

DISPUTE RESOLUTION SERVICE

DRS 18342

Decision of Independent Expert

Optimizely UK Limited

Complainant

and

Chun Ping Liu

Respondent

1 The Parties

Complainant:	Optimizely UK Limited
Address:	9th Floor 107 Cheapside London EC2V 6DN

Respondent:	Chun Ping Liu
Address:	Haidian Area Beijing 10085 China

2 The Domain Name

optimizely.co.uk (the "Domain Name").

3 Procedural History

I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, which need be disclosed as being of such a nature as to call into question my independence in the eyes of one or both of the parties.

29 December 2016	Dispute received
29 December 2016	Complaint validated
29 December 2016	Notification of complaint sent to parties
18 January 2017	Response reminder sent
23 January 2017	No Response Received
23 January 2017	Notification of no response sent to parties
31 January 2017	Expert decision payment received

4 Factual Background

- 4.1 The Domain Name was registered on 31 May 2012 by the Respondent. The Respondent registered as a "UK Individual" and opted, on the basis that he was a "non-trading individual", not to have his address shown on Whois search results.
- 4.2 There is a data validation notice on the entry stating that Nominet was unable to match the registrant's name and/or address against a third party source on 11 June 2014.
- 4.3 The Domain Name is not currently being used either in the URL of a website or to re-direct internet users to another site.
- 4.4 The Complainant, Optimizely UK Limited, is a UK company which, according to the Companies House website, was incorporated on 22 September 2014, i.e. more than two years after registration of the Domain Name.

5 Parties' Contentions

- 5.1 The Complainant makes it clear in the first sentence of the Complaint that "*the Complaint is brought by Optimizely UK Ltd*". It explains that it is a limited company registered in England and Wales, though does not mention its date of incorporation.
- 5.2 The Complainant is a wholly owned subsidiary of a US entity named Optimizely Inc, which appears to have been incorporated on 15 December 2009. The Complainant "*forms part of a group of companies which trade under the Optimizely name. Other companies in the Optimizely group include Optimizely Inc., Optimizely GmbH and Optimizely B.V. (together the "Optimizely Group")*".
- 5.3 The Complainant's business is "*to deliver customer experience optimisation services for other companies through a SaaS platform*". It is not explained what that means.
- 5.4 The Complainant provides evidence demonstrating that the Domain Name is not currently being used and does not appear to have been used in the past. It has been unable to contact the Respondent because there are no contact details on the Whois search result.
- 5.5 The Complainant asserts that it has Rights (i.e. as defined in the DRS Policy) in the OPTIMIZE trade mark which is identical to the Domain Name. Its case in this regard is that: "*the Complainant and the Optimizely Group have the following rights:*

- (a) *a number of registered trade marks taking effect in territories around the world, including the UK;*
 - (b) *prior ownership of the domain name *optimizely.com*; and*
 - (c) *common law rights in the name OPTIMIZELY."*
- 5.6 Specifically, the Complainant relies on registered OPTIMIZELY trade marks in the EU, the US and, pursuant to the Madrid Protocol, in a number of other jurisdictions. Confusingly, these are defined in the Complaint as "*The Complainant's Trade Marks*", notwithstanding that they are all in fact owned by its parent company, Optimizely Inc.
- 5.7 Secondly, the Complainant relies on the fact that the domain name *optimizely.com* was registered on 11 January 2010, and that it is used in the URL for "*the corporate website of Optimizely*". In fact, the *optimizely.com* domain name appears from the Complainant's evidence to be registered to an individual named Chad Kalmes.
- 5.8 The Complainant provides detailed statistics as to the number of visits to the Optimizely website, of which approximately 8% appear to emanate from the UK. The Complainant evidences a report from Alexa giving the *optimizely.com* website a UK country rank of 5,573 as at December 2016.
- 5.9 Finally, the Complainant asserts that "*substantial goodwill has been built up in the OPTIMIZELY trade mark through extensive advertising, marketing, promotion and investment in the brand by the Optimizely Group*". It asserts that it carries out "*extensive advertising using the Optimizely mark through media, including Google Adwords, LinkedIn, Twitter and Facebook*". No evidence of any such advertising, or of any expenditure on such advertising, is provided.
- 5.10 It says that "*The Optimizely Group have [sic] a global reputation and high profile clients*". It also asserts that it has had extensive press coverage, including in the UK.
- 5.11 The Complainant asserts that it "*is recognised and reputed as being OPTIMIZELY and benefits from the goodwill which has been generated in that mark through use of the term to describe its services*". It says that the Respondent has no rights in the OPTIMIZELY mark.
- 5.12 The Complainant argues that the Domain Name is an Abusive Registration under paragraph 5.1.6 of the Policy (no reasonable justification for registering a domain name which is an exact match of the Complainant's mark and in which the Complainant has a reputation). In support of that assertion, it asserts that at the time the Domain Name was registered in 2012, the Optimizely Group "*was an established and successful business*". It says that in 2012, Optimizely was featured in press and online coverage and had a number of customers.
- 5.13 The Complainant relies also on paragraph 5.1.3 of the Policy (pattern of registration of infringing domain names). It says that the Respondent has registered 6,388 domain names. The reverse Whois search exhibited in support of that assertion identifies approximately 40 domain names but does not show the complete domain name. The Complainant asserts that "*the Respondent is engaged in a pattern of registrations where they have no apparent rights, and the domain name is part of that pattern*". No explanation or evidence is provided for that assertion.
- 5.14 Finally, the Complainant argues that either the domain name was registered with the intention of selling it to the Complainant or one of its competitors at some point in the future (i.e. contrary to paragraph 5.1.1 of the Policy) or as a blocking registration (paragraph 5.1.1.2) or for the purpose of disrupting the Complainant's business (paragraph 5.1.1.3, though no mention is made of unfair such disruption). In support of its assertion of business disruption, the

Complainant says that "*its customers are confused by the existence of the Domain Name which is not currently linked to the Optimizely Group business*". No further detail, and no evidence, is provided in support of that assertion.

5.15 No Response has been filed.

6 Discussions and Findings

General

6.1 To succeed under the DRS Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"Abusive Registration means 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) is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Complainant's rights

6.3 Paragraph 2.1.1 of the Policy requires the Complainant to prove that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". "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*" (paragraph 1).

6.4 The Complainant puts its case on Rights on the basis that it "*and the Optimizely Group*" (a) own an EU registered trade mark, a US registered trade mark and trade marks registered in a number of other jurisdictions in OPTIMIZEY; (b) "*prior ownership*" of the domain name *optimizely.com*; and (c) common law rights in the OPTIMIZEY name.

6.5 However, the Optimizely Group which is defined in the Complaint to include Optimizely Inc, Optimizely GmbH and Optimizely BV, together with the Complainant, is not a party to this DRS proceeding. In any event, it is plain from the Complainant's evidence that the registered trade marks in question are all owned, not by the Complainant, nor by the Optimizely Group, but by the Complainant's US parent company, Optimizely Inc.

6.6 What appears to have happened is that the Complaint has been brought, presumably without the benefit of legal advice, not, as it should have been, by the US parent company which owns the registered trade marks in question, but by its UK subsidiary, which does not. In such circumstances, paragraph 2.2 of the Nominet DRS Experts' Overview, which provides as follows, by reference to the Appeal decision in DRS 00248 (*seiko-shop.co.uk*), may be relevant:

"If the right arises out of a trade mark or service mark registration, a copy of the registration certificate or print out from the registry database will suffice together with, in the case of a licensee, evidence of the licence. If the Complainant can demonstrate

that it is a subsidiary or associated company of the registered proprietor, the relevant licence, if asserted, will ordinarily be assumed."

- 6.7 Attention is drawn to the words "if asserted" in the passage above. In this case, the Complainant has demonstrated by reference to its evidence, that it is a wholly owned subsidiary of the owner of the registered marks. Further, it defines the Optimizely Group as comprising Optimizely Inc, Optimizely GmbH, Optimizely BV and itself, and then goes on to assert that various common law rights attach to that defined group of companies.
- 6.8 While the merits are evenly balanced, the Expert is, somewhat reluctantly, prepared to infer from the Complaint and its enclosures an assertion that the relevant licence is in place. On that basis, the Complainant would therefore have the benefit of the registered trade marks on which it relies and therefore has the requisite Rights in the OPTIMIZELY mark for the purposes of the Policy.
- 6.9 The *optimizely.com* domain name is likewise not registered to the Complainant. It is in fact registered to an individual named Chad Kalmes. No explanation is provided as to who that individual is or of any connection with the Complainant (or, for that matter, with Optimizely Inc).
- 6.10 So far as common law rights are concerned, the Complainant puts its case on a number of bases. First, it relies on the "*substantial goodwill*" which it says has been built up in the OPTIMIZELY name "*through extensive advertising, marketing, promotion and investment in the brand by the Optimizely Group*", but not by the Complainant itself.
- 6.11 Secondly, the Complainant says that it "*carries out extensive advertising*". No evidence of any such advertising or of its expenditure on such advertising (e.g. by way of invoices etc.) is provided.
- 6.12 Thirdly, it asserts that the Optimizely Group has "*a global reputation and high profile clients*". That may well be so, but it is not explained how or why any such reputation attaches to the Complainant. Again, there is no evidence of such reputation or clients.
- 6.13 Fourthly, it relies on the fact that it has "*had extensive press coverage, including in the UK*". However, it is very far from clear from the evidence provided that such press coverage relates to the Complainant. The vast majority appears to relate to the parent company in the US.
- 6.14 Its case is that, in essence, it has inherited common law rights as a result of trading goodwill generated and owned by its US parent. It has not explained, let alone evidenced, how or why any common law rights attaching to the parent, or other members of the Optimizely Group, attach to it. However, given the reliance on the registered trade marks referred to above, ultimately that point is moot.
- 6.15 Accordingly, the Complainant has, just about, proved on the balance of probabilities that it owns the requisite Rights in respect of the OPTIMIZELY mark. It is accepted that that mark is identical (for DRS purposes) to the Domain Name.

Abusive Registration

- 6.16 First, the Complainant relies on paragraph 5.1.6 of the Policy, which provides that Abusive Registration may be found where the Domain Name is an exact match for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation, and the Respondent has no reasonable justification for having registered the Domain Name.

- 6.17 Plainly, the Domain Name is an exact match for the OPTIMIZEZLY mark. It is equally plain that that mark has a reputation, as evidenced in the enclosures with the Complaint. Given that the Respondent has not filed a response, and has therefore provided no justification for having registered the Domain Name, and given that he is not using, and it would appear never has used, the Domain Name, the criteria set out in paragraph 5.1.6 of the Policy are satisfied.
- 6.18 Secondly, the Complainant relies on paragraph 5.1.3 of the Policy, which provides that Abusive Registration may be found where "*a Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names 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*".
- 6.19 However, no evidence is provided of the domain names which are said to form the 'pattern' in question. It is asserted by the Complainant, and demonstrated by reference to a reverse Whois search result, that the Respondent appears to have registered 6,388 domain names. But without evidencing what at least some of those domain names are, the Complainant has not demonstrated an essential limb of that provision, namely that those domain names "*correspond to well known names or trade marks in which the Respondent has no apparent rights*". Nor is it therefore able to prove that the Domain Name is part of that pattern of registrations. Accordingly, the Complainant fails to satisfy paragraph 5.1.3.
- 6.20 Thirdly, and in the alternative, the Complainant asserts that "*either*" the domain name was registered with the intention of selling it to the Complainant or one of its competitors "*or*" for the purpose of stopping the Complainant using it "*or*" in order to disrupt the Complainant's business. In support of the last, the Complainant says that the existence of the Domain Name is confusing to its customers. Those assertions appear to be directed at paragraphs 5.1.1.1, 5.1.1.2 and 5.1.1.3 respectively of the Policy. However, no evidence at all is provided in support of any of them. Accordingly, the Complainant has not succeeded on any of those grounds.
- 6.21 Overall, notwithstanding its failure to make good its second and third grounds of Abusive Registration, the Complainant has succeeded in proving, on the balance of probabilities, that it has Rights in respect of the OPTIMEZLY mark; that that mark is similar or identical to the Domain Name; and, for the reason set out at paragraph 6.17 above, that the Domain Name is an Abusive Registration in the hands of the Respondent.

7 Decision

- 7.1 The Expert therefore finds that the Complaint has rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration.
- 7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

David Engel

Signed

Dated 24 February 2017