

## Decision for dispute CAC-UDRP-100878

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Domain names	Skyvegas.email, Attenda.email, Jacuzzi.email, Britneyspears.email, Polycell.email, Dulux.email, Camper.email, Fulhamfc.email, Lucozade.email, Jamesvillas.email

### Case administrator

Name	Lada Válková (Case admin)
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### Complainants

Organization	British Sky Broadcasting Limited
Organization	Attenda Limited
Organization	Jacuzzi Inc
Organization	Brandcasting Unlimited, LLC (Ms. Britney Spears)
Organization	Akzo Nobel Coatings International B.V.
Organization	Camper, S.L.
Organization	Fulham Football Club Limited
Organization	Lucozade Ribena Suntory Ltd
Organization	James Villa Holidays Ltd

### Complainant representative

Organization	Safenames Ltd
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### Respondent

Organization	Giovanni Laporta, Yoyo.Email,
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#### OTHER LEGAL PROCEEDINGS

Other pending proceedings between the parties are not known to the Panel.

#### IDENTIFICATION OF RIGHTS

Sky International AG, a wholly owned subsidiary of British Sky Broadcasting Group Plc, owns a trademark registration for Sky

Vegas, CTM, 010315851 applied for on October 5, 2011 and registered on January 21, 2013 in classes 09, 16, 28, 35, 36, 38, 41, 42, 45. Sky International AG has licenced this mark to British Sky Broadcasting Group plc as shown from the registry of the Community trademark. The Complainant British Sky Broadcasting Limited belongs to the Licensee in accordance with the further information provided by Complainant.

Attendo Limited owns a trademark registration for Attenda, CTM 001809474 applied for on August 7, 2000 and registered on November 20, 2011 in classes 9, 35, 38, 42.

Jacuzzi, Inc. owns a trademark registration for Jacuzzi, CTM 007289 283 applied for on September 26, 2008 and registered on July 29, 2009 in classes 03, 05, 06, 07, 09, 10, 11, 17, 19, 20, 21, 24, 25, 35, 39, 42, 44.

Britney Spears owns a trademark registration for Britney Spears, CTM 001610021 applied for on April 13, 2000 and registered on July 11, 2001 in classes 9, 14, 16, 20, 24, 25, 26, 28, 41. The Complainant Brandcasting Unlimited LLC is authorized by the conservators of the Estate of Ms. Britney Spears to file the complaint.

Akzo Nobel Coatings International B.V. owns a trademark registration for DULUX, CTM 000136432 applied for April 1, 1996 on and registered on September 28, 1998 in classes 2, 7, 16.

Akzo Nobel Coatings International B.V. owns a trademark registration for POLYCELL, CTM 000691550 applied for on November 20, 1997 and registered on June 20, 2000 in classes 01, 02, 03, 06, 09, 16, 17, 19.

CAMPER, S.L. owns a trademark registration for CAMPER, CTM 009016262 applied for on April 9, 2010 and registered on December 16, 2011 in classes 04, 25, 39, 40.

Fulham Football Club owns a trademark registration for Fulham FC, UK00002394203 applied for on June 13, 2005 and registered on March 24, 2006 in classes 6, 9, 14, 16, 18, 20, 21, 24, 25, 26, 28, 36, 41, 43.

Lucozade Ribena Suntory Ltd owns a trademark registration for LUCOZADE, CTM 003765393 applied for on April 24, 2004 and registered on September 19, 2005 in classes 21, 33, 41.

James Villa Holidays Ltd. owns a trademark registration for James Villa, CTM 004993531 applied for on March 15, 2006 and registered on February 9, 2007 in classes 39, 43.

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#### FACTUAL BACKGROUND

1. The Complainants are described as follows (hereinafter collectively "the Complainant" or "the Complainants"):

The complainant British Sky Broadcasting Limited as part of the British Sky Broadcasting Group Plc is serving over 20 million customers in five countries, Sky has annual revenues of over £11 billion and is listed on the London Stock Exchange. Among the Sky groups many operations is their betting and gambling sector which consists of the brand "Sky Vegas", an online casino created in March 2003. Sky Vegas provides over 130 games, including Roulette and Blackjack from its primary website <skyvegas.com>.

Attenda Limited is one of the UK's leading managed services and cloud platform providers with clients such as Christian Aid, Microsoft, NHS, Nisa-Today's, Princes, Regus, St. James's Place and Travelodge. Founded in 1997, Attenda has an operational presence in the UK and Germany and employs over 270 people.

Jacuzzi, Inc. is an Italian multinational corporation that produces whirlpool bathtubs and hot tub spas. Founded in 1915 they now distribute products worldwide and have over 5,000+ employees. It also owns various domains incorporating their JACUZZI mark, which resolve to a website for its goods and services at <www.jacuzzi.com>.

Brandcasting Unlimited, LLC is the online media firm which manages the American recording artist, entertainer and pop icon, Britney Spears' online properties. Born in 1981 Britney Spears released her first No. 1 single "Hit Me Baby One More Time" in

1999 and received a star on the Hollywood Walk of Fame in 2009. She is an internationally recognised superstar, acting as a judge on the TV show "The X-Factor" in 2012 and has sold over 100 million albums worldwide making her one of the best-selling music artists of all time. Britney Spears has sold over 30 million bottles of perfume under the BRITNEY SPEARS mark worldwide and has grossed over \$1.5 billion worldwide as of 2012. Britney Spears' digital media and online properties include the website <britneyspears.com>, a twitter following of over 40.4 million and a Facebook page with over 42 million likes.

Akzo Nobel Coatings International B.V. is a leading global producer of paints, coatings and speciality chemicals. With a heritage that traces back more than 350 years, AkzoNobel employ more than 50,000 people in over 80 countries from its 200+ production sites. AkzoNobel are the proprietors of a vast selection of brands, many of which are household brands including DULUX and POLYCELL. AkzoNobel also own various domain names incorporating the POLYCELL and DULUX marks which resolve to corresponding websites for its services at <www.dulux.com> and <www.polycell.com>.

Camper, S.L. is a shoe company based in Spain. Founded in 1975, Camper designs and manufactures footwear that encompasses style and comfort and has over 1,000+ employees. Camper owns various domains incorporating their CAMPER mark, which resolve to a website for its goods and services at <www.camper.com>.

Fulham Football Club Limited is a professional football club playing in the English Football League Championship. Founded in 1879 the club has been established for over 120 years and has become widely known throughout the world through advertising and media coverage. Complainant also owns various domains incorporating their marks, which resolve to a website for their goods and services at <www.fulhamfc.com>.

Lucozade Ribena Suntory Limited is home to two of the UK's biggest soft drinks brands, and is the third largest branded soft drinks supplier in the UK market after the acquisition of the brand in 2013. First established in 1927 as "Glucozade", it was later renamed as "Lucozade" in 1929 and has gone on to become the No.1 selling Sports Drink in the UK. Lucozade also owns various domains incorporating their LUCOZADE mark, which resolve to a website for their goods and services at <www.lucozade.com>.

James Villa Holidays Ltd is the leading villa tour operator in the UK. Established in 1984, they offer villas in over 50 destinations and are ATOL protected. In addition, they were the Telegraphs' Travel Awards 2014 runner up for specialist tour operators and the winners of the Sunday Times Travel Award for the "Best Villa Company" for three consecutive years. Complainant also owns various domains incorporating their JAMES VILLA mark, which resolve to a website for their goods and services at <jamesvillas.co.uk>.

2. The Respondent is operating a certified email service for which he has registered the disputed domain names and many others being subject of diverse ADR proceedings. The way this service shall work is nowhere in these proceedings explained in detail.

3. The Complainants claim (and provide list of these proceedings) that the Respondent was party in many ADR proceedings, the majority of them decided against the Respondent.

4. In other ADR proceedings, Complainants did not succeed against the Respondent such as Stuart Weitzman IP, LLC v. yoyo.email et al., NAF Claim No. 1554808 (June 24, 2014) and eHarmony, Inc. v. yoyo.email et al., NAF Claim No. 1575592 (September 4, 2014).

5. The Respondent obtained a declaratory judgement decision of the United District Court of Arizona against another company not being a party to this proceeding stating inter alia that the Respondent had not a bad faith intent to use the disputed domain name in this US proceeding.

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#### PARTIES CONTENTIONS

#### PARTIES' CONTENTIONS:

## COMPLAINANT:

The Uniform Domain Name Dispute Resolution Policy (UDRP) provides a threshold test for determining whether or not a domain name is identical or confusingly similar to that of a trade mark in which the Complainant (in the following only Complainant) has rights. The Policy requires the Complainant to establish, based on de facto evidence, that they have rights in a trade mark or service mark which is identical or confusingly similar to the infringing domain name. By establishing this fact the Complainant avoids the misappropriation of rights and sets the foundation for a prima facie case.

The Complainant's registered trade marks are recognisable within the limits of the second level domain name, and by applying the identical or confusing similarity test under the Policy, the visual, phonetic and conceptual comparison of both the Complainant's registered trade marks and the Respondent's domain names, there is undoubtedly an identical or confusing similarity between them which inherently exists without any adornment.

Respondent has no rights or legitimate interests

According to the Complainant, the Respondent has (a) never been commissioned to manage the Complainant's email communications; (b) has never been licensed to use the Complainant's mark for the receipt and transmission of email communications; (c) has never received any approval, expressed or implied, to use these marks in or as part of a domain name. Furthermore the Complainants state that they have no association, affiliation and/or dealings of any nature whatsoever with the Respondent and neither endorse or promote its services.

Under the Policy, a Respondent may demonstrate it has legitimate interest in a domain name by showing that it used or prepared to use the domain for a [bona fide] offering of goods or services, that it is commonly known by the disputed domain name, or that it is making a legitimate non commercial or [fair] use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

To date of filing of the complaint, the Respondent has been involved in over 24 UDRP and URS cases which have given him the opportunity to adjust, supplement and perfect his arguments in support of his controversial business model. Nevertheless, after careful consideration of the facts Panels have come to the consensus view that the use of third party trade marks in connection with Respondent's certified email service cannot be legitimate for the reasons outlined below.

Respondent's intended business model does not constitute a legitimate plan for demonstrable preparations of use.

"Demonstrable preparations" requires a Respondent to show prior activity which does not amount to taking unfair advantage of a third party's trade mark. In previous disputes the Respondent has expressed that he has spent approximately [USD] 82,000 registering over 4,000 domain names, the majority of which relate to third party trade marks, but provides no visible justification for its registration of trade mark-containing domain names, how the service would actually be operated and how it would be monetized without falling foul of the type of infringement outlawed by the Policy.

In the case of *o2 Holdings Limited v Yoyo.Email/Giovanni Laporta*, Case No. D2014-1399 it was held;

"Despite Respondent's assertion that the registration of trade marked domain names was useful to accomplish a number of verified administrative and technical goals, Respondent chose not to articulate a single specific goal that this large-scale registration served. This omission is particularly striking in light of the fact that Respondent has had at least eleven opportunities to present some rationale for its pattern of behaviour, in the form of eleven separate UDRP and URS challenges."

Similarly, the Panel in the case of *Maplin Electronics Limited v Yoyo.Email*, Case No. D2014-1346 observed that "the Respondent has filed a Response that lacks much in the way of details to explain its new business."

It appears from these prior decisions that the Respondent would have the Panel make a determination in his favour based on a mere indication of intent; this is insufficient especially when such intended use requires the unauthorized use of Complainant's famous trade marks.

The above raises another issue which has been expressed in many cases already:

The Respondent intends to benefit from the underlying value of the Complainant's trade marks.

As previously mentioned, the Respondent has had many opportunities to explain his business model in detail. Among the many unanswered questions one thing is certain, that Respondent's intended business model could not exist, but for the third party trade marks and brands, to which he has no prior or other rights. This would explain why after 24 cases the Respondent is still unable to sufficiently explain the connection between the domain names and a web service which has the goal of ultimately making money from active users and advertising, while at the same time falling within the safe harbours of the Policy. Not only does the service derive from the Complainant's goodwill in their marks but the Respondent readily admits that the domains were deliberately registered to oblige the Complainant to join its system.

In the case of Sheraton the Respondent submitted "that without a very large portfolio of such domain names its service cannot be viable". The Panel were of the view that this type of pre-emptive registration "reinforces the fact that the Respondent seeks to be in a position where the trade mark owner is deterred from refusing its recorded delivery services." Such use cannot be considered legitimate as the Respondent is clearly using coercion to attract Complainant to a service which ultimately makes money from them as an unwilling participant.

The Respondent fails to appreciate the extent that some of these organizations have gone to in order to establish goodwill in their respective industries. Many of the organizations listed in the complaint employ thousands of employees around the world, spend millions in advertising and trade mark registrations to promote and protect their brands. Complainant is responsible for how their customers/clients respond to their brands and the companies they attach themselves to in order to further that purpose. It is only reasonable that any new service provider would have to undergo a rigorous assessment as to their suitability and for the receiving party to adequately detail the key expectations for a service of this nature. To have a service forced upon them in this manner and to impose a unilateral obligation on the Complainant to use or lose its privileged access to communications intended for its sole use cannot be considered to be legitimate by any stretch of the imagination.

The Panel in the Sheraton case confirmed their disapproval of Respondent's business model by stating:

"The Panel would be reluctant to lend its approval to the registration of a domain name incorporating another party's trade mark for the purpose of being able to establish a system or scheme in relation to which the trade mark owner becomes a supplicant. This would set the clock back on the Policy in a way that was never intended."

The Respondent cannot justify the registration of the domain names.

In previous cases the Respondent has always held the belief that the domain names perform a necessary function as part of his recorded delivery service which could not be possible without them. However, as numerous Panels have already highlighted this is not true.

The Panel in *Statoil ASA v. Giovanni Laporta, Yoyo.Email Ltd.*, Case No. D2014-0637 held that "the Respondent does not necessarily have to register the disputed domain name and other domain names consisting of well established trade marks to establish his service. An email address such as 'recipient\_statoil@yoyo.email' would work just as well as 'recipient@statoil.email.'" Respondent will argue that the latter form attempts to avoid consumer confusion however such reasoning is not only nonsensical but irrelevant in light of the fact the Respondent claims the domain names will never be visible to the public as this is a back-end service (See *Maplin Electronics Case*). The majority of Panels have rejected Respondent's argument because as the Panel in *Accor, SoLuxury HMC v. Giovanni Laporta, Yoyo.Email*, Case No. D2014-1650 rightly held:

"Even if such a use does not amount to trade mark infringement under particular national laws, this is not the test under the Policy, and such registration without a supporting trade mark or a credible justification does prevent the bona fide owner of

an identical mark from registering in the “.email” gTLD space.”

Contrary to Respondent’s argument, such a system would in fact open up the opportunity for the Respondent to adopt alternative terms as expressed by the Statoil Panel that would allow Respondent to serve its business purpose without affecting the Complainant’s intellectual property.

The Sheraton Panel further found:

“nothing the Respondent has put before the Panel either explains or justifies why the Respondent actually has to register and own the disputed domain names for this purpose. The analogy with a directory does not hold: any person may indeed be free to compile a directory of domain names, or telephones or addresses or similar, but need not for that purpose actually own any related domain names, by registration or otherwise. To compile a list or directory of trade marks, or company names, or business or trading names, the compiler need not acquire any rights whatsoever in those names. In most cases it would in fact render the directory pointless if he did.”

The Complainant believes the Panel’s observation to be an essential step to understanding the Respondent’s true intention and will be discussed further under the relevant heading which deals with bad faith. What can be said at this point is that there is little to no proximity between the nature of Respondent’s “business” and the use of the domain names.

The Respondent has never fully addressed this broken link between the nature of the service and the activity pursued to bring that plan to fruition. For example, why is it necessary to register variations of a single company’s name such as <glaxosmithkline.email> and <gsk.email> or the names of products rather than the company if the domain names were truly intended to operate as mailboxes? The Panel in the o2 Holdings case also raised this concern, stating: “It is by no means self-evident that a user of the Respondents’ service would address a communication to a company’s product, rather than the company’s actual name. Were a consumer, even less a person doing business with such a company, to write to a company in the hope that his or her email would end up in the right inbox of these large companies, he or she would not be addressing a branded tub of butter.”

According to the Complainants, the Respondent may argue that the domains utilized are based on how a consumer readily identifies with a brand name rather than a company but once again this argument holds no weight because as Respondent has already stated the domain names will never be visible to the public as this is a back-end service. There is no justifiable reason for the registration of the domain names in dispute, none of which would constitute a bona fide offering of goods and services or non commercial, fair use.

The Respondent has shown multiple times that he has misunderstood the Policy, which is not simply concerned with the functionality or even viability of his proposed email service but the concept of using third party marks as the foundation for that service. Such a service could never be legitimate or effective without the support of the organizations to which it is directed.

The Respondent has previously argued that the service is a certified email service assuring consumers that their email has been delivered, however it is safe to assume that many consumers that choose to send emails to the Complainant would also expect a response or even that their mail had been acknowledged. The Complainant finds it very hard to see how the Respondent can guarantee this in cases where organizations do not sign up to, or in this case, fiercely oppose such a service.

The Complainant contends the Respondent has not been commonly known by the Domain Name.

For completion, the Complainant also asserts that there is no evidence that the Respondent has been commonly known by the disputed domain name as an individual, business or other organization.

Bad Faith Registration and Use

The Complainant emphasize (and provides list of relevant cases) that Panelists have uniformly found that the Respondent lacks sufficient rights and legitimate interest in the domain names he has acquired and that his registration of names identical to third party marks were made in bad faith, within the meaning of the Policy.

To date of filling of the complaint, there have been over 24 cases decided against the Respondent which clearly identifies him as a "cybersquatter"; the principal arguments have been outlined below:

(ii) you have registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct.

The Respondent's admitted conduct of registering over 4,000 domain names, with the majority incorporating third party marks falls squarely within paragraph 4 (b) of the Policy. By his own admission the Respondent has invested approximately 82,000 USD in acquiring scores of domain names in the full knowledge that they related to famous marks in a deliberate scheme to coerce these companies into joining its system and further preventing them from reflecting their mark in the ".email" gTLD space. The Panel in AA Brand Management Limited v. Giovanni Laporta, Yoyo.Email Ltd, Case No. D2014-1444 reconfirmed this position:

"Such behaviour obviously fulfils paragraph 4(b)(ii) of the Policy, which states that registration of a domain name "in order to prevent the owner of a trade mark...from reflecting the mark in a corresponding domain name, provided that [respondent] has engaged in a pattern of such conduct" is evidence of the registration and use of a domain name in bad faith".

In addition to this the Panel in Accor, SoLuxury likened the Respondent's actions to a "land grab", precisely the behaviour which the Policy was designed to combat.

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor.

The Respondent's email system is seeking to impose a unilateral obligation on the Complainant to use or lose its privileged access to its email communications. There is no opt-out method by which mark owners can refuse the email system; a system that the Complainant in this dispute already possesses.

The Complainant in this dispute already have the means to communicate with the public through their own "support tracking systems" (i.e. support tickets, incident ticket systems), many have employed dedicated teams to acknowledge, respond and manage such issues as they arise. Furthermore, much of the information which is transmitted to these organizations is of a confidential nature and is intended only for the person or entity to which it is addressed.

The Respondent has clearly not mitigated the concerns of these organizations in relation to how the domain names will be used and the data protected, for the purpose of offering the service. The statements made in his responses merely raise more questions.

In the case of The Royal Bank of Scotland Group plc, National Westminster Bank plc, and Coutts & Co. v. Domain Manger / yoyo.email / Giovanni Laporta, Case No. D2014-0825 the Respondent stated in his response:

"YOYO should be free to offer the domain name as a free private email to any person which can make use of the RBS and Coutts names. YOYO can make any legitimate email address from the domain name it currently owns. For example, neil@coutts.email (whose name is Neil Coutts) sarah@coutts.email (whose name is Sarah Coutts) and so on." It would appear that with over 4,000 domain names at Respondent's disposal, the different ways to exploit them is endless. The Complainant in the aforementioned case addressed the disruptive nature of this additional service stating; "if a third party was to operate an email address such as [firstname].[lastname]@natwest.email, there is indeed a risk that such an email address could be used for a fraudulent purpose, regardless of whether the Respondent claims that the operation of these email addresses will be controlled by the Respondent."

All the organizations that form part of this complaint have established an austere reputation in their corresponding brands giving them the exclusive right to control how their marks are used. With full knowledge, the Respondent has registered the

domain names precisely because they are identical to Complainant's well-known marks; this is where the value lies. By doing so he hopes to gain a commercial benefit, which constitutes registration and use in bad faith.

Respondent's statements cannot be relied upon; his ever changing business plans and the methods he has adopted in furthering his commercial venture are nothing short of audacious, in that it "piggybacks" on the goodwill and reputation of the Complainant without their authorization. It would be irresponsible on the part of the Complainants to lend their approval to such a service.

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The "likelihood of confusion" is at the core of the Respondent's business model, as without it there could be no business. It has already been established in previous cases that the Respondent could have chosen a number of different alternative domain names to accomplish his purpose, ones which would not interfere with the exclusive right of a trade mark owner, but the Respondent's "business" is entirely dependent on third party marks and his ability to convince the public that his service is endorsed or at the very least accepted by the mark owners. The case of Arla Foods supported the above view, finding:

"In terms of the Policy, by registering this domain name and many others that also contain brand names, in the ".email" gTLD, the Panel finds that the Respondent is attempting to attract Internet users to its website and email service for commercial gain. Further, by having a portfolio of many ".email" domain names that contain brand names, the Respondent is inevitably going to confuse consumers and other companies into believing that the companies whose trade marks are reflected in the Respondent's domain names may have endorsed its Yoyo email service."

Even if the Respondent claims that the domain names will never be visible to the public, his contemplated use expressed in The Royal Bank of Scotland Case (para 5.c.4) contradicts this and clearly shows that the domain would be accessible. Additionally, even if the Respondent's proposed service is to be free at this point, his statements expressed in previous cases demonstrates that he clearly intends to benefit commercially from the use of the disputed domain names in some way, therefore paragraph 4 (b) (iv) of the Policy has been satisfied.

#### RESPONDENT:

According to the Respondent, there is no legitimate basis, based on actual evidence, for transferring the disputed domain names to Complainants. In fact, the evidence establishes that the Respondent registered the domain names for a legitimate business purpose, with the good faith intent to comply with all laws, including trademark laws. There has been no use of the domains to date. The intended use is not a trademark use, or public use. There has been no trafficking of the domains.

The facts are the Respondent purchased all its .email domain names lawfully in good faith. It is a legitimate technology business responding to ICANN's express goal for the new gTLD program and expanding consumer choice on the internet. The Respondent has invested tremendous time and money to developing a lawful business under the .email gTLD. See; <http://yoyo.email> (holding page) <http://yoyo.email/beta> which is under development and should be launched soon. Yoyo beta site is not yet fully functional and is subject to change.

Facts such as the "Respondent has readily admitted that it aims is to oblige trademark holders to join it service", are untrue.

According to the Respondent, the evidentiary basis of adverse decisions seems to be because the trademark is included in a domain name and there is no permission from a Complainant, that its defacto cybersquatting. This argument is not in compliance with the UDRP.

The only evidence that has been known as fact, is that the Respondent purchased its <.email> domain names assets. The purchase of domain names cannot by itself evidence bad faith intent or bad faith use. The purchase by a non-trademark holder of a domain name that includes a matching trademark is not prohibited under the UDRP. Nor does a Registrant

require permission from any particular trademark holder before deciding to purchase a domain name featuring a matching trademark. The UDRP Policy is clear on this issue. Otherwise there would be no good faith uses or fair uses in which a Registrant can demonstrate its rights in accordance with paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

The UDRP does not say that every registration of a domain name that knowingly includes a matching trademark is a violation of the UDRP.

The process after the Sunrise Period given exclusively to owners of matching trademarks by ICANN is that all domain names go on sale to the public. The UDRP Policy does not prevent a Registrant who does not fall under either illustration from purchasing a domain name after domain names go on general sale, if this was not ICANN's desire then the Policy would have said so which is not the case. It's fair to say ICANN and trademark law envision ways in which domain names which may include trademarks can be used legitimately when guided by Policy rules, by all. If this was not ICANN's intention then the disputed domain name should never have gone on general sale without a warning notice written in plain language that domain names featuring trademarks cannot be purchased by anyone other than a trademark holder and/or by someone that can be commonly known by the domain name. There is no such notice before purchase or any such language used in the UDRP Policy or written into the terms and conditions of GoDaddy.com, who was the Registrar that sold the domain name to the Respondent.

It is also worth noting, that the Complainant as holders of a matching trademark had an exclusive opportunity given to them by ICANN lasting three whole months to secure the domain names at issue during ICANN's Sunrise Period and did not do so. In contrast, the Respondent paid and acquired its business domain name assets legitimately when the domain names went on public sale in keeping with "fair and good use" Policy rules. It is not understood why the Complainants IT department did not opt to purchase the subject domain name when there was a clear opportunity to do so. It can only be presumed the Complainants did not want to purchase them at the time. The very existence of a limited Sunrise period would suggest there must come a time when all domain names can be purchased legitimately when guided by Policy rules. Otherwise what's the point of a limited period, it would last indefinitely, if such a "time" did not exist.

Prior Examiners have engaged in little more than speculation and conjecture about Respondent's business model, and its intentions and relied on unsupported statements in prior decisions, which in all cases were unproven, never argued and certainly not supported by any independent evidence. Contrary to what prior Examiners have reported the Respondent has not used its domain names to profit from advertising connected to the use of a trademark web service. Nor is there any evidence, beyond raw speculation or regurgitated undocumented hearsay from prior panel decisions, to support any future intent to use the subject domain in such a way. All the evidence is to the contrary.

There is also suggestion that somehow using a brand name as opposed to the corporate name suggests bad faith. Because these domain names are simply being used to store email metadata, it doesn't matter what short hand domain is chosen to represent the company. This type of operation is not bad faith.

Yoyo is primarily a consumer focused service working on behalf of the sender (Consumer) and NOT the receiver. Yoyo is the neutral party that sits between sender and receiver and works on behalf of the sender as proof the email has been sent, much like regular mail courier services. Therefore Examiners and Complainants are under the false impression that the Respondent's service could never be a legitimate service without the "support" of the organizations to which it is directed. This reasoning is illogical, if it were not, it would mean that all mail & parcel courier services throughout the world in order to become legitimate, would need the "support" from organizations (trademark holders) before accepting mail directed to them. It is also not bad faith to purchase variations of a domain name required for the same service. Such as <glaxosmithkline.email> and <gsk.email>. It was not illegal to purchase either domain name. Purchasing variations of a domain name and then deciding which if any to keep is not bad faith. Domain names were not stolen they were paid for when they went on general release to the public. In fact all suggested "bad faith" views made by prior Examiners and Complainants are themselves bad faith attempts to manipulate the facts and UDRP Policy rules.

The initial idea is to launch the service as a closed software service which means that users can only send emails via the Respondents software, so initially the service works as a back end service where all emails are directed and documented

internally by name. At this point domain names are not seen by the general public, however domain names may be used to forward emails to the respective company (recipient). At this point there can be no confusion as to source and origin as the company (recipient) cannot be confused to who they are. Further, there is absolutely no need for Recipients (the Complainant) to “sign up” for the Respondent service.

The service at some point in the future may be extended so that consumers can send emails via any email client software, the intention is to expand consumer choice. However as long as users sent emails using the Respondents domain names which pass through its owns email servers Yoyo could still provide an email certified service when emails are then sent from other software email clients.

ICANN’s UDRP policy is intended to prevent trademark owners from being extorted by cybersquatters, but it is also intended to protect individuals who register domain names in good faith and have a legitimate interest in the domain names from overreaching trademark owners or worst trademark bullies. A correct application of the spirit and letter of the UDRP gives each of these concerns equal weight. The UDRP was designed to provide a quick and relatively inexpensive procedure that could be used by TM owners against those who register domain names in bad faith AND without a legitimate right or interest. As with the spirit of the UDRP, the procedure may only be initiated by TM owners. Previous Examiners have spectacularly failed to balance these concerns fairly.

On November 5, 2014 the United States District Court of Arizona entered a judgment, which stated that “[p]laintiff’s legitimate purpose seeking to certify the sending and receipt of emails, as described in the Complaint, does not evidence a bad-faith intent to profit from the “registration, use or trafficking” of a domain name.” The Court specifically ordered that the “[p]laintiff has a good faith intent to register, use, and traffic” the specific “.email” domain name at issue in that case, the “[p]laintiff’s intended use of [the specific “.email” domain name] as set forth in the Complaint is not trademark use,” and “[p]laintiff’s intended use of [the specific “.email” domain name] as described in the Complaint is not a violation of the Anti-Cybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d) et seq., the Lanham Act, 15 U.S.C. § 1051 et seq., the ICANN URS and UDRP policy or other law. In this case, the Respondent is using the subject domain name in the same manner as he was with the domain in Case No. CV-14-01922-PHX-JJT. Specifically, the Respondent is using the subject domain name as a non-public, back-end email server used to link multiple email servers, to track, record, and verify email communication.

Relevant to this Complaint is the use of the subject domain as a backend, non-public email server in order to route emails for the storing of Metadata which will allow yoyo.email to certify delivery and potentially receipt. The Complainant has provided no evidence to contradict the business model or domain use described in the Judgement. The Complainant has provided no evidence for the basis of this Compliant beyond raw speculation or regurgitated undocumented hearsay from prior panel decisions. The Complainant relies entirely upon adverse previous UDRP and URS cases for its evidentiary obligations. This is simply not enough to support a legal transfer under the UDRP policy of the domain name ownership. To date, no evidence other than conclusory statements has ever been provided by any previous Complainant to support a finding that the UDRP Policy has been violated. This Complainant in this case, is no different. Complainant can only argue rank, in that it is a holder of a matching trademark, which does not meet all the evidentiary obligation required by the UDRP policy.

The Respondent does not use trademarks qua trademarks as required by law to establish commercial use. Rather, the Respondent uses words that happen to be trademarks for their non-trademark value.

First, the Respondent has made demonstrable preparations to use the disputed domain name in connection with a bona fide offering of services under the Policy. Specifically, the Respondent is providing certification of e-mail services, which will be free for both the sender and receiver of e-mails. Further, by using the disputed domain names as a backend, non-public email server in order to route emails for the storing of Metadata, there is no public use of the domain name, no diversion of website traffic from the trademark holder and no intent to profit related to the use or trafficking of the subject domain name. The Complainant’s trademark rights are not harmed in any way.

The Respondent has also set up offices and engaged staff including hiring an experienced WIPO Examiner the Hon Neil Brown QC and leading trademark attorneys Traverse Legal PLC. Both have opined that Respondent’s business model and use do not violate trademark law or the UDRP. Both have been retained to ensure compliance with all laws including the

UDRP and ACPA.

The Respondent has fiercely defended each UDRP and URS complaint filed against it in support of its business legitimacy. Respondent by providing the free use of its domains and limiting the use of the domain name to route and capture email meta data is making a legitimate fair use of its <.email> domain name portfolio, with no intent to profit from the Complainant and certainly has never intended to deceive or attract internet users for commercial gain by "intentionally creating" confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Registrant web site or location or of a product or service on the Registrant's web site or location.

The Respondent has also applied on the August 1, 2014 for a Community Trade Mark for YOYO.EMAIL with the European Union in International Classes 35, 38 (Telecommunication services), 42 (Computer services) and 45 (Domain name registration services). This further helps demonstrate the Respondent has every intention to operate a legitimate business that has a legitimate interest in the disputed domain name. Further, Respondent's CEO is a respected inventor and businessman who has a proven track record in the developing innovative ideas. The Respondent's CEO has some 22 granted patents that demonstrates Respondent often finds innovative solutions to day to day problems. The Respondent's certified email service is just another of one of those solutions.

The Respondent has never accepted and still does not accept that a service with a primary objective not to deceive, and that can only work by demonstrating independence from the Complainant so that it can be advertised as an "independent certified email service" can ever be described as "bad faith" to deceive. The Respondent has never intended to mislead or deceive internet users for commercial gain.

The Respondent has registered and is using the disputed domain name in good faith

In the Complaint, the Complainant states again without any independent evidence that the Respondent is using the disputed domain name in bad faith. The Respondent has never intended to profit in any way relating to the use of the domain name as a trademark. The Respondent has not used the domain to date to profit from advertising connected to the use of a trademark-related web service. Nor is there any evidence, beyond raw speculation or regurgitated undocumented hearsay from prior panel decisions, to support any future intent to use the subject domain in such a way.

The Complainant is under the false impression that the Respondent cannot operate any commercial service, directly or indirectly, with its domain names. Paragraph 4(c)(iii) of the Policy clearly says that Registrants can operate a commercial service as long there is no intention to profit from the subject domain by deceiving internet users or tarnish a trademark.... "for commercial gain to misleadingly divert consumers" or to "tarnish the trademark or service mark at issue".

The fact that Respondent intends to be a for profit business in general from the use of the many generic domains it has registered, in no way supports the allegation that it intends to profit from the subject domain or trademark by deceiving internet users. The Respondent is not using the disputed domain name to defraud the public by creating a false impression the domain name is the Complainant's genuine internet name. The Respondent did not register the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant. The Respondent has never approached the Complainant. It is noted that the Respondent has previously when legal counsel has offered the Respondent \$1,000 to purchase another TM disputed domain name, refused the offer and stated that "selling domain names is not the reason why domain names were registered, so I respectfully have to decline your offer." If the Respondent's intent was to profit from trademark domain names, as it has been suggested, the Respondent would have simply accepted \$1000 when it was offered. Further, the Respondent did not register the domain name for the purpose of disrupting the business of the Complainant, but instead to provide a new way in email verification.

The mere registration of a domain name, which in this case is all the evidence which is known as fact cannot by itself be a sign of bad faith. The mere purchase by a non-trademark holder of a domain name that includes a trademark is not bad faith under the Policy. Nor does a Registrant require permission from the Complainant as a trademark holder before it purchased its domain name. The Policy is clear on this issue. If ICANN wanted these conditional rules included into the Policy when it was drafted in October 1999, then it would have been and still could be easy conditions to draft and include into the UDRP

Policy.

Because the Complainant has not proven each of the three elements required in all UDRP proceeding by a preponderance of the evidence, and relies entirely upon adverse previous UDRP cases for its evidentiary obligations, which were all erroneously determined based on an Examiner's subjective interpretation of alleged UDRP Policy violations rather than determinations guided by evidence or as a matter of law, the domain names should not be transferred to the Complainant. The Complainant bears the burden of showing that the Respondent's registered the domain name at issue with a motive of bad faith or bad faith intent by any general member of the public.

Therefore the Respondent is of the opinion that the Complaint shall be denied.

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#### RIGHTS

The Complainants have, to the satisfaction of the Panel, shown the Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights (within the meaning of paragraph 4(a)(i) of the Policy).

The Respondent does not dispute that the trademarks of the Complainants are incorporated in the second level domain of the disputed domain names. Each of the Domain Names is clearly confusingly similar to the corresponding trade mark in which one of the Complaints has trade mark rights. Only with regard to the James Villa mark, the disputed domain name has an additional letter, „S“, at the end which does not change this assumption. The Panel therefore considers the Domain Names in question to be confusingly similar to the trademarks in which the Complainants have rights in accordance with paragraph 4(a)(i) of the Policy.

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#### NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Names (within the meaning of paragraph 4(a)(ii) of the Policy).

The Respondent has no rights in the Domain Names since the Respondent is not a licensee of the Complainant nor have the Complainants granted any permission or consent to the Respondent to use its trademarks. Furthermore, the Respondent has no legitimate interest in the Domain Names since there is no indication that the Respondent is commonly known by the names reflecting the trademarks nor that the Respondent is using the Domain Names in connection with a bona fide offering of related goods or services.

Respondent's registration and intended use of the disputed domain names is not considered as bona fide within the meaning of paragraph 4(c)(i) of the Policy. Panel does not see any legal reason or justified interest to use Complainants' marks for use with the Respondent's email service. As the panel found correctly, also in view of prior ADR decisions, in CAC 100891 (Logitech International S.A and other ./ G.La Porta/yoyo email), the Respondent's conduct prevents the Complainants from registering its mark as a domain name in the <.email> gTLD space, and potentially would force the Complainants to be an unwilling participant in the Respondent's commercial enterprise.

The Respondent also refused to clearly indicate why his service shall, technically or otherwise, require domain names reflecting and/or incorporating existing trademarks. The pure investment in obtaining the domain names and defending itself against numerous accusations of alleged wrong doing bears no indication with regard to a bone fide offering of related goods or services.

The Respondent also heavily relies on a declaratory judgement rendered in the Unites States of America which has however no sufficient relevance for the present case. The judgement is not between the same parties as being parties in this proceeding and is related to a different domain name. Furthermore, the parties of this judgement agreed to enter this Declaratory Judgment after discussions of the allegations and settlement of the claims. No reasoning for this judgment was provided. Neither the parties of this proceeding, nor the Panel is accordingly bound to this judgement nor can the panel discuss or evaluate any substantiation of this judgement.

The Panel therefore finds that the Respondent does not have rights or legitimate interests in the Domain Names.

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#### BAD FAITH

The Complainants have, to the satisfaction of the Panel, shown the Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

The Paragraph 4(b) of the Policy stipulates: For the purposes of Paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

In view of the Respondent's activities, this panel fully shares the view of the panel in CAC 100891 (Logitech International S.A and other /. G.La Porta/yoyo email) that the requirements of paragraph 4 (b) (ii) of the Policy are met. The Respondent has, in the course of business, registered the disputed domain names and many others comprised of third-party marks in order to prevent the Complainant and other brand owners from reflecting their trademarks in corresponding domain names in the ".email" gTLD space. The number of decisions where the Respondent was involved as a respondent shows a pattern of conduct demonstrating bad faith registration and use.

It is the consensus view of UDRP panels that a lack of active use of the disputed domain name without any active attempt to sell or to contact the trademark holder (passive holding) does not, per se, prevent a finding of bad faith (see inter alia Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>; Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273, <pentiumgroup.net>).

The Panel therefore considers the Domain Names to have been registered and used in bad faith in accordance with paragraph 4(a)(iii) of the Policy under the present circumstances.

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#### PROCEDURAL FACTORS

The Complaint was filled by 9 Complainants. Given the fact the Complainants have a common grievance against the Respondent who has engaged in common conduct that has affected their rights in a similar fashion, the Panel finds that this class complaint is admissible in accordance with Article 4 of the Czech Arbitration Court's UDRP Supplemental Rules.

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

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#### PRINCIPAL REASONS FOR THE DECISION

The Panel regards the registration of several confusingly similar domain names in this case incorporating registered trademarks for an email service as without rights or a legitimate interest and not being a "bona fide" offering of services. In

view of several other similar cases against the Respondent, it is also regarded as a bad faith registration and use within the scope of paragraph 4(b)(ii) of the Policy.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

**Accepted**

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AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. SKYVEGAS.EMAIL: Transferred
  2. ATTENDA.EMAIL: Transferred
  3. JACUZZI.EMAIL: Transferred
  4. BRITNEYSPEARS.EMAIL: Transferred
  5. POLYCELL.EMAIL: Transferred
  6. DULUX.EMAIL: Transferred
  7. CAMPER.EMAIL: Transferred
  8. FULHAMFC.EMAIL: Transferred
  9. LUCOZADE.EMAIL: Transferred
  10. JAMESVILLAS.EMAIL: Transferred
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## **PANELLISTS**

Name	Dietrich Beier
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DATE OF PANEL DECISION 2015-04-13

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Publish the Decision

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