

DISPUTE RESOLUTION SERVICE

D00019507

Decision of Independent Expert

Dell Inc.

and

Sideways Group Limited

1. The Parties:

Complainant: Dell Inc.
One Dell Way
Round Rock
Texas
78682
United States

Respondent: Sideways Group Limited
Unit 7
Campus 5
Letchworth Garden City
Hertfordshire
SG6 2JF
United Kingdom

2. The Domain Names:

<dellvirtustream.co.uk>
<dellvmware.co.uk>
<emcvirtustream.co.uk>

3. Procedural History:

I confirm that 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, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

08 November 2017 15:55 Dispute received
09 November 2017 16:02 Complaint validated
09 November 2017 16:04 Notification of complaint sent to parties
28 November 2017 01:30 Response reminder sent
01 December 2017 12:28 No Response Received
01 December 2017 12:28 Notification of no response sent to parties
13 December 2017 01:30 Summary/full fee reminder sent
13 December 2017 09:35 Expert decision payment received

4. Factual Background

Founded by Michael Dell in 1984, the Complainant, Dell Inc., an information technology corporation, is the parent company of the subsidiaries Virtustream Inc., VMware Inc., and EMC Corporation. The group's trademarks are well-known and include the following EU registered word marks ("the marks"), for the management and protection of which the Complainant asserts that it is responsible:

DELL, No. 4261038, registered on March 21, 2006 in the name of the Complainant;

VIRTUSTREAM, No. 8378952, registered on December 24, 2009 in the name of Virtustream Inc.;

VMWARE, No. 1333178, registered on May 21, 2001 in the name of VMware Inc.;

and
EMC, No. 49783, registered on May 7, 1998 in the name of the Complainant.
(Complaint Annex 3).

The domain name <dellvmware.co.uk> was registered by the Respondent on October 14, 2015. The domain names <dellvirtustream.co.uk> and <emcvirtustream.co.uk> were registered by the Respondent on October 21, 2015. None of the Domain Names resolve to an active website.

5. Parties' Contentions

Complainant

The Complainant requests that the Panel exercise the discretion under paragraph 24.4 of the Nominet Dispute Resolution Service Policy, version 4, applicable to all disputes filed on or after 1 October, 2016 ("the Policy") to allow the Complainant to proceed on its own behalf and on behalf of its subsidiaries.

The Complainant submits (on its own and its subsidiaries' behalf) that, as a result of the Complainant's worldwide success and promotional efforts, the marks have become uniquely identified with the Complainant in the minds of consumers and signify the high quality of the products and services offered by Complainant. For the purposes of the Policy, each of the Domain Names is confusingly similar to the Complainant's rights and is an Abusive Registration in accordance with 5.1.1.1, 5.1.1.2, 5.1.1.3, 5.1.2 and 5.1.3 of the Policy. The Domain Names should be transferred to the Complainant.

The Respondent is not using the Domain Names in connection with a bona fide offering of goods or services. The Domain Names do not host any active and/or relevant content. The Respondent has not (either as an individual or business), to the best of the Complainant's knowledge, been known by the Domain Names.

It appears immediately apparent that the Domain Names were acquired for the purpose of selling them to the Complainant for valuable consideration, in excess of their out-of-pocket costs related to the Domain Names, as per 5.1.1.1 of the Policy. Given the scale of the Complainant's operation, and the reputation associated with the marks, it is inconceivable that the Respondent would not have known about the Complainant's brands prior to registering the Domain Names. The Respondent could have reasonably surmised that the registrations of the Domain Names would have come to the Complainant's attention, and would have hoped that the Complainant could be persuaded to purchase the Domain Names from the Respondent for more than the out-of-pocket costs of acquiring them.

Given that the Respondent is not making any legitimate, non-commercial or fair use of the Domain Names and is in fact making unfair use of them with the sole intention of gaining financially, the registrations fall foul of 5.1.1.1 of the Policy.

By registering the Domains Names containing the marks, the Respondent has also prevented the Complainant, the owner of the marks, from registering the marks in corresponding domain names and the Domain Names were obtained as blocking registrations, per 5.1.1.2 of the Policy.

Bearing in mind the rights of the Complainant and its reputation, it is impossible to imagine how any use of the Domain Names would not cause confusion to any relevant consumer. Any average consumer familiar with the marks would assume such Domain Names were related to the provision of technology products and services by the Complainant, and so would assume that the business provided under the Domain Names is formally connected with the Complainant. As such it is a reasonable assumption that the Respondent intentionally registered the Domain Names to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation or endorsement of the Respondent's website or location or of a product or service on the Respondent's website.

As a result of all this, the Complainant submits that it is plain that the Domain Names were registered as Abusive Registrations as the Respondent has registered the Domain Names in a way which has confused and is likely to confuse people or businesses into

believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant under 5.1.2 of the Policy.

The Complainant submits that there is no reason for the Respondent to register the Domain Names except to refer to the Complainant, and/or to benefit in some way from the Complainant's marks, or to interrupt or block the Complainant's business in the UK. It is clear that the website is targeting the UK consumer because it is using a ".co.uk" gTLD. It is also inevitable that consumers coming across the Domain Names will assume they have a formal connection with the Complainant. This confusion on the part of Internet users is also aimed at unfairly disrupting the business of the Complainant, per 5.1.1.3 of the Policy.

A Google Search of the Respondent, Sideways Group Limited, revealed the name of the Company Director, Mr. Simon Greer (Annex 14). A reverse WHOis of Simon Greer revealed his domain name registrations <dell-virtustream.com>, <dell-vmware.com>, <dellvirtustream.com>, <dellvmware.com> and <emcvirtustream.com> (Annex 15), against which a UDRP complaint has been filed. Mr. Greer also registered <amazon-workspaces.com>; <amazonworkspace.com> and <amazonworkspaces.info>. The Complainant could allege that the director of Sideways Group Limited has a history of cybersquatting on domain names consisting of famous and/or well-known brands, indicating a pattern of bad faith, abusive registrations under 5.1.3 of the Policy.

Respondent

As mentioned, the Respondent did not submit any response.

6. Discussions and Findings

As to the Complainant's request that the Panel exercise the discretion under paragraph 24.4 of the Policy to allow the Complainant to proceed on its own behalf and on behalf of its subsidiaries, paragraph 24 of the Policy, entitled "General powers of Nominet and the Experts", provides, *inter alia*:

“24.3 The Expert shall determine the admissibility, relevance, materiality and weight of the evidence.

24.4 We shall decide a request by a Party to consolidate multiple Domain Name disputes in accordance with this Policy.

Under paragraph 1 of the Policy "We means Nominet UK" and "Expert means the expert we appoint under paragraph 10.5 or 12.1". Accordingly, the Complainant's request is not a matter for the Panel's discretion. Since Nominet UK has appointed the Expert to determine these proceedings, it is clear that Nominet UK has accepted the Complainant's request, having regard to the Complainant's assertions that it is the parent company of Virtustream Inc., VMware Inc., and EMC Corporation and that it has responsibility for the management and protection of the group's trademarks.

Pursuant to paragraph 2.1 of the Policy, for a complainant to succeed it must prove on the balance of probabilities that:

- (i) it 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.

Rights

‘Rights’ are defined in the Policy as 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 Expert is satisfied that the Complainant has rights in its registered trademarks DELL and EMC and that, as the parent company of Virtustream Inc. and VMware Inc., it has rights in their registered trademarks VIRTUSTREAM and VMWARE.

Aside from the inconsequential “co.uk” suffixes, which may be disregarded, each of the Domain Names <dellvirtustream.co.uk>, <dellvmware.co.uk> and <emcvirtustream.co.uk> comprises a combination of a trademark registered to the Complainant and a trademark registered to one of its subsidiaries, in which, as mentioned above, the Complainant also has rights. Each of the Domain Names is thus identical or similar to two trademarks in which the Complainant has rights.

Abusive registration

“Abusive Registration” is defined in paragraph 1 of the Policy 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. 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.

Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration. The Complainant relies on each of the following:

- “5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - 5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
 - 5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

5.1.4 It is independently verified that the Respondent has given false contact details to us...”

It is unnecessary to consider all the arguments upon which the Complainant relies in claiming that all these provisions apply since the Expert finds that paragraphs 5.1.1 and 5.1.2 are satisfied. The Expert notes that the Complainant makes no contentions in relation to paragraph 5.1.4.

As to paragraph 5.1.1, the DELL, EMC, VIRTUSTREAM and VMWARE trademarks incorporated into the Domain Names are well known and exclusively referable to the Complainant or to one of its subsidiaries. The decision of the Respondent to combine two of those marks in each of the Domain Names leads to the inescapable conclusion that the Respondent was well aware of those marks when registering the Domain Names. These circumstances, together with the Respondent’s failure to offer any explanation for adopting the Domain Names in response to the Complaint leads the Expert to infer, on the balance of probabilities, that the Respondent had no legitimate justification for doing so and did so for one or more of the purposes contained in the non-exhaustive list set out in paragraph 5.1.1 of the Policy or for some other abusive purpose.

In this respect, apart from the inconsequential fact that each of the Domain Names comprises two well-known trademarks instead of one, this case is on all fours with DRS 00658: chivasbrothers.co.uk (transfer), in which the learned Expert held:

“Where a Respondent registers a Domain Name:-

1. which is identical to a name in respect of which the Complainant has rights; and
2. where that name is exclusively referable to the Complainant; and
3. where there is no obvious justification for the Respondent having adopted that name for the Domain Name; and
4. where the Respondent has come forward with no explanation for having selected the Domain Name,

it will ordinarily be reasonable for an expert to infer first that the Respondent registered the Domain Name for a purpose and secondly that that purpose was abusive."

As to paragraph 5.1.2, even though the Domain Names have not been used, Internet users seeing any of the Domain Names are likely to be confused into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant.

Accordingly the Expert is satisfied, on the balance of probabilities, that each of the Domain Names is an Abusive Registration.

7. Decision

I direct that the Domain Names, <dellvirtustream.co.uk>, <dellvmware.co.uk> and <emcvirtustream.co.uk> be transferred to the Complainant.

Signed: Alan Limbury

Dated: December 30, 2017