

DISPUTE RESOLUTION SERVICE

D00022812

Decision of Independent Expert

Ziff Davis, LLC

and

Safi Ullah

1. The Parties:

Complainant: Ziff Davis, LLC
114 5th Avenue, 15th Floor
New York 10011
United States

Respondent: Mr. Safi Ullah
United Kingdom

2. The Domain Name:

<humblebundle.uk> (the “Domain Name”)

3. Procedural History:

3.1 I have confirmed to Nominet that I am independent of each of the parties and that 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 nature as to call in to question my independence in the eyes of one or both of the parties.

3.2 The procedural chronology of this dispute is as follows:

08 July 2020 15:18 Dispute received
08 July 2020 17:44 Complaint validated
08 July 2020 17:50 Notification of complaint sent to parties
13 July 2020 11:08 Response received
13 July 2020 11:08 Notification of response sent to parties
14 July 2020 11:28 Reply received
14 July 2020 11:28 Notification of reply sent to parties
14 July 2020 15:03 Mediator appointed
14 July 2020 15:03 Mediation started
14 July 2020 15:05 Mediation failed
14 July 2020 15:05 Close of mediation documents sent
15 July 2020 10:28 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is a Delaware corporation, with numerous subsidiaries that operate under various brands. One of these subsidiaries is Humble Bundle, Inc. This subsidiary operates a website from the <humblebundle.com> domain name. Founded in 2010, this website provides a subscription service for video games, ebooks and software. A share of revenues generated is donated to charity, with over US\$117 million raised as at January 2018.
- 4.2 The Complainant is the owner of various registered trade marks that incorporate the term “Humble Bundle”. They include:
- (i) United States registered trade mark no 4,597,050 for HUMBLE BUNDLE as a standard character mark registered on 2 September 2014 in class 9; and
 - (ii) European Union registered trade mark no 015503642 for HUMBLE BUNDLE as a word mark registered on 5 October 2016 in classes 9 and 35.
- 4.3 On 20 June 2020, the Complainant received an email from someone using the name “Tom Hanks” offering to sell the Complainant the domain name <humbebundle.us> for US\$3,000. The Complainant purchased that domain name for a reduced price that was agreed on 23 June 2020. In the course of subsequent email correspondence in relation to the mechanics of the sale and transfer, the owner of that domain name stopped using the name “Tom Hanks” and instead used the name “Jerry L Greco”. The email address used to communicate with the Complainant also changed to a gmail email address that contained the text “iamjerry”.
- 4.4 The Domain Name was registered on 23 June 2020 in the name of Mr Safi Ullah, who gave an address in the United Kingdom. The contact email

address used in respect of that registration was the “iamjerry” gmail email address.

- 4.5 In late June 2020 the Complainant also received an email from “Jerry L Greco” using the “iamjerry” gmail address in relation to the Domain Name. In the course of correspondence that followed, the Domain Name was offered for sale for US\$1,000. Subsequently, “Mr Greco” reduced the price of the Domain Name to US\$200, but the Complainant was unwilling to purchase it for that price.
- 4.6 As at 7 July 2020, the Domain Name was being used to display a web page that offered the Domain Name for sale and invited offers in excess of US\$500.
- 4.7 On 8 July 2020 the Complainant informed “Mr Greco” that legal action had been commenced in respect of the Domain Name. “Mr Greco” then responded as follows:

“Dear Mam, I already sold the domain. So, you are wasting your own time! I hope that your team will try best to get access to the domain as soon as possible. Best of luck!”

5. Parties’ Contentions

Complaint

- 5.1 In its Complaint, the Complainant sets out its business and marks and the history of the communications between it and the person or persons responsible for the registration of the <humbebundle.us> domain name and the Domain Name.
- 5.2 The Complainant contends that the Domain Name and its marks are identical once the “.uk” ccTLD extension is discounted.
- 5.3 The Complainant further contends that the Domain Name is abusive in circumstances where the registration took place 10 years after the Complainant first started using the “Humble Bundle” name, and where the registration of the Domain Name took place at a time when negotiations in relation to the purchase of the <humbebundle.us> domain name were ongoing.
- 5.4 The Complainant also relies upon the offer to sell the Domain Name to the Complainant for US\$1,000 and contends that the Domain Name was registered by the Respondent “primarily for the purposes of selling...the Domain Name to 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.”

- 5.5 The Complainant also contends that the Respondent has engaged in a pattern of domain name registrations that correspond to well-known names or trade marks in which the Respondent has no apparent rights. In this respect, the Complainant claims that the Respondent has registered nearly 100 domain names of this sort and provides as examples <advanceautoparts.us>, <crunchbase.us>, <rottentomatoes.us>, <seattletimes.us>, <vudu.us>, <rollingstone.us> and <downdetector.us>. This claim is said to be evidenced by reverse WHOIS searches annexed to the Complaint, although a copy of these search results does not appear to have been filed with the Complaint.

Response

- 5.6 The Respondent's response reads as follows:

“Right now, I don't have ownership rights of mentioned domain (www.humblebundle.uk) name. So, i can't do anything in this situation. Please, delete this complaint against me!”

Reply

- 5.7 In its Reply, the Complainant points out that section 26.1 of the DRS Policy prohibits a respondent from transferring a domain name whilst proceedings under the DRS in relation to the domain name are ongoing.

6. Discussions and Findings

- 6.1 To succeed under Nominet's Dispute Resolution Service Policy (the "Policy"), the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2 of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2.2 of the Policy).

- 6.2 Abusive Registration is defined in paragraph 1 of the Policy as follows:

"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 took unfair advantage

of or has been unfairly detrimental to the Complainant's Rights."

Complainant's Rights

- 6.3 The Complainant has clearly demonstrated that it is the owner of several registered trade marks in respect of the words "Humble Bundle". The only sensible reading of the Domain Name is as that text combined with the ".uk" suffix. In the circumstances, the Complainant has clearly demonstrated that it has rights in respect of mark that is at least similar to the Domain Name. The Complainant has thereby satisfied the requirements of paragraph 2.1.1 of the Policy.

Abusive Registration

- 6.4 I accept the Complainant's contention that the Domain Name was registered with the intention of selling this to the Complainant (or the relevant subsidiary of the Complainant). This is clear from (a) the offer for sale of the <humblebundle.us> domain to the Complainant; (b) the Domain Name having then been registered at a time when discussions in relation to the transfer of the <humblebundle.us> domain name were ongoing; (c) the fact that "Mr Greco", was involved in both registrations; and (d) the offer for sale of the Domain Name to the Complainant.
- 6.5 Indeed, it is difficult to understand the registration of the Domain Name as anything other than a cynical and transparent attempt to extort further monies from the Complainant at a time when the Complainant had already expressed a willingness to purchase the <humblebundle.us> domain name. It is unsurprising that, faced with this, the Complainant instead chose to commence these proceedings.
- 6.6 The Respondent's activities therefore fall within the scope of paragraph 5.1.1.1 of the Policy, and constitute evidence of abusive registration.
- 6.7 Further, there is the Respondent's claim to have sold the Domain Name to a third party. If there has been an attempt to transfer the Domain Name, that transfer has not taken effect since it post-dates the commencement of these proceedings. However, I do not accept that there has been any sale to a third party with a genuine interest in the Domain Name in this case. It is inherently implausible that any third party would have such an interest. Accordingly, it seems likely (absent any evidence to the contrary) that either (a) there was no sale, or (b) if there was a formal sale, it was an attempt to frustrate the proceedings at that time threatened by the Complainant. Either way, this provides further evidence of abusive registration.
- 6.8 The Complainant has thereby satisfied the requirements of paragraph 2.1.2 of the Policy.

- 6.9 The Complainant also relies upon paragraph 5.1.3 of the Policy in that the registration of the Domain Name is said to constitute part of a pattern of abusive registrations. In this respect not only does it refer to the <humblebundle.us> domain name, but also other domain names said to incorporate the trade marks of third parties. The Complainant's contentions seem plausible, but the evidence relied upon to support these claims appears to have been omitted from the Complaint. Had this been an issue of importance, it is likely that I would have issued a Procedural Order in this respect. However, I do not need to make a finding that there has been a broader pattern of abusive registrations on the part of the Respondent in order to find in favour of the Complainant. It is, therefore, unnecessary to consider this issue further.
- 6.10 It also appears that the physical address the Respondent has given to Nominet in respect of the Domain Name is one that does not exist, and the use of a false address can also indicate abusive registration. This is not an argument advanced by the Complainant, and again it is not necessary to consider this issue further in order to decide this case.

7. Decision

- 7.1 I find that the Complainant has Rights in a name, which is at least similar to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I, therefore, determine that the Domain Name be transferred to the Complainant.

Signed Matthew Harris

Dated 22 July 2020