.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On August 1, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

Hotwire's Trademark/Service Mark Information:

Since at least as early as June 2000, Hotwire has been using the inherently distinctive marks HOTWIRE and HOTWIRE.COM, (collectively "Hotwire Marks") on or in connection with travel agency services provided through Hotwire's website, located at <http://www.hotwire.com>. Through Hotwire's website, customers can reserve airline tickets, hotel accommodations, car rentals, vacation packages, and cruise bookings. ("Hotwire Services").

Hotwire owns numerous valid and subsisting registrations for the Hotwire Marks worldwide, including, but not limited to, United States registrations and European Community Trade Mark registrations.

Factual and Legal Grounds

Hotwire Marks

Long prior to the Respondent's registration of the Infringing Domain Name, Hotwire adopted, and has continuously used since that adoption, the inherently distinctive Hotwire Marks for the Hotwire Services described above, in the United States, European Union, and around the world.

Hotwire has invested substantial sums to advertise and promote the Hotwire Services and the Hotwire Marks in a variety of media. As a result of Hotwire's marketing efforts, substantial sales, and the resulting success of its Hotwire Services, the Hotwire Marks have become famous and represents extraordinarily valuable goodwill owned by Hotwire.

One of the means by which Hotwire promotes its Hotwire Marks is through an affiliate marketing program. Through this program, third parties can obtain a limited license to use the Hotwire Marks on their websites to provide a hyperlink to Hotwire's website. If someone visits the third party site, clicks on the licensed hyperlink, and then reserves travel services through Hotwire, the third party receives a commission.

Paragraph 6.2 of the Hotwire Affiliate Program Terms of Agreement provides that:

Affiliate represents and warrants to Hotwire that except for the limited, personal right to use the Hotwire Marks as set forth herein, it shall not use or display (directly or indirectly), the Hotwire Marks or any trademark, logo, or branding (including, without limitation, any misspelling or substantially similar version thereof) of Hotwire, in any manner whatsoever (including without limitation, in any search engine marketing or optimization, in any domain name, any other online/offline marketing or advertising, press releases, etc.) without first obtaining prior written approval from Hotwire, which may be denied in Hotwire's sole discretion.

Respondent's Registration and Use of the Infringing Domain Name

Respondent is located in Pasadena, California and was previously enrolled in Hotwire's affiliate marketing program. Respondent's participation in that program has been terminated, and she is no longer affiliated or related to Hotwire in any way, nor is Respondent licensed by Hotwire or otherwise authorized to use the Hotwire Marks.

On August 13, 2003, long after the Hotwire Marks became famous, Respondent registered the Infringing Domain Name. That same day, Respondent enrolled in Hotwire's affiliate marketing program.

The Infringing Domain Name presently resolves to a holding page featuring a search engine.

On June 9, 2006, Hotwire sent a letter to Respondent by email and courier advising it of Hotwire's rights in the Hotwire Marks and demanding that the Infringing Domain Names be transferred to Hotwire. A follow up letter was sent on June 19, 2006. The emails sent to Respondent were returned as undeliverable.

The Infringing Domain Name is Confusingly Similar to the Hotwire Marks.

The Infringing Domain Name is confusingly similar to the Hotwire Marks because the Infringing Domain Name is a misspelling of the Hotwire Marks. *America Online, Inc. v. Peppler*, Case No. FA0112000103437 (NAF, Feb. 22, 2002) (stating that, "[i]t has been generally held that the addition of a generic term, number or letter(s) does not diminish the confusing similarity between a disputed domain name and a famous mark... [and that] a

misspelling of a famous mark creates a confusing similarity between a domain name and the mark."); *Neiman Marcus Group, Inc. v. Rukash*, Case No. FA0503000444456 (NAF, April 25, 2005) (holding that addition, replacement, or transposition of letters or general misspelling did not sufficiently distinguish a domain name from a famous mark and thus created a likelihood of confusion).

The Infringing Domain Name is confusingly similar in sound to the Hotwire Marks, also making it likely that Internet users will be confused as to the relationship between Respondent and Hotwire. *America Online, Inc. v. Pebbler*, Case No. FA0112000103437 (NAF, Feb. 22, 2002) (finding that "when a word in a domain name has the same sound as a famous trademark, it can be considered that there is a confusing similarity..." and holding that "mapcrest" was confusingly similar to "mapquest", as well as pointing out that "yawho" was held to be confusingly similar to "yahoo").

The Infringing Domain Name is confusingly similar to the Hotwire Marks as it is a close misspelling, and it is phonetically similar to the Hotwire Marks. Hotwire therefore satisfies ICANN Policy ¶4(a)(i).

Respondent Has No Rights or Legitimate Interests in the Infringing Domain Name

Respondent is not known by the Hotwire Marks and has not acquired any trademark or service mark rights in the Hotwire Marks. *See Gallup v. Amish Country Store*, Case No. FA 96209 (NAF Jan. 23, 2001) (respondent does not have rights in domain name incorporating another's mark when respondent is not known by that mark).

Hotwire has not licensed or otherwise permitted Respondent to use the Hotwire Marks, or apply for or use any domain name incorporating the Hotwire Marks. *See Telstra Corp. Ltd. v. Nuclear Marshmallows*, Case No. D2000-003 (WIPO Feb. 13, 2000) (respondent had no rights or legitimate interests to use domain name because respondent was not licensed or otherwise permitted to use complainant's trademark); *Alta Vista Company v. Jean-Daniel Gamanche*, Case No. FA 95249 (NAF Aug. 17, 2000) (respondent was not licensed to use complainant's mark and therefore had no rights or legitimate interests in the domain name). Indeed, the Agreement between Hotwire and respondent (now terminated) specifically provides, in Paragraph 6.2, that Respondent is not to register any domain name similar to the Hotwire Marks.

Respondent's use of a misspelling of the Hotwire Mark as a domain name is not "nominative" in that it is not an unavoidable use of the trademark to identify the goods or services that Respondent offers on its web site. Respondent does not offer any goods or services on its web site. The Infringing Domain Name merely resolves to a page with a search engine option. It is not necessary to use the Hotwire Marks in the Infringing Domain Name in order to provide a search engine. *See Six Continents Hotels, Inc. v. Hotel Partners of Richmond*, Case No. D2003-0222 (WIPO May 14, 2003) (finding that the use of the complainant's HOLIDAY INN mark in the domain name <holidayinnhotelreservations.com> was not nominative fair use because it was not an unavoidable and necessary use of a mark to identify respondent's services).

Respondent has failed to develop a website at the Infringing Domain Name and thus Respondent's use of the Infringing Domain Name is not in connection with a *bona fide* offering of goods or services. See *Dollar Financial Group, Inc. v. Mobile Internet Technologies, LLC*, Case No. FA 363953 (NAF Dec. 28, 2004) ("Respondent has not made any use of the domain name...Passive holding is not considered a use in connection with a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i)...").

Based on its lack of rights in the Hotwire Marks and lack of affiliation with Hotwire, in addition to its disruption of Hotwire's business and failure to make legitimate use of the web site located at the Infringing Domain Name, Respondent does not have rights or a legitimate interest in the Infringing Domain Name under ICANN Policy ¶4(a)(ii).

Respondent Registered and Is Using the Infringing Domain Name in Bad Faith

Long after Hotwire's adoption, use and registration of the Hotwire Marks, Respondent began making unauthorized use of that mark by registering the Infringing Domain Name.

As a participant in Hotwire's affiliate marketing program, Respondent clearly was aware of Hotwire and the Hotwire Marks, and sought, in fact, to profit from the commercial reputation of the Hotwire Marks by participating in the Hotwire affiliate marketing program.

Because Respondent had knowledge of the Hotwire Marks, Respondent could not have registered the Infringing Domain Name with the intention of using it legitimately. *Ticketmaster Corp. v. Spider Web Design, Inc.*, Case No. D2000-1551 (WIPO Feb. 4, 2001) ("active or constructive knowledge of complainant's rights in trademarks is a factor supporting bad faith"). See also *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221 (WIPO Dec. 4, 2000) (finding that respondent's domain names to be "so obviously connected" to the complainant's that "use or registration by anyone other than complainants suggests 'opportunistic bad faith'").

Respondent is engaged in a practice known as typosquatting, which has been recognized as a bad faith use of a domain name under the UDRP. See *Nat'l Ass'n of Prof'l Baseball Leagues v. Zuccarini*, D2002-1011 (WIPO Jan. 21, 2003) ("Typoquatting is the intentional misspelling of words with the intent to intercept and siphon off traffic from its intended destination, by preying on Internauts who make common typing errors. Typosquatting is inherently parasitic and of itself evidence of bad faith.").

Respondent's current lack of use of the Infringing Domain Name evidences bad faith. Panels have consistently found that a respondent's passive holding of a domain name incorporating a trademark of a third party is evidence of the respondent's bad faith use and registration of that domain name. See *VICORP Restaurants, Inc. v. Paradigm Technologies Inc. c/o Arden Bohanec*, Case No. FA 702527 (NAF June 21, 2006); see also *Megatrax Production Music, Inc. v. Fulltone*, Case No. FA 649297 (NAF Apr. 12, 2006) ("The Panel finds that

Respondent registered the <megatracks.com> domain name in bad faith, because Respondent has made no use of the domain name since registering it in December 1999 and has not provided evidence of demonstrable preparations to use the domain name.").

Respondent has also failed to supply a correct contact information to the Registrar, as Hotwire's correspondence sent to Respondent sent via email was returned as undeliverable. Respondent is required to keep her address information up to date. *Out2.com, Inc. v. Rustom Corp.*, Case No. FA095896 (NAF, Dec. 20, 2000) ("Respondent is required to provide correct addresses to the Registrar and if Respondent failed to do so, that does not place a higher burden on those dealing with Respondent to find it where it really is rather than where Respondent notified those dealing with it that it was located."). Failure to do so is evidence of bad faith. *Amherst LLC v. IFC Corp.*, Case No. FA096768 (NAF, April 3, 2001).

The combination of Respondent's actual knowledge of Hotwire's prior rights and the fame of the Hotwire Marks, Respondent's attempt to trade off of the goodwill of the Hotwire Marks, and Respondent's failure to provide correct contact information all demonstrates bad faith registration and use of the Infringing Domain Name under ICANN Policy ¶4(a)(iii).

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, Hotwire, Inc., is a well-known Internet company that provides online travel agency services. Since at least June 2000, Complainant has been using its HOTWIRE mark in connection with the travel agency services it provides. Complainant holds a registration with the United States Patent and Trademark Office ("USPTO") for its HOTWIRE mark (Reg. No. 2,681,692 issued January 28, 2003). Complainant provides its services using the <hotwire.com> domain name.

Respondent registered the <hotwi.com> domain name on August 13, 2003.

Respondent's disputed domain name currently resolves to a hold page containing a search engine link.

DISCUSSION

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

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the

respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

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

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

Identical and/or Confusingly Similar

The Panel finds Complainant's trademark registration with the USPTO sufficiently establishes Complainant's rights in the HOTWIRE mark. *See Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) ("Registration of the NASAL-AIRE mark with the USPTO establishes Complainant's rights in the mark."); *see also Janus Int'l Holding Co. v. Rademacher*, D2002-0201 (WIPO Mar. 5, 2002) ("Panel decisions have held that registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive.").

The Panel finds Respondent's <hotwi.com> domain name is confusingly similar to Complainant's mark as it is a misspelling of Complainant's HOTWIRE mark. In *Compaq Info. Techs. Group, L.P. v. Seocho*, FA 103879 (Nat. Arb. Forum Feb. 25, 2002), the panel found that the <compq.com> domain name was confusingly similar to the complainant's COMPAQ mark because the omission of the letter "a" in the domain name did not significantly change the overall impression of the mark. *See State Farm Mut. Auto. Ins. Co. v. Try Harder & Co.*, FA 94730 (Nat. Arb. Forum June 15, 2000) (finding that the domain name <statfarm.com> is confusingly similar to the complainant's STATE FARM mark). Accordingly, the Panel finds Respondent's use of Complainant's mark is confusingly similar to the HOTWIRE mark, despite the omission of the last two letters of the mark in the disputed domain name.

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Complainant initially must establish Respondent lacks any rights or legitimate interests with respect to the <hotwi.com> domain name. However, once Complainant demonstrates a *prima facie* case, the burden of proof shifts, and Respondent must show that it has rights or legitimate interests in the disputed domain name. *See Compagnie Generale des Matieres Nucleaires v. Greenpeace Int'l*, D2001-0376 (WIPO May 14, 2001) ("Proving that the Respondent has no rights or legitimate interests in respect of the

Domain Name requires the Complainant to prove a negative. For the purposes of this sub paragraph, however, it is sufficient for the Complainant to show a prima facie case and the burden of proof is then shifted on to the shoulders of Respondent. In those circumstances, the common approach is for respondents to seek to bring themselves within one of the examples of paragraph 4(c) or put forward some other reason why they can fairly be said to have a relevant right or legitimate interests in respect of the domain name in question.”); *see also G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (“Because Complainant’s Submission constitutes a *prima facie* case under the Policy, the burden effectively shifts to Respondent. Respondent’s failure to respond means that Respondent has not presented any circumstances that would promote its rights or legitimate interests in the subject domain name under Policy ¶4(a)(ii).”).

Complainant asserts Respondent is not currently authorized to use Complainant’s HOTWIRE mark, and Respondent is not currently associated with Complainant in any way. Complainant admits Respondent did previously have a very limited authorization to use Complainant’s HOTWIRE mark, but that such authorization did not allow Respondent to register the domain name in question. The authorization was revoked when Complainant discovered the currently disputed domain name (which was expressly prohibited by their agreement). Respondent’s WHOIS information does not suggest Respondent is commonly known by the disputed domain name, and there is no evidence in the record to suggest Respondent is or has ever been known by the <hotwi.com> domain name. The Panel finds Respondent is not commonly known by the disputed domain name under Policy ¶4(c)(ii). *See Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); *see also Ian Schrager Hotels, L.L.C. v. Taylor*, FA 173369 (Nat. Arb. Forum Sept. 25, 2003) (finding that without demonstrable evidence to support the assertion that a respondent is commonly known by a domain name, the assertion must be rejected).

The evidence on record indicates Respondent is not actively using the disputed domain name. There is no evidence in the record that indicates Respondent has any demonstrable preparations to use the disputed domain name in any way. Consequently, the Panel finds Respondent has not made a *bona fide* offering of goods or services under Policy ¶4(c)(i) and the website does not serve a legitimate noncommercial or fair use under Policy ¶4(c)(iii). *See Melbourne IT Ltd. v. Stafford*, D2000-1167 (WIPO Oct. 16, 2000) (finding no rights or legitimate interests in the domain name where there is no proof that the respondent made preparations to use the domain name or one like it in connection with a *bona fide* offering of goods and services before notice of the domain name dispute, the domain name did not resolve to a website, and the respondent is not commonly known by the domain name); *see also Flor-Jon Films, Inc. v. Larson*, FA 94974 (Nat. Arb. Forum July 25, 2000) (finding that the respondent’s failure to develop the site demonstrates a lack of legitimate interest in the domain name).

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith

The Panel finds Respondent has registered the <hotwi.com> domain name but has failed to actively use the disputed domain name. In *Caravan Club v. Mrgsale*, FA 95314 (Nat. Arb. Forum Aug. 30, 2000), the panel found that the respondent made no use of the domain name or website that connected with the domain name, and that such inactive use of a domain name permitted an inference of registration and use in bad faith. See *DCI S.A. v. Link Commercial Corp.*, D2000-1232 (WIPO Dec. 7, 2000) (concluding that the respondent's passive holding of the domain name satisfies the requirement of ¶4(a)(iii) of the Policy).

Furthermore, Respondent knew of Complainant's trademarks because Respondent became a Hotwire affiliate on the same day Respondent registered the domain name. It seems clear Respondent wanted to profit from re-directing traffic (through a typographical error) to Complainant. While it is an interesting business model, it appears (to this Pnaelist, at least) to violate the UDRP.

The Panel finds Policy ¶4(a)(iii) satisfied.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <hotwi.com> domain name be **TRANSFERRED** from Respondent to Complainant.


Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: August 11, 2006