

DISPUTE RESOLUTION SERVICE

D00011439

Decision of Independent Expert

Yahoo! Inc

and

rexis

1. The Parties:

Lead Complainant: Yahoo! Inc
Byron House, Cambridge Business Park, Cowley Road
Cambridge
Cambridgeshire
CB4 0WZ
United Kingdom

Respondent: rexis
36 Waterman Way
London
London
E1W 2QN
United Kingdom

2. The Domain Names:

yahoo-auctions.co.uk
yahooauctions.co.uk

3. Procedural History:

12 June 2012 16:22 Dispute received
13 June 2012 09:18 Complaint validated
13 June 2012 09:28 Notification of complaint sent to parties

20 June 2012 08:24 Response received
20 June 2012 08:25 Notification of response sent to parties
25 June 2012 02:30 Reply reminder sent
28 June 2012 09:22 No reply received
28 June 2012 09:23 Mediator appointed
03 July 2012 10:28 Mediation started
29 August 2012 17:20 Mediation failed
29 August 2012 17:24 Close of mediation documents sent
04 September 2012 10:48 Expert decision payment received

4. Factual Background

The Complainant is the operator of the well-known search engine and web portal Yahoo! Inc, incorporated in California, US. The Complainant and its predecessors have traded under the name “Yahoo!” since 1994.

The Complainant owns many trade mark registrations for the word “YAHOO!” including Community Trade Mark no. 2003150 dated 1 April 1996 in classes 9, 14, 16, 18, 21, 28, 35, 41, 42.

The Respondent registered the Domain Names on 30 May 2002.

As of 23 April 2012, the Domain Names resolved to www.rexis.co.uk, the website of REXIS Auto Export Ltd, an exporter of vehicles from Japan to the UK.

Following communications between the parties on unspecified dates, both Domain Names were pointed by the Respondent to the Complainant’s own website at www.yahoo.com.

5. Procedural Issues

The Response opens by stating that the Respondent “could not see the complaint from Louise on this site hence I am not sure of the exact point she is making here”. This suggests that the Respondent had not actually seen the Complaint by the time that the Response was submitted.

In accordance with paragraph 2(a) of the Procedure (which entitles Nominet to serve the Complaint by any of the means specified therein), on 13 June 2012 Nominet sent its Complaint-notification letter plus a copy of the Complaint by email to the registrant’s email address and to “postmaster@[Domain Name]”. Nominet’s online account shows that these emails bounced back.

Nominet also sent a hard copy of the letter by post and it seems likely that it was this version which prompted the Respondent’s above comment in its Response. While I understand that the hard copy letter would not have included a copy of the Complaint itself, the letter did state:

“To view and respond to the complaint, you will need to log into online services at www.nominet.org.uk/go/login. After logging in, click on 'Dispute Resolution Service'. If you need help accessing online services, please contact us on 01865 332248 or email us at drs@nominet.org.uk quoting the DRS reference number at the top of this email/letter.”

Therefore, if the Respondent had not yet seen the Complaint, and wanted to do so, it could easily have achieved this by simply contacting Nominet as advised in the letter. However, the Respondent seemed happy to file its Response without seeing the Complaint and, instead, to base its defence on a brief rebuttal of prior correspondence from the Complainant. That may have been an unwise decision but it was the Respondent's prerogative. Accordingly, in these circumstances, I did not consider there was any reason for me to order that the Respondent be reserved with the Complaint and given an extension of time to respond (which, in any case, the Respondent had not requested).

6. Parties' Contentions

Complaint

The Complainant makes the following points;

The Complainant is a leading global brand and household name, attracting more than half a billion consumers every month in more than 30 languages. It grew at a rapid pace after it was founded in 1994 and, like many search engines and web directories, soon diversified into the now well-known web portal.

Today, the Complainant is a leading global internet communications, commerce and media company that offers a branded network of services to more than 245 million individuals each month worldwide.

The Complainant's offerings include both local and international web directory and search services covering a wide variety of subjects, including music, website design and web hosting services, games, people searches, astrology and horoscopes, clubs, greetings, corporate network software and services, travel related services, real estate and mortgage information and quotes, movie reviews, news, weather, sports, yellow pages, maps, auctions, message boards, and various types of entertainment. In connection with many of these services, the Complainant uses the "Yahoo!" brand name in conjunction with the descriptive name of the relevant services.

The "Yahoo!" brand has been listed by the INTERBRAND survey in the top 100 global brands in 2009 to 2011.

The Complainant's mark is inherently very strong and distinctive and the mark has acquired an enhanced distinctive character through the high profile use which has been made on a significant global scale.

The Complainant's earlier rights are confusingly similar to the Domain Names. The Complainant operates in the digital media field. Online auctions are very common. There is no doubt that any relevant consumer seeing the Domain Names would assume that they relate to a service provided by the Complainant.

The Domain Names are abusive registrations under the paragraphs 3(a)(i)(A), 3(a)(i)(B), 3(a)(i)(C) and 3(a)(ii) of the DRS Policy.

There was no legitimate reason for the Respondent to register the Domain Names except to benefit in some way from the Complainant's well known mark by either attempting to sell, rent or otherwise transfer the Domain Names to the Complainant, and/or by using them to refer to the Complainant, and/or to interrupt the Complainant's business in the UK and/or to block registration by the Complainant. Furthermore, the Domain Names have been used in a number of ways which are likely to confuse people and businesses into believing that they are owned by the Complainant or in some way connected to the Complainant.

There was no legitimate reason for the Respondent to redirect the Domain Names to, and so use them in connection with, the site of Rexis Auto Export Ltd.

A letter was sent to the Respondent by the Complainant and a brief response received. Subsequent to further correspondence the Respondent suggested that he would be happy to entertain a dialogue if the Complainant were offering to buy the Domain Names. This further supports the claim that the Respondent may have registered the domain for the sole purpose of selling, renting or otherwise transferring the Domain to the Complainant.

Following redirection of the Domain Names to the website of the Complainant, consumers and businesses would undoubtedly consider the Domain Names to be owned by the Complainant.

Furthermore, in view of the extremely distinctive nature of the Complainant's trade mark, and its fame, there is no way in which the Respondent could use the Domain Names without falling foul of paragraph 3(a)(ii) of the DRS Policy.

The Complainant draws attention to DRS decisions 821, 1694, 2431 and 6334. In each case, the domains registered (yahho.co.uk, yahoopersonals.co.uk, yahoo-finance.co.uk and yahooo.co.uk) were found to be abusive.

Response

The Response is brief and is reproduced here in full:

"I could not see the complaint from Louise on this site hence I am not sure of the exact point she is making here.

I would however refer to my mail to her on the 13th March of this year to which I have had no response. In this mail I asked under what basis I was being requested to relinquish my registration of said domains.

It is my view that:

- I registered the domains in good faith many years ago
- Any other person / organisation had equal opportunity to register the domains prior to that time
- By registering the domains I do not purport to be acting on behalf of Yahoo, indeed the domains are to all intents and purposes dormant therefore no harm whatsoever is possible to the Yahoo brand as a result of my registration
- Furthermore, it is my understanding that Yahoo operates no auction sites in any English language speaking countries, hence the domains refer to a product that is not offered

So in essence I am not sure exactly why Louise is going to such lengths to threaten me with various legal processes and has hence far failed to answer my very simple questions regarding her claim.

I look forward to any light you may be able to throw on the matter.”

7. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Names and, second, that the Domain Names, in the hands of the Respondent, are abusive registrations (as defined in paragraph 1 of the DRS Policy).

Complainant's rights

The meaning of “rights” is clarified and defined in the Policy in the following terms:

“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 Complainant clearly has rights in the name “Yahoo!” arising from its extensive worldwide use as well as from its registered trade marks for that term.

The Domain Names differ from the trade mark only by omission of the exclamation mark (which cannot be replicated in a domain name) and addition of the suffixes “auctions” and “-auctions”. Those generic terms in no way distinguish the Domain Names from the trade marks. On the contrary, they are suggestive of auction sites operated by the Complainant.

I conclude that the Complainant has established rights in a name or mark which is similar to both of the Domain Names.

Abusive registration

Are the Domain Names an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”*

Both the Complainant and the Respondent rely to some extent on the pre-action correspondence between the parties. However, neither party has seen fit to exhibit that correspondence. This is unfortunate as Experts should be given as full a picture as possible of pre-action dealings between the parties. In any case, I am unable to reach any conclusion based on alleged correspondence which has not been provided to me.

The Respondent asserts that “[a]ny other person/organisation”, presumably including the Complainant, could have registered the Domain Names before it did so. But the fact that a complainant does not, for whatever reason, register a particular version of its trade mark as a domain name, in no way justifies a third party stepping in and doing so.

It is obvious that the Respondent was aware of the Complainant's well-known trade mark when it registered the Domain Names and indeed it does not deny this.

While the Respondent claims that it registered the Domain Names in good faith, the Response notably lacks any attempt by the Respondent to explain exactly why it selected the Domain Names.

The Respondent formerly used the Domain Names to resolve to a car import website and so it may well be that the Respondent had in mind to capitalise on internet users intending to buy motor vehicles from an auction site which they thought was operated by the Complainant. If so, in my view it is irrelevant if, as the Respondent claims, the Complainant does not operate any auction site in English-language speaking countries. The Complainant offers a wide and varied range of online products and services and it would not be in the least surprising if a significant number of people assumed that it also operated an auction site. And the fact that, having been confronted by the Complainant, the Respondent without explanation pointed the Domains at the Complainant's own site is in my view something of an admission by the Respondent that its previous use had been abusive.

The Respondent argues that the Domain Names are “to all intents and purposes dormant” and therefore of no possible harm to the Complainant. Even if pointing the Domain Names to the Complainant's site were to render them “to all intents and purposes dormant”, the Respondent could not by taking such a step evade responsibility for its previous misuse of the Domain Names or indeed wipe out any illicit intent which it possessed at the time of registration.

Another possibility is that Respondent's dominant purpose was to sell the Domain Names to the Complainant for a substantial profit, as the Complainant asserts.

In conclusion, I do not consider it is necessary to make a finding under any of the specific non-exhaustive factors evidencing abusive registration in paragraph 3(a) of the Policy. Whatever the Respondent's exact purpose, I think it reasonable to infer in the circumstances of this case, including the famous and highly distinctive nature of the Complainant's mark and the absence of any explanation by the Respondent for the registrations, that the Respondent registered the Domain Names in order to take unfair advantage of the Complainant's rights in some manner.

8. Decision

I find that the Complainant has rights in a mark which is similar to each of the Domain Names and that the Domain Names are, in the hands of the Respondent, abusive registrations. I therefore direct that the Domain Names be transferred to the Complainant.

Signed: Adam Taylor

Dated: 5 October 2012