



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

American Appraisal Associates Inc. v. R Hagar, Kinja LLC

Case No. D2006-1556

1. The Parties

The Complainant is American Appraisal Associates Inc., Milwaukee, Wisconsin, United States of America, represented by Whyte Hirschboeck Dudek, SC, United States of America.

The Respondent is R Hagar, Kinja LLC, Washington, United States of America; represented by Graham & Dunn, PC, United States of America.

2. The Domain Name and Registrar

The disputed domain name <americanappraisals.com> is registered with Dotster, Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 7, 2006. On December 10, 2006, the Center transmitted by email to Dotster, Inc. a request for registrar verification in connection with the domain name at issue. On December 11, 2006, Dotster, Inc. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 20, 2006. In accordance with the Rules, paragraph 5(a), the due date for Response was January 9, 2007. The Response was filed with the Center on that date.

The Center appointed Richard G. Lyon as the sole panelist in this matter on January 19, 2007. The Panel finds that it was properly constituted and has jurisdiction over this dispute. The Panel has submitted his Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

On January 12, 2007, Complainant's representative contacted the Center by email, requesting leave to submit a reply. Later that day Respondent's representative (who had been copied on the email request) objected to Complainant's request. Complainant submitted its proposed reply to the Center on January 17, 2007. On January 22, 2007, Respondent submitted a written statement of opposition together with a surreply in the event that the Panel allowed Complainant to file its reply. In Procedural Order No. 1, issued January 23, 2007, the Panel denied each party's request to submit a supplemental pleading.¹ The response contained nothing that Complainant could not have anticipated when the Complaint was filed. Both parties merely reiterated arguments advanced earlier. There was nothing exceptional justifying a supplemental pleading.

4. Factual Background

The Panel finds that the following facts have been established by the evidence submitted by the parties or by the Panel's review of materials readily available to the public.² Allegations of other facts that have no evidentiary support are discussed in footnotes 3, 5, and 8 and in Section 5.

Complainant offers appraisal and evaluation consulting services in many fields. It owns marks registered in the United States Patent and Trademark Office (USPTO) for AMERICAN APPRAISAL (issued in 1981) and AMERICAN APPRAISAL ASSOCIATES (issued in 1987), both in International Class 36.³ Complainant's principal website is "www.American-Appraisal.com". Complainant also owns the domain name <americanappraisal.com>; an Internet user entering this in her browser will be redirected to "www.american-appraisal.com".

Respondent also offers appraisal and evaluation services, principally for real estate, in King, Snohomish, and Pierce Counties, Washington, United States of America, the area in and around that state's largest city, Seattle. Respondent's business name is American Home Appraisals. Respondent has operated its business under this name continuously since 1988 and has made use of the disputed domain name for its appraisal services since 1998.

5. Parties' Contentions

Complainant contends as follows:

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- 1 Complainant's request to file a reply was based upon its belief that Respondent had misstated certain facts in the Response. In substance, the reply brief did nothing but restate arguments made in the Complaint, but with citations to alleged misstatements of the Respondent.
 - 2 The Panel has verified the Complainant's trademarks by reviewing the website of the United States Patent and Trademark Office and has reviewed the contents of each party's website. See *WIPO Overview of WIPO Panel Views on Selected UDRP Questions* ("Overview"), ¶4.5.
 - 3 Complainant asserts but provides no evidence that it owns service mark registrations for AMERICAN APPRAISAL in five other countries and for AMERICAN APPRAISAL ASSOCIATES in eleven other countries.

Confusingly similar to a mark in which Complainant has rights. Complainant has valid and enforceable trademark rights in both AMERICAN APPRAISALS and AMERICAN APPRAISAL ASSOCIATES. The disputed domain name is confusingly similar to both of these marks; it differs from the former by single letter and includes two of the three words of the latter.

Rights or legitimate interests. Complainant has never authorized Respondent to use its marks. Respondent is not known by the term American Appraisals; rather it does business under the name American Home Appraisals. Respondent's intentional use of the disputed domain name, which is confusingly similar to Complainant's registered marks, cannot be legitimate because Respondent registered the disputed domain name "long after Complainant's trademark registrations issued," and therefore "was seemingly obtained with the intention of trading on the goodwill of the Complainant." This is comparable to typosquatting, as missing or adding a single keystroke will take an Internet user seeking Complainant's website to the website of Respondent, a competitor.

Bad faith. When Respondent registered the domain name in 1998, it was either actually aware or charged with knowledge under the doctrine of constructive notice⁴ of Complainant's mark, so its registration of the disputed domain name breached its undertaking to the Registrar that to the best of its knowledge the domain name to be registered did not infringe any third party's trademark rights. Respondent's using the domain name for services that compete with Complainant evidences both registration and use in bad faith. By using a similar name for competing services, Respondent is intentionally attempting to attract for commercial gain Internet users Respondent's website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliate, or endorsement of Respondent's website in direct violation of paragraph 4(b)(iv) of the Policy.⁵

Respondent contends as follows:

Confusingly similar to a mark in which Complainant has rights. Complainant's trademark rights are limited because they are descriptive or generic, and no confusion with Complainant's marks is likely because "a web searcher who typed an internal 'AmericanAppraisals.com' into a URL would expect to find a website owned by an American company that performs appraisals." Respondent submits as evidence a partial search (using a prominent search engine) result for *American Appraisals* that shows a large number of different companies performing such services. Any appraisal company in America has "as much right as Complainant to use 'American' and 'appraisals' in their domain names because doing so in an efficient way to tell web searchers what they sell." Complainant's services are not directly competitive with Respondent's. Complainant serves primarily businesses; Respondent serves primarily

⁴ The Panel discusses constructive notice in Section 5 below.

⁵ Complainant also alleges that in 2003 Respondent referred to itself as "American Appraisal" on its website at the disputed domain name and that in response Respondent changed its website to refer to itself by its more common name American Home Appraisals. Complainant further alleges that it "made several further requests for the Respondent to discontinue use of the domain name, all of which remain unanswered." Because Complainant offers no proof of these communications, the Panel takes no account of them. *The Skin Store, Inc. v. eSkinStore.com*, WIPO Case No. D2004-0661; *Lyons Partnership LP v. NetSphere, Inc.*, WIPO Case No. D2004-0118. "The Policy requires the Complainant to prove each of the three elements". *Western Research 3000, Inc. v. NEP Products, Inc.* WIPO Case No. D2004-0755 (emphasis in original; citation omitted). See also Overview", ¶4.6; Rules, paragraphs 3(b)(xv) and 10(b)(referring to "evidence"). Counsel's assertions are not evidence or proof. As discussed in the text *infra*, even if these allegations were true it would not change the Panel's decision in this proceeding.

residential real estate customers.⁶ Complainant has provided no evidence of confusion.

Rights or legitimate interests. Respondent has operated its business under the name American Home Appraisals since 1988 and has conducted this business at a website using the disputed domain name since 1998, long before notice of this dispute. Respondent's business is commonly known as "American Appraisals" as an informal abbreviation of its full business name. Respondent's use of disputed domain name is "fair use" because it describes the services Respondent provides. The disputed domain name was available in 1995, but Complainant chose its own domain name <american-appraisal.com> instead. Respondent denies (without any evidence) changing its website as charged by Complainant.

Bad faith. Complainant has not submitted any evidence that Respondent registered or used the disputed domain name in bad faith. Respondent has never offered to sell the disputed domain name to Complainant or anyone else and in fact registered and has used it for a legitimate business accurately described by the words in the disputed domain name. Complainant and Respondent are in fact not competitors, so Respondent did not register the disputed domain name "primarily for the purpose of disrupting the business of the competitor" in violation of paragraph 4 (b)(iii) of the Policy. Because there is no likelihood of confusion between the disputed domain name and Complainant's marks, Respondent did not register the disputed domain name intentionally to attempt to attract for commercial gain Internet users to Respondent's websites by making use of the goodwill attached to Complainant's marks; furthermore, Complainant offers no evidence in support of its charge under this paragraph of the Policy.

6. Discussion and Findings

Confusingly Similar to a Mark in which Complainant has Rights. Because the requirements of paragraph 4(a) of the Policy are conjunctive, a complainant's failure to meet any of them results in a denial of the complaint. The Panel finds, for reasons stated in the third following paragraph, that Complainant has not established that Respondent lacks rights or legitimate interests, so the requirements of 4(a)(ii) of the Policy have not been met. While there is thus no need to address paragraph 4(a)(i), the Panel chooses to do so because of Respondent's contention that because Complainant's marks are "generic" or "descriptive" Complainant's rights are somehow narrowed under paragraph 4(a)(i) of the Policy.

Paragraph 4(a)(i) requires a complainant to prove two things: that it has trademark rights sufficient to invoke the Policy, and that the disputed domain name is identical or confusingly similar to its mark. Proof of a national registration of a mark satisfies the first of these elements conclusively in all but the most extraordinary circumstances even if, as is true in this proceeding, the mark at issue is comprised of common words or is in trademark parlance "descriptive" or "generic." The Panel in a UDRP proceeding lacks jurisdiction or competence to set aside, or limit the effect under paragraph 4(a)(i), of the action of the governmental body that registered the mark, in this instance the USPTO.⁷

⁶ Respondent submits evidence to support this distinction, but the Panel is not convinced. While Respondent's market is considerably narrower than Complainant's the parties are direct competitors within that limited geographic area.

⁷ *Julie & Jason, Inc. d/b/a The Mah Jongg Maven v. Faye Scher d/b/a Where the Winds Blow*, WIPO Case No. D2005-0073; *Rudy Rojas v. Gary Davis*, WIPO Case No. D2004-1081.

While Complainant technically has not proven its ownership of a registered mark,⁸ the public website of the USPTO confirms such ownership.

The second element of paragraph 4(a)(i) requires the Panel to compare the registered marks with the disputed domain name to see if there is confusing “similarity in sound, appearance, and ideas suggested by the mark and the domain name. . .” *Sharman License Holdings, Limited v. Gregg Smitherman*, WIPO Case No. D2004-0375. The content of Respondent’s site is irrelevant to this exercise, see Overview, ¶1.2. While proof of actual confusion may be useful or even determinative in a close case, here the only difference between the disputed domain name and one of Complainant’s registered marks is Respondent’s use of the plural instead of Complainant’s use of the singular. Similarity is obvious and confusion likely based upon this comparison.

Rights or Legitimate Interests; Bad Faith. The fact that Complainant’s marks use everyday words and describe the Complainant’s services, however, does bear on the Panel’s evaluations under paragraphs 4(a)(ii) and 4(a)(iii) of the Policy. Just as a generic or descriptive mark may limit its owner’s right to exclude others under trademark law, that fact makes it more difficult for a complainant to establish a *prima facie* case under paragraph 4(a)(ii) that respondent lacks rights or legitimate interests in the disputed domain name and makes it easier for a respondent to rebut such a *prima facie* case if it is made.⁹ Of particular relevance to this proceeding, it makes it more difficult for Complainant to establish that Respondent selected the disputed domain name with Complainant’s mark in mind and not simply to describe Respondent’s own business. Complainant has offered no evidence that Respondent selected the disputed domain name with an intention to take advantage of Complainant’s marks or the reputation surrounding them and no evidence from which the Panel could reasonably make such an inference.

Complainant contends that the Panel, contrary to prevailing Policy practice,¹⁰ should apply the United States trademark law doctrine of constructive notice to the facts of this case. While both parties to this proceedings are United States companies, the few exceptions to the consensus view almost always occur in cases of obvious cybersquatting, where circumstances would allow the Panel reasonably to infer that the Respondent had actual knowledge of Complainant’s marks,¹¹ or in cases involving domain name aggregators, entities that buy domain names consisting of common words *en masse* for resale to the general public.¹² Neither of these circumstances obtains in this proceeding. There is not even an allegation, much less proof, that Respondent has attempted to sell the disputed domain name to Complainant or to the public generally, that Respondent has regularly engaged in acquiring domain names consisting of the marks of third parties, or that Respondent has used the disputed domain name for anything other than a legitimate business. That this use predated by eight years any

⁸ A complainant ordinarily annexes copies of its marks to the complaint or to a factual affidavit from a person with appropriate knowledge. Complainant here did identify its marks by registration numbers.

⁹ *Julie & Jason, Inc. d/b/a The Mah Jongg Maven v. Faye Scher d/b/a Where the Winds Blow*, *supra* n7.

¹⁰ See Overview, ¶ 3.4.

¹¹ *E.g., The Sportsman’s Guide, Inc. v. Modern Limited, Cayman Islands*, WIPO Case No. D2003-0305 (Respondent used disputed domain name for click-through revenue; Internet user immediately diverted to unrelated site. Also a default case.); *Kate Spade, LLC v. Darmstadter Designs*, WIPO Case No. D2001-1384 (Three years’ warehousing of the disputed domain name); *J. Crew International, Inc. v. crew.com*, WIPO Case No. D2000-0054 (Respondent had registered many domain names incorporating well-known marks; no use of disputed name for two years.)

¹² *E.g., Centron GmbH v. Michele Dinoia*, WIPO Case No. D2006-0915; *Media General Communications, Inc. v. Rarenames, WebReg*, WIPO Case No. D2006-0964; *Prestige Brands Holdings, Inc., and Prestige Brands International, Inc. v. The domain is not for sale / Motohisa Ohno*, WIPO Case No. D2006-0608.

proven notice of this dispute, or (if the Panel were to accept as fact Complainant's counsel's assertion of communications with Respondent in 2003) five years from any objection by Complainant, further emphasizes that Respondent, in the circumstances of this proceeding, has established that it "as a[. . .]business . . .ha[s] been commonly known by the [disputed] domain name," or a close variant of it, see Policy, paragraph 4(c)(ii).

For these same reasons, Complainant has failed to establish that Respondent registered the disputed domain name in bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

Richard G. Lyon
Sole Panelist

Dated: January 29, 2007