

.nz Dispute Resolution Service

DRS Reference: 203

Thai Airways International Public Company Limited v E-Promote

Key words – unregistered mark – trade name – similar – likely to confuse, mislead or deceive

1. Parties

Complainant:

Thai Airways International Public Company Limited
Level 8, CITIGROUP Building
23 Customs Street East
PO BOX 4559
Auckland 1140
New Zealand

Respondent:

E-Promote
536 Leavenworth St
San Francisco
United State of America

2. Domain Name

thaiairways.co.nz ("the Domain Name")

3. Procedural history

The Complaint was lodged on 21/05/2007 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated Complaint on 24/05/2007. The notification was effected by posting a copy of the Complaint to the Respondent at its address listed in the registered "WHOIS" particulars for the Domain name, and by transmitting a copy of the Complaint by email to the Respondent at the email address provided in the WHOIS particulars. The copies of the Complaint sent to the Respondent were accompanied by a letter from InternetNZ to the Respondent, enclosing a copy of the Dispute Resolution Service Policy and Procedure issued by InternetNZ ("the Policy"), and advising that the Respondent had until 14 June 2007 to file a Response to the Complaint. The letter contained a prominent warning that failure to file a Response might result in the transfer, suspension, or cancellation of the Domain Name without further reference to the Respondent. The letter drew attention to the information available at the Domain Name Commissioner's Dispute Resolution Service website at www.drs.org.nz.

The Domain Name was locked on 22/05/2007, preventing any changes to the record until the conclusion of these proceedings.

There was no response filed by the Respondent.

The Complainant paid InternetNZ the appropriate fee on 22/06/2007 for a decision of an Expert, pursuant to Paragraph 9 of the Policy.

Mr Warwick Smith, the undersigned, (“the Expert”) confirmed to InternetNZ on 25/06/2007 that he knew of no reason why he could not properly accept the invitation to act as Expert in this case, and that he knew of no matters which ought to be drawn to the attention of the parties which might appear to call into question his independence and/or impartiality. On 25 June 2007, Mr Smith was appointed by InternetNZ to decide the Complaint under the provisions of the Policy.

4. Factual background

The Complainant

The Complainant is Thai Airways International Public Company Limited (“Thai”). Thai was formerly known as Thai Airways International Limited, and it was registered in New Zealand as an overseas company under that name on 19 December 1986. Thai’s name was changed to Thai Airways International Public Company Limited, in 1994.

Very little information about Thai was provided in the Complaint itself, but the Complaint did contain an invitation to visit Thai’s primary international website at www.thairways.com, (referred to hereafter as “Thai’s main website”), and to obtain more information. Thai’s main website provides links to numerous national websites operated by Thai at a number of country code top level domains. One of those is Thai’s Singapore website, and the Singapore website contains a helpful summary of Thai’s history under the heading “THAI MILESTONES”.

According to that section of Thai’s Singapore website, Thai’s origins go back to 1959, when the Government of Thailand entered into a partnership with Scandinavian Airlines System to create a new international airline for Thailand. The partnership was operated through a company called Thai Airways Company.

The new international airline appears to have grown steadily from those early beginnings. New destinations were added in a number of Asian countries, and the airline had carried its millionth passenger by 1967. Its first intercontinental route (linking Bangkok with Sydney) was launched in 1971, and services to Europe commenced in 1973.

The Thai Government acquired the interest of SAS in 1977, and thereafter the airline continued to grow, acquiring more and larger aircraft, and extending its

network to many new destinations. One of those new destinations was Auckland: Thai commenced services into Auckland in 1987.

According to the Complaint, Thai now serves a total of 72 destinations in six continents.

Thai was listed on the Stock Exchange of Thailand in 1992, and the new public company was formally registered in May of 1994.

The Complaint shows that Thai maintains office premises in Auckland. Thai provides regular international air services to and from Auckland International Airport.

Thai's Trade Marks

Thai has not produced evidence that it owns any registered trade marks or service marks. (Presumably it does, but it has not produced evidence of them, and it is not for the Expert to do Thai's work for it by searching databases maintained by trade mark registration authorities in New Zealand or elsewhere.)

However, it is readily apparent from looking at Thai's main website (and the various Thai national websites which are accessible through Thai's main website) that Thai has adopted and used for many years a brand consisting of a distinctive logo followed by the word THAI, in upper case lettering with a stylized "T" and "A". The "THAI MILESTONES" page at Thai's Singapore website records that its distinctive purple, pink and gold logo was adopted in 1975, and that it was "embraced worldwide".

Thai's main website shows that this distinctive logo appears on the tails of its aircraft, and also on the sides of the aircraft, followed by the word "THAI". Throughout Thai's main website, and throughout Thai's various national websites, the combined logo mark (logo with the word "THAI" immediately to the right of the logo) can be seen, in some instances with the tag line "Smooth as silk".

Also throughout the text on Thai's main website (and in its various national websites), Thai is consistently referred to as "THAI" (i.e., in upper case lettering).

Thai's Domain Names

According to the Complaint, Thai has registered domain names incorporating the expression "thaiairways" in every country where Thai's offices are located. Clearly, that does not include New Zealand, where the Domain Name is presently held by the Respondent, and nor does it appear to be true of some other country code domain names used by Thai. For example, the country domains used by Thai in Italy, Switzerland, and Japan, consist of the shorter expression "thaiair". (Thai also appears to own the domain name thaiair.com.) For the most part, however, it appears that Thai's country code

domains *do* generally include the expression “thaiairways”. For example, Thai holds the domain names thaiairways.com.au in Australia, thaiairways.com.sg in Singapore, and thaiairways.fr in France. As noted above, the domain name which resolves to Thai’s main website also incorporates the expression “thaiairways”.

The Respondent and the Domain Name

The Domain Name was registered on 17 May 2005.

The Domain Name presently resolves to a website (“the Respondent’s website”) which provides sponsored links to various third party websites, many of which have some sort of travel connection. On the home page, the site visitor can click on any of a number of travel-related headings grouped under two principal headings, “Main” and “Popular”. For example, under the heading “Main”, the site visitor can click on “Discount Travel”, “Travel Insurance”, “Cheap Airfare”, and so on. Under the “Popular” heading, the subheadings include “Flights”, “Cheap Airline Ticket”, “Cheap Travel”, and “Airline Travel”. There is also a “Favorites” heading, with a number of “click-on” subheadings, one of which is “Thai Airway”.

Clicking on one of these subheadings takes the site visitor to a subpage containing sponsored links to third party websites which offer goods or services in the relevant category.

Clicking on “Thai Airway” in the “Favorites” category, takes the site visitor to a webpage containing a number of click-on headings, one of which is:

“Cheap Thai Airway Flights
Book Thai Airway Flights Online Now
Compare Other Airlines and Prices.”

Beneath that heading is a sponsored link to the website at www.jetabroad.co.nz, which provides information on airline bookings and provision for making online reservations. This website contains a lengthy list of airlines from which the site visitor can select in conducting his or her search. Only one of them appears to have any connection with Thailand, and it is listed as “Thai Airways International”.

Not all of the headings and associated sponsored links on the Respondent’s website are to travel-related websites. There are sections dealing with “Dating”, “Houses For Sale”, and “Work from Home”, and various other apparently unrelated topics. One of those other topics is headed “Pay Per Click”.

Apart from what is apparent from the WHOIS particulars and the Respondent’s website, no information has been provided about the Respondent.

5. Parties' contentions:

a. Complainant

Thai contends as follows:

1. Thai's customers around the world recognise Thai, and believe that when they search for the "thaiairways" name on the internet in each country, they should be taken to a Thai website. They understand "thaiairways" as Thai's trade name on the Internet.
2. Thai has been receiving numerous calls from its passengers and agents in New Zealand, claiming that, when entering the Respondent's website, they have been misled into believing that the Respondent's website is Thai's official website in New Zealand. That is at least in part because the name "Thai Airways" is mentioned on the Respondent's website.
3. The Respondent has been using Thai's trade name to mislead customers and make them believe that the Respondent's website in fact belongs to Thai in New Zealand. In so doing, the Respondent is unfairly taking advantage of Thai's customers and agents, and of Thai's goodwill and reputation worldwide.

b. Respondent

The Respondent did not file any Response.

6. Discussion and findings

Relevant Provisions of the Policy

The Policy applies to a Respondent when a Complainant asserts that:

- "(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 Unfair Registration."* (Policy, paragraph 4.1)

The Complainant is required to prove on the balance of probabilities that both elements are present (Policy, paragraph 4.2).

The expressions "Rights" and "Unfair Registration", are both defined in paragraph 3 of the Policy.

The expression "Rights" includes, but is not limited to, rights enforceable under New Zealand law. The definition continues:

“However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant’s business.”

The expression “Unfair 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) has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”*

At paragraph 5.1, the Policy contains a non-exhaustive list of factors which may be evidence that a domain name is an “Unfair Registration”. The list includes the following:

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

- (i) 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;*
- (ii) as a blocking registration against a name or mark in which the Complainant has Rights; or*
- (iii) for the purpose of unfairly disrupting the business of the Complainant; or*

5.1.2 Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.”

Paragraph 6.1 of the Policy sets out a list of factors which may be evidence that the Domain Name is *not* an Unfair Registration. This list, which is again non-exhaustive, contains the following:

“6.1.1 Before being aware of the Complainant’s cause for complaint (not necessarily the Complaint itself), the Respondent has:

- (i) used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;*
- (ii) been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*
- (iii) made legitimate non-commercial or fair use of the Domain Name; or*

6.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character.”

Application of the Policy to the Facts of this Case

1. Rights

The first question is whether Thai has “Rights” in respect of a name or mark which is identical or similar to the Domain Name. The Expert is satisfied that it has.

Thai has not produced evidence of any registered trade mark. Its case is that it has established a reputation in its trade name on the Internet, and the evidence is essentially limited to what the Expert has been able to glean from Thai’s main website and the pages linked to it.

However, the Expert is mindful of the decisions of the appeal panels in the United Kingdom which have held that the requirement under the Policy to demonstrate “rights” is not a particularly high threshold test. See, for example, the decision of the appeal panel in *Seiko UK Limited v Designer Time/Wanderweb*; Nominet Case No DRS 00248. As this Expert noted in the New Zealand DRS case *bopmemorials.co.nz* (New Zealand DRS No. 108), the purpose of the Policy is primarily to provide a quick and relatively cheap means of obtaining redress in circumstances of abusive or otherwise unfair registration of a domain name, and the level of proof required cannot reasonably be expected to be at the level which would be necessary to support a court claim for passing off, or an application to register a trademark based on distinctiveness acquired through years of use.

See also the New Zealand DRS decision *NZ Aerial Mapping Limited v Terralink International Limited* (New Zealand DRS Case No. 172), where the Expert said:

“... decisions under the English Nominet Policy show that the requirement to demonstrate rights is not a particularly high threshold test – See DRS 00248, seiko-shop.co.uk and DRS 00359, parmaham.co.uk. The English definition of ‘rights’ is similar to that in the New Zealand Policy.”

The relatively low threshold for establishing Rights under the Policy, is also illustrated in other New Zealand DRS cases. See for example, the *skypeshop.co.nz* case (New Zealand DRS No 150), where the Expert accepted as a “right” the First Complainant’s right as registrant of the skype.com domain name, and the *fleetpartnersnz.co.nz* case (New Zealand DRS No. 149), where the Expert accepted that rights under the Companies Act 1993 in a company name could qualify as “rights” under the Policy.

Having regard to the relatively low level of proof required to establish a Right under the Policy, the Expert finds that Thai has the following relevant Rights:

- (i) rights in its name registered under the New Zealand Companies Act, i.e., in “Thai Airways International Public Company Limited” (following the decision of the Expert in *fleetpartnersnz.co.nz*, New Zealand DRS No. 149); and
- (ii) rights in its distinctive logo coupled with the word THAI. The latter rights are sufficiently established by what appear to have been many years of commercial use as a service mark for Thai’s airways services.

In the Expert’s view neither Thai’s name nor the Thai logo mark are wholly descriptive of Thai’s business, so the exception in the definition of “Rights” in paragraph 3 of the Policy does not apply.

It may be that Thai also enjoys trade mark rights in the expression “Thai Airways”. It has certainly used that expression as a domain name, both in the .com g.t.l.d. and in a number of country code top level domains. However, the Complainant has not produced evidence that it has registered “Thai Airways” as a trade mark or service mark (something it presumably would have done if it had such rights), and it has not clearly *claimed* trade mark rights in that expression. While it has registered some country code domains consisting of the expression

“thaiairways”, it appears that it has not used that expression in *all* countries.

In the event, the established Rights in Thai’s name and in the THAI logo mark are sufficient for the Expert to resolve the Complaint, and it is not necessary to make a finding on whether or not Thai enjoys rights in the expression “Thai Airways”.

Are Thai’s Rights Identical or Similar to the Domain Name?

The Expert is in no doubt that they are.

First, the distinctive part of Thai’s name is the part consisting of the first two words, “Thai Airways“. That part is of course identical to the operative part of the Domain Name.

The Expert is also satisfied that the Domain Name is similar to the THAI logo mark. The logo part of the THAI logo mark could not be incorporated in any domain name, so the word element of the mark assumes greater importance in the comparison. That word element is of course incorporated in full in the Domain Name. Furthermore, the word “airways” in the Domain Name describes precisely Thai’s principal service, thereby enhancing the likely perception of those familiar with Thai as an airline operating under the THAI logo mark, that any website operated at the Domain Name would be associated with Thai. Those factors in combination are more than sufficient to establish similarity for the purposes of the Policy.

The Expert therefore finds that Thai has Rights in respect of a name or mark which is similar to the Domain Name.

Unfair Registration

The Expert concludes, without difficulty, that the Domain Name *is* an Unfair Registration in the hands of the Respondent. That conclusion is based on the following grounds.

1. The Domain Name is similar to Thai’s name and to its THAI logo mark.
2. Thai (and its predecessors with names incorporating the words “Thai Airways”) have been operating international air transport services to numerous countries, including the United States of America where the Respondent resides, for many years. Thai has also established a significant presence on the Internet, operating through domain names most of which include the expression “thaiairways“. The Respondent’s website appears to be primarily travel-related – for example, all of the click-on

links on the home page are concerned with travel or accommodation, and nearly all of them are concerned with air travel. Having regard to those points alone, it seems most unlikely that the Respondent would not have been aware of Thai when it registered the Domain Name.

And there is more. On the home page of the Respondent's website, there is a "Favorite" link to "Thai Airway". Clicking on that link takes the site visitor to a subpage at which the site visitor is offered a further link to a website where one can book "cheap Thai Airway flights". The services offered at that website (www.jetabroad.co.nz) include booking services for numerous airlines and destinations. A "special" offering is "Melbourne to Bangkok flying Thai Airways". The website at www.jetabroad.co.nz also includes a full listing of airlines on which the site visitor might book a flight. One of those airlines is "Thai Airways International". In the absence of any evidence to the contrary, the Expert finds that the various references to "Thai Airway", "Thai Airway Flight", "Thai Airways", and "Thai Airways International", are all references to Thai or its services.

Having regard to these factors, and in the absence of any response, the Expert finds that the Respondent was well aware of Thai and its Rights when it registered the Domain Name

3. The Respondent's website contains a number of links to websites offering the services of Thai's competitors. For example, there is a click-on link on the Respondent's website headed "Qantas flights from NZ", and a link to the Qantas website at www.qantas.co.nz. There is also a link to a website promoting Pacific Blue services.
4. It is reasonable to infer from the nature of the Respondent's website, which is entirely commercial, that the Respondent has been deriving revenue from the provision of the various hyperlinks on the Respondent's website, probably on a pay-per-click basis.
5. Circumstances of the kind described in paragraphs 1 to 4 above have routinely been regarded by panels resolving disputes under the Uniform Domain Name Dispute Resolution Policy (applicable to disputes in the .com, .org, and .net g.t.l.d.'s), as evidence of a lack of bona fides on the part of the Respondent and/or as evidence of bad faith registration and use. For an example, see the decision of the WIPO Panel in *Shahnaz Husain v Saxena*

Dinesh O, WIPO Case No D2006-1132, where the Panel said:

“In addition, in line with consistent WIPO UDRP decisions, the Respondent’s use of the Domain Name to divert internet users to his website and redirect them to other websites, some of which offer for sale the complainant’s direct competitor’s products, presumably receiving compensation for this misdirection, cannot be considered a bona fide use of a domain name as per paragraph 4(c)(iii) of the Policy (See e.g. Lyonnaise de Banque v Richard J; WIPO Case No D2006-0142, and Motorola Inc v Mr. Josip Broz; WIPO Case No 2002-1063)” followed/applied by 3-member panel in Provident Financial plc and Another v Mode h; WIPO Case D2007-0149.”

In the Expert’s view, the same result is appropriate under the provisions of the (New Zealand) Policy. In the absence of any Response, the inference is irresistible that the Respondent registered the Domain Name with the intention of riding on the back of Thai’s goodwill in its Rights, and attracting (to the Respondent’s website) site visitors who would be expecting to find Thai’s official New Zealand website. Indeed, it appears from the Complaint that that very kind of confusion has occurred: the Complainant says that it has been receiving numerous calls from its passengers and agents in New Zealand claiming to have been misled into believing that the Respondent’s website would be Thai’s official New Zealand website.

6. In the circumstances described in paragraphs 1- 5 above, any services offered by the Respondent through the Respondent’s website cannot be regarded as a “*genuine* offering of goods or services” within the meaning of paragraph 6.1.1(a) of the Policy. Nor can the Respondent’s use of the Domain Name be regarded as “legitimate”, or “fair”, within the meaning of paragraph 6.1.1(c) of the Policy. Similarly, the unfair nature of the Respondent’s use of the Domain Name would have ruled out any reliance by the Respondent on paragraph 6.1.2 of the Policy.

None of the other examples of (possibly) fair registrations which are provided in paragraph 6 of the Policy, appear to have any possible application in this case.

7. In the Expert's view, the circumstances fall squarely within paragraph 5.1.2 of the Policy. The Respondent has been using the Domain Name in a way which is likely to confuse, mislead or deceive people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. Under the Policy, those circumstances are deemed to be evidence of an Unfair Registration, and there is no evidence which would point to any contrary conclusion.
8. For the foregoing reasons, the Expert finds that the Domain Name has been used in a manner which has taken unfair advantage of, *and* has been unfairly detrimental to, Thai's Rights.

7. Decision

For the foregoing reasons, the Expert finds that the Complainant, Thai, has Rights in respect of a name or mark which is similar to the Domain Name. The Expert further finds that the Domain Name, in the hands of the Respondent, is an Unfair Registration.

Pursuant to Paragraph 13 of the Policy, the Expert directs that the Domain Name be transferred to the Complainant.

Place of decision Auckland, New Zealand

Date 9 July, 2007

Expert Name Mr Warwick Smith

Signature