

# **DISPUTE RESOLUTION SERVICE**

**D00022241**

## **Decision of Independent Expert**

Snap Inc.

and

Mr Muhibur Rahman

**1. The Parties:**

Lead Complainant: Snap Inc.  
2772 Donald Douglas Loop North  
Santa Monica CA 90405  
United States

Respondent: Mr Muhibur Rahman  
23 Sebright House  
Coate Street  
London  
E2 9AD  
United Kingdom

**2. The Domain Name(s):**

snapchats.co.uk

### **3. Procedural History:**

I can 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 such a nature as to call into question my independence in the eyes of one or both of the parties.

16 January 2020 18:01 Dispute received  
22 January 2020 12:28 Complaint validated  
22 January 2020 12:34 Notification of Complaint sent to parties  
24 January 2020 15:09 Response received  
24 January 2020 15:09 Notification of response sent to parties  
29 January 2020 01:30 Reply reminder sent  
31 January 2020 16:29 Reply received  
03 February 2020 12:25 Notification of reply sent to parties  
06 February 2020 14:58 Mediator appointed  
13 February 2020 11:24 Mediation started  
09 March 2020 16:30 Mediation failed  
09 March 2020 16:30 Close of mediation documents sent  
19 March 2020 01:30 Complainant full fee reminder sent  
23 March 2020 13:18 Expert decision payment received

### **4. Factual Background**

Nominet's DRS policy offers a procedure which allows a person or company to dispute the registration of a .uk domain name. The requirement that binds the domain registrant to the DRS policy is rooted in the contract he enters into with Nominet when he obtains a .uk registration. Under this provision, a complaining party may bring a complaint under the Policy where it can show:

- i. 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.

The Complainant must prove both elements are present on the balance of probabilities.

The Complainant is globally recognised through its SNAPCHAT camera and messaging application. The app allows users to share photographs, videos and messages it refers to as “Snaps” with others through mobile devices. After its launch in 2011, the Complainant’s popularity grew exponentially. By the end of 2014, SNAPCHAT had 70 million daily users, 100 million users by the end of 2015, growing to 158 million by the end of 2016. During this period, the Complainant’s app consistently ranked among the top five most downloaded photo applications and the top 15 most downloaded mobile applications overall on the Apple App Store. As of 2019, additional usage statistics provided by the Complainant show that on average, 210 million people use its app daily.

The Complainant owns several trade mark registrations for SNAPCHAT in the UK and EU. Such trade mark registrations include but are not limited to the following:

- European trade mark 11827334 registered on 16 October 2013 covering classes 9, 38 and 45.
- European trade mark 12925971 registered on 22 October 2014 covering classes 9, 38, 41, 42 and 45.
- European trade mark 13632369 registered on 15 February 2016 covering classes 9, 35, 36, 38, 41 and 42.
- European trade mark 17370586 registered on 7 February 2018 covering class 35.
- United Kingdom trade mark 3264951 registered on 12 January 2018 covering class 35.

The Respondent registered the Disputed Domain on 7 February 2019 and the website to which it resolved claimed to offer some form of photography service.

Appearing to conflict with the Complainant's marks, they first sought to contact the Respondent on 4 June 2019 asking him to cease use of the Domain and to transfer it to the Complainant. What followed was a series of emails between the Parties, in which the Respondent requested a figure in the region of £1m to transfer the Domain Name.

At the time of the Complaint, the Domain Name no longer resolves to an active website.

## **5. Parties' Contentions**

### The Complainant

The essence of Complainant's case is that as a result of its widespread use of the SNAPCHAT mark and high degree of public recognition, the registration of the Disputed Domain can be for no other reason than to take unfair advantage of its famous mark. In support of these assertions, the Complainant provides extensive material demonstrating its reputation and goodwill. The Complainant also relies on registered trade marks which predate the Disputed Domain by at least five years.

The Complainant asserts, on information and belief, any use of the Domain Name since its registration is fictitious and is simply a front to conceal the Respondent's intention to extract money from the Complainant.

### The Respondent

The Respondent gives the impression that he has no desire to participate in these proceedings. Rather than submitting a substantial response to the Complaint, his defence consists of a single paragraph which reads as follows:

*"I am no longer using snapchats.co.uk, I have deactivated the domain and website is also deactivated. I have taken snap chats off all social platforms and no longer using snap chats. My domain snapchats.co.uk expires in few weeks and I will not renew it and I will no longer have anything to do with snapchats.co.uk. I didnt realise the law*

*behind trademark and never [k]new this is a serious matter. I thought we can change one letter of a big brand and make a business and its alright, clearly it isn't."*

Nominet does not question an applicant's entitlement to a domain name. But when contested under the DRS, he is encouraged to provide some justification for his choice. Even in cases such as this where the Respondent appears to concede defeat, the obligation on Experts to decide a case on its merits still remains. There is much that can be gained from a full analysis of the facts.

## **6. Discussions and Findings**

The Complainant's reputation and rights are not in dispute in this case. The registration of trade marks coupled with Complainant's evidence of substantial goodwill is sufficient in showing rights in the name SNAPCHAT. Neither would anyone contest that the Disputed Domain is similar to the Complainant's mark. As rightly pointed out by the Complainant, the Disputed Domain is virtually identical to the mark, with the only difference being the addition of the letter 's' – the suffix can be ignored as part of the comparison.

The only point contested by the Respondent in his email to the Complainant, was that he had "not broken the law in anyway". In one email he even goes as far as goading the Complainant into filing legal action against him:

*"If Snap Chat declines to offer me any sort of payment, I will not close my business and I will want Snap Chat to take legal action on me."*

Whether it would be sensible to incur the risks of formal legal action through the courts is a separate matter. The Expert's role is to decide the dispute in line with the DRS policy, which considers the abusive registration of a domain name.

Paragraph 1 of the 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."

Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors which may indicate evidence of abusive registration.

One factor in particular that applies in this case is found under paragraph 5.1.1.1 of the Policy, which states that abusive registration exists where the domain name has been registered or acquired "primarily 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."

To determine whether a domain name has been registered "primarily" for the specific purpose to sell, instead of some other purpose, the Complainant would need to show that its mark formed the basis for such an offer to sell. Otherwise the buying and selling of domain names in itself would be objectionable, which it is not.

The second point is that the value requested by the Respondent has to be "in excess" of what he can rightly justify as his "out-of-pocket costs". Where the Respondent can show that the Domain Name's value derives from its intrinsic value, for example its use as a generic term, then the price put forward would be less of a factor. But the Respondent has provided no such argument.

The Expert is therefore satisfied that both requirements are present in this case. Based on Respondent's offer to sell the Disputed Domain to the Complainant for £1,000,000, a sum vastly in excess of the Respondent's out of pocket expenses, it can be inferred that it was, and has always been the Respondent's primary intention to sell the Disputed Domain based on its value as a famous mark.

The evidentiary burden shifts to the Respondent to prove the Disputed Domain is not an abusive registration. The only evidence able to assist the Expert has once again been provided by the Complainant.

Annex 21 of the Complaint reveals that the Disputed Domain previously resolved to a website purporting to offer photography services. Having regard to the defences available to the Respondent under paragraph 8 of the Policy, the Complainant asserts that the Respondent's offering of goods and services is fictitious. In support of these allegations, Complainant provides several examples of the Respondent misrepresenting the work of third-parties as its own.

In an email dated 15 October 2019, the Respondent claims to be running a "business" under the name "Snap Chats". The Respondent certainly does make use of the phrase "Snap Chats" throughout the site, even utilising the tagline "Snaps do Chat", but the meaning of this statement is not explained. In fact, the Expert does not understand what the website is trying to accomplish, and can find no credible reason why he would choose to combine these words.

Considering all the facts and the worldwide reputation of the SNAPCHAT mark, the Expert finds no plausible explanation for the registration of the Disputed Domain other than to take unfair advantage of the Complainant's mark.

## **7. Decision**

The Expert finds that the Complainant has Rights in a name similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration.

The Expert directs that the Domain Name be transferred to the Complainant.

**Signed Micah Ogilvie**

**Dated 8 April 2020**