

Nominet UK Dispute Resolution Service

DRS 14995

The Spamhaus Project Ltd.

and

Top Store

Decision of Independent Expert

1 Parties

Complainant: The Spamhaus Project Ltd.

Address: 26 York Street
London

Postcode: W1U 6PZ

Country: United Kingdom

Respondent: Top Store

Address: Unit 3b, Telmere Industrial Estate
Luton
Bedfordshire

Postcode: LU1 3QF

Country: United Kingdom

2 Domain name

<spamhaus.co.uk>

3 Procedural History

- 3.1 On 4 November 2014 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet notified the respondent the next day. The respondent’s response was received on 13 November 2014, and the complainant’s reply later on the same day. The matter was not resolved in mediation. The complainant requested referral of the matter for expert decision under the Procedure, and on 24 November 2014 paid the applicable fee.
- 3.2 I was appointed as expert on 28 November 2014. I have made the necessary declaration of impartiality and independence.

4 Factual background

- 4.1 The complainant is an internet “anti-spam” organisation.
- 4.2 The respondent registered the domain name on 23 December 2003.

5 Parties’ Contentions

Complainant

- 5.1 The complainant says it owns a Community trade mark for the word “SPAMHAUS”, and that the domain name is identical to this mark. It says it has used this mark prominently on its website since 2001, and that it is widely known by this distinctive name.
- 5.2 The complainant says its has operated a website at the domain <spamhaus.org> since 1999. It says it did not register the domain name because Nominet at the time reserved <co.uk> domains for business only. It says it owns <spamhaus.org.uk>. It says Nominet has now relaxed its approach, and that it now wishes to obtain the domain name in order to register <spamhaus.uk>.
- 5.3 It says the respondent has no legitimate interest in the domain name and has never run a business using the name.
- 5.4 It says the respondent was aware of its existence at the time of registration and registered the domain name to attracted misdirected traffic, and to sell the domain name.
- 5.5 It says for the past decade the web site at the domain name has shown either a generic parking page, or an offer to sell the domain name.
- 5.6 It says that, in response to a communication from the complainant in September 2014, Chris Meakes for the respondent offered to sell the domain name if a suitable offer was made.

- 5.7 It says the respondent attempted to mimic its website in October 2006, when it sold “anti-spam” products from a web page at the domain name which gave the impression it was the complainant.

Respondent

- 5.8 The respondent claims not to have been aware of the complainant when the domain name was registered.
- 5.9 It argues that the complainant is not as well known as it claims, and that this is shown by the fact that the complainant did not register the domain initially, and has taken 10 years to make a claim to it.
- 5.10 It says it registered the domain name 5 years before the complainant's trade mark was granted, and had the right to register the domain name, since it was available.
- 5.11 It says it was registered for the purposes of a project it had been planning, but doesn't explain what the project was.
- 5.12 The respondent says it parked the domain name until the start of the project. It says the parking page displayed at the domain name looked nothing like the complainant's website.
- 5.13 The fact that its domain parking service offers the domain name for sale is simply a normal, common part of a domain parking service.
- 5.14 It claims that the complainant is using unfair tactics to gain the domain name. It argues that it has done nothing wrong, and has never tried to pass itself off as the complainant or make money from the complainant's domain.
- 5.15 It argues that the domain name cannot be an abusive registration since it displays nothing apart from a landing page.

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show on the balance of probabilities that:
- it has rights in respect of a name or mark which is identical or similar to the domain name, and that
 - the domain name, in the hands of the respondent, is an abusive registration.

Rights

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.

- 6.3 The complainant has produced documentary evidence from the UK Intellectual Property Office of its Community trade mark registration for the mark "SPAMHAUS". There is no dispute that it owns the domains <spamhaus.org> and <spamhaus.org.uk>.
- 6.4 At the third level (i.e. disregarding "co.uk"), the domain name consists entirely of the eight letter string "spamhaus", which corresponds to the complainant's trade mark.
- 6.5 In those circumstances, I am satisfied that the complainant has rights in respect of a mark which is identical to the domain name.

Abusive Registration

- 6.6 Under paragraph 1 of the Policy, abusive registration means a domain name which either:
- 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
 - has been used in a manner which took unfair advantage of or was unfairly detrimental to the complainant's rights.

This definition obviously covers both the time of registration, and later use.

- 6.7 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using a domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.
- 6.8 Given that the domain name is identical to the complainant's mark, in my view some initial interest confusion is likely between the domain name and the complainant. My view is not affected by what the respondent says about the appearance of the website connected to the domain name.
- 6.9 In addition, the complainant has produced evidence in the form of a screenshot showing that a parking page connected to the domain name has been used to advertise products intended to combat "spam" – which is the complainant's field of activity. The respondent has not disputed that. In my view that took unfair advantage of the complainant's rights.
- 6.10 In those circumstances I am satisfied on the balance of probabilities that the domain name, in the hands of the respondent, is an abusive registration.

7 Decision

- 7.1 I find that the complainant has rights in a mark which is identical to the domain name; and that the domain name, in the hands of the respondent, is an abusive registration.

7.2 The complaint is upheld. I direct that the domain name be transferred to the complainant.

Carl Gardner

22 December 2014