

DISPUTE RESOLUTION SERVICE

D00010398

Decision of Independent Expert

Advance Magazine Publishers, Inc

and

sheng zhong

1. The Parties:

Lead Complainant: Advance Magazine Publishers, Inc
Four Times Square
23rd Floor
New York
NY
10036
United States

Complainant: The Conde Nast Publications Limited
Vogue House
Hanover Square
London
W1S 1JU
United Kingdom

Respondent: sheng zhong
BIG TREE STREET
Hong Kong
20 075
Hong Kong

2. The Domain Name(s):

fashionsnightout.co.uk (“the Domain Name”).

3. Procedural History:

The Complaint was submitted to Nominet on 14 October 2011 and was validated on the same date. On 19 October 2011, Nominet sent the notification of complaint to the parties. The Respondent was informed in the notification that it had 15 working days, that is, until 9 November 2011 to file a response to the Complaint. No response was received and accordingly on 10 November 2011 Nominet invited the Complainant to pay the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Dispute Resolution Service Procedure Version 3 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 3 ("the Policy"). On 14 November 2011, the Complainant paid the fee for an expert decision. On 18 November 2011, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 18 November 2011.

4. Outstanding Formal/Procedural Issues

The Respondent has failed to submit a response to Nominet in time in accordance with paragraph 5(a) of the Procedure.

Paragraph 15(b) of the Procedure provides *inter alia* that "If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint."

Paragraph 15(c) of the Procedure provides that "If in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate." In the view of the Expert, if the Respondent does not submit a response, the principal inference that can be drawn is that the Respondent has simply not availed himself of the opportunity to attempt to demonstrate that the Domain Name is not an Abusive Registration. This does not affect the primary requirement upon the Complainant, on whom the burden of proof rests, to demonstrate Abusive Registration, nor does it in the Expert's view entitle an expert to accept as fact all uncontradicted assertions of the Complainant, irrespective of their merit.

5. Factual Background

The Lead Complainant is a US corporation and the Complainant is an England and Wales company which is owned and controlled by the Lead Complainant. Together, the Complainants are part of the US based Advance Magazine group of companies, one of the world's most prominent publishing and media companies, whose famous magazine titles include *Vogue*,

Glamour, GQ, Wired, Gourmet, Conde Nast Traveller, The New Yorker and Vanity Fair.

In 2009 the Complainants, in conjunction with their magazine *Vogue*, originated and organised a series of worldwide promotional events which took place under a name and trade mark devised by the Complainants, namely FASHION'S NIGHT OUT. The first such events took place in September 2009 in various cities across the world including New York, Paris, Milan, Beijing and London. The events were held again on a larger scale in September 2010 and recently on a still larger scale in September 2011. The events have attracted considerable publicity since inception.

The Lead Complainant is the owner of various registered trade marks for the word mark FASHION'S NIGHT OUT including (1) European Community Trade Mark no. 8302051, filed on 14 May 2009 and registered on 28 January 2010 in classes 16, 35 and 41; and (2) European Community Trade Mark no. 8402034, filed on 2 July 2009 and registered on 22 February 2010 in classes 14, 18, 21 and 25.

The Domain Name was registered on 6 October 2009. It is presently in a suspended status and thus has no website associated with it. Furthermore, there is no evidence before the Expert that the Domain Name has ever had a website associated with it.

6. Parties' Contentions

Complainants

The Complainants contend that the Domain Name is identical to a name and mark in which the Complainants have rights and that the registration of the Domain Name was and continues to be abusive.

The Complainants assert that, by the date of the registration of the Domain Name, the Complainants enjoyed a substantial goodwill and reputation under the name and trade mark FASHION'S NIGHT OUT in the UK and worldwide such that this name or mark was synonymous with the Complainants and their events, and that it continues to be so. The Complainants submit that they invested heavily in promotion for the 2009 FASHION'S NIGHT OUT events and organised significant pre-event publicity. The Complainants note that more than 100 stores participated in the London 2009 FASHION'S NIGHT OUT event and that it attracted several thousand visitors. The Complainants state that their advertising and marketing expenditure for promoting the London 2009 FASHION'S NIGHT OUT event was approximately £20,000.

The Complainants note that the Domain Name was registered a few weeks after the Complainants' first FASHION'S NIGHT OUT events were held in September 2009. The Complainants state that they gave no permission to the Respondent or anyone else to register or use the Domain Name. The

Complainants submit that the timing of the registration of the Domain Name indicates that it was registered in full knowledge of the Complainants and their use of the FASHION'S NIGHT OUT name and trade mark. The Complainants assert that this is strong evidence that the Respondent's primary purpose in registering the Domain Name was for it to act as a blocking registration against the Complainants' name and trade mark and/or at some time of the Respondent's choosing, to sell the Domain Name to the Complainants or indeed one of their competitors for a substantial consideration, or otherwise unfairly to disrupt and interfere with the Complainants' business under their FASHION'S NIGHT OUT name and trade mark.

The Complainants note that there is no website currently associated with the Domain Name and that they have no knowledge of any web site previously associated with it. The Complainants assert that it is plain that in addition to its purpose as a blocking registration, the Domain Name was registered with the purpose of using or threatening to use it in a way likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainants.

The Complainants submit that they have identified other domain names registered to the Respondent at the same address, each containing the famous trade mark TIFFANY, namely, fabuloustiffany.info, besttiffany.info and besttiffanyonline.co.uk. The Complainants further assert that the owners of the TIFFANY trade mark have raised an action against the Respondent in the United States District Court for the Southern District of Florida in relation to the registration of a large number of other domain names incorporating the mark TIFFANY, in which case the Plaintiff has filed for a Final Default Judgment (evidence provided). The Complainants assert that those proceedings and the Respondent's failure to respond to them provides additional evidence of abusive behaviour in the present case.

The Complainants state that the address provided by the Respondent and which is listed against the Domain Name is false and that this falsity is further evidence that the Domain Name was and is abusive. The Complainants assert that mail bearing the address was returned (evidence provided) and that no such address exists or existed in October 2009 when the Domain Name was registered. The Complainants state that there is no "Big Tree Street" in Hong Kong according to Google Maps. The Complainants assert further that the address given is not in a format which has ever been used in Hong Kong and in particular, Hong Kong does not, and did not at the time, use postal codes (evidence provided).

The Complainants note that the Domain Name was suspended at the request of the Metropolitan Police following police enquiries and further state that the Metropolitan Police have indicated to the Complainants that they will cooperate in any transfer of the Domain Name to the Complainants.

Respondent

The Respondent has not filed a response.

7. Discussions and Findings

General

In terms of paragraph 2(b) of the Policy the primary onus is on the Complainants to prove to the Expert on balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely 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 Abusive Registration.

Complainants' Rights in the name or mark FASHION'S NIGHT OUT

Paragraph 1 of the Policy provides that Rights "means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning".

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Under English Law, rights in a name or mark can be protected by registered trade marks, or unregistered rights such as the entitlement to bring a claim for passing off to protect goodwill inherent in any such name or mark.

In the present case, the Complainants have demonstrated to the satisfaction of the Expert that the Lead Complainant is the owner of two European Community Trade Mark registrations for the word mark FASHION'S NIGHT OUT, as listed in the Factual Background section above. While the Complainants candidly state that the Domain Name was registered after the filing of the Lead Complainant's trade marks but before their respective dates of registration, it is not a requirement of paragraph 1 of the Policy that the Rights relied upon by a complainant must have been enforceable prior to the date of registration of a domain name. It is sufficient if, as in the present case, the Rights are enforceable at the date of filing of the Complaint.

In addition to their submissions regarding registered trade marks, the Complainants assert that they had established earlier rights in FASHION'S NIGHT OUT in terms of the goodwill and reputation in the UK, and many other countries, which they had established through their use of the mark. The Complainants' first FASHION'S NIGHT OUT events were held in September 2009. The Complainants have provided evidence that the events were the subject of substantial pre-publicity, along with extensive press coverage thereafter. The Complainants also make the unchallenged assertion that their advertising and marketing expenditure for the London 2009 event amounted to a substantial sum, namely £20,000. On the basis of the totality of this evidence, the Expert is satisfied that the Complainants had built sufficient goodwill to constitute enforceable rights in the then unregistered mark

FASHION'S NIGHT OUT no later than September 2009. To the extent that FASHION'S NIGHT OUT is a mark composed of ordinary English words and may be considered by some to be a descriptive phrase, the Expert also finds that the phrase acquired a secondary meaning which was associated with the Complainants and their commercial activities by September 2009.

For the purposes of comparison between the Complainants' registered and unregistered marks and the Domain Name, the first (.uk) and second (.co) levels of the Domain Name are disregarded as being wholly generic. Likewise, white space in the marks is not of any significance as it is not permissible to have spaces in a domain name. Accordingly, on the basis of this comparison, the Expert finds that the Complainants have Rights in a name or mark which is identical to the Domain Name.

Abusive Registration

Paragraph 1 of the Policy defines "Abusive Registration" as 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 used in a manner, which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

This general definition is supplemented by paragraph 3 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

The Complainants have pled a detailed case in which their submissions cover the following paragraphs of the Policy:- 3(a)(i)(B) - registration primarily for the purpose of a blocking registration against the Complainants' mark; 3(a)(i)(A) - registration primarily for the purpose of selling the Domain Name to the Complainants or one of their competitors for valuable consideration in excess of the Respondent's out of pocket costs; 3(a)(i)(C) - registration primarily for the purpose of unfairly disrupting the business of the Complainants; 3(a)(ii) - Respondent using or threatening to use the Domain Name in a way likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainants; 3(a)(iii) - the Respondent is engaged in a pattern of domain name registrations which correspond to well known names or trade marks in which the Respondent has no apparent rights and the Domain Name is part of that pattern; and 3(a)(iv) - independent verification that the Respondent has given false contact details to Nominet.

Despite their extensive submissions, the truth of the matter is that the Complainants do not know what exactly the Respondent's purpose was in

registering the Domain Name, given (1) there is no evidence that the Respondent has used the Domain Name in connection with any website, (2) the Domain Name is in any event suspended and thus not in use at present, and (3) the Respondent has neither communicated with the Complainants nor filed any response in the present proceeding.

While the Complainants assert that the Respondent is engaged in a pattern of registrations within the meaning of paragraph 3(a)(iii) of the Policy, namely the TIFFANY domain names *fabuloustiffany.info*, *besttiffany.info* and *besttiffanyonline.co.uk*, there is no evidence before the Expert which demonstrates that the Domain Name is necessarily part of the same pattern as required by the Policy. For example, the TIFFANY domain names were not registered at the same time as the Domain Name but were each registered on 7 September 2009. Equally, while the Complainants state that the Domain Name was suspended at the request of the Metropolitan Police, a fact which might have established that the Domain Name was an Abusive Registration depending upon the reasons why such suspension was sought, this submission is made without any supportive evidence or mention of the reasons for such suspension.

Nevertheless, the Expert is prepared to find on the balance of probabilities that the Domain Name is an Abusive Registration in the hands of the Respondent for the following reasons. First, the proximity of the date of registration of the Domain Name to the date of the first FASHION'S NIGHT OUT events, which were clearly successful and the subject of extensive reporting, is consistent with the submission that the Respondent registered the Domain Name with intent to take unfair advantage of the Complainants' Rights. Secondly, the existence of the TIFFANY domain names, while not demonstrated to be a pattern within the meaning of paragraph 3(a)(iii) of the Policy, is likewise supportive of the notion that the Respondent probably intended to take unfair advantage of the Complainant's Rights. Accordingly, this is a further factor pointing in the direction of Abusive Registration.

Finally, there is the Complainant's assertion regarding the Respondent's alleged provision of false contact details to Nominet. This submission is made in accordance with paragraph 3(a)(iv) of the Policy. The requirements are discussed in the Experts' Overview at paragraph 3.6 as follows:-

What is required for independent verification under paragraph 3(a)(iv) of the Policy?

Delivery service or post office certification will certainly suffice, but it is not necessary to obtain formal verification. An authoritative letter, email or note from a third party explaining how the contact details are known to be false will usually suffice.

In the present case, the Complainants have made a variety of submissions regarding the Respondent's contact details and have produced a range of supportive evidence. In the first place, the Complainants produce a copy of a letter posted to the Respondent at the contact details concerned. This was

returned by the relevant postal authorities marked “incomplete address”. It is clear to the Expert from the case file that Nominet’s letter to the Respondent was also returned on the same basis. This of course indicates incompleteness rather than absolute falsehood of contact details although having seen many such returned envelopes the Expert is doubtful as to whether the postal authorities take care to distinguish between incomplete and false addresses, even though the official stamp evidently contains a ‘tick box’ for either option.

Secondly, the Complainants note that Google Maps does not show any “Big Tree Street” in Hong Kong. The Expert is not aware of the comprehensiveness of Google Maps’ coverage of Hong Kong. However, the Expert is prepared to accept that this too is at least indicative of the fact that the address may be false.

Finally, the Complainants produce an extract from Hong Kong Post’s website providing instructions for addressing mail to that country. This document expressly states that there is no post code system in place for Hong Kong. The Complainants note that the Respondent however provided a post code to Nominet which, on that basis alone, must be false.

Clearly none of this material constitutes a formal verification however, as the Experts’ Overview notes, this is not strictly necessary. The Overview provides that an authoritative note from a third party will suffice, and in the opinion of the Expert, the Hong Kong Post document, taken with the returned envelopes, has the requisite degree of independence and authority. The Expert accordingly considers that the Complainants have demonstrated on the balance of probabilities that the Respondent has provided false contact details to Nominet. Clearly this in itself is evidence that the Domain Name is an Abusive Registration.

8. Decision

The Expert finds that the Complainants have proved that they have Rights in a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name be transferred to the Lead Complainant.

Signed
Andrew D S Lothian

Dated 29 November, 2011
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