

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Medjet Assistance, L.L.C. v. Air AmbulanceCard LLC

Case No. D2005-1152

1. The Parties

The Complainant is Medjet Assistance, L.L.C., Birmingham, Alabama, United States of America, represented by Sirote & Permutt, P.C., Birmingham, Alabama, United States of America.

The Respondent is Air AmbulanceCard LLC, Birmingham, Alabama, United States of America, represented by Donaldson & Guin, LLC, Birmingham, Alabama, United States of America.

2. The Domain Name and Registrar

The disputed domain name <medjet.com> is registered with Network Solutions, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 4, 2005. On November 8, 2005, the Center transmitted by email to Network Solutions, LLC a request for registrar verification in connection with the domain name at issue. On November 10, 2005, Network Solutions, LLC 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 November 15, 2005. In accordance with the Rules, paragraph 5(a), the due date for Response was December 5, 2005. The Response was filed with the Center on December 3, 2005.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on December 14, 2005. 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.

By e-mail of December 9, 2005, Complainant transmitted a Supplemental Filing to Complaint to the Center. By e-mail of December 14, 2005, Respondent transmitted a Response to Complainant's Supplemental Filing to the Center. Following e-mail exchange with the Center, the Panel elected to review the supplemental filings and received them by e-mail on December 19, 2005.

4. **Factual Background**

A service mark registration owned by Medjet International, Inc. for the word mark MEDJET in stylized form (Registration number 1582986, dated February 13, 1990) was canceled by the United States Patent and Trademark Office (USPTO) on March 9, 2001, pursuant to Section 8 of the Lanham Act.¹ Complaint, Annex E.

Complainant is the holder of a registration for the service mark MEDJET ASSISTANCE on the Principal Register of the USPTO, reg. no. 2,558,160, dated April 9, 2002, in international class (IC) 39, covering "transportation services; namely, emergency medical transportation services of patients by air ambulance", asserting first use and first use in commerce of June 30, 2000. Exclusive rights to use "assistance" apart from the mark as shown are disclaimed. Complaint, Annex G.

Medjet International, Inc., is the holder of a registration for the stylized word service mark MEDJET on the Principal Register of the USPTO, reg. no. 2,616,782, dated September 10, 2002, in IC 39, covering "medical transportation services, namely, emergency transportation and ambulance transportation in the form of an air ambulance", claiming first use and first use in commerce of December 17, 1987. Complaint, Annex H. This trademark was assigned to Complainant (but not yet recorded) on September 7, 2005. Complaint, Annex N.

Complainant has applied to register the word service mark MEDJETASSIST on the Principal Register of the USPTO, serial no. 76589702, dated April 30, 2004, with current TESS status noting that "An office action suspending further action on the application has been mailed." The application claims date of first use and first use in commerce of April 5, 2004. Complaint, Annex I.

Complainant acquired a nonexclusive license to use all of the trademarks and trade names of Medjet International, Inc., an Alabama corporation, (the "assignor") by bill of sale and assignment dated March 18, 1998, which bill of sale also provided that in the event of the insolvency or bankruptcy of the assignor, Complainant would acquire all of assignor's rights in the MEDJET service mark without any further act being necessary. Complaint, Annex D.

Complainant asserts that it has used the MEDJET and MEDJET ASSISTANCE marks

¹ Section 8 of the Trademark Act of 1946 (15 USC §1058) requires registration owners to pay renewal fees and submit an affidavit of continuing use (or excuse for nonuse), *inter alia*, within one year following the 10th year after registration.

since 1998, in connection with the advertising and offering for sale of medical transportation services in print media and in radio and television advertisements. Complaint, *inter alia*, Annex C, affidavit of Roy Berger. Complainant has since 1998, maintained an active commercial Internet web site offering its medical transportation services at "www.medjetassistance.com". Complaint, Annex F.

The disputed domain name, <medjet.com>, was initially registered by the founder of Medjet International, Jeffrey Tolbert, in 1995. At that time, Medjet Assistance was operated as a division of Medjet International. Response, and Complaint, Annex A (indicating record of registration for <medjet.com> created October, 17, 1995).

Complainant acquired the Medjet Assistance division of Medjet International in 1998. At that time, Complainant acquired a nonexclusive license to use the MEDJET trademark and trade name (see above). In 2002, a former employee of Medjet International, Sam Jackson, formed Respondent. Clause S. ("Stan") Bradley, current owner of Respondent, was an owner and officer of Medjet International. Response.

In May 2002, the Circuit Court of Jefferson County, Alabama, separately rejected requests from Complainant to obtain injunctions against Respondent and against Medjet International from competing against Complainant (*Medjet Assistance, LLC v. Medjet International, Inc., AirMed Assistance, LLC and Jeffrey T. Tolbert, et al.*, Civ. No. CV02-2443, May 17, 2002, Final Judgment Dismissing All Claims Against Defendant *AirMed Assistance, LLC and Medjet Assistance, LLC v. Medjet International, Inc., AirMed Assistance, LLC and Jeffrey T. Tolbert, et al.*, Civ. No. CV02-2443, May 23, 2002, Final Judgment on Plaintiff's Complaint as Amended and the Defendant Tolbert and the Defendant International's Counterclaim). Response, Annexes 4 & 5.

In September 2002, Complainant sought to purchase the disputed domain name from Medjet International as part of an agreement to end litigation between Complainant and Medjet International. Medjet International offered to sell the disputed domain name for the price of US\$75,000. Complainant declined this offer. Response, Annex 6.

As part of a settlement of litigation, and pursuant to a Mediation Agreement and Release dated November 1, 2004, Tolbert and Medjet International transferred all of their interest in the disputed domain name to Bradley, in exchange for which Bradley transferred his ownership in Medjet International to Tolbert. Medjet International debts of more than US\$200,000 to Bradley were extinguished and debts claimed from Medjet International to Respondent of approximately US\$52,000 were extinguished, and Bradley's alleged liability under a personal guarantee of a Medjet International debt for approximately US\$3 million was extinguished. Response, and Complaint, Annex K. Medjet International and Tolbert executed a Bill of Sale to Bradley dated April 3, 2005, transferring all their rights in the disputed domain name. Response and Complaint, Annex L. Bradley then transferred ownership of the disputed domain name to Respondent.

The date on which Respondent effected the transfer of registration of the disputed domain name with the Registrar does not appear on the record. The bill of sale from Medjet International to Bradley for the disputed domain name was executed on April 3, 2005 (Complaint, Exhibit L). The WHOIS database for the disputed domain name was last updated on April 21, 2005, and the change was presumably effected on or before this date. The current record of registration with the Registrar indicates that Respondent is the registrant of the disputed domain name. Complaint, Annex A.

In at least June and August 2004, Complainant proposed to purchase the disputed

domain name from Respondent. Response, Annexes 9 & 10.

Complainant purchased the active MEDJET service mark from Medjet International for US\$1000 on September 7, 2005, following a petition from Complainant to the USPTO to cancel the registration held by Medjet International. Complaint Annex N and Response.

In 2002, while Medjet International was registrant of the disputed domain name, Respondent AirMed Assistance was prominently linked on the web site maintained by Medjet International at "www.medjet.com". Respondent's Supplemental Filing to Complaint, Annex 19 and Affidavit from Samuel W. Jackson, Jr., December 2, 2005, Respondent's Annex 17 to Response.

As of October 25, 2005, the disputed domain name was used by Respondent to direct Internet users to a web page reading as follows:

"The www.medjet.com domain is owned by Air Ambulance Card TM

If you are not automatically directed to www.AirAmbulanceCard.com within 7 seconds click here." Complaint, Annex M."

The Air Ambulance Card web site, located at "www.airambulancecard.com", as of November 15, 2005 (Center verification file, item E), describes a membership program providing prepaid air medical services to its members. It makes no reference to Medjet.

By letter of September 20, 2005, Complainant through its counsel made a cease and desist and transfer demand with respect to the disputed domain name to Respondent. Complaint, Annex O. By letter of October 14, 2005, Respondent through its counsel rejected this demand, but indicated that Respondent may be willing to assign the disputed domain name if the parties could agree on a price. Complaint, Annex P. By subsequent letter erroneously dated September 20, 2005, Complainant through its counsel reiterated its cease and desist and transfer demand. Complaint, Annex Q. In this letter, Complainant's counsel observed:

"On November 4, 2004, MedJet International quit claimed *any* right, title or interest it had in the medjet.com domain name to Claude Bradley, and on April 3, 2005, MedJet International executed an assignment of the domain name to Bradley. As a result of these conveyances, Bradley received only the right and license to reserve and use the medjet.com domain. However, no trademark rights associated with the 'medjet' name were ever conveyed by Medjet International to Bradley. In fact, no mention of trademark rights is made anywhere in the documents. Thus, while AAC presumably now had the right to use the domain name, its use was limited in view of the trademark rights owned by MedJet International and MEDJET Assistance as well as the trademark rights of all third parties having marks confusingly similar to the medjet name.

[Paragraph concerning Respondent's alleged misuse of the domain name omitted.]

On September 7, 2005, MedJet International assigned to my client all right, title and interest in and to the '782 registration, along with all of its common law trademark rights in the MEDJET mark and associated goodwill. In doing so, my client acquired exclusive right and title to the

'782 registration, all common-law trademark rights in the MEDJET mark and all federal rights in the MEDJET and Design registration. Further, by virtue of its ownership of the '782 registration and AAC's infringing use of medjet.com, my client acquired the additional claim against AAC of federal trademark infringement of the '782 registration for MEDJET and Design."

Complainant has provided affidavits from nine of its employees indicating that they have received multiple telephone calls from customers who have sought to access Complainant's web site but mistakenly accessed Respondent's web site and have been redirected to Respondent's business. According to these affidavits, employees of Respondent have told some of these customers "that the companies respective services were the same and attempted to mislead the customers into believing that the Company is affiliated with AAC". These customers are alleged to subsequently have become aware of the mistake when receiving materials from Respondent that did not correspond to Complainant's promotional materials. This is said by some of Complainant's employees to have led web customers to question whether Complainant is a legitimate business. Complaint, Annexes T-BB.

The Registration Agreement in effect between Respondent and Network Solutions, LLC subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory Administrative Proceeding conducted by an approved dispute resolution service provider, of which the Center is one, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

5. Parties' Contentions

A. Complainant

Complainant asserts rights in the service marks MEDJET, MEDJET ASSISTANCE and MEDJETASSIST (hereinafter collectively the "Medjet Marks") based on registration at the USPTO and use in commerce dating collectively from 1998. See Factual Background, *supra*.

Complainant alleges that the disputed domain name is identical or confusingly similar to the Medjet Marks.

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name. It contends that Respondent has never used the disputed domain name for a *bona fide* offering of goods or services, that it has established no brand awareness in connection with <medjet.com> (which is used only to redirect Internet users to Respondent's branded web site), that Respondent has never commonly been known by the disputed domain name and that Respondent is not making legitimate noncommercial or fair use of the disputed domain name.

Complainant argues that Respondent acquired the disputed domain name in bad faith with the sole intent of using it to divert Internet users away from Complainant's web site and to Respondent's web site. It is therefore alleged to be using the disputed domain name intentionally to attract, for commercial gain, Internet users to its web site by creating a likelihood of confusion with Complainant's Medjet Marks as to source sponsorship, affiliation or endorsement of Respondent's web site by Complainant.

Complainant requests the Panel to direct the registrar to transfer the disputed domain name to it.

B. Respondent

Respondent alleges that Complainant does not hold service mark rights in MEDJET because it has registered only a stylized version of that mark. Respondent contends that Complainant could not register MEDJET as a word only mark because it is a combination of generic terms. Respondent further alleges that Complainant did not, in any case, hold exclusive service mark rights in the MEDJET mark at the time Respondent began using the disputed domain name because another party, Medjet International, also held rights in the mark and had granted a nonexclusive license with respect to the mark to Complainant.

Respondent contends that Complainant's stylized MEDJET registered trademark is not identical or confusingly similar to the disputed domain name. Respondent further contends that MEDJET ASSISTANCE and MEDJET ASSIST are not confusingly similar to the disputed domain name.

Respondent asserts that it has rights and legitimate interests in the disputed domain name. Specifically, Respondent states that it acquired the disputed domain name for substantial value from a party, Medjet International, with full right and power to convey that name to it. Further, the party so conveying the name held nonexclusive rights in the MEDJET trademark at the time it transferred the disputed domain name to Respondent, and had previously allowed Respondent to prominently link its main business web site to that maintained by Medjet International. Respondent argues that it has not used the disputed domain name in a way intended to create confusion with Complainant's business or trademarks.

Respondent observes that Complainant was well aware that in the settlement of the various legal claims arising out of the breaking up of the business of Medjet International it did not acquire the disputed domain name or any rights in it, and that it is attempting to use this proceeding as a means to accomplish what it did not accomplish through civil litigation. Respondent states that Complainant has made a number of overtures to purchase the disputed domain name from Respondent, but that the parties have been unable to agree on a price.

Respondent argues that it registered the disputed domain name in good faith and has always used the disputed domain name in good faith to sell its own goods and services. Respondent states that it has taken significant measures to assure that any customers that inadvertently enrolled in Respondent's business when intending to enroll in Complainant's business are given full refunds and redirected to Complainant.

Respondent argues that Complainant is precluded by the doctrine of laches from pursuing its claim here because Respondent has been using the disputed domain name in connection with its business for several years, the subject matter has been part of civil litigation proceedings, and that Complainant's failure to obtain the disputed domain name in those proceedings should bar its success here.

Respondent argues that a general release executed by Medjet International on November 1, 2004, in favor of Respondent, relinquishing "any and all claims, demands, causes of action in suits of every kind and nature, at law or in equity ..." and binding on Medjet International's successors and assigns, encompasses any claims Complainant may have based on the MEDJET trademark or other assets Complainant may have

acquired from Medjet International. Respondent states that Complainant acquired the MEDJET trademark registration from Medjet International in September 2005, for the sole purpose of initiating this proceeding.

Respondent requests the Panel to reject the Complainant's request for a transfer of the disputed domain name.

Respondent requests a finding of reverse domain name hijacking against Complainant.

6. Discussion and Findings

Summary of Facts and Finding

This proceeding involves a set of circumstances not typically assessed under the Policy. The facts flow from the financial unraveling of a medical transportation enterprise, Medjet International. Prior to the financial failure of Medjet International, a division was spun off, and that spinoff, MedJet Assistance, is the Complainant in this proceeding. Complainant in 1998, acquired assets and trademark rights from Medjet International, but left Medjet International with the <medjet.com> domain name, along with ownership of and continuing right to use the MEDJET service mark in connection with its business. Subsequently, a second enterprise, AirMed Assistance, was formed involving some of the principals of Medjet International, and that enterprise is Respondent. Principals of Respondent continued to have financial and business links with Medjet International. As Medjet International's financial woes deepened, it made a litigation settlement in 2004, with a principal of Respondent, Claude S. ("Stan") Bradley, Jr., that included transferring to him the disputed domain name. With nothing more left of Medjet International, Complainant, finally, in September 2005, acquired ownership rights in the registered MEDJET service mark. Complainant is here to obtain the <medjet.com> domain name from Respondent.

Throughout the financial unraveling of Medjet International, principals of Complainant, Respondent and Medjet International have been involved in litigation with each other.

The primary atypical aspect of the case is that an investor in a failing enterprise, Bradley, received the disputed domain name as a distribution from the company, Medjet International, in which he had already established a substantial financial stake. He did not receive the disputed domain name as an independent third party newly acquiring that name. When he transferred the disputed domain name to his business, Respondent, Bradley already had an interest in the domain name arising from his prior investment. The Panel finds it difficult to ascribe bad faith to this chain of events as to Respondent. It decides that Respondent has a "legitimate interest" in the disputed domain name based on the prior interest of its principal as the earlier registrant of the name. Respondent has not been shown to have "registered" the disputed domain name in bad faith.

However, the Panel notes that Respondent is now making use of the disputed domain name in a way that, from the standpoint of United States trademark law, probably infringes on the rights of the present trademark holder, Complainant. In other words, Respondent is presently using the disputed domain name in bad faith. By this decision, the Panel does not intend to suggest that Respondent should continue its current use of the disputed domain name. However, for a finding of abusive domain name registration and use, a Panel must find both that the respondent "registered" and "used" the disputed domain name in bad faith. In this atypical case, the Panel finds that the

Respondent registered the disputed domain name in good faith, but is using it in bad faith.

Discussion

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. The Panel will confine itself to making determinations necessary to resolve this Administrative Proceeding.

It is essential to dispute resolution proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them, and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)). The Panel is satisfied that Respondent had adequate notice of the proceedings and that the parties have been given adequate opportunity to participate.

Complainant and Respondent have each filed initial and supplemental submissions. Respondent raised certain issues and facts in its Response that Complainant might not reasonably have foreseen in its Complaint, and Complainant's supplemental submission is principally directed to these issues and facts. Respondent in its supplemental submission principally responds to Complainant's supplemental submission. The Panel accepts the supplemental submissions.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use, and to obtain relief. These elements are that:

- (i) respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) respondent's domain name has been registered and is being used in bad faith.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

A. Identical or Confusingly Similar

Complainant claims rights in three service marks: MEDJET, MEDJET ASSISTANCE and MEDJETASSIST. It asserts rights in the MEDJET and MEDJET ASSISTANCE marks from 1998, based on a contract with a third party, Medjet International, Inc. The 1998 contract granted Complainant a nonexclusive license to use the MEDJET mark. Medjet International, by terms of the contract, "shall continue to own the MEDJET name and retain the right to use it "simultaneously with [Complainant] in connection with [Medjet International's] medical emergency air transportation business".

Complainant secured registration of the MEDJET ASSISTANCE mark at the USPTO on April 9, 2002.

Complainant has not succeeded in registering MEDJETASSIST at the USPTO.

Complainant purchased ownership of the MEDJET service mark and registration from Medjet International on September 7, 2005.

Complainant has established rights in the MEDJET ASSISTANCE mark based on registration at the USPTO and evidence of use in commerce included with the Complaint. Those rights arose as early as June 30, 2000, which is the date of first use claimed in its service mark application. Principally because the USPTO has so far rejected registration of MEDJETASSIST, the Panel finds that Complainant has not succeeded here in establishing rights in the MEDJETASSIST mark.

Complainant has established rights in the service mark MEDJET based on assignment of all rights in the mark and the service mark registration from Medjet International of September 7, 2005. Prior to that date, Complainant was nonexclusive licensee of the MEDJET mark from Medjet International, an independent third party. Medjet International owned the MEDJET mark until September 7, 2005, with rights to continue using the mark in connection with its medical air transportation business.

Complainant asserts common law trademark rights in the MEDJET mark from 1998, when the license contract with Medjet International was concluded and it began to use the name in connection with its business. However, Medjet International was acknowledged to be the "owner" of the trademark, and therefore to have exclusive rights to control the use of the mark. It is problematic for Complainant to simultaneously assert independent common law rights in the mark. Complainant derived its service mark rights from Medjet International as a licensee. It could not separately establish common law rights because service marks are understood to be exclusive to their owner and Medjet International had registered the MEDJET mark.

Complainant has rights in the service mark MEDJET ASSISTANCE. The disputed domain name is <medjet.com>. MEDJET ASSISTANCE adds the term "assistance" to MEDJET. The term MEDJET is a combination of an abbreviation of the term "medical" with the term "jet". The combination has a meaning of "medical jet" which is descriptive of the use of the term made by Complainant. The additional noun "assistance" conveys the further meaning of aiding or providing help to the term "MEDJET." This does not result in a significant change of meaning. The sound and appearance of <medjet.com> and MEDJET ASSISTANCE are different, but an Internet user nonetheless might be confused by the domain name since it incorporates the principal term of the service mark. The Panel considers that <medjet.com> is confusingly similar to MEDJET ASSISTANCE, but this conclusion is subject to a limitation.

The special circumstance in this case is that while the disputed domain name is confusingly similar to Complainant's service mark, MEDJET ASSISTANCE, Complainant could not have opposed this mark to the disputed domain name prior to the date on which the original registrant transferred its registration. Prior to the date Medjet International transferred the disputed domain name to Respondent, the owner of the service mark (with rights to use it) and the disputed domain name were the same party. Complainant could not have successfully made a claim based on ownership of MEDJET ASSISTANCE against Medjet International (and <medjet.com>) because Medjet International had full rights to use the disputed domain name. Medjet International assigned the disputed domain name to the Respondent by agreement of November 1, 2004, and executed a bill of sale dated April 3, 2005. After those dates, Complainant could have pursued a claim against Respondent on the basis of MEDJET ASSISTANCE (in which Complainant held exclusive rights) if Respondent did not

have Medjet International's permission to use the MEDJET mark in connection with Medjet International's business. Respondent appears to indicate by affidavit that it did not associate itself with Medjet International after 2004 (Response, Annex 17, affidavit of Jackson). The Panel concludes that the disputed domain name is confusingly similar to Complainant's MEDJET ASSISTANCE mark, but that it is opposable to Respondent and the disputed domain name only from April 3, 2005.

Complainant had some "rights" in the MEDJET mark from 1998. Up until September 7, 2005, it had the rights of a nonexclusive licensee. However, the Panel is disinclined to accept that Complainant was in a position to enforce rights in the MEDJET mark as against Respondent and the disputed domain name prior to April 3, 2005. Respondent acquired the disputed domain name from Medjet International in transactions which were initiated on November 1, 2004, and which culminated with a bill of sale dated April 3, 2005. Medjet International was the owner of the MEDJET mark at that time and had the right to use and transfer the disputed domain name to Respondent (and its predecessors). Complainant could not have succeeded on a claim against the disputed domain name while it was in the hands of Medjet International.

Complainant is the exclusive owner of rights in the MEDJET service mark from September 7, 2005, with rights opposable to Respondent as early as April 3, 2005. In theory, Medjet International might have allowed Respondent to make use of the MEDJET mark up until September 7, 2005, such as by licensing back use of the disputed domain name to Medjet International, but Respondent has indicated that it ceased doing business with Medjet International by the end of 2004 (see affidavit of Jackson, *supra*), so this option does not appear to have been exercised. Therefore, the effective date of opposition by Complainant is deemed to be April 3, 2005.

The Panel does not accept Respondent's argument that "MEDJET" is a generic term for medical evacuation services. The USPTO has accepted the service mark for registration, and the Panel is disinclined to upset the determination that the mark is capable of registration absent a substantial showing of evidence by Respondent. Respondent has cited an instance of another medical transportation service using a similar domain name (<medjets.com>) to identify a business with a substantially different name (Air Trek Inc.) as proof that the term "MEDJET" is generic. The Panel does not consider this sufficient evidence that the term "MEDJET" is generic. The holder of rights in the trademark MEDJET might have a valid and not yet pursued claim against the registrant of the similar domain name. Nor does the panel consider that the combination of an abbreviation for a generic term (i.e., "med" for "medical") and the generic term for a form of transport (i.e., "jet") necessarily or even presumptively creates another generic term. Finally, the fact that Complainant has registered a stylized word mark and not a word mark alone is not sufficient evidence that the word mark would be non-registrable because it is generic. Respondent has not submitted evidence of any USPTO action rejecting an application for a non-stylized word mark. A stylized word mark may be confusingly similar to a domain name. In this case, the Panel determines that the disputed domain name is confusingly similar to the MEDJET mark, but as noted above, Complainant's rights in that mark as against Respondent were not effective until April 3, 2005.

In summary, the Panel determines that Complainant has rights in the service marks MEDJET ASSISTANCE and MEDJET, and that the disputed domain name is confusingly similar to those marks, but that Complainant's rights in the marks are opposable to Respondent only subsequent to April 3, 2005.

B. Rights or Legitimate Interests

The second element of a claim of abusive domain name registration and use is that the respondent has no rights or legitimate interests in respect of the domain name (Policy, paragraph 4(a)(ii)). The Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.” (Policy, paragraph 4(c)).

Respondent acquired the disputed domain name in settlement of litigation with its prior registrant, Medjet International, in accordance with the agreement dated November 1, 2004. A bill of sale for the domain name was executed by Medjet International on April 3, 2005, and Respondent became the registrant on or before April 21, 2005. During that period, Medjet International owned the MEDJET trademark and a nonexclusive right to use it in connection with its business.

There is no evidence that Medjet International conveyed any service mark rights to Respondent in connection with the November 1, 2004 transaction. However, prior to that date, Medjet International had permitted Respondent to place a link on the web site of Medjet International which was identified by the disputed domain name, which was then registered by the service mark owner, Medjet International.

Paragraph 4(c) includes a nonexhaustive listing of the ways that a respondent may establish rights or legitimate interests in a domain name. The panel grounds its finding of legitimate interests on the part of Respondent outside the express listing in subparagraphs 4(c)(i)-(iii).

The Panel finds that Respondent has a legitimate interest in the disputed domain name because (a) one of its principals was a substantial investor in the initial registrant and transferor of the name, which registrant and transferor had rights in a service mark identical to the name, and (b) Respondent’s principal and transferee received the disputed domain name as a distribution of assets from the initial registrant and transferor, which transfer occurred when the initial registrant and transferor was financially failing, had limited assets and the right to transfer the disputed domain name. Respondent derives its legitimate interest in the disputed domain name from its prior financial interest in the initial registrant and service mark owner. Respondent acquired a continuing legitimate interest in the disputed domain name.

Complainant has failed to establish that Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates that certain circumstances, “in particular but without limitation” ... “shall be evidence of the registration and use of a domain name in bad faith” (Policy, paragraph 4(b)). Among these circumstances are that a respondent “by using the domain name, [has] intentionally attempted to attract, for commercial gain, Internet users to [its] web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [respondent’s] web site or location or of a product or service on [its] web site or location” (*id.*, paragraph 4(b)(iv)). This is the ground relied on by Complainant here.

Complainant argues that Respondent’s use of the disputed domain name (which is confusingly similar to Complainant’s marks) to redirect Internet users to Respondent’s commercial web site is evidence that Respondent acquired and registered the disputed domain name in bad faith.

Respondent is using the disputed domain name to redirect Internet users to its commercial web site at “www.airambulancecard.com.” The message at “www.medjet.com,” displayed prior to the redirection taking effect, reads:

“The www.medjet.com domain is owned by Air Ambulance Card TM

If you are not automatically directed to www.AirAmbulanceCard.com within 7 seconds click here.”

Respondent argues that its redirection page includes accurate information concerning the owner of the disputed domain name. However, it is unlikely that this information, as stated, is adequate to cure confusion among Internet users who are not familiar with both Complainant and Respondent. Respondent is using the disputed domain name to redirect Internet users to its own web site unconnected with Complainant, and is creating confusion as to the source, sponsorship, affiliation or endorsement of its web site. It is doing this for commercial gain.

Ordinarily, use of a disputed domain name to create confusion is evidence of bad faith registration and use under paragraph 4(b)(iv) of the Policy. However, the Panel has previously determined that Respondent acquired a legitimate interest in the disputed domain name at the time it was received. In the atypical circumstances of this case, the Panel finds that, despite evidence of current misuse of the disputed domain name, Respondent “registered” the disputed domain name in “good faith”, but is using it in “bad faith”. Because the Policy requires both bad faith registration and use for a finding of bad faith, the Panel finds that Complainant has not carried its burden of proving bad faith under paragraph 4(b) of the Policy.

Because Complainant has failed to establish that Respondent has no rights or legitimate interests in the disputed domain name, and has failed to establish that Respondent registered the disputed domain name in bad faith, the Panel finds that Complainant has not succeeded in proving abusive domain name registration. Hence, the Panel will not direct the Registrar to transfer the disputed domain name to Complainant.

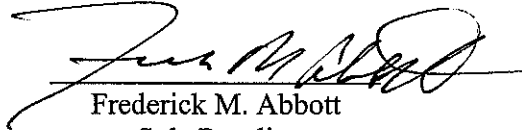
However, the Panel cautions Respondent against reading this decision as approval of its

current use of the disputed domain name. It appears likely that Respondent is infringing service mark rights of Complainant. It happens that the Policy does not capture all forms of trademark infringement. This does not preclude Complainant from pursuing an action for infringement in the courts.

The panel declines to make a finding of reverse domain name hijacking in favor of Respondent.

7. Decision

For all the foregoing reasons, the Complaint is denied.



Frederick M. Abbott
Sole Panelist

Dated: December 30, 2005