

ADMINISTRATIVE PANEL DECISION

Expedia, Inc., HomeAway.com, Inc. v. Steven Nicolosi, American Marketing Advisors Inc.

Case No. D2023-0953

1. The Parties

The Complainants are Expedia, Inc., and HomeAway.com, Inc., United States of America (“United States”), represented by Kilpatrick Townsend & Stockton LLP, United States.

The Respondent is Steven Nicolosi, American Marketing Advisors Inc., United States.

2. The Domain Names and Registrar

The disputed domain names <expediaconfirmation.com> and <joinvrbo.com> (individually, a “Domain Name”, and, collectively, the “Domain Names”) are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 3, 2023. On March 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On March 6, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names that differed from the named Respondent (Domains by Proxy, LLC/DomainsByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainants on March 7, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an Amended Complaint on March 8, 2023.

The Center verified that the Complaint, together with the Amended 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 3, 2023. The Respondent did not submit a response. Accordingly, the Center notified the Respondent’s default on April 12, 2023.

The Center appointed A. Justin Ourso III as the panelist in this matter on April 18, 2023. The Panel finds that it was properly constituted. 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.

4. Factual Background

The Complainants, Expedia, Inc., and HomeAway.com, Inc. (which Expedia acquired in November 2015), two American companies (each, individually, a “Complainant,” and, collectively, the “Complainants”), operate the well-known Expedia and VRBO travel and accommodations websites, respectively. These sites are among the most well-known and visited travel and accommodations web sites on the Internet.

The Complainant Expedia owns a United States registration for its EXPEDIA trademark, issued on August 27, 2002, with a first use in Class 39 in 1996 for providing travel information via global information networks, among other services, and another registration issued on April 20, 1999, with a first use in Class 42 in 1996 for providing posting and other services over global communication networks for use by travelers, among other registrations, including registrations in India, Australia, and the European Union.

The Complainant HomeAway.com owns a United States registration for its VRBO trademark, issued on March 9, 2004, with a first use in Class 35 as early as 1996 for vacation listing services, including online, and another registration issued on February 19, 2019, with a first use in Class 43 as early as 1996 for services in the nature of online travel agency services and related services, and with a first use in Class 9 in 2017 for software, downloadable software, and mobile apps for booking temporary and vacation accommodations, and related services, among other registrations, including registrations in the European Union, Canada, and China.

The Complainant Expedia is the registrant for the domain name <expedia.com>, registered on November 25, 1995, and the Complainant HomeAway.com is the registrant for the domain name <vrbo.com>, registered on July 30, 1996.

The Respondent registered both Domain Names on the same date, July 8, 2022, and at the same time, without any authorization from the Complainants. Prior to the filing of the Complaint both Domain Names resolved to websites offering travel bookings and vacation rentals and displaying the Complainants’ trademarks. Shortly before and after the filing of the Complaint, these websites were parked with the Registrar and employing pay-per-click (“PPC”) advertising for travel services and vacation rentals, among other services. During the preparation of this Decision, the Domain Names did not resolve to active, functioning websites.

5. Parties’ Contentions

A. Complainant

In addition to facts set forth in the Factual Background in Part 4 above, the Complainants contend the following.

Regarding the element of confusing similarity with a trademark in which it has rights, the Complainants contend that the Domain Names are confusingly similar to their well-known EXPEDIA and VRBO trademarks; the Domain Names each fully incorporate one of the marks; the addition of the words “confirmation” to the EXPEDIA mark and “join” to the VRBO mark do not dispel confusion, but heighten it by suggesting that the websites to which the Domain Names resolve are related to the Complainants and their services; and consumers who see the Domain Names will reasonably believe that they are related to the Complainants.

Regarding the element of rights or legitimate interests in the Domain Names, among other contentions, the Complainants contend that the Respondent registered the Domain Names long after the Complainants had established rights in their well-known trademarks, so the burden is on the Respondent to establish rights or legitimate interests in them; the Domain Names are not legitimate names of the Respondent; the Complainants have never granted the Respondent the right to use their marks; neither the Respondent, as an individual, nor the Respondent's organization is affiliated with or authorized by the Complainants to use their marks; the Respondent's selection and use of the Domain Names is no mere coincidence; the Respondent selected the Domain Names because of their notoriety to attract web traffic to the Respondent's websites offering competing vacation rental and travel services, by creating a false impression that the Respondent is affiliated with the Complainants, which is neither a legitimate use nor a *bona fide* offering of goods or services, and is not a legitimate noncommercial or fair use; this use is intended to benefit the Respondent financially or enable it to collect names and information about consumers and constitutes *prima facie* a showing that the Respondent lacks rights or legitimate interests in the Domain Names.

Regarding the element of bad faith registration and use of the Domain Name, among other contentions, the Complainants contend that the Respondent registered and is using the Domain Names in bad faith for commercial gain to benefit from the goodwill and reputation associated with their trademarks; the Domain Names fully incorporate the Complainants' trademarks, and the Respondent registered them long after the marks became well-known, which is of itself sufficient to constitute bad faith; because of the fame of the trademarks, the Respondent was fully aware of the Complainants' rights in their trademarks and targeted the Complainants by referring to "Expedia" and "VRBO" on its websites as "Our Trusted Partners"; the incorporation of the exact wording of the trademarks in the Domain Names and the references to them on the websites will cause consumers to believe that a connection exists with the Complainants, establishing a bad faith registration and commercial use by intentionally attempting to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainants' marks.

The Complainants requested transfer of the Domain Names.

B. Respondent

The Respondent did not submit a formal response to the Complaint. On May 8, 2023, during the preparation of this Decision, the Respondent sent an email stating, notably: "Please release the domains to the party of Expedia, specifically JoinVRBO.com and Expediaconfirmation.com."

6. Discussion and Findings

A. Multiple Complainants

Two Complainants filed the Complaint. In assessing the propriety of multiple complainants filing against a single respondent, panels examine whether (i) the complainants have a common grievance or common conduct by the respondent affected the complainants similarly, and (ii) it would be equitable and procedurally efficient to permit the consolidation. Rules, paragraph 10(e); WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1. The Panel finds that the Complainants are related companies, a parent and subsidiary, with a common grievance against the Respondent, whose conduct has affected them in the same way. Tellingly, the Respondent registered the Domain Names at the same time on the same day. Additionally, it would be equitable and procedurally efficient not to require that the Complainants initiate separate proceedings. Accordingly, the Panel concludes that the consolidation of the two Complainants in this proceeding is proper.

B. Multiple Domain Names

The Complainants initiated this proceeding against the Respondent for the registration and use of two Domain Names and have requested the transfer of the Domain Names. A complaint may relate to more than one domain name, provided that the same person registered the domain names. Rules, paragraph

3(c); [WIPO Overview 3.0](#), section 4.11.1. The Panel finds that the Respondent registered both Domain Names that are the subject of the Complaint and concludes that the inclusion of both Domain Names in this proceeding is proper.

C. The Effect of the Respondent's Default

If a respondent does not submit a response to a complaint, a panel decides the dispute based upon the complaint. Rules, paragraphs 5(f) and 14(a). Because a complainant has the burden of proof, Policy, paragraph 4(a), the Complainants must still prove the elements of a claim to obtain the requested relief, notwithstanding the Respondent's default. [WIPO Overview 3.0](#), section 4.3.

In the absence of exceptional circumstances, a respondent's failure to respond to a complaint requires that a panel draw the inferences from this failure that it considers proper. Rules, paragraph 14(b). The Panel finds that no exceptional circumstances exist for the failure of the Respondent to submit a response. Accordingly, the Panel infers that the Respondent does not deny the facts alleged and the contentions urged by the Complainants based upon these facts and will draw all reasonable inferences that are proper from the evidence and the facts found by the Panel. *Id.*

Although the Panel may draw negative inferences from the Respondent's default, the Complainants may not rely on conclusory allegations and must support its allegations with evidence to prove the three elements. *Id.*

D. Elements of a Claim

A complainant must prove three elements to obtain relief: (i) the domain name is identical or confusingly similar to a trademark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in the domain name; and (iii) the respondent registered and is using the domain name in bad faith. Policy, paragraph 4(a).

(i). Identical or Confusingly Similar

On the first element, the Panel finds that the Domain Name <expediaconfirmation.com> is confusingly similar to the Complainant Expedia's EXPEDIA trademark. The Domain Name incorporates the entire trademark, and the trademark is readily recognizable within the Domain Name, notwithstanding the addition of the word "confirmation" after the trademark. [WIPO Overview 3.0](#), sections 1.7 and 1.8. The Panel also finds that the Domain Name <joinvrbo.com> is confusingly similar to the Complainant VRBO's VRBO trademark. The Domain Name incorporates the entire trademark, and the trademark is readily recognizable within the Domain Name, notwithstanding the addition of the word "join" before the trademark. *Id.*

Accordingly, the Panel concludes that the Complainants have proven the first element: each Domain Name is confusingly similar to a trademark in which one of them has rights.

(ii). Rights or Legitimate Interests

The Respondent has not claimed the existence of any circumstance under the Policy, paragraph 4(c), that demonstrates that a respondent has rights to, or legitimate interests in, a domain name. The Complainants, on the other hand, have shown that they established their trademark rights long before the Respondent registered each of the corresponding Domain Names, they have not authorized the Respondent to use their trademarks, and the Respondent is not known by the mark. This is *prima facie* a showing that the Respondent lacks any rights or legitimate interests in the Domain Names under the Policy, paragraph 4(a)(ii), shifting the burden of production on this second element to the Respondent to come forward with relevant evidence proving rights or legitimate interests in the domain name. [WIPO Overview 3.0](#), section 2.1. The Respondent has not submitted any evidence to rebut the *prima facie* showing.

Additionally, the Panel finds that the Respondent masked its identity by using a privacy service; the Registrar identified the Registrant as “Steven Nicolosi,” and the Registrant organization as “American Marketing Advisors Inc.,” neither of which resemble the Domain Names, and provided an email address for the Respondent that does not resemble the Domain Names, which corroborate that the Respondent is not known by the Domain Names; the Respondent failed to respond to the Complaint; and the Domain Names formerly resolved to websites competing with the Complainants’ websites, which is not a *bona fide* commercial use, a noncommercial use, or a fair use of the Domain Names, and then resolved to PPC sites with links to competing services, and then resolved to inactive, nonfunctioning websites, which are also not a *bona fide* commercial use, a noncommercial use, or a fair use of the Domain Names.

Accordingly, the Panel concludes that the Complainants have proven the second element: the Respondent lacks rights or legitimate interests in the Domain Names.

(iii). Registered and Used in Bad Faith

The Policy provides that the following circumstance is “evidence of the registration and use of a domain name in bad faith: [. . .] by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site . . . , by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site”. Policy, paragraph 4(b)(iv).

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a well-known trademark, particularly where a respondent adds a descriptive word to the trademark, can create a presumption of bad faith registration, which here is unrebutted by the Respondent. [WIPO Overview 3.0](#), section 3.1.4. In addition to incorporating the marks in the Domain Names, the Respondent also used both well-known trademarks on each of the Respondent’s websites. The Panel, therefore, finds that the Respondent must have been aware of the Complainants’ trademarks and of their rights in their marks at the time that the Respondent registered the Domain Names and that the Respondent registered the Domain Names in bad faith. Rules, paragraph 14(b); [WIPO Overview 3.0](#), section 3.2.2.

The Respondent’s websites not only each originally displayed both of the Complainants’ trademarks, but also referred to them as “Our Trusted Partners.” In view of the Complainants’ allegation that they have not authorized the use of their marks and have no relationship with the Respondent, the Respondent’s failure to respond to the Complaint is significant. Panels have found that a respondent’s lack of an explanation, coupled with an absence of rights or legitimate interests, to be a factor tending to show bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In addition to the facts found and recited in Parts 6(D)(ii) and (iii) above, the Panel finds that the Complainants’ marks are well-known worldwide and of longstanding prior use and registration; the Respondent has not offered an explanation for selecting the Domain Names, and the Panel cannot conceive of a plausibly legitimate one; the Respondent’s websites displayed the Complainants’ well-known trademarks, expressly promoted an affiliation with the Complainants, and offered competing services, in effect passing off the sites as associated with the Complainants; and the Respondent’s sites originally appeared intended to attract, misleadingly and deceptively, customers and potential customers of the Complainants for the Respondent’s commercial gain.

In particular, the original content of the Respondent’s websites, which not only displayed both of the Complainants’ trademarks, but also referred to the Complainants as “Our Trusted Partners” and offered competitive services, demonstrates that the Respondent registered and has used the Domain Names to attract Internet users to the site for the Respondent’s own profit. The Respondent’s failure to submit a response to the Complaint confirms this finding.

All these findings, collectively, compel the Panel to conclude that the Respondent intentionally registered the Domain Names in bad faith to take unfair advantage of the Complainants’ trademarks and that the Respondent has used the Domain Names in bad faith intentionally to attract Internet users to its site for

commercial gain by creating a likelihood of confusion with the Complainant's trademarks as to the source of the sites or the source of the services offered on the sites, in violation of the Policy, paragraph 4(b)(iv).
[WIPO Overview 3.0](#), sections 3.1.4, 3.2.1, and 3.2.2.

During the preparation of this Decision, the Domain Names did not resolve to active, functioning websites. However, panels have consistently found that non-use of a domain name would not prevent a finding of bad faith, under the doctrine of passive holding, when other elements are present that demonstrate bad faith.
[WIPO Overview 3.0](#), section 3.3.

It is common knowledge that owners of websites customarily use email addresses containing the domain name of a web site in email communications. The use of a domain name that is confusingly similar to a trademark in emails that do not originate with the trademark owner presents a risk to the reputation of a trademark and its owner. Because the Respondent has not explained its intentional incorporation of globally famous trademarks in the Domain Names, and its references on the sites to the Complainants, considering that the Respondent has already engaged in deceptive conduct by operating "passing off" sites, the risk of other deceptive conduct, such as deceptive emails, is real and continuing. These facts, together with the foregoing findings, compel the Panel to find that the Respondent is using the Domain Names in bad faith.

Accordingly, the Panel concludes that the Complainants have proven the third element: the Respondent registered and is using the Domain Names in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names <expediaconfirmation.com> and <joinvrbo.com> be transferred to the Complainants.

/A. Justin Ourso III/

A. Justin Ourso III

Panelist

Date: May 10, 2023