# Decision for dispute CAC-UDRP-100982

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| Case number | CAC-UDRP-100982 |
| Time of filing | 2015-04-30 16:11:58 |
| Domain names | allsaints.email , mfc.email , Karenmillen.email , Sse.email , Rac.email , Randstad.email |

## Case administrator

| | |
|---|---|
| Name | Lada Válková (Case admin) |

## Complainants

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| Organization | All Saints Retail Limited |
| Organization | Karen Millen Fashion Limited |
| Organization | Middlesbrough Football and Athletic Co. (1986) Ltd |
| Organization | RAC Motoring Services Ltd |
| Organization | Randstad Holding N.V. |
| Organization | SSE Plc |

## Complainant representative

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| Organization | Safenames Ltd |

## Respondent

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| Organization | YOYO EMAIL |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings, which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainants rely on the following trademarks:

1. All Saints Retail Limited ("All Saints")

- ALL SAINTS (word), CTM registration No. 4610945, filed on 30 August 2005 and granted on 10 November 2009, for goods and services in classes 3, 9, 14, 18, 25, 35;

- ALL SAINTS SPITALFIELDS (script), CTM registration No. 6356547, filed on 2 November 2007 and granted on 2 April 2009, for goods in classes 3, 9, 14, 18, 25, 35, 41 and 43.

2. Karen Millen Fashions Limited ("Karen Millen")

- KAREN MILLEN (word), CTM registration No. 995001, filed on 17 November 1998 and granted on 3 April 2000, for goods in classes 9, 14, 24;

- KAREN MILLEN (device), CTM registration No. 814038, filed on 27 April 1998 and granted on 13 October 1999, for goods in classes 3, 18, 25;

3. Middlesbrough Football & Athletic Co. (1986) Ltd. ("MFC")

- MFC (device), UK registration No. 2167951, filed on 28 May 1998 and granted on 4 January 1999, for goods in classes 14, 16, 18, 24, 25, 26, 27, 28;

- MFC (device), UK registration No. 2167894, filed on 28 May 1998 and granted on 29 December 1998, for goods in classes 14, 16, 18, 24, 25, 26, 27, 28;

4. RAC Monitoring Services Ltd. ("RAC")

- RAC (word), UK registration No. 1293393, dating back to 21 November 1986, for goods and services in classes 12, 16, 36, 37, 39, 42, 43, 45;

- RAC (word), UK registration No. 2470656, dating back to 25 October 2007, for goods and services in classes 9, 16, 35, 36, 37, 38, 39, 41, 42, 43, 45.

5. Randstad Holding N.V. ("Randstad")

- RANDSTAD (word), CTM registration No. 3468311, filed on 29 October 2003 and granted on 13 October 2005, for services in classes 35, 41 and 42;

- RANDSTAD (device), CTM registration No. 13181821, filed on 18 August 2014 and granted on 9 January 2015, for services in classes 35, 41 and 42;

6. SSE plc ("SSE")

- SSE (word), CTM registration No. 8521585, filed on 1 September 2009 and granted on 26 April 2010, for goods and services in classes 1, 4, 6, 7, 8, 9, 11, 12, 16, 17, 19, 35, 36, 37, 38, 39, 40, 41 and 42;

- SSE PROUD TO MAKE A DIFFERENCE (device), CTM registration No. 13150388, filed on 6 August 2014 and granted on 30 December 2014, covering goods and services in classes 4, 6, 7, 9, 11, 16, 17, 19, 35, 36, 37, 38, 39, 40, 41, 42.

FACTUAL BACKGROUND

The Complainants in the current proceedings are:

1. All Saints is a British fashion retailer established in 1994 that sells menswear, womenswear from its 120 stores located in 10 countries worldwide. All Saints has an active online presence, shipping to over 200 countries via its e-commerce websites with revenue in its most recent fiscal year amounting to over £210 million. All Saints has a noticeable international presence and uses social platforms to promote and market their products through Twitter (95,000+ followers), Facebook (614,000+ likes) and YouTube (22,000+ subscribers), which contributes to their global presence and reputation.

2. Karen Millen is a company incorporated under the laws of England and Wales and originated from its founder Karen Millen who studied fashion at the Medway College of Design. Since opening its first store in 1983, Karen Millen has grown into an internationally recognized brand with stores in over 65 countries across six continents. In 2010 Karen Millen had revenue of £250m and received 60 percent of sales from outside of the UK. The international retail value of products sold under the Karen Millen brand directly or through authorized resellers/partners was GBP 272,384,000 for the year ended on January 31, 2012.
Karen Millen uses a range of social media platforms which has contributed to its global presence with 28,000+ followers on Twitter, 185,000+ likes on Facebook and over 37,000+ followers on Instagram.

3. MFC, is an English football club based in Middlesbrough, which participates in the Football League Championship. Founded in 1876 the club achieved a home record attendance of 53,596 in 1949 against Newcastle United and finished in the top 10 in the Premier League in 1999 and 12th in 2000. In February 2004 after 128 years, MFC lifted their first ever trophy, the Carling Cup and later reached the UEFA Cup Final in May 2006. The club has become identifiable by the acronym MFC. For example, the clubs Football charity which works with over 20,000 people across a number of sports, health, education and youth projects is known as the MFC Foundation. The clubs merchandise, which consists of Football equipment, souvenirs and articles of clothing incorporates the “MFC” logo and the clubs continued use of the “MFC” acronym through its various website domain names and on various social media platforms further demonstrates the clubs extensive common law rights.

4. SSE was formed in 1998 following the merger of Scottish Hydro Electric and Southern Electric. SSE is involved in the producing, distributing and supply of electricity, gas and other energy-related services and is the only company listed on the London Stock Exchange involved in such a wide range of energy businesses. SSE is considered as one of the “Big Six”, dominating the energy market in the United Kingdom with annual profits of £1.5bn in 2013/14 and being one of the UK’s largest officially-accredited Living Wage Employers with nearly 20,000 staff across the UK.

5. RAC is a British automotive services company headquartered in Walsall, West Midlands and is a wholly owned subsidiary of the private equity firm The Carlyle Group. Founded in 1897 as the Royal Automobile Club, the RAC was incorporated as an Associate Section in 1978. RAC provides motoring services to private and business motorists including breakdown cover with roadside assistance, insurance, assistance with buying a used car, vehicle inspections and checks, legal services and traffic and travel information. RAC has over eight (8) million members of its services and in 2014, RAC's patrol force of approximately 1,500 patrols attended to 2.3 million rescue breakdowns. RAC has gone to great lengths to protect its rights and interests in RAC mark through the registration of multiple domain names covering at least 12 different classes of goods and services.

6. Randstad was founded in the Netherlands in 1960 and is the world’s second largest recruitment and Human resources (“HR”) services company with operations in 39 countries and representing 90 per cent of the global HR services market. Randstad also hosts and presents the Randstad Award each year, which covers 75 per cent of the global economy and is awarded to the most attractive employer worldwide out of 225,000 respondents. Randstad are the proprietors of European Community trade marks, which they have used extensively to promote and offer its services.

The six organizations that form this complaint have a common grievance against the Respondent who has engaged in common conduct that has affected their rights in a similar fashion; henceforth, in accordance with Para. 4 of the CAC Supplemental Rules (which expressly provides for proceedings to be brought by multiple complainants) they will be referred collectively as the “Complainants” (See CAC Cases No. 100890 and 100891).

PARTIES CONTENTIONS

1. The Complainants

The Complainants' contentions are the following:

The disputed domain names are identical to the Complainants' earlier trademarks.

The Respondent lacks rights and legitimate Interests to the disputed Domain Names.

Neither Yoyo Email, nor Giovanni Laporta have:

(a) ever been commissioned to manage the Complainants' email communications;
(b) ever been licensed to use the Complainants' marks for the receipt and transmission of email communications;
(c) ever received any approval, expressed or implied, to use these marks in or as part of a domain name. Complainants have no association, affiliation and/ or dealings of any nature whatsoever with the Respondent and neither endorse or promote its services;
(d) ever been commonly known by the disputed Domain Names.

Under the Policy, a Respondent may demonstrate that 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.

None of the aforesaid circumstances apply to the case at issue.

To date, the Respondent has been involved in many UDRP and URS cases. After careful consideration of the facts Panels have come to the consensus view that the use of third party trade marks in connection with the Respondent's certified email service cannot be legitimate.

The Respondent's intended business model does not constitute a legitimate plan for demonstrable preparations of use. Demonstrable preparations require a Respondent to show prior activity which does not amount to taking unfair advantage of a third party's trade mark. In previous disputes 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 trademarks, but provides no visible justification for its registration of trademark-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.

It appears that the Respondent relies on a mere indication of intent; this is insufficient especially when such intended use requires the unauthorized use of Complainant's famous trademarks.

The Respondent intends to benefit from the underlying value of the Complainants' trademarks. The Respondent has had many opportunities to explain his business model in detail. The Respondent's intended business model could not exist, but for the third party trademarks, to which the Respondent has no prior or other rights. This would explain why the Respondent is still unable to sufficiently explain the connection between its 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; this is impossible. Not only does the service derive from the Complainants' goodwill in their marks but the Respondent readily admits that its domain names were deliberately registered to oblige the trademark owners to join its system. Such use cannot be considered legitimate as the Respondent is clearly using coercion to attract the Complainants to a service, which ultimately makes money from them as an unwilling participant.

The Respondent cannot justify the registration of the disputed 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 (See Statoil ASA v. Giovanni Laporta, Yoyo.Email Ltd., Case No. D2014-0637).

Although the Respondent will argue that the latter form attempts to avoid consumer confusion such reasoning is irrelevant in light of the fact the Respondent claims that its domain names will never be visible to the public as this is a back-end service. The majority of Panels have rejected the Respondent's argument because as the Panel in Accor, SoLuxury HMC v. Giovanni Laporta, Yoyo.Email, Case No. D2014-1650 states, "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 the 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 the Respondent to serve its business purpose without affecting the Complainants' intellectual property.

There is little to no proximity between the nature of the Respondent's "business" and the use of the disputed 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> (See CAC Case No. 100890) 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."

The Respondent may argue that the domain names 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 the Respondent has already stated its 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's trademarks 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 Complainants would also expect a response or even that their mail had been acknowledged. Complainants find 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.

Previous Panels have held that "There is no way Respondent can guarantee a message sent from its proprietary SMTP server actually arrives at a particular email address. This is due to the fact email receipts were never implemented uniformly and consistently throughout the internet. So, this little bit of history means Respondent has knowingly lied to the Panel. That single fact will make it a little bit easier for Complainant to prove Respondent acted in bad faith." (See MySQL AB v. Giovanni Laporta / Yoyo.Email Claim Number: FA1412001595391).

The Respondent has registered and used the disputed Domain Names in bad faith because to date there have been over 37 cases decided against the Respondent which clearly identifies him as a "cybersquatter"; the principal arguments have been outlined below:

The Respondent's admitted conduct of registering over 4,000 domain names, with the majority incorporating third party marks falls squarely within para. 4(b) of the Policy. By its 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 scores of UDRP/ URS cases against the Respondent including the present class action, only seek to further demonstrate that his current transgression against the Complainants' trademarks is not an isolated incident but that its poorly conceived plan to offer an ill-defined email service based on famous trademarks is quickly unravelling.

The Complainants 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 its 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. Contrary to the WHOIS record, the Respondent (Giovanni Laporta trading as Yoyo.Email) is a UK registered company having its principle place of business in the UK and would have been very familiar with the Complainants’ which all but one, are household names within the UK. Therefore, it can be said that with full knowledge that the Respondent has registered the disputed Domain Names precisely because they are identical to the Complainants' well-known marks. By doing so the Respondent hopes to gain a commercial benefit, which constitutes registration and use in bad faith.

The Respondent’s statements cannot be relied upon; its ever changing business plans and the methods it has adopted in furthering its 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.

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 its 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 its ability to convince the public that its service is endorsed or at the very least accepted by the trademark owners.

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

Finally, in anticipation of Respondent’s arguments in relation to its feigned success in the Yoyo.Email, LLC vs. Playinnovation, Ltd, case filed with the United States District Court of Arizona, it must be noted that the declaratory judgment was as a consequence of a settlement between the parties. The case does not relate to matters central to the requirements of the Policy, neither does it involve the same parties.

2. The Respondent

As to the Respondent, for the procedural reasons mentioned below, the Panel decided not to take into account the Response, even if it was filed within the given deadline. However, prior to the relevant deadline, the Respondent also sent to the CAC an e-mail with arguments in its defense. The arguments contained in this e-mail, that the Panel will take into consideration for the purpose of this decision, may be summarised as follows.

The disputed Domain Names were registered in good faith for legitimate use. The prior Panels having to deal with similar Complaints against the same Respondent for comparable domain names have misinterpreted the Respondent's arguments and evidence. The individuals who run the UDRP system do not possess the same quality of legal and fair minds as those found in federal judges. The Respondent does not recognize the value of the UDRP proceedings and since the UDRP loss has no bearing on subsequent litigation, the Respondent will initiate a federal lawsuit to avoid hijacking through the UDRP against Complainants successful in UDRPs. Moreover, the Respondent's lawyers will also bring a cause of action at the USPTO to cancel the Complainants' registered trademark rights under a provision that states that trademark rights may be cancelled if they are misused.

The Respondent's registration of the disputed Domain Names does not constitute trademark infringement or any other unlawful action, and does not violate the UDRP, URS, ACPA or Lanham Act, as the District Court of Arizona already stated.

On losing a UDRP Complaint, the Respondent is able to satisfy the four elements necessary for a reverse domain name hijacking under the ACPA and therefore to claim substantial damages to the Complainant.

The Respondent, when purchasing its domain names does not claim any IP trademark rights in the domain name, but claims legitimate business interest in its property. This property has been paid for, and governed by, purchase terms and conditions, which the Respondent complied with.

Accordingly, the Respondent invites the Complainant to promptly withdraw the URDP Complaint.

In addition to the Respondent's e-mail, the Respondent enclosed a declaratory judgment of the United States District Court for the District of Arizona, dated 5 November 2014, where the Respondent was declared to have a good faith intent to register, use and traffic the domain name <playinnovation.email>, and not to have a bad faith intent to profit from the registration, use or trafficking of the aforesaid domain name.

Moreover, in this declaratory judgment one may read that the Respondent's intended use of <playinnovation.email> as set forth in the Complaint does not amount to trademark use.

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 para. 4(a)(i)of the Policy).

The Class Complaint involves six Complainants and the Panel has therefore analysed the first requirement of para. 4(a)(i) of the Policy separately for each of them:

1. All Saints , has shown to be the owner of at least ALL SAINTS, word Community trademark registration No. 4610945, dating back to 2005 for goods and services in classes 3, 9, 14, 18, 25, 35. This trademark is identical to the Domain Name <allsaints.email>, since the distinctive part of this Domain Name lies in the "allsaints" component, while the ".email" component lacks distinctive character, as it simply refers to the type of new gTLD under which the second level Domain Name has been registered.

2. Karen Millen , has shown to be the owner of at least KAREN MILLEN, word Community trademark registration No. 995001, dating back to 1998, for goods in classes 9, 14, 24. This trademark is identical to the Domain Name <karenmillen.email>, since the distinctive part of this Domain Name lies in the "karenmillen" component, while the ".email" component lacks distinctive character, as it simply refers to the type of new gTLD under which the second level Domain Name has been

registered.

The Panel has noted that this Complainant has been constantly referred to as Karen Millen Fashion Limited in the Complaint, while the proprietor of the trademarks listed in the Complaint is named Karen Millen Fashions Limited. However, since the Complainant's address indicated in the Complaint coincides with the address shown on the trademark record, the Panel takes the view that the Complaint contains a minor typographical error that cannot affect the right of this Complainant to bring this UDRP proceeding.

3. MFC, has shown to be the owner of at least MFC, device UK registration No. 2167951, dating back to 1998, for goods in classes 14, 16, 18, 24, 25, 26, 27, 28. This trademark is confusingly similar to the Domain Name <mfc.email>, since the distinctive part of this Domain Name lies in the "mfc" component, while the ".email" component lacks distinctive character, as it simply refers to the type of new gTLD under which the second level Domain Name has been registered. Moreover, the device accompanying this Complainant's trademark has a minimum distinctive character compared to the word part of the trademark, and domain names can only contain alphanumerical characters, not designs.

4. As far as RAC is concerned, this Complainant has relied on two UK registrations for the word mark RAC, covering goods and services in various classes and respectively dating back to 1986 and 2007. However, these two trademark registrations appear to be in the name of RAC Brand Enterprises LLP, rather than in the Complainant's name. To clarify this point, in compliance with the general powers conferred to the Panel under paragraph 10 of the Rules, the Panel has asked the Complainant to provide information about the existing relationship between RAC Brand Enterprises LLP and the Complainant, as well as evidence of the right to use the RAC trademarks by the Complainant.

The Complainant informed the Panel of the fact that RAC Motoring Services and RAC Brand Enterprises LLP are both wholly owned subsidiaries of The RAC Ltd Group, and provided relevant evidence to support this statement. According to the Complainant, the ownership and management of the RAC brand and other intangible assets was centralised within RAC Brand Enterprises LLP in 2012, and this entity now licenses access to the use of the brand to all companies part of The RAC Group companies, thus also to the Complainant.

The Panel accepts that due to the fact that both the Complainant and RAC Brand Enterprises LLP belong to the same group of companies, and to the fact that it is apparent from the documentary evidence attached to the Complaint that the RAC trademark is used by all companies of The RAC Group, the Complainant was entitled to file this Complaint as a licensee of the RAC trademarks, and to ground its rights on the RAC trademarks cited in the Complaint.

The two RAC trademarks cited as a basis of this Complaint are identical to the Domain Name <rac.email>, since the distinctive part of this Domain Name lies in the "rac" component, while the ".email" component lacks distinctive character, as it simply refers to the type of new gTLD under which the second level Domain Name has been registered.

5. Randstad has shown to be the owner of at least RANDSTAD, word CTM registration No. 3468311, dating back to 2003, for services in classes 35, 41 and 42. This trademark is identical to the Domain Name <randstad.email>, since the distinctive part of this Domain Name lies in the "randstad" component, while the ".email" component lacks distinctive character, as it simply refers to the type of new gTLD under which the second level Domain Name has been registered.

6. SSE has shown to be the owner of at least SSE, word CTM registration No. 8521585, dating back to 2009 for goods and services in classes 1, 4, 6, 7, 8, 9, 11, 12, 16, 17, 19, 35, 36, 37, 38, 39, 40, 41 and 42. While the certificate of registration for this trademark enclosed with the Complaint indicates the company Scottish and Southern Energy Plc, as the registered owner of the subject trademark, upon further verifications on the CTM's database, the Panel has ensured that the actual owner of this trademark is indeed SSE plc. This trademark is identical to the Domain Name <sse.email>, since the distinctive part of this Domain Name lies in the "sse" component, while the ".email" component lacks distinctive character, as it simply refers to the type of new gTLD under which the second level Domain Name has been registered.

For all reasons mentioned above, the Panel is satisfied that the first requirement under the Policy is met.

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 Name (within the meaning of paragraph 4(a)(ii)of the Policy).

The Complainants have anticipated in their Complaint most of the Respondent's arguments, on the assumption that these arguments would have been similar to those made by the Respondent in the past URS and UDRP cases referring to other domain names under the gTLD .email.

The Panel has thoroughly reviewed the prior UDRP decisions involving the Respondent on those similar cases cited in the Complaint, and has come to the conclusion that the Complainants' summary of the Respondent's arguments is accurate. Moreover, these arguments do not contradict the Respondent's arguments contained in its e-mail of 6 may 2015 (see the procedural section below). Therefore, despite the Panel has decided not to take into consideration the Respondent's arguments for the procedural reasons mentioned below, the Panel will take into consideration the summary of the Respondent's arguments included in the Complaint.

The Panel notes that the Respondent does not dispute the following circumstances:

- that the Complainants never granted to the Respondent any right to register and use the disputed Domain Names, nor entrusted the Respondent with any specific task in connection with the Complainants' e-mail communication system;

- the well-known character of the Complainants' trademarks;

- that the Respondent is not known by the Domain Names.

On the contrary, it appears that the Respondent maintains that the disputed Domain Names were legitimately registered to provide a certified email service assuring consumers that their email has been delivered.

The Panel notes that since the disputed Domain Names are not actually used, the Respondent should have provided actual and convincing evidence of the fact that it made "demonstrable preparations" to use the Domain Names before becoming aware of these proceedings. However, it does not appear that the Respondent has provided such convincing evidence, or any evidence at all.

Furthermore, it is clear from the Complaint, from the Respondent's e-mail of 6 May 2015, and from the prior UDRP decisions involving the same Respondent, that the Respondent registered numerous domain names, all corresponding to well-known third parties' trademarks, and that all these registrations were not authorised by the respective trademark owners.

The unauthorised registration of thousands of domain names corresponding to well-known trademarks to allegedly provide a certified email service not required by the trademark owners - as such unduly taking advantage of the lack of registration of their respective trademarks under the gTLD .email - cannot qualify as a bona fide offering of services, or as a legitimate noncommercial or fair use of the Domain Names.

For all reasons mentioned above, the Panel takes the view that the Complainant has satisfactorily proved the Respondent's lack of rights and legitimate interests in the Domain Names.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

As far as registration in bad faith is concerned, the Panel notes that the Respondent was obviously well aware of the Complainants' trademarks at the time it registered the disputed Domain Names. Indeed, it registered the disputed Domain Names precisely because they corresponded to the Complainants' well-known trademarks, in order to offer its e-mail certification service. The Respondent could have asked the Complainants' authorisation to register the disputed Domain

Names, but deliberately decided not to do so, and to proceed with the registration of the disputed Domain Names, as well as many others, the majority of which, incorporating third parties' well-known trademarks. The Respondent has already been involved in many UDRPs and URS, and these cases have been decided against the Respondent.

According to para. 4(b)(ii) of the Policy, a Respondent is to be considered in bad faith if it registered the domain names "in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name", provided the Respondent "has engaged in a pattern of such conduct". It appears to the Panel that the large number of domain names the Respondent has registered without authorisation to provide a service that no trademark owner has requested, falls afoul in the provision of para. 4(b)(ii) of the Policy. This is even more so considering that the Respondent could have registered alternative domain names, not infringing the Complainants' trademarks (see also, among others, Statoil ASA VS. Giovanni Laporta, Yoyo.Email Ltd., Case No. D2014-0637; Sarwood Hotels & Resorts worldwide, Inc., Sheraton LLC, Sheraton International IP, LLC vs. Giovanni Laporta / Yoyo.email, Case No. D2014-0686) but instead deliberately decided to proceed with the registration of Domain Names identical to the Complainants' earlier marks.

With regards to the use of the disputed Domain Names in bad faith, the Panel notes that the current passive holding of the Domain Names does not prevent a finding of bad faith (see also, among others, Compagnie Gervais Danone, Société Anonyme des Eaux Minérales d'Evian (SAEME), Société des Eaux de Volvic, Nutricia International BV v. Giovanni Laporta, Yoyo.Email, WIPO Case No. D2015-0505).

The disputed Domain Names could be used to disrupt the business of the Complainants.

It is obvious that large and important companies like the Complainants, providing their services many consumers must already have viable and reliable means of communications. Many of them employ dedicated teams to acknowledge, respond and manage all issues that may arise. It is also obvious that the correspondence between the Complainants and their customers may often contain personal and confidential information. Allowing the Respondent to maintain and use the disputed Domain Names is therefore likely to result in a breach of the applicable personal data regulations and is likely to expose the Complainants to third parties' disputes and liabilities.

Therefore, the intended use of the disputed Domain Names is likely to disrupt the Complainants' business and damage their reputation.

Moreover, as the Respondent itself maintained in the case of The Royal Bank of Scotland Group plc, National Westminister Bank plc, and Coutts & Co. vs. Domain Mager/ yoyo .email / Giovanni Laporta (Case No. D2014-825), the domain names could be offered as a free private email to any person who can make use of these domain names.

Therefore, according to the Respondent, those persons could make use of a domain name consisting of personalname@trademark.email. The disrupting nature of this possible use is apparent considering that anyone could potentially make use of this email address in a deceptive or otherwise infringing manner, which could seriously damage the activities and reputation of the Complainants.

According to para. 4(b)(iv) of the Policy, there is a finding of bad faith when the Respondent's use of the domain name is to intentionally attempt to attract, for commercial gain, Internet users to its website, 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 the Respondent's website or location or of a product or service on the Respondent's website or location.

As the Complainant correctly points out, the Respondent could have chosen alternative domain names to accomplish its purpose and at the same time avoid infringing the Complainants' trademarks. However, the Respondent's intended activity is entirely dependent on the Complainants' trademarks to convince the public that its service is endorsed or at the very least accepted by the Complainants. There is therefore no doubt that the Respondent's intended use of the disputed Domain Names to offer a certified email service is likely to cause confusion among customers.

As far as the commercial gain requirement is concerned, considering that the Respondent is not a non-profit or charitable

organization, and the amount of money that the Respondent has invested in its business model, it is extremely unlikely that the Respondent's intended purpose is to offer its services free of charge, or to not benefit from the profits that its services generate.

Finally, regarding the declaratory judgment of the United District Court for the District of Arizona in the case between Yoyo.Email, LLC and Playinnovation, Ltd., the Panel, in agreement with the Complainants and with other Panels in previous similar UDRP cases, notes that this case does not involve the same parties and the same domain names. Furthermore the declaratory judgment does not contain any adjudication on the merits and was the consequence of a settlement between the parties. Therefore, the specific circumstances of the case are different from the present ones and the declaratory judgment at issue has no bearing on this proceeding (see also, among others, Stuart Weitzman IP, LLC v. Giovanni Laporta, Yoyo.Email Ltd., WIPO Case No. D2014-1537; Compagnie Gervais Danone, Société Anonyme des Eaux Minérales d'Evian (SAEME), Société des Eaux de Volvic, Nutricia International BV v. Giovanni Laporta, Yoyo.Email, WIPO Case No. D2015-0505).

For all considerations made above, the Panel concludes that the Complainants have satisfactorily proved that the disputed Domain Names were registered and have been used in bad faith.

PROCEDURAL FACTORS

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

In particular, this procedure raised several procedural issues, as follows.

Firstly, as far as the Complainants are concerned:

1. The Complainants submitted a Class Complaint under para. 4(a) of the CAC Supplemental Rules. A Class Complaint can be filed under existing rules provided the following conditions are met:

a. the Class Complaint is based on legal arguments applicable equally, or substantially in the same manner, to all the disputed domain names;
b. the person representing the different Complainants joined in the Class Complaint must provide evidence that it is authorised to act on behalf of each of the Complainants; and
c. the Panel can order the transfer of any of the disputed domain name(s) only to the individual Complainant on whose behalf the transfer was requested in the Class Complaint, in accordance with established UDRP Policy.

The Panel is satisfied that all three conditions mentioned above are met and therefore nothing prevents her from rendering a decision in respect of this Class Complaint.

2. The Complainant RAC Monitoring Services Ltd. objected to the registration of <rac.email> based on two UK registrations in the name of RAC Brand Enterprises LLP, rather than in its own name. To clarify this point, in compliance with the general powers conferred to the Panel under para. 10 of the Rules, and because the Complainant seemed to have a prima facie right on the RAC trademarks, the Panel asked the Complainant to provide information about the existing relationship between RAC Brand Enterprises LLP and the Complainant, as well as evidence of the Complainant's right to use the RAC trademarks.

On 9 June 2015, the Complainant submitted a Non-Standard Communication stating that both the Complainant and the trademark holder are wholly owned subsidiaries of The RAC Ltd Group, and provided evidence to support this statement. RAC Brand Enterprises LLP became the owner of the RAC brand and other intangible assets in 2012, and this entity now licenses the RAC trademarks to all companies belonging to The RAC Group.

In view of the above, the Panel is satisfied that the Complainant has successfully proved to be entitled to file its Complaint and to rely on the RAC trademarks cited therein, as a licensee of the RAC trademarks.

Secondly, as far as the Respondent is concerned:

- the Respondent filed its Response in due time, but the Response failed to meet the requirement under para. 13(b) of the CAC Supplemental Rules, which sets a word limit of 5,000 words for the Response. On the contrary, the Respondent's legal grounds to object to the Complainants' arguments exceeded 7,000 words, not counting the Respondent's arguments contained in its e-mail to the CAC of 6 May 2015.

It is a well-known and generally accepted principle that one of the main advantages of UDRP is its expedition, which is essential to the efficacy of the procedure. This is why the Supplemental Rules set a word limit to each party's arguments.

Para. 10(c) of the Rules requires the Panel to ensure that the administrative proceeding takes place with due expedition. Accepting a too long Response could represent an obstacle to this general principle and could create a dangerous precedent that could weaken the applicability and enforceability of this provision and requirement.

At the same time, however, the Panel must ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case (Para. 10(b) of the Rules). The Panel notes that the Respondent filed its Response within the required deadline. Therefore simply disregarding the Respondents' arguments seemed unfair to the Panel. Based on this reasoning, and in accordance with the general powers conferred to the Panel under Para. 10 of the Rules, the Panel decided to grant a new term to the Respondent to file an amended Response, which complied with the word limit set forth in para. 13(b) of the CAC Supplemental Rules.

On 9 June 2015, the Respondent sent and e-mail to the CAC reading as follows:

"Dear Panellist ,
If I thought it would do the slightness bit of good I would instruct my lawyers to rewrite the response to fit the 5000 word count limit, but it won't. So I won't be spending anymore of my money on what essentially is a corrupt process. I made my position very clear in how I see matters progressing in my email dated Wed 06/05/2015 13:03.
Thanks for the invite anyway.
Giovanni Laporta
CEO Yoyo.Email Ltd."

In light of the foregoing and considering that the Respondent had the opportunity to remedy the deficiency of its Response but purposely decided not to take any action in this respect, the Panel decided not to take into account the Respondent's lengthy arguments contained in its Response. However, the Respondent also submitted some arguments by e-mail on 6 May 2015, which meet the maximum number of word requirement, and the Panel will consider these arguments to evaluate the Respondent's rights in this case.

## PRINCIPAL REASONS FOR THE DECISION

With respect to the first requirement under the Policy, the Panel found that the disputed Domain Names are identical to the Complainants' earlier well-known marks.

With respect to the second requirement under the Policy, the Panel found that the Respondent lacks rights and legitimate interests in the disputed Domain Names because the Complainants never authorised the Respondent to register and use domain names identical to the Complainants' well-known marks, and because the intended use of the Domain Names does not appear to be a legitimate, bona fide or fair use.

With respect to the third requirement under the Policy, the Panel found that the Respondent's registration and use of the Domain Names is in bad faith because the Respondent was well aware of the Complainants' trademarks when it registered the Domain Names. The Respondent's passive holding of the Domain Names does not prevent a finding of bad faith, especially when, like in the case at issue, the Respondent intended use is likely to disrupt the Complainants' business and to damage their reputation. Moreover, the Respondent is also likely to gain an undue economic advantage from its intended

use of the Domain Names by creating a likelihood of confusion with the Complainants' marks, as to the source, sponsorship, affiliation, or endorsement of the Respondent’s activity.

Finally, the declaratory judgment on which the Respondent relied has no bearing on this proceeding as it does not involves the Complainants and does not concern any of the disputed Domain Names. Moreover, the declaratory judgment is the result of a settlement between the parties and does not contain any arguments on the merits of the case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALLSAINTS.EMAIL** : Transferred
2. **MFC.EMAIL** : Transferred
3. **KARENMILLEN.EMAIL** : Transferred
4. **SSE.EMAIL** : Transferred
5. **RAC.EMAIL** : Transferred
6. **RANDSTAD.EMAIL**: Transferred

## PANELLISTS

| Name | **Angelica Lodigiani** |
|---|---|

DATE OF PANEL DECISION 2015-06-03

Publish the Decision