Decision for dispute CAC-UDRP-100891

Case number	CAC-UDRP-100891
Time of filing	2014-12-04 11:31:50
Domain names	LOGITECH.EMAIL, AUTOTRADER.EMAIL, RYANAIR.EMAIL, DAILYMAIL.EMAIL, WOWCHER.EMAIL, THISISMONEY.EMAIL, SAVILLS.EMAIL, REDLETTERDAYS.EMAIL, OXFAM.EMAIL

Case administrator

Name	Lada Válková (Case admin)

Complainants

Organization	Logitech International S.A
Organization	Auto Trader Limited
Organization	Ryanair Limited
Organization	Associated Newspapers Limited
Organization	Wowcher Limited
Organization	Savills plc
Organization	Red Letter Days Limited
Organization	Oxfam International

Complainant representative

Organization	Safenames Ltd

Respondent

Organization	Yoyo.Email

OTHER LEGAL PROCEEDINGS

See comments in main decision in relation to proceedings in the US District Court in Arizona.

IDENTIFICATION OF RIGHTS

Various including:

(i) Community trade mark No 193433 for the word mark DAILY MAIL with a date of 5 November 1999 in the name of

Associated Newspapers Limited.
(ii) Community trade mark No 2410298 for the words AUTO TRADER in the form of a design with a date of 26 October 2010 in the name of Trade Media Group (2003) Limited.
(iii) Community trade mark No 4168721 for the word mark RYANAIR with a date of 5 December 2004 in the name of Ryanair Limited.
(iv) International Trade Mark 680876 for the word LOGITECH in stylised text together with a design with date of 24 June 1997 in the name of Logitech International SA. Numerous states are designated and the mark has proceeded to registration in a large number of those states.
(v) Community trade mark No 1584200 for the word mark OXFAM with a date of 1 October 2001 in the name of Oxfam GB.
(vi) Community trade mark No 5242615 for the word mark RED LETTER DAYS with a date of 26 July 2007 in the name of Red Letter Days Limited
(vii) Community trade mark No 1593912 for the word mark SAVILLS with a date of 9 October 2001 in the name of Savills plc.
(vii) Community trade mark No 10774830 for the word mark THIS IS MONEY with a date of 31 July 2002 in the name of Associated Newspapers Limited.
(ix) Community trade mark No 12075024 for the word mark WOWCHER with a date of 24 January 2014 in the name of Wowcher Limited.

FACTUAL BACKGROUND

The Complainants are a number of businesses and one charity. They are predominantly based in the United Kingdom, although Logitech International SA, would appear to be based in Switzerland and Ryanair Limited is based in the Republic of Ireland. Many of the Complainants are very well known, particularly in the United Kingdom.

The trade marks relied upon by the Complainants are identified in “Identification of Rights” section of this decision.

The WhoIs details for each of the domain names the subject matter of these proceedings (the “Domain Names”) identify “Giovanni Laporta” of “Yoyo.email” as the registrant. Although the WhoIs details for each Domain Name provide an address in the United States (which would appear to be the address of the Respondent’s US attorneys), Giovanni Laporta appears to be the name of an individual located in the United Kingdom.

The Response filed in this proceeding asserts that the “Respondent” is Yoyo.Email Limited. Although the Response gives a contact address for that company in the United States, this is once again address of the Respondent’s US attorneys. There appears to be no dispute that the Yoyo.Email Limited is a company registered in England and Wales on 31 March 2014 with company registration number 08967696.

Yoyo.Email Limited (as opposed to “yoy.email”) is not expressly mentioned in the WhoIs details for the Domain Name. However, it appears to be undisputed that Mr. Laporta and Yoyo.Email Limited can be treated as one person for the purposes of this proceeding. Accordingly, the Panel proceeds on this basis and the Panel hereafter simply refers to the Respondent.

The Domain Names were registered between 27 March 2014 and 5 May 2014 (i.e. some before and some after the incorporation of Yoyo.Email Limited). These are ten of a very large number of domain names registered by the Respondent that incorporate the trade mark names of others followed by the “.email” Top-Level Domain (“TLD”).

Many of these Domain Names have been the subject of proceedings either under the Policy or the Uniform Rapid Suspension System (“URS”). These include:

Deutsche Lufthansa AG v. yoyo.email et al., NAF Claim No. 1552833 (June 18, 2014)
Stuart Weitzman IP, LLC v. yoyo.email et al., NAF Claim No. 1554808 (June 24, 2014)
Starwood Hotels & Resorts Worldwide, Inc., Sheraton LLC, Sheraton International IP, LLC v. Giovanni Laporta / yoyo.email, WIPO Case No. D2014-0686 (July 1, 2014)
Playinnovation Ltd. v. yoyo.email et al., NAF Claim No. 1568549 (August 6, 2014)
Statoil ASA v. Giovanni Laporta, Yoyo.Email Ltd., WIPO Case No. D2014-0637 (July 16, 2014)

Mejeriforeningen Danish Dairy Board v. Domain Manager, Yoyo.email, WIPO Case No. D2014 0730 (July 23, 2014)
NVIDIA Corporation v. Giovanni Laporta, Yoyo.email Ltd., WIPO Case No. D2014-0770 (August 5, 2014)
Lockheed Martin Corporation v. yoyo.email et al., NAF Claim No. 1563665 (August 6, 2014)
Beiersdorf AG v. yoyo.email et al., NAF Claim No. 1571112 (August 7, 2014 – Suspension)
McDermott Will & Emery LLP v. yoyo.email et al., NAF Claim No. 1564796 (August 7, 2014)
Arla Foods amba v. Giovanni Laporta, Yoyo.email Ltd, WIPO Case No. D2014-0724 (August 10, 2014)
Anheuser-Busch, LLC v. yoyo.email et al., NAF Claim No. 1571472 (August 10, 2014)
The Royal Bank of Scotland Group plc, National Westminster Bank plc, and Coutts & Co. v. Domain Manager / yoyo.email / Giovanni Laporta, WIPO Case No. D2014-0825 (August 11, 2014)
Government Employees Insurance Company v. G La Porta, yoyo.email / Yoyo.Email Ltd, WIPO Case No. D2014-0805 (August 18, 2014)
Foot Locker Retail, Inc. v. yoyo.email et al., NAF Claim No. 1565344 (August 19, 2014)
Arla Foods amba v. G. La Porta / yoyo.email, WIPO Case No. D2014-0855 (August 23, 2014)
Dunkin' Brands Group, Inc., DD IP Holder LLC, and BR IP Holder LLC v. Giovanni Laporta / yoyo.email, NAF Claim No. 1568547 (August 25, 2014)
The Hartford Fire Insurance Company v. yoyo.email et al., NAF Claim No. 1574384 (August 25, 2014)
L'Oréal SA v. Yoyo.email, Giovanni Laporta, WIPO Case No. D2014-1172 (September 4, 2014)
eHarmony, Inc. v. yoyo.email et al., NAF Claim No. 1575592 (September 4, 2014)
Groupama SA v. Giovanni Laporta, yoyo.email, WIPO Case No. D2014-1287
(September 15, 2014)
O2 Holdings Limited v. Yoyo.email / Giovanni Laporta, WIPO Case No. D2014-1399
(September 24, 2014)
eBay Inc v. Yoyo.Email et al. NAF Claim Number: FA1409001581264 (September 29, 2014)
AA Brand Management Limited v. Giovanni Laporta, Yoyo.Email Ltd., WIPO Case No. D2014 1444 (October 13, 2014)
Virgin Enterprises Limited v. Yoyo.Email et al. NAF Claim Number: FA1410001585811 (October 28, 2014)
Bank of Scotland Plc v. Giovanni Laporta, Yoyo.Email, WIPO Case No. D2014-1539 (November 3, 2014)
3M Company v. Giovanni Laporta / Yoyo.Email, NAFClaim Number: FA1410001585346 (November 26, 2014)
Maplin Electronics Limited v. Yoyo.Email, WIPO Case No. D2014-1346 (October 14, 2014)
Stuart Weitzman IP, LLC v. Giovanni Laporta, Yoyo.Email Ltd., WIPO Case No. D2014-1537 (November 6, 2014)
Accor, SoLuxury HMC v. Giovanni Laporta, Yoyo.Email, WIPO Case No. D2014-1650 (November 7, 2014)
Guardian News & Media Limited v. Giovanni Laporta, Yoyo.email WIPO Case No. D2014-1656 (November 21, 2014)
M.F.H. Fejlesztõ Korlátolt Felelõsségû v. Giovanni Laporta, Yoyo.Email, WIPO
Case No. D2014-1743 (November 25, 2014)
Speedo Holdings B.V. v. Yoyo.Email et al. NAF Claim Number: FA1411001589779 (December 3, 2014)

The Respondent appears to have adopted a broadly similar explanation of its activities in each of those cases; namely, that they will be used in connection with a service whereby it will be possible to certify delivery and/or receipt of emails.

In virtually all of these proceedings the Respondent has ultimately lost. As far as the Panel can discern there are two URS appeal cases where the Respondent has been successful, but in one of these cases that same domain name was ordered to be transferred to the complainant in a subsequent UDRP proceeding. The Respondent does not appear to have been successful in any proceeding under the UDRP.

On 29 August 2014 the Yoyo.Email LLC filed a complaint in the United States District Court for the District of Arizona against an English company, Playinnovation Limited, in which it sought to overturn a previous suspension of the domain name <playinnovation.email> under the URS. That proceeding also appeared to seek declarative relief that extended to a very large number of domain names incorporating the trade marks of others that were not a party to that proceeding.

The address given for the place of business of "Yoyo.Email LLC" is the same as the registered office of Yoyo.Email Ltd, and in the Response the Respondent contends that this is a proceeding begun by the Respondent. In the circumstances, the Panel is prepared to assume without deciding for the purposes of this proceeding that this is merely an error in the filling and that Yoyo.Email Ltd was the Plaintiff in that case.

On 4 September 2014 the Respondent filed a Claim Form in the English Courts against The Royal Bank of Scotland plc. In that proceeding, the Respondent seeks to overturn the suspension of the domain names <rbs.email>, <rbsbankemail>, <natwest.email> and <coutts.email> under the URS (notwithstanding the fact that all of these domain names are included in the list of domain names identified in the Arizonan proceeding).

On 5 November 2014, declaratory judgment was entered in the Arizonan proceeding that was broadly favourable to the Respondent. However, this judgment was by agreement of the parties and "with no admission of liability by any party". The judgment also concluded as follows:

"This Judgment resolves the last pending claim between these parties. As such, the Clerk is directed to administratively close this case."

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainants contend that the first element of the Policy provides a threshold test for determining whether or not a domain name is identical or confusing similar to that of a trade mark in which a complainant has rights. As each of the Complainants trade marks are recognised in the corresponding Domain Name in respect of which complaint is made, the Complainants contend that this test is satisfied.

So far as legitimate right or interest is concerned, after confirming that none of the Complainants have consented to the registration of the Domain Names, it contends that the Respondent's use of third party trade marks in connection with a certified email service does not provide a legitimate interest. In this respects it quotes from a number of previous UDRP cases involving the Respondent.

The Complainants also contend that in the numerous cases in which the Respondent has been involved "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". It refers, for example to the decision in Statoil ASA v. Giovanni Laporta, Yoyo.Email Ltd., WIPO Case No. D2014-0637, in which the Panel questioned why the Respondent had to register domain names that incorporate the trade marks of others for the purposes of its business model (suggesting that the email address "recipient_[trademark]@yoyo.email" would work just as well as "recipient@[trademark].email").

The Complainants also refer to the following statement in Sheraton LLC, Sheraton International IP, LLC v Giovanni Laporta / Yoyo.email, Case No. D2014-0686

"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."

So far as bad faith is concerned, the Complainants, inter alia, refer to a number of decisions in which the Respondent's activities were held to fall within the scope of 4(b)(ii) of the Policy, likening that activity to a "land grab" of precisely the sort that paragraph in the Policy was intended to address.

So far as the Respondent's lawsuit filed with the United States District Court of Arizona, is concerned, the Complainants note that this was "as a consequence of a settlement between the parties" and did not involve any of the parties in the current

proceedings. It refers to the decision in Maplin Electronics Limted v Yoyo.Email, Case No. D2014-1346, in which the panel declined to give that decision any weight.

RESPONDENT:

The Respondent contends that it registered the Domain Names "for a legitimate business purpose with a good faith intent to comply with all laws including trade mark laws". It claims it has invested tremendous time and money in developing a lawful business under the <.email> gTLD and from the <yoyo.email> domain name. It states that the website is in beta but provides a password to the Panel and invites it to view the live test site.

The Respondent is highly critical of the panels and examiners that have decided the numerous cases against it, claiming that on occasion they have "deliberately misinterpreted and in some cases … have made facts up".

It appears to contend that those decisions involved panels determining that because a trade mark is included in a domain name without the trade mark owner's consent, there is de facto cybersquatting. This is said not to a supportable reading of the UDRP. It is also claims that this would be contrary to ICANN's stated goal of innovation within the new gTLD program. The competence and credibility of UDRP Examiners [presumably this is reference to UDRP panellists] is called into question.

Further, the Respondent refers to the Sunrise process whereby trade mark owners might secure domain names in respect of new gTLDs and states that after that process is over, the domain names are available to the general public. The Respondent appears contend that this supports it contention that thereafter it is legitimate for persons to register domain names that incorporate the trade marks of others.

The Respondent complains that "Examiners" have engaged in little more than speculation and conjecture about the Respondent's business model. It denies that it intends or has ever intended to use its domain names "to profit from advertising connected to the use of a trade[]mark web service".

Instead it contends (as it has done in many previous UDRP proceedings and in court proceedings in Arizona) that the domain names are being used for a "non-public, back-end email server used to link multiple email servers, to track, record, and verify email communication". In particular, it claims that this use will involve "the storing of Metadata which will allow yoyo.email to certify delivery and potentially receipt". Such use it is claimed will involve no public use of the domain names.

In support of its claims that it has made "demonstrable preparations", it refers to the beta site operating from the <Yoyo.email> domain name and the fact that Mr Laporte has applied for a community trade mark for the word mark YOYO.

The Respondent further states that it had obtained advice from Traverse Legal and from the UDRP panellist the Hon Neil Brown QC that "the Respondent's business model and use do not violate trade[ ]mark law or the UDRP". This is supported by an Affidavit from Enrico Schaeffer of Travers Legal in which he states he was approached by Mr Laporte to provide advice to him in June 2014 and that at that time Mr Laporte stated he had "previously retained" Mr Brown.

The Respondent complains about the fact that "Examiners" have dismissed its court order in the proceedings it commenced in Arizona and says that this is inconsistent with the tendency of those persons to follow the precedent of earlier UDRP decisions so far as the Respondent's activities are concerned.

The Respondent also refers to those URS proceedings in which it has succeeded (at least prior to appeal or subsequent UDRP proceedings) in which the Examiners held that there was "a genuine contestable issue" as to whether the domain name registration and use of a trade mark had been in bad faith. It also seeks to rely upon the reasoning of the dissenting Examiner in the URS Appeal Deutsche Lufthansa AG v. yoyo.email et al., supra.

The Respondent recites in some detail the statements in the declaratory judgement and urges the Panel not to read this as "just" a consent order or just" a stipulation between parties. It asserts that "the court did not have to agree to enter the Judgment".

So far as the requirements of the Policy are concerned that Respondent contends that it has demonstrated preparations to use the Domain Names in connection with a bona fide offering of services.

Further on the issue of bad faith registration and use, it contends that it cannot be said to have registered and used the Domain Names in bad faith when it activities are said to clearly fall within the scope of paragraph 4(c) (iii) of the Policy.

It further contends as follows:

“Complainants and some Examiners simply disagree with Respondent’s business model as the basis for their Complaint and decision; finding because there may be “ANOTHER WAY” for the Respondent to do things, the Respondent’s chosen way must be illegitimate. Examiners here are not saying the Respondent’s way is IN FACT ILLEGAL UNDER the UDRP Policy, Examiners are saying because the Respondent did not choose a another way, a way ‘they like’ then therefore it’s illegal. It’s nonsense. It’s NOT within the Examiner’s General Powers to choose how the Respondent must provide its service for it to be lawful, especially if the Respondent’s chosen way has NOT been proven unlawful under UDRP rules and supported by independent evidence. The Respondent feels not only must it defend itself against the Complainant, but also from bias UDRP Examiners”

The Respondent also contends that there is a bias among UDRP panellists against the Respondent. This bias is said to arise from the fact that these panellists are commercial trade mark lawyers and it contends that such persons “have never agreed with ICANN’s launch of the new gTLDs”.

Further, by (the Respondent claims) ignoring paragraph 4(c) of the Policy, UDRP panellists are said to be in “direct violation of their Statement of Declaration of Impartiality”.

RIGHTS

There is no dispute that each of the Domain Names comprises the entirety of a word mark or the word element of a trade mark in combination with the <.email> TLD. In contrast with some earlier cases; see for example, Guardian News & Media Limited v. Giovanni Laporta, Yoyo.email WIPO Case No. D2014-1656 (“The Guardian Case”), the Respondent rightly does not seek to argue that the first element of the Policy is not satisfied. Each of the Domain Names is clearly confusingly similar to the corresponding trade mark in which one of the Complaints has trade mark rights. The Complainants have made out the requirements of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

In the recent decision of Stuart Weitzman IP, LLC v. Giovanni Laporta, Yoyo.Email Ltd, supra the panel concluded that the Respondent’s activities did not provide a right or legitimate interest under the Policy for the following reasons:

“The Respondent claims rights or legitimate interests arising from use or demonstrable preparations to use the disputed domain name with a bona fide offering of goods or services – namely, the email services referred to above.

In addition, the Respondent claims to be making a legitimate fair use of the disputed domain name, without intent for commercial gain or to misleadingly divert consumers.

The Panel does not consider that the Respondent’s registration and planned use of the disputed domain name is bona fide within the meaning of paragraph 4(c)(i) of the Policy. The Respondent has no right to appropriate the Complainant’s mark for use with the Respondent’s email service. The Respondent’s intentional conduct prevents the Complainant from registering its mark as a domain name in the <.email> gTLD space, and potentially would force the Complainant to be an unwilling participant in the Respondent’s commercial enterprise. See Arla Foods amba v. G. La Porta / yoyo.email, WIPO Case No. D2014-0855 (<cravendale.email>). Further, the Respondent has merely asserted but never clearly articulated why it is required to use the disputed domain name as a behind the scenes technical link to provide its services. This assertion without more plainly is insufficient to demonstrate rights or legitimate interests under the Policy. Id. Even if the Respondent

was able to show that the disputed domain name was a necessary technical link for its services, the Panel doubts any legitimate interest would be evident.

The Respondent's assertion to be making a legitimate noncommercial or fair use of the disputed domain name within the contemplation of paragraph 4(c)(iii) of the Policy also is unsustainable. The Respondent's business model, as that term implies and the Respondent concedes, is intended to be a profitable, commercial enterprise. The Respondent's claim that the users of its services will not be charged does not establish otherwise. Moreover, it is not a legitimate or fair use for the Respondent to register domain names comprised of the Complainant's and thousands of other brand owners' trademarks, deliberately undertaken without the trademark owners' consent, to facilitate the creation of a directory of email addresses to support the Respondent's commercial venture. See, e.g., Arla Foods amba v. G. La Porta / yoyo.email, supra.

In sum, and having regard to all of the relevant circumstances in this case, the Panel finds that the Respondent has not used or made demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services. The Panel further finds that the Respondent is not making a legitimate noncommercial or other fair use of the dispute domain name. It is undisputed that the Respondent has not been commonly known by the disputed domain name, and that the Respondent has not been authorized to use the Complainant's mark in any manner."

This Panel in The Guardian Case agreed with and gratefully adopts the reasoning of the panel in that case. It does so again.

The Respondent appears to contend that previous panellists have failed to take into account the Respondent's substantial investment in developing a product or service using these domain names. For the avoidance of doubt, that is not what this Panel has done. The Panel is prepared to accept that this investment has been significant. The Panel has also taken advantage of the Respondent's invitation to view its beta website. The decision in the present case (and the Panel suspects in a very large number of the other UDRP cases) does not assume or presume that this investment is anything other than genuine and substantial. The finding in this case is that even if genuine and substantial investment has occurred, the wholesale registration of thousands of domain names that deliberately incorporates the trade mark of others in their entirety with no addition over and above the <.email> gTLD, is not "bona fide" within the meaning of paragraph 4(c)(i) of the Policy nor is it a "fair use" within paragraph 4(c)(i) of the Policy.

There is also the fact that as far as the Panel can tell the Respondent appears to accept that the Respondent could offer the service that it wishes to offer without registering all these Domain Names. The Respondent appears to maintain that this is irrelevant and complains that what panellists are doing is saying that it should be forced to use a different technical solution because the panellists do not like the one the Respondent has chosen.

However, with all due respect to the Respondent, this misunderstands and mischaracterises the position of panellists. The fact that there may be other ways of doing what the Respondent wishes to do without engaging in a wholesale "land grab" of thousands of domain names of this particular structure and character, is something that is clearly of potential relevance to the assessment of whether that activity is "bona fide" or "fair". Therefore, the fact that the Respondent chose this approach rather than some other on its face cries out for an explanation. It is remarkable that neither in this case (where the issue was expressly raised by the Complainants in their Complaint) nor (as far as the Panel is aware) in any earlier case has such an explanation been offered.

In The Guardian Case, the Panel also added the following comments:

"6.9 At the heart of the Respondent's contentions are claims that its activities are lawful under trade mark law and it relies upon both United States case law, and the proceeding that have been brought in the United States District Court in Arizona and the courts of England and Wales in this respect. These contentions are problematic in a number of respects.

6.10 So far as the litigation in Arizona is concerned, the Panel notes that the Domain Name is mentioned in the documents that the Respondent filed at court and in respect of which declaratory relief was sought. However, the Panel has difficulty in seeing why this is relevant.

6.11 First, the Complainant was not named as a party in that litigation, and there is no suggestion that it was asked to participate in or would be bound by the outcome of that litigation. The fact that a declaration was sought in that proceeding in relation to the Domain Name (among many others) when this is a domain name in which the defendant in that litigation had no interest, is curious to say the least. The Panel (comprising an English lawyer), professes no knowledge of United States law or procedure, but it is aware that in many jurisdictions a court will be unable, or at the very least will be extremely reluctant, to grant declaratory relief that may impact upon the rights of a person who is not a party to that litigation. The reasons for this and the obvious unfairness that might result if this were not so, are obvious. The Panel also notes that the panel in the recent decision of Maplin Electronics Limited v. Yoyo.Email, supra appears for similar reasons to have been reluctant to take any notice of that very same litigation.

6.12 Second, it is notable that the judgment finally entered in the Arizonan litigation was entered by consent, contains no reasoning as to the basis for the declarations granted and is drafted in such a way that it only extends to the domain name <playinnovation.email>. The case has also otherwise been declared closed. As such, it provides the Panel with little or no guidance as to the claimed lawfulness of the Respondent's activities either generally or so far as the Domain Name is concerned.

6.13 Third, the Panel is puzzled as to what law of the United States has to do with the current case before the Panel, which appears to involve two English entities. Indeed, the Panel similarly does not understand what United States law had to do with the case before the Arizonan courts, which also happened to involve two English entities. The fact that the United States District Court in Arizona had jurisdiction to hear that case is unsurprising (presumably the defendant had consented to that jurisdiction in the preceding URS proceedings). But, of course, jurisdiction is not the same as applicable law.

6.14 So far as the English litigation is concerned, it is similarly unhelpful. In that case the Complainant is not a party, the Domain Name is not even mentioned and there is as yet no judgment. Indeed, from the papers that the Panel has seen, it is far from clear what underlying cause of action is relied upon by the Respondent in that case. None appears to be asserted and presumably the Respondent will have the difficulty of having to deal with the decision of the English High Court in Toth v. Emirates [2013] EWHC 517.

6.15 There is also in the opinion of the Panel an even greater problem with the Respondent's contention that it has a legitimate interest in the Domain Name because the proposed use of the Domain Name is said to be lawful. That is that this contention assumes that national law is of relevance. As this Panel explained in some detail in 1066 Housing Association Ltd. v. Mr. D. Morgan, WIPO Case No. D2007-1461, when it comes to questions of legitimate interests and bad faith, then in the opinion of the Panel reliance upon arguments based on national law are fundamentally flawed. The Panel is instead of the view that the Policy sets out a sui generis set of rules and principles as to what constitutes legitimate interests and bad faith (albeit ones that draw upon general principles of law to be found across different legal systems).

6.16 The Panel accepts that this is a view that is not universally shared among panellists. Nevertheless, it is one that is sufficiently prevalent that paragraph 4.15 of the WIPO Overview 2.0 answers the question 'To what extent is national law relevant to a panel assessment of rights and legitimate interests and/or bad faith?' as follows:
'Paragraph 15 (a) of the UDRP provides that a panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP, the UDRP Rules, and any rules and principles of law that it deems applicable. Rooted in generally-recognized principles of trademark law, and designed to operate in the context of the world wide web, the decision framework of the UDRP generally does not require resort to concepts or jurisprudence specific to national law (other than with respect to the question of whether trademark rights exist). For example, WIPO panels have recognized that bad faith under the UDRP may be assessed by reference to the consistent body of prior UDRP decisions. Where panels have chosen to apply national law in UDRP decisions, they have done so on grounds including the location or nationality of the parties, or where a specific concept of national law is judged germane to an issue in dispute, or bearing in mind, in certain circumstances, the mutual jurisdiction election in the UDRP proceeding that would likely govern the location (and therefore the law) of any subsequent court case.' "

Once again these points are equally applicable to the current proceedings (subject to the qualification that two of eight

Complainants are not UK entities).

In the present proceedings, the Respondent sets out further argument over and above that set out in The Guardian Case as to why the decision in the Arizona proceedings should be given greater weight. The Respondent asserts that the judge in that case did and must have turned his mind to the substance of the Respondent's case. However, even if this is correct, it does not really answer any of the points that the Panel raised in The Guardian Case.

Similarly, the fact that some lawyers, no matter how renowned and respected, may have advised that the Respondent's activities are legitimate under trade mark law and UDRP, does not really take matters further. What matters is not whether lawyer A or lawyer B has provided such advice. What matters is the reasoning that leads to that conclusion.

This Panel would also add that it finds it hard to believe that any lawyer advising the Respondent in relation to these issues, would not have advised the Respondent that there was at least a risk that the Respondent's business model would fall foul of the UDRP. If they did not and the Respondent relied upon that advice in adopting its business model, then that is a matter for the Respondent to take up with those lawyers.

BAD FAITH

In Stuart Weitzman IP, LLC v. Giovanni Laporta, Yoyo.Email Ltd, supra the panel concluded that the Respondent's registration and use of the domain name in issue was in bad faith for the following reasons:

"Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant for valuable consideration in excess of respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct; or

(iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online 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 its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. Match.com, LP v. Bill Zag and NWLAWS.ORG, WIPO Case No. D2004-0230.

For the reasons discussed under this and the preceding heading, the Panel considers that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name within the meaning of paragraph 4(a)(iii) of the Policy. The Panel finds that the Respondent, for purposes of its business model, has registered the disputed domain name and thousands of other domain names 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 record reflects that the Respondent has deliberately engaged in a pattern of conduct demonstrating bad faith registration and use under

paragraph 4(b)(ii) of the Policy.

As noted earlier, the Panel has concluded that the Respondent has no right to appropriate the Complainant's mark for use with the Respondent's email service, and that the Respondent's intentional conduct in so doing prevents the Complainant from registering its mark as a domain name in the ".email" gTLD space. In the Panel's view the Respondent's registration and (passive) use of the disputed domain name more likely than not is intended to induce the Complainant to be an unwilling participant in the Respondent's commercial enterprise. The Panel considers this an abusive registration and use of the disputed domain name in circumstances evincing the Respondent's intent to profit from and exploit the Complainant's trademark – a bad faith practice the Policy was created to curb. Even if not intended to force the Complainant to participate in the Respondent's enterprise, overall the Respondent's conduct violates the spirit of the Policy."

In The Guardian Case the Panel agreed with and gratefully adopts the reasoning of the panel in that case. It does so again in the present case where the reasoning applies equally to the Domain Names. The Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

It would also add that it notes that the Respondent appears to raise an argument based upon the fact that the Domain Names might have been registered in the Sunrise process and that the new gTLDs were brought in to encourage innovation of the sort in which the Respondent is engaged.

With all due respect to the Respondent and its advisers, this is a quite hopeless argument. The Sunrise process incorporated various mechanisms that were intended to provide certain additional protection to trade mark owners. The existence of those processes did not in any way seek to dilute or modify the operation of the UDRP, which applies equally both to domain names registered in the new gTLDs as well as many previous domains. Given this, the arguments raised by the Respondent boil down to a regurgitation of an old argument often recited by respondents that a registration could not be in bad faith, because a complainant could have registered the domain name itself and that the domain was available on a first come first served bases. It was and is misconceived in the case of domain names registerable prior to the introduction of the new gTLDs and is equally misconceived in this case.

PROCEDURAL FACTORS

There are eight different Complainants in this case and nine different marks. The Complaint assumes (without addressing the point), that it is legitimate for multiple Complainants to bring such proceedings in a single Complaint. Nevertheless, the Panel accepts that (perhaps subject to a discretion on the part of the Panel not to allow this) even absent any express provision in the relevant rules, this would be possible (see paragraph 4.16 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition). Further, so far as proceedings brought in the CAC are concerned, Article 4 of the CAC's UDRP Supplemental Rules of the Czech Arbitration Court does expressly provides for proceedings to be brought by multiple complainants; designating such proceedings as a "Class Complaint". This is subject to the fulfilment of certain conditions (see Article 4(a)), but these conditions appear to be met in this case. Further, the Respondent appears to raise no objection in this respect. In the circumstances, the Panel accepts that the Complaint can be brought on this basis.

There is also the issue that the Respondent complains bitterly about a perceived bias on the part of URS Examiners and UDRP Panellists in dealing with cases involving the Respondent. It even goes so far as to suggest that those persons are acting in a manner inconsistent with the declaration of impartiality given by panellists when they accept a UDRP case. When the Response was filed the Respondent would have been unaware who would be appointed to decide the case, and the Response does not levy any personal attack on the Panel. Nevertheless, the Panel will proceed on the assumption that these complaints are equally levelled against the current Panel.

Given this the Panel has carefully considered the Respondent's submissions and whether given those submissions it should recuse itself from deciding this case. It has reached the conclusion that there is no good reason why it should do so.

The issue of independence and recusal was recently considered in Grupo Costamex, S.A. de C.V. (COSTAMEX), Operación y Supervisión de Hoteles, S.A. de C.V. (OPYSSA) v. Vertical Axis Inc. WIPO Case No. D2013-1829. It is clear from the reasoning in this case that the mere fact that panellists may form a particular view on the interpretation of the Policy is not of itself a

good reason for recusal. This is so even if the panellist's opinion is a minority one when compared with the views of other panellists, and the panellist has previously been involved in deciding cases involving one or other of the parties.

Therefore, the fact the Panel has already expressed a view on the operation of the Policy so far as the Respondent's business model is concerned in The Guardian Case, is not a good reason for the Panel to recuse itself in this case. This would be so even if this view expressed in The Guardian case was a minority opinion. However, it is clear that the view expressed (at least on the core issues in that case) is one that almost universally accepted among UDRP panellists.

Further, although a panel may be made up "a commercial trade mark lawyer", it does not see why this would result in any reasonable perception that the lawyer would be biased, lacks independence or holds some general antipathy to new gTLD registrations that would mean that he would unfairly decide any UDRP case involving a new gTLD registration before him.

This Panel is indeed made up of a lawyer who could be described as a "a commercial trade mark lawyer". However, this is a lawyer who (like many trade mark lawyers) has acted for both complainants and respondents in proceedings under the UDRP or similar ADR proceedings. It also happens to acts for one of the new gTLD registry.

In the circumstances, any allegation of bias would unfounded and there is no good reason why the Panel should recuse itself and not go on to consider the substance of the case.

PRINCIPAL REASONS FOR THE DECISION

This case is one in what is now a long line of cases involving a the Respondent's deliberate registration of thousands of domain names that comprise a third party trade mark together with the <.email> gTLD. The Panel held that such activity was not in connection with a "bona fide" offering of services within the meaning of that term in paragraph 4(c)(i) of the Policy or "fair use" under paragraph 4(c)(iii) of the Policy. It was also bad faith registration and use within the scope of paragraph 4(b)(ii) of the Policy.

The Panel also held that the fact that it had previously decided a case that had required it to express a view as to whether the Respondent's activity fell within the on the meaning of the Policy did not mean that it should recuse itself from deciding this case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LOGITECH.EMAIL**: Transferred
2. **AUTOTRADER.EMAIL**: Transferred
3. **RYANAIR.EMAIL**: Transferred
4. **DAILYMAIL.EMAIL**: Transferred
5. **WOWCHER.EMAIL**: Transferred
6. **THISISMONEY.EMAIL**: Transferred
7. **SAVILLS.EMAIL**: Transferred
8. **REDLETTERDAYS.EMAIL**: Transferred
9. **OXFAM.EMAIL**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2015-01-11

Publish the Decision