Decision for dispute CAC-UDRP-100890

Case number	CAC-UDRP-100890
Time of filing	2014-12-04 12:33:14
Domain names	MOLTONBROWN.EMAIL, ROCHE.EMAIL, GLAXOSMITHKLINE.EMAIL, GSK.EMAIL, BEECHAMS.EMAIL, VERTU.EMAIL, LYONDELLBASELL.EMAIL, VELUX.EMAIL, G4S.EMAIL

Case administrator

Name	Lada Válková (Case admin)

Complainants

Organization	Molton Brown Limited
Organization	F. Hoffmann-La Roche AG
Organization	GlaxoSmithKline
Organization	Vertu Corporation Limited
Organization	Lyondellbasell Industries
Organization	VKR Holding A/S
Organization	G4S Plc

Complainant representative

Organization	Safenames Ltd

Respondent

Organization	Yoyo.Email

OTHER LEGAL PROCEEDINGS

None.

IDENTIFICATION OF RIGHTS

Molton Brown Limited owns trade mark registrations for the word mark MOLTON BROWN, including United Kingdom Trade mark Registration No. 1061648 and European Community Trade mark Registration No. 23366, the earliest dating from 1976.

F. Hoffmann-La Roche AG owns trade mark registrations for the word mark ROCHE including European Community Trade mark Registration No. 223107 dating from 1996 and International Trade mark Registration No. 313051 dating from 1966.

SmithKline Beecham plc owns trade mark registrations for the word marks GSK, including International Trade mark Registration No. 748727 dating from 2000; GLAXOSMITHKLINE, including United States Trade mark Registration No. 2766062 dating from 2003 and United Kingdom Trade mark Registration No. 2219528 dating from 2001 and BEECHAMS, United Kingdom Trade mark Registration No. 469021 dating from 1926.

Vertu Corporation Limited owns trade mark registrations for the mark VERTU including European Trade mark Registration No. 2486603 dating from 2004.

Lyondellbasell Industries owns trade mark registrations for the mark LYONDELLBASELL including International Trade mark Registration No. 972681 in 2008.

VKR Holding A/S owns trade mark registrations for the mark VELUX including United Kingdom Trade mark Registration No. 691115 dating from 1950 and United States Trade mark Registration No. 1091446 dating from 1942.

G4S Plc owns trade mark registrations for the mark G4S including United Kingdom Trade mark Registration No. 2391944 dating from 2005 and International Trade mark Registration No. 885910 from 2005.

FACTUAL BACKGROUND

Molton Brown Limited is a UK cosmetic firm. It operates from its website at <www.moltonbrown.co.uk>.

F. Hoffmann-La Roche AG is a Swiss health-care company. It owns various domain names incorporating the ROCHE mark, which resolve to its website at <www.roche.com>.

SmithKline Beecham plc merged with Glaxo Wellcome plc in 2000 to form GlaxoSmithKline, a research based pharmaceutical and healthcare organization. It owns various domain names incorporating the GSK, GLAXOSMITHKLINE and BEECHAMS marks, which resolve to its websites at <www.gsk.com> and <www.beechams.co.uk>.

Vertu Corporation Limited is a British manufacturer and retailer of mobile phones. It owns various domain names incorporating the VERTU mark, which resolve to its website at <www.vertu.com>.

Lyondellbasell Industries is a chemical company established in 2007 after the acquisition of Lyondell Chemical Company by Basell Pololefins. It owns various domain names incorporating the LYONDELLBASELL mark, which resolve to its website at <www.lyondellbasell.com>.

VKR Holding A/S is a Danish company that manufactures windows, skylights and blinds, established in 1941. It owns various domain names incorporating the VELUX mark, which resolve to its website at <www.velux.com>.

G4S Plc is a British security services company, established in 2004 following the merger of Securicor Plc and Group 4 Falck. It owns various domain names incorporating the G4S mark, which resolve to its website at <www.g4s.com>.

Following the expiration on March 15, 2014 of the Sunrise Period in relation to the new gTLD <.email>, Giovanni Laporta, the CEO of Yoyo.Email Limited (a UK company), both of which are hereafter collectively referred to as "the Respondent", registered the domain names: <glaxosmithkline.email>, <gsk.email> and <roche.email> on March 27, 2014; <beechams.email> on March 30, 2014; <vertu.email> on March 31, 2014; <g4s.email> on April 1, 2014; <moltonbrown.email> on April 2, 2014; <lyondelbasell.email> on April 25, 2014 and <velux.email> on June 1, 2014 ("the Domain Names"). Hitherto the Domain Names have not been used. The Respondent intends to use them, with other domain names, to operate a service seeking to certify the sending and receipt of emails.

The Domain Names form part of a large portfolio of more than 4000 <.email> domain names registered by the Respondent, many of which, as here, incorporate the trademarks of third parties and some of which have been the subject of UDRP and URS proceedings brought by the owners of those trademarks against the Respondent, including the following:

1. Deutsche Lufthansa AG v. yoyo.email et al., NAF Claim No. 1552833 (June 18, 2014)
2. Stuart Weitzman IP, LLC v. yoyo.email et al., NAF Claim No. 1554808 (June 24, 2014)
3. Starwood Hotels & Resorts Worldwide, Inc., Sheraton LLC, Sheraton International IP, LLC v. Giovanni Laporta / yoyo.email, WIPO Case No. D2014-0686 (July 1, 2014)
4. Playinnovation Ltd. v. yoyo.email et al., NAF Claim No. 1568549 (August 6, 2014)
5. Statoil ASA v. Giovanni Laporta, Yoyo.Email Ltd., WIPO Case No. D2014-0637 (July 16, 2014)
6. Mejeriforeningen Danish Dairy Board v. Domain Manager, Yoyo.email, WIPO Case No. D2014-0730 (July 23, 2014)
7. NVIDIA Corporation v. Giovanni Laporta, Yoyo.email Ltd., WIPO Case No. D2014-0770 (August 5, 2014)
8. Lockheed Martin Corporation v. yoyo.email et al., NAF Claim No. 1563665 (August 6, 2014)
9. Beiersdorf AG v. yoyo.email et al., NAF Claim No. 1571112 (August 7, 2014)
10. McDermott Will & Emery LLP v. yoyo.email et al., NAF Claim No. 1564796 (August 7, 2014)
11. Arla Foods amba v. Giovanni Laporta, Yoyo.email Ltd, WIPO Case No. D2014-0724 (August 10, 2014)
12. Anheuser-Busch, LLC v. yoyo.email et al., NAF Claim No. 1571472 (August 10, 2014)
13. 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)
14. Government Employees Insurance Company v. G La Porta, yoyo.email / Yoyo.Email Ltd, WIPO Case No. D2014-0805 (August 18, 2014)
15. Foot Locker Retail, Inc. v. yoyo.email et al., NAF Claim No. 1565344 (August 19, 2014)
16. Arla Foods amba v. G. La Porta / yoyo.email, WIPO Case No. D2014-0855 (August 23, 2014)
17. 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)
18. The Hartford Fire Insurance Company v. yoyo.email et al., NAF Claim No. 1574384 (August 25, 2014)
19. L'Oréal SA v. Yoyo.email, Giovanni Laporta, WIPO Case No. D2014-1172 (September 4, 2014)
20. eHarmony, Inc. v. yoyo.email et al., NAF Claim No. 1575592 (September 4, 2014)
21. Groupama SA v. Giovanni Laporta, yoyo.email, WIPO Case No. D2014-1287 (September 15, 2014)
22. O2 Holdings Limited v. Yoyo.email / Giovanni Laporta, WIPO Case No. D2014-1399 (September 24, 2014)
23. eBay Inc v. Yoyo.Email et al. NAF Claim Number: FA1409001581264 (September 29, 2014)
24. AA Brand Management Limited v. Giovanni Laporta, Yoyo.Email Ltd., WIPO Case No. D2014 1444 (October 13, 2014)
25. Virgin Enterprises Limited v. Yoyo.Email et al. NAF Claim Number: FA1410001585811 (October 28, 2014)
26. Bank of Scotland Plc v. Giovanni Laporta, Yoyo.Email, WIPO Case No. D2014-1539 (November 3, 2014)
27. 3M Company v. Giovanni Laporta / Yoyo.Email, NAFClaim Number: FA1410001585346 (November 26, 2014)
28. Maplin Electronics Limited v. Yoyo.Email, WIPO Case No. D2014-1346 (October 14, 2014)
29. Stuart Weitzman IP, LLC v. Giovanni Laporta, Yoyo.Email Ltd., WIPO Case No. D2014-1537 (November 6, 2014)
30. Accor, SoLuxury HMC v. Giovanni Laporta, Yoyo.Email, WIPO Case No. D2014-1650 (November 7, 2014)
31. R.C. Purdy Chocolates Ltd. v. Giovanni Laporta, Yoyo.Email Ltd, WIPO Case No. D2014-1670 (November 18, 2014)
32. Guardian News & Media Limited v. Giovanni Laporta, Yoyo.email WIPO Case No. D2014-1656 (November 21, 2014)
33. M.F.H. Fejlesztõ Korlátolt Felelõsségû v. Giovanni Laporta, Yoyo.Email, WIPO Case No. D2014-1743 (November 25, 2014)
34. Speedo Holdings B.V. v. Yoyo.Email et al. NAF Claim Number: FA1411001589779 (December 3, 2014)
35. The Black & Decker Corporation v. Giovanni Laporta, Yoyo.Email, WIPO Case No. D2014-1891(December 23, 2014)
36. Logitech International S.A, Auto Trader Limited, Ryanair Limited, Associated Newspapers Limited, Wowcher Limited, Savills plc, Red Letter Days Limited and Oxfam International v. Yoyo.Email, CAC Case No.100891 (January 11, 2014).

On August 29, 2014 "Yoyo.Email LLC" (presumably a reference to Yoyo.Email Limited), commenced proceedings No. CV-14-01922-PHX-PGR in the United States District Court for the District of Arizona seeking declaratory judgement in its favour in relation to the domain name <playinnovation.email>, the registration of which had been suspended in URS proceedings. The Complaint included the following description of the services the Plaintiff intended to provide:

"Plaintiff's intention at the time of the domain name registration and today is to use the subject domain name <playinnovation.email> as an independent, back-end email server controlled by Plaintiff and invisible to consumers to route, capture and store Email Meta Data [such as time stamps and routing of email] so that Plaintiff can certify that the email was sent, and potentially, received. Plaintiff has not displayed, and does not intend to display, the subject domain name in

commerce as part of the sale of [sic] advertising of YOYO's services."

Those proceedings were settled between the parties and on November 5, 2014 a judge of that court entered judgement upon a motion by consent, declaring, inter alia, that Plaintiff's intended use of <playinnovation.email> as described in the Complaint is not a violation of the Anti-Cybersquatting Consumer Protection Act, the Lanham Act, the ICANN URS and UDRP policy or other law. The domain name <playinnovation.email> was restored to the Plaintiff's GoDaddy Registrant Account with full control rights and privileges. The order limited the Plaintiff's use of the <playinnovation.email> domain name to: (a) use as a non-public, back-end email server used to link multiple email servers, (b) use to track, record, document, or verify email communication, and (c) use only by an individual or entity whose corporate or trade name is or incorporates "playinnovation".

On September 4, 2014 Yoyo.Email Limited, through Mr. Laporta, commenced proceedings in the UK County Court Business Centre seeking an order that "RBS.email, RBSbank.email, NATWEST.email & COUTTS.email be removed from lock at the Plaintiffs registrar GoDaddy and restored to Plaintiff so that Plaintiff may continue to develop its business model and use the subject domain names consistent with its intended use as a non-public, back-end email server as set forth in detailed particulars."

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANTS:
On behalf of each of the Complainants, their representative makes the following submissions:

The Complainants have a common grievance against the Respondent who has engaged in common conduct that has affected their rights in a similar fashion. Each of the domain names is identical or confusingly similar to a Complainant's corresponding trade mark and the Respondent has no rights or legitimate interests in the Domain Names, which were registered and are being used in bad faith.

As to legitimacy, the Complainants say Yoyo Email or Giovanni Laporta have never been commissioned to manage the Complainants' email communications; have never been licensed to use the Complainants' marks for the receipt and transmission of email communications; and have never received any approval, expressed or implied, to use these marks in or as part of a domain name. The Complainants have no association, affiliation and/ or dealings of any nature whatsoever with the Respondent and neither endorse nor promote its services.

To date of filling 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:

1. The Complainants claim the 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 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, WIPO 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 Limted v Yoyo.Email, WIPO 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 Complainants' famous trade marks.

2. According to the Complainants the Respondent intends to benefit from the underlying value of the Complainants' trade marks.

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. See Starwood Hotels & Resorts Worldwide, Inc, Sheraton LLC, Sheraton International IP, LLC v Giovanni Laporta / Yoyo.email, WIPO Case No. D2014-0686. This would explain why after 24 cases the Respondent is still unable to explain sufficiently 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. This is impossible. Not only does the service derive from the Complainants' goodwill in their marks but the Respondent readily admits that the domains were deliberately registered to oblige the Complainants 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 was 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 Respondent is clearly using coercion to attract Complainant to a service which ultimately makes money from them as an unwilling participant.

Many of the organizations listed in the Complaint employ thousands of employees around the world and spend millions in advertising and trade mark registrations to promote and protect their brands. The Complainants are 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 its 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 Complainants to use or lose privileged access to communications intended for their sole use cannot be considered to be legitimate by any stretch of the imagination.

The Complainants appeal to the Panel to consider the impact of ruling in Respondent's favour.

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."

3. The Complainants claim 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., WIPO 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.'" According to the Complainants the Respondent´s expected assertion that latter form attempts to avoid consumer confusion 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. The majority of Panels have rejected Respondent's argument because as the Panel in Accor, SoLuxury HMC v. Giovanni Laporta, Yoyo.Email, WIPO 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.”

The Complainants state that 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 the Respondent to serve its business purpose without affecting the Complainant’s intellectual property.

The Sheraton Panel further exposed the weaknesses in Respondent’s arguments, finding: “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 Complainants believe the Panel’s observation to be an essential step to understanding the Respondent’s true intention. This is discussed in relation to 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.”

The Complainants contend that 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 the 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 Policy is not simply concerned with the functionality or even viability of the Respondent's 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 Complainants would also expect a response or even that their mail had been acknowledged. The 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.

4. There is no evidence that the Respondent has been commonly known by the Domain Names as an individual, business or other organization.

As to bad faith, the Complainants say Panellists 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 filing the Complaint, there have been over 24 cases decided against the Respondent which clearly identifies him as a “cybersquatter”. The principal arguments are outlined below.

The Complainants claim that 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, WIPO 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.

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

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. 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, WIPO 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 the 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 the Complainants' 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. The 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 Complainants without their authorization. It would be irresponsible on the part of the Complainants to lend their approval to such a service.

The Complainants claim that 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 Names would be accessible. Additionally, even if the Respondent's proposed service is to be free at this point, his statements expressed in previous cases demonstrate 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.

In anticipation of Respondent's arguments in relation to his feigned success in the Yoyo.Email, LLC v 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. The Panel in the Maplin Electonics Case rightly refused the Respondent's request for relief stating: "In these circumstances, the Panel does not consider that it is premature to consider the Complaint, as this is not a situation where the same parties are engaged in related litigation. The Respondent has chosen only to pursue litigation against a non-party who is entirely unconnected to the disputed domain name. This is not a sufficient nexus to oust the jurisdiction of this panel. To decide otherwise would invite respondents to initiate similarly framed litigation to prevent and frustrate the UDRP process from moving forward. Accordingly, the Panel does not agree that the Complaint is premature, and will therefore move forward with a decision according to the Policy."

Finally, the Complainants state that the Respondent, Yoyo.Email Ltd is a UK registered company having its principal place of business at 38 Market Square, Toddington, Dunstable, LU5 6BS . The address on the WHOIS was changed to reflect the address of the Respondent's legal counsel Traverse Legal, Plc, possibly in an attempt to restrict Complainants' choice of mutual jurisdiction; however the Complainants hold United States trade mark registrations which predate the registration of the Domain Names.

RESPONDENT
The Respondent says there is no legitimate basis, based on actual evidence, for transferring the Domain Names to the Complainants. In fact, the evidence establishes that 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 Domain Names to date. The intended use is not a trademark use, or public use. There has been no trafficking of the Domain Names.

The Respondent claims that it 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.

Prior Examiners have concluded that the Respondent is cybersquatting, based on pure speculation and despite the lack of evidence supporting such a finding. The Respondent's has been repeatedly misquoted and its previous Responses have been grossly and deliberately misinterpreted and in some cases Examiners have made facts up. The evidentiary basis of these adverse decisions seems to be because the trademark is included in a domain name and there is no permission from a Complainant, that its de facto cybersquatting. The UDRP says no such thing.

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.

Contrary to what prior Examiners have reported the Respondent says it 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 Domain Names in such a way. All the evidence is to the contrary.

The Respondent has gone to great effort to show it is a legitimate technology service and Examiners repeatedly ignore the Respondent's efforts.

In this case, the Respondent is using the Domain Names in the same manner as he was with the domain in Case No. CV-14-01922-PHX-JJT. Specifically, the Respondent is using the Domain Names as a non-public, back-end email server used to link multiple email servers, to track, record, and verify email communication.

While there are various aspects to the Yoyo services business model, as seen on its beta test site http://yoyo.email/beta, the one that is relevant to the Complaint is to use the Domain Names 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, as described in the Judgement entered by Judge John. J. Tuchi on November 5, 2014. The Complainants have provided no evidence to contradict the business model or domain use described in the Judgement. The Complainants have provided no evidence for the basis of this Compliant beyond raw speculation or regurgitated undocumented hearsay from prior panel decisions. The Complainants rely entirely upon adverse previous UDRP and URS cases for their evidentiary obligations. This is simply not enough to support a legal transfer under the UDRP policy of 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. The Complainants in this case are no different. They can only argue rank, in that they hold matching trademarks, which does not meet all the evidentiary obligations required by the UDRP policy.

The Respondent understands, given the history of cybersquatters, why Complainants may have had some concerns before the Declaratory Judgement, but now those concerns should be eased. Clearly there has been NO trademark infringement or intent to violate the UDRP but yet some Examiners together with Complainants continue to steamroll
the Respondent without good cause in direct violation of UDRP procedural rules. It is clear not all Examiners have agreed with their peers. The Respondent asks that the following URS cases also be considered as part of the proofs in this matter as additional case precedent to the Declaratory Judgment:

1. On September 4, 2014 in eHarmony, Inc. v. yoyo.email et al, NAF Claim No. FA1408001575592 <eharmony.email>, Honorable Karl V. Fink (Ret. US Federal Judge) denied the Complainant's URS claim quoting "genuine contestable issue as to whether a domain name registration and use of a trademark are in bad faith"…. "Trading in domain
names for profit, and holding a large portfolio of domain names, are of themselves not indicia of bad faith under the URS"…. "the use of the domain name in question is a non-infringing use or fair use of the trademark."

2. On August 19, 2014, panelist Jeffrey M. Samuels (Professor Emeritus) dissented and found on an URS Appeal Complaint that the Respondent acted lawfully when registering other "brand.email" domains. See Foot Locker Retail, Inc. v. yoyo.email et al., NAF Claim Number: FA1406001565344.

3. On June 24, 2014, the Respondent was successful in an appeal under URS: NAF Claim Number: FA1404001554808 for the disputed domain name <stuartweitzman.email>. The majority of the appeal Examiners in the URS correctly determined that the "Complainant has NOT demonstrated all three elements."

4. On June 18 2014, professor Jeffrey M. Samuels dissented on another ICANN URS domain name dispute. See appeal in Deutsche Lufthansa AG v. yoyo.email et al., NAF Claim Number: FA1404001552833, <lufthansa.email>: ... "With respect to fair use, Respondent has made a convincing enough argument that it needs to use the disputed domain name, as well as many others, in order to offer a credible and useful service and does not possess the requisite intent to misleadingly divert consumers. How else can the service provide proof of the sending of emails to Lufthansa other than through the use of the term "Lufthansa" In this sense, Respondent appears to be using the term "Lufthansa" merely to describe the intended recipient of an email. Whether Complainant supports such a service or believes it is technically or commercially viable seems to me to be beside the point".

As to legitimacy, the Respondent says it has made demonstrable preparations to use the Domain Names 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. This fact has been repeatedly stated and repeatedly ignored by previous Examiners. Further, by using the 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 Names, no diversion of website traffic from the trademark holder and no intent to profit related to the use or trafficking of the Domain Names. The Complainants' trademark rights are

not harmed in any way, this is clear to see: http://yoyo.email/beta is still under development and should be launched in beta soon.

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 Declaratory Judgment details the Respondent's business model as a legitimate business model under the UDRP. 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 Names 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 Complainants 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's web site or location or of a product or service on the Registrant's web site or location.

The Respondent applied on 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 Domain Names. Respondent's CEO is a respected inventor and businessman who has a proven track record in the developing innovative ideas. He has some 22 granted patents. This demonstrates that the 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 Complainants so that it can be advertised as an "independent certified email service" can ever be described as "bad faith" to deceive. Moreover, how can a service that is linked to the free operational service of a domain name, which costs the Respondent an annual charge to operate, ever be described as a bad faith intent to profit or an unfair use? The Respondent has never intended to mislead or deceive Internet users for commercial gain.

As to bad faith, the Respondent says it has registered and is using the Domain Names in good faith. It has never intended to profit in any way relating to the use of any of the Domain Names as a trademark and has not used the Domain Names to date to profit from advertising connected to the use of a trademark-related web service.

Rule 4C (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 the 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 giant leap that it intends to profit from the subject Domain Names or trademarks by deceiving internet users. The Respondent is NOT using the Domain Names to defraud the public by creating a false impression the Domain Names are the Complainants' genuine Internet names.

The Respondent claims not to have registered the Domain Names primarily for the purpose of selling, renting, or otherwise transferring the domain name registrations to the Complainants. The Respondent has never approached the Complainants. 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 has been suggested, the Respondent would have simply accepted $1000 when it was offered. Further, the Respondent did not register the Domain Names for the purpose of disrupting the business of the Complainants, but instead to provide a new way in email verification. The Respondent's evidence has been repeatedly ignored and dismissed without good reason by previous Examiners.

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, Examiners are saying because the Respondent did not choose 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 Complainants, but also from biased UDRP Examiners.

As regards the Declaratory Judgement, the Respondent says the District Judge had all the case papers to review whether the UDRP Policy was violated or not and determined that the UDRP Policy had not been violated. If the Judge did not agree with the Declaratory Judgement, the Judge simply would not have signed it. The Respondent did nothing wrong when registering its <.email> domain names. The Judge saw this and agreed to enter a Declaratory Judgment that the UDRP was not violated. The Complainants in this case provide no other facts that contradict the court order.

Because bad faith can be a subjective state of mind, arbitration decisions concerning alleged Policy violations found by prior Examiners are being stretched to fit, completely ignoring the UDRP and UDRP Rules that could favour the Respondent's rights. Examiners are only interested in the Complainants' rights and not the Respondent's legal rights: Policy R. 4C. It is a direct violation of their Statement of Declaration of Impartiality required to be followed by Policy rules. Examiners are manipulating the Policy to suit their requirement out of the Policy rather than what the Policy requires Examiners to do which is to remain fair and impartial. Previous Examiners have forgotten that under the UDRP Rules the Complainant bears the burden of proving the Respondent's alleged bad faith intent in registration of the domain names at issue. 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 purchasing the domain name. Examiners should not award a transfer of a lawfully purchased domain name to a Complainant, if Complainant's arguments of bad faith are merely speculative and do not make a clear case of bad faith intent registration and illegitimate use.

The Respondent is a legitimate technology business responding to ICANN's express goal for the new gTLD program and expanding consumer choice on the internet. The Complainants, as trademark holders, had an exclusive opportunity given to them by ICANN lasting three whole months to secure the Domain Names during ICANN's Sunrise Period and did not do so. In contrast, the Respondent acquired its domain names legitimately when they went on general release in keeping with ICANN's desire to support and utilize the new TLDs and without any breach of ICANN's policies.

The facts are that the Respondent purchased all its .email domain names in good faith. The Respondent, here, does not possess the bad faith intent to mislead consumers. All facts and all independent credible evidence clearly support this view. See http://yoyo.email/beta. Because the Complainants have not proven each of the three elements required in a UDRP proceeding by a preponderance of the evidence, and rely entirely upon adverse previous UDRP cases for their 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 Complainants.

RIGHTS

The Complainants have, to the satisfaction of the Panel, shown that each of the Domain Names is identical or confusingly similar to a trademark or service mark in which a Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy) because the Complainants´ trade marks are fully incorporated in the corresponding Domain Names. The Respondent does not dispute this.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants' assertions that Yoyo Email or Giovanni Laporta have never been commissioned to manage the

Complainants' email communications; have never been licensed to use the Complainants' marks for the receipt and transmission of email communications; and have never received any approval, expressed or implied, to use these marks in or as part of a domain name; and that the Complainants have no association, affiliation and/ or dealings of any nature whatsoever with the Respondent and neither endorse nor promote its services suffice to make out a prima facie case of absence of rights or legitimate interests in the Domain Names on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in the Domain Names: Do The Hustle, LLC v. Tropic Web, WIPO Case No. D2000-0624 and the cases there cited.

Paragraph 4(c) of the Policy sets out three illustrative circumstances as examples which, if established by a respondent, shall demonstrate its rights to or legitimate interests in the domain name for purposes of paragraph 4(a)(ii) of the Policy, i.e.
(i) before any notice to the respondent of the dispute, the use by the respondent of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) the respondent (as an individual, business or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
(iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

The Respondent does not contend that either Giovanni Laporta or Yoyo.Email Limited are commonly known by any of the Domain Names. Instead, the Respondent relies on Paragraphs 4(c)(i) and (iii).

In the National Arbitration Forum URS Appeal Determination in Deutsche Lufthansa AG v. yoyo.email et al.,
Claim Number: FA1404001552833, dated June 18, 2014, the majority (of which this Panel was one) stated: "The Respondent states, and the Examiners find no reason to question that, the disputed domain name is registered and will be used for a free of charge recorded delivery service, especially meant for the Complainant and customers of the Complainant. On this basis, such “free of charge” use may be considered as a more technical and non-commercial use of <lufthansa.email>, that may – under some circumstances – have been seen as legitimate interest. However, in the Statement of Giovanni Laporta, that the Respondent provides as evidence of Legitimate Interests as well as supporting good faith Registration and Use, the Respondent states that the business is serious, involving up to 10 employees and that “a lot of money” has been spent on the project so far, thereby contradicting that the use is non-commercial. Further, in the same Statement, the Respondent says that it was important to start building up a directory of large companies such as Lufthansa, as the intention is to “make money by the value of having large numbers of active users…”, by charging for connected social media, as well as connected advertising. Whatever might be the Respondent’s intent, the juxtaposition of the distinctive and well-known trademark LUFTHANSA with the descriptive gTLD .email is likely to convey to Internet users a false representation that the domain name belongs to or is approved by the Complainant. To register another’s well-known trademark as a domain name and using that domain name connecting to a web service with the specific goal to earn money from active users and advertising connected to the use of the trademark related web service, cannot be considered as legitimate interest. Accordingly, the Examiners find that the Complainant has established that the Respondent has no rights or legitimate interests in <lufthansa.email>. "

It is clear that in that case the majority were under the impression that the domain name would be visible to consumers. Here the Respondent has made clear that this is not so.

The Arizona judgement is not persuasive in the present Administrative Proceeding because the Complainants were not parties; none of the Domain Names was involved; and the judgement was made upon a motion to which both parties consented, thereby depriving the court of the benefit of a contested hearing on the issues.

The opinion attributed to the Hon. Neil Brown QC cannot be accorded any weight in this Administrative Proceeding because it is not accompanied by a statement of the issues he was asked to address nor by a copy of his opinion.

The Respondent's attorney, Mr. Enrico Schaffer, has provided an affidavit dated December 8, 2014 stating that he was contacted by Mr. Laporta on or about June 30, 2014 concerning his business to be launched at yoyo.email which included, among many other email services, a certified email service. Mr. Schaffer concluded that yoyo.email's registration of the

domain names that include trademarks for the use as a backend email server to store metadata that can be used to verify the sending of emails is not a violation of the UDRP, Anti-Cybersquatting Protection Act or general trademark law. He continued: "Overall, the general tone of many of the UDRP decisions is that they do not believe that yoyo.email intends to use the domains for their stated purpose, despite the complete lack of evidence to the contrary. There has been no use of the domain names in any trademark sense, and no trafficking of the domain names in any way. The only anticipated 'use' of the domain names is not a trademark use which could in any way cause confusion as to source, origin or ownership."

The Panel accepts that the Respondent's intended use of the Domain Names is as a backend email server to store metadata that can be used to verify the sending of emails and further accepts that such use is not trademark use, since the Domain Names are not intended to be visible to users of the Respondent's intended email service. However, the Policy applies whether or not a domain name is being or is intended to be used as a trademark.

The Panel finds that the Respondent's intended use of the Domain Names is neither "bona fide" nor "fair" for the reasons set out in Logitech International S.A, Auto Trader Limited, Ryanair Limited, Associated Newspapers Limited, Wowcher Limited, Savills plc, Red Letter Days Limited and Oxfam International v. Yoyo.Email, CAC Case No.100891 (January 11, 2014). The Panel respectfully adopts the following passages from that decision as fully applicable in the present case:

"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."

The Complainant has, 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).

BAD FAITH

The Complainants must establish both bad faith registration and bad faith use.

Paragraph 4(b) of the Policy provides 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.

Although the above circumstances are common to the URS and the UDRP, the standard of proof required is higher in URS proceedings, which are determined without prejudice to a complainant's right to bring UDRP proceedings. The success of the Respondent in resisting suspension in some URS cases therefore carries little weight when considering the application of the UDRP. Hence although the Respondent successfully appealed in NAF URS claim FA1404001554808 in relation to the domain name <stuartweitzman.email> (June 24, 2014), on November 6, 2014 that domain name was ordered to be transferred in a subsequent UDRP proceeding: Stuart Weitzman IP, LLC v. Giovanni Laporta , Yoyo.Email Ltd., WIPO Case No. D2014-1537.

It is true that during the Sunrise Period trademark owners had an opportunity to register their marks in the .email space before domain names in that space became generally available on a first come, first served basis. This does not mean, however, that upon the expiration of the Sunrise Period non-trademark owners became entitled to register any available <trademark.email> domain names without regard for the UDRP. Accordingly, although the mere registration of a large number of <trademark.email> domain names by a non-trademark owner following the Sunrise Period is not, in itself, a violation of the UDRP, it is necessary to consider all the circumstances of registration and use in determining whether the UDRP has been violated.

The Panel considers that the Respondent's business model contemplates that the larger the number of <trademark.email> domain names registered by the Respondent, the wider would be the coverage of the Respondent's intended email verification service. Further, the Respondent has not explained why, since the Respondent's contemplated email verification service is intended to verify the sending of email to and the receipt of email by a company, it was necessary for the trademarks GSK and BEECHAMS to be incorporated in two of the Domain Names, when the domain name <glaxosmithkline.email> would be adequate for that service. These circumstances indicate that the Respondent chose to register domain names that the Respondent knew were <trademark.email> domain names, including the Domain Names, in order to prevent the owners of the trademarks from reflecting their marks in a corresponding domain name, and that, having regard to the very large number of such domain names involved, the Respondent has engaged in a pattern of such conduct. This is evidence of both bad faith registration and bad faith use under paragraph[h 4(b)(ii) of the Policy.

The fact that the Domain Names have not been actively used to date does not outweigh that evidence, since the 'use' requirement has been found not to require positive action, inaction being within the concept: Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; Barney's, Inc. v. BNY Bulletin Board, WIPO Case No.D2000-0059; CBS Broadcasting, Inc. v. Dennis Toeppen, WIPO Case No. D2000-0400; Video Networks Limited v. Larry Joe King, WIPO Case No.D2000-0487; Recordati S.P.A. v. Domain Name Clearing Company, WIPO Case No.D2000-0194; Revlon Consumer Products Corporation v. Yoram Yosef aka Joe Goldman, WIPO Case No.D2000-0468.

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

PROCEDURAL FACTORS

1. Independence and impartiality of the Panel.

Having completed a declaration of impartiality and independence on January 9, 2014 and having been appointed as the Panel that day, the Panel informed the CAC on January 12, 2014 : "Now that I have read the case file, I realise that I was one of the two panellists in the majority in the National Arbitration Forum URS Appeal Determination No. FA1404001552833 <lufthansa.email> 18/06/14. The Response in this case refers to the dissenting panellist in that case. I do not consider that will actually affect my independence and impartiality in determining the present case under the UDRP. However, to avoid any appearance of lack of independence or impartiality, I draw these circumstances to your attention in case you wish to appoint another panellist. You may wish to ask the parties if they have any objection to my continuing."

On January 13, 2014 the CAC replied: "after careful consideration the CAC confirms that we do not believe that outlined situation could prevent you from issuing an impartial and independent decision and therefore we do not consider it a conflict of interest."

2. Multiple Complainants.

This is a Class Complaint which satisfies the conditions in CAC's UDRP Supplemental Rules of the Czech Arbitration Court, Article 4(a) and UDRP Rule 3(c) as well as principles articulated in previous decisions. Therefore, this Panel is of the opinion that the Complainants (i) have a specific common grievance against the Respondent and the Respondent has engaged in common conduct that has affected the Complainants' individual rights in a similar fashion and (ii) it is equitable and procedurally efficient to permit such Complaint.

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

PRINCIPAL REASONS FOR THE DECISION

Each of the Domain Names is identical or confusingly similar to a trademark or service mark in which a Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy). The Respondent does not dispute this.

The Respondent's intended use of the Domain Names is as a backend email server to store metadata that can be used to verify the sending of emails. Such use is not trademark use, since the Domain Names are not intended to be visible to users of the Respondent's intended email service. However, the UDRP applies whether or not a domain name is being or is intended to be used as a trademark.

The Respondent's intended use of the Domain Names is neither "bona fide" nor "fair" for the reasons set out in Logitech International S.A, Auto Trader Limited, Ryanair Limited, Associated Newspapers Limited, Wowcher Limited, Savills plc, Red Letter Days Limited and Oxfam International v. Yoyo.Email, CAC Case No.100891 (January 11, 2014).

The Respondent chose to register domain names that the Respondent knew were <trademark.email> domain names, including the Domain Names, in order to prevent the owners of the trademarks from reflecting their marks in a corresponding domain name and, having regard to the very large number of such domain names involved, the Respondent has engaged in a pattern of such conduct. This is evidence of both bad faith registration and bad faith use under paragraph 4(b)(ii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MOLTONBROWN.EMAIL**: Transferred
2. **ROCHE.EMAIL**: Transferred
3. **GLAXOSMITHKLINE.EMAIL**: Transferred

4. **GSK.EMAIL**: Transferred
5. **BEECHAMS.EMAIL**: Transferred
6. **VERTU.EMAIL**: Transferred
7. **LYONDELLBASELL.EMAIL**: Transferred
8. **VELUX.EMAIL**: Transferred
9. **G4S.EMAIL**: Transferred

PANELLISTS

Name	**Alan Limbury**

DATE OF PANEL DECISION 2015-01-18

Publish the Decision