

DISPUTE RESOLUTION SERVICE

D00021777

Decision of Independent Expert

FlightAware, LLC

and

Mr Vrundesh Trivedi

1. The Parties:

Complainant: FlightAware, LLC
Houston, TX
United States

Respondent: Mr Vrundesh Trivedi
Gujarat
India

2. The Domain Name(s):

flightaware.uk

3. Procedural History:

The Expert has confirmed (1) he is independent of each of the parties; and (2) to the best of his knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, which need to be disclosed because they might be of such a nature as to call into question his independence in the eyes of one or both of the parties.

22 August 2019 15:13 Dispute received
23 August 2019 11:46 Complaint validated
23 August 2019 12:01 Notification of complaint sent to parties
12 September 2019 02:30 Response reminder sent
16 September 2019 11:15 Response received
16 September 2019 11:16 Notification of response sent to parties
19 September 2019 02:30 Reply reminder sent
20 September 2019 11:14 Reply received
20 September 2019 11:14 Notification of reply sent to parties
25 September 2019 16:33 Mediator appointed
26 September 2019 14:59 Mediation started
08 October 2019 16:46 Mediation failed
08 October 2019 16:46 Close of mediation documents sent
18 October 2019 02:30 Complainant full fee reminder sent
18 October 2019 14:53 Expert decision payment received

4. Factual Background

The Complainant is a global aviation software and data services company, based in Houston, Texas, USA.

The Respondent is an individual whose address is in Gujarat, India. He registered the Domain Name on 2 July 2019. On 16 July 2019 he contacted the General Counsel of the Complainant, by LinkedIn message, in the following terms:

“Domain Name Selling Offer - flightaware.uk

Dear Concern Greetings from India!!! I would like to take this opportunity to offer you one of the important domain names (At least I think) for your company as you have been expanding to UK. I have recently bought a domain name flightaware.uk I have turned down few purchase enquiries as I felt I should offer it your company first rather than offering to someone else. Kindly contact for further details if you are interested Sincerely Vrundesh”

As at the date of this decision, the Domain Name resolved to a GoDaddy parking site.

5. Parties’ Contentions

The Complainant

Rights

The Complainant says that is a global aviation software and data services company based in Houston, Texas. It operates a website and mobile applications which offer free flight tracking of both private and commercial aircraft worldwide. In the UK it owns and uses the website flightaware.co.uk which it says is a very important asset

to its business. It registered the domain name flightaware.co.uk on 6 December 2005. It is the owner of international trade mark registration 1109598 FLIGHTAWARE in class 39 (covering commercial and non-commercial flight tracking services), which was registered on 8th January 2012. The registration designates the European Union and other territories.

The Complainant says that the Domain Name is identical (and closely similar) to the Complainant's trade mark FLIGHTAWARE.

Abusive Registration

Given the its strong reputation in the FLIGHTAWARE name (particularly in the UK), the Complainant says that no trader would choose the Domain Name unless with an intention to create a false impression of association with the Complainant, in order to defraud members of the public, attract business from the Complainant, to misleadingly divert the public to the Respondent, to tarnish the Complainant's reputation, or to sell the Domain Name to the Complainant (or one of its competitors) for an inflated price.

The Complainant says that the registration of the Domain Name on 2nd July 2019, shortly after the expiry on 25th June 2019 of the period for which it was reserved to the Complainant (as the owner of the .co.uk domain), shows that the Respondent acted quickly upon becoming aware that the Complainant had not registered the Domain Name. In addition, as it would have taken some time to locate the Complainant's General Counsel, it notes the speed of the approach made to it by the Respondent on 16 July 2019 by LinkedIn message. Both of those factors show that the Respondent had the intention of selling the Domain Name to it (or one of its competitors) at the date of its acquisition.

The approach on 16th July 2019 constituted an offer to sell the Domain Name for a fee to be negotiated. If the Complainant was not interested in purchasing the Domain Name there is a real risk that it would be used to disrupt the Complainant's business, confuse internet users, or it would be sold to a competitor for either of those purposes.

The Respondent has therefore acquired the Domain Name for the primary purpose of selling, renting or otherwise transferring the Domain Name to the Complainant or a competitor for more than he paid for it, in breach of paragraph 5 of the DRS Policy, amounting to an abusive registration.

The Complainant notes that the Domain Name does not resolve to a proper, functioning website. However, it says that if the Respondent uses the Domain Name in any way (or sells it to a competitor) there is a severe risk that, given the identity of the names in question, together with fact that the FLIGHTAWARE name cannot sensibly refer to any third party, an internet search engine will promote the Domain Name as if it were owned by the Complainant. That could result in serious damage to the Complainant's business. There is also a serious risk that an internet user may

guess the website address, and mistakenly landing on the Respondent's site, assume it is operated or authorised by, or otherwise connected with the Complainant. This will deceive the user. The same applies to any use of the Domain Name in connection with an email address.

The Respondent is not making legitimate non-commercial or fair use of the Domain Name, as it does not resolve to a proper, functioning website.

The Complainant seeks transfer of the Domain Name to itself.

The Respondent

Rights

The Respondent contests the Complainant's Rights in the name or mark FLIGHTAWARE on the basis that the Complainant's trade mark is only a registration for services in Class 39, and cannot stop anyone from using the FLIGHTAWARE name in other categories of services or goods.

Abusive Registration

The Respondent disputes the Complainant's characterisation of the LinkedIn message as an offer for sale – there was no request for a monetary transaction, nor a threat to use the Domain Name elsewhere.

He says that the Domain Name registration is not abusive because it has not been used anywhere "on the web portal" to take advantage of the Complainant, nor has it been offered to the Complainant's competitors. The Respondent tried to purchase the Domain Name from Nominet on 20th June 2019, but it was only released to it on 2nd July 2019.

The Domain Name has not been used to disrupt or block the registration of the Complainant.

It is not necessary to have an email or website (DRS Policy, 5.2), so the Respondent argues that the fact that the Domain Name does not point to a proper, functioning website is not evidence to prove abusive registration.

The Respondent says that the response to his LinkedIn message was somewhat threatening:

"We will file a complaint unless you agree to transfer the domain flightaware.uk to our client before 4 pm UK time on Tuesday 6 August. Given the clear cut nature of this case, we presume that it won't be necessary for our client to file a complaint."

The Respondent says that he has recently started domain name trading with a partner (and relies upon DRS Policy, 8.2 and 8.3). Together they hold some 100 domain names, including x-art.uk , insurancetimes.uk, pornhd.uk , employeewelfare.org , tourfinder.co , bookfinderusa.com , manuline.uk , and auctionservice.co.

The Respondent notes that it does not take long to find the Complainant's General Counsel's contact details - in a Google search for "flightaware general counsel" those details come up second.

Reply

Although the Complainant filed a Reply, it did not add anything new to the Complaint, and just maintained the Complainant's position.

6. Discussions and Findings

In order to succeed in its Complaint, in accordance with the Policy, the Complainant needs to establish:

- "i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration."*

The Complainant needs to establish both elements on the balance of probabilities.

The definition of Abusive Registration under the Policy is as follows:

"Abusive Registration means a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights".*

The definition of Rights under the Policy is as follows:

"Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning."

Rights

Although the Respondent points out that the Complainant's registered trade mark rights are limited to services in class 39, this does not alter the conclusion that (as required by the DRS Policy) the Complainant has clearly demonstrated (inter alia by its trade mark registration) that it has enforceable rights under English law (and otherwise) in the name or mark FLIGHTAWARE which is identical to the Domain

Name. The Expert therefore finds that the Complainant has established that it has Rights under the DRS Policy.

Abusive Registration

The Complainant does not explain why it did not register the Domain Name within the period when it was reserved to itself under Nominet's procedures introducing the new shorter .uk domain, which provided a window of opportunity in which a holder of (inter alia) an existing .co.uk Domain Name retained exclusivity over registration of the .uk equivalent (which Nominet termed "the right of registration"). Once that period expired at 06:00 am on 25th June 2019, the Complainant lost the protection afforded to it as a holder of an existing .co.uk domain name, and the Domain Name became freely available. As a consequence, although the Complainant can of course still object to a registration if it contends that it is abusive, it does not enjoy any special status. It needs to satisfy the Expert, on the balance of probabilities, that the registration is abusive within the wording of the DRS Policy.

In this case, the fundamental question is: what were the Respondent's intentions when he applied to register the Domain Name? It appears to be common ground that the Respondent has not yet used the Domain Name in a way which is objectionable (although the Complainant speculates as to what it might be used for, and the damage which might ensue). The Complainant says that the Respondent "will have known of the Complainant's business and [its] earlier rights in the "FlightAware" name" when he registered the Domain Name. Indeed, it goes as far as to say that "no trader" would have chosen that name unless with the intention to create a false impression of association with the Complainant or to sell the Domain Name to it or one its competitors for an inflated price. The basis for that contention as regards the Respondent appears to be a combination of its "strong reputation in the FlightAware name, particularly in the UK", and the Respondent's speed out of the blocks after the end of the "right of registration" period in both applying for the registration and making contact with the Complainant's General Counsel. However, it does not put forward any evidence to support its "strong reputation", nor the extent of its trading and reputation in the UK. In the absence of any such evidence, it is difficult for the Expert to draw the conclusion that the Respondent (or any other trader) must necessarily have had it in mind when it came to registering the Domain Name.

The Respondent, for his part, says nothing about the Complainant and the extent of its reputation. He could have taken the opportunity to deny any prior knowledge of the Complainant before registering the Domain Name, but did not do so. Instead, he concentrates upon his assertion that he and an (unnamed) partner have gone into business as domain name traders, which is not objectionable per se under the DRS Policy. He says that the registration of the Domain Name was part of that business decision. He can easily and quickly find out the contact details of the Complainant's General Counsel by a Google search. However, again he does not say whether he in fact had some prior plan to make contact with the Complainant when he registered, or whether that was something which occurred to him later, after making enquiries.

The Respondent does give some details of his other registrations. Some of those appear to the Expert to be perhaps questionably close to others' brand names (such as the Insurance Times). However, the Complainant has not argued that the Domain Name registration is part of a pattern of questionable registrations, despite having had the opportunity to do so in its Reply.

It is worth recalling the full terms of the DRS Policy regarding registration of a Domain Name for the purpose of selling it on:

5.1 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

Here, the Complainant says that the correspondence makes clear that the Respondent acquired the Domain Name with the primary purpose of selling it to the Complainant (or a competitor) for more than he paid for it. The Respondent says the LinkedIn message does not go that far (which, on its own terms, it does not). Does the message implicitly give the suggestion the Complainant contends for, when combined with the other surrounding circumstances?

This is not the clearest of cases, and the DRS process is not an inquisitorial one. The Expert has to form a view on the evidence and arguments before him, bearing in mind that the onus is on the Complainant to establish its case, on the balance of probabilities. The Expert's view is that (1) the speed with which the Respondent made contact with the Complainant's General Counsel after registering the Domain Name, (2) the implicit invitation in the LinkedIn message to enter into negotiations, and (3) the failure by the Respondent in these proceedings to deny knowledge of the prior rights of the Complainant, mean that it is more likely than not that the Respondent had the Complainant in mind when he registered the Domain Name, and that he intended to profit from selling the Domain Name to the Complainant (or, perhaps, to a competitor). In hoping to profit in this way, it is of course inherent that the intended selling price would be more than the Respondent's out-of-pocket costs.

As the Respondent points out, the DRS Policy, 5.2 says that *"Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration"*. Also, that *"Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits"* (DRS Policy, 8.4). However, in this case, the merits are (on balance) with the Complainant - the Expert is not deciding against the Respondent because of his failure to use the Domain Name, or engaging in trading in domain names. Instead, the Expert has formed the view that, more likely than not, the Respondent's motives

when registering the Domain Name took unfair advantage of the Complainant's Rights.

Therefore, the registration is abusive, and the Complaint succeeds. It does not seem to the Expert to be necessary to deal with the Complainant's conjecture about what the Domain Name might be used for, nor the hypothetical damage which might result.

7. Decision

The Expert finds that the Complainant has Rights in the name or mark FLIGHTAWARE which is identical to the Domain Name, and that that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complaint therefore succeeds and the Domain Name should be transferred to the Complainant.

Signed: Bob Elliott

Dated 9th November 2019