

# **DISPUTE RESOLUTION SERVICE**

**D00016322**

## **Decision of Independent Expert**

Edmodo, Inc.

and

Porchester Partners Inc.

### **1. The Parties**

Complainant: Edmodo, Inc.  
1200 Park Place  
San Mateo  
California  
94403  
United States

Respondent: Porchester Partners Inc.  
Mossfon Building  
2nd Floor  
East 54th Street  
P.O. Box 0832-0886  
W.T.C Panama  
Panama

### **2. The Domain Name**

edmodo.co.uk ('the Domain Name')

### **3. Procedural History**

Nominet checked that the complaint received on 22 July 2015 complied with its UK Dispute Resolution Service ('DRS') Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). It then notified the Respondent of the complaint and invited it to file a response. No response was received so mediation was not possible and, on 14 August, Nominet advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. Nominet received that fee on 20 August.

On 25 August 2015 I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I have confirmed that I am independent of each of the parties and that there are no facts or circumstances that might call into question my independence.

#### **4. Factual Background**

From the complaint and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant, a US corporation, runs a social learning network that connects students with teachers. It has been using the 'Edmodo' name, in the UK and elsewhere, since the launch of the service in 2008. The Complainant now has more than 50 million users. It operates primarily through a web site at edmodo.com, registered on 1 November 2006. It has a federal trademark registration with the United States Patent and Trademark Office for the Edmodo name and logo.

The Respondent is a corporation based in Panama. It registered the Domain Name on 22 January 2010.

At the time of writing, the Domain Name does not resolve to a web page. The Complainant says that, in the past, it has been connected to content unrelated to its educational business and that there are indications that it has also been connected to malware. Screenshots included as evidence in support of the complaint show the Domain Name pointing to a web page with headings that might be appropriate to visitors looking for educational content:

Online School

What is Distance Education

Online Distance Learning

What Is A Management Degree

The Respondent has been named as a respondent in at least six other complaints settled under Nominet's DRS since 2010, as well as similar complaints invoking the World Intellectual Property Organisation's dispute

resolution procedure. The DRS decisions relate to the following domain names:

<b>Domain name</b>	<b>Date of decision</b>
nametagit.co.uk	16 July 2014
allbelli.co.uk	14 August 2013
mybigjohns.co.uk	23 July 2013
smokefreenhs.co.uk	1 March 2012
lurpac.co.uk / wwwlurpak.co.uk	24 October 2010
legolanddiscovery.co.uk	17 September 2010

There is no connection between the Complainant and the Respondent.

## **5. Parties' Contentions**

### *Complaint*

The Complainant says it has rights in the name Edmodo and that this name is identical to the Domain Name. It argues that the Domain Name is an abusive registration because the Respondent:

- (i) is using the Domain Name in a way that is likely to confuse internet visitors into believing there is some connection between the Respondent and the Complainant.
- (ii) is engaged in a pattern of registrations where it is the registrant of domain names that correspond to well-known names or trademarks in which it has no apparent rights.
- (iii) has been found to have made abusive registrations on three separate occasions in the two years immediately preceding the filing of this complaint. The usual burden of proof is therefore reversed and the Respondent must (but will be unable to) rebut the presumption that registration of the Domain Name is an abusive registration.

### *Response*

There has been no response.

## 6. Discussion and Findings

To succeed in this complaint, the Complainant must start by proving, 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.

The usual rule is then that the Complainant must also show, to the same standard of likelihood, that the Domain Name, in the hands of the Respondent, is an abusive registration. Here, the Complainant argues that the usual rule does not apply and that – once it has been established that it possesses the relevant rights – the burden of proof lies with the Respondent to prove that this is not an abusive registration.

I deal with the burden of proof when considering the character of the registration, which I turn to after dealing with the question of rights.

### *Rights*

The Complainant has been operating under the Edmodo name for several years, establishing a substantial user base, and has registered the name as a trade mark in the US. It clearly has both registered and unregistered rights in the name Edmodo.

In looking at rights for the purpose of this test, it is usual to ignore the .co.uk suffix as a generic feature of the domain name register. On that basis, the Domain Name is identical with the name Edmodo.

I conclude that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name.

### *Registration*

As defined by the Policy, an abusive registration is a domain name which:

- 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 has taken unfair advantage of or has been unfairly detrimental to the complainant's rights.

The Complainant's arguments reflect three elements from the Policy's non-exhaustive list of factors that may be evidence that a domain name is an abusive registration: that the use of the Domain Name is likely to cause confusion; that the Respondent is engaged in a pattern of registrations corresponding to well known names in which it has no apparent rights; and that the Respondent's history of adverse DRS decisions means that it must prove that the Domain Name here is not an abusive registration.

### confusion

The potential for confusion is evidently very high indeed. 'Edmodo' is an unusual word and, as the Domain Name is identical to the Complainant's trade mark, confusion could obviously occur even when the Domain Name does not resolve to a web page. At times, though, the Domain Name has been connected a page with links to what purports to be education-related content, increasing the scope for confusion from that high starting point.

#### pattern

The Complainant seems to me to be on less firm ground when arguing that there is a pattern of registrations involving domain names that correspond to well-known names in which the Respondent has no apparent rights. No evidence is offered in relation to the profile of the names in question, so taking a view about whether or not they are well known would involve a degree of subjectivity. Happily, I do not need to take a view on that because I think the potential for confusion already clinches the argument.

#### burden of proof

The Policy says (Paragraph 3 c):

There shall be a presumption of abusive registration if the Complainant proves that the Respondent has been found to have made an abusive registration in three or more DRS cases in the two years before the complaint was filed.

The complaint was filed on 22 July 2015. In the two years before that date, the Respondent was found to have made abusive registrations in three DRS cases, relating to the domain names <nametagit.co.uk>, <allbelli.co.uk> and <mybigjohns.co.uk>. I accept therefore that there is a presumption of abusive registration here. In the absence of a response, the Respondent cannot have discharged its obligation to show that the Domain Name is not an abusive registration.

#### overall

But the conclusion to be drawn here seems to me to be clear even if the burden of proof had not been reversed. Section 3.3 of the *Experts' Overview* says:

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue...

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived...

This seems to me to cover the situation here precisely. The Domain Name is identical to the name of the Complainant and that name cannot sensibly refer to anyone else. The evident potential for initial interest confusion seems to me a solid basis for a finding that the Respondent's registration and use of the Domain Name takes unfair advantage of the Complainant's rights in the name Edmodo.

## **7. Decision**

I find that the Complainant has rights in respect of a name which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an abusive registration.

In the light of that, I direct that the Domain Name be transferred to the Complainant.

**Mark de Brunner**

**13 September 2015**