Decision for dispute CAC-UDRP-101115

Case number	CAC-UDRP-101115
Time of filing	2015-11-18 15:51:24
Domain names	Homeaway.email, Lateroom.email, Laterooms.email, Airtours.email, Amey.email, Pokerstar.email, Pokerstars.email

Case administrator

Name	Lada Válková (Case admin)

Complainants

Organization	HomeAway.com, Inc
Organization	LateRooms Limited
Organization	Thomas Cook UK Limited
Organization	Amey plc
Organization	Amaya Services Limited
Organization	Rational Intellectual Holdings Limited

Complainant representative

Organization	Safenames Ltd

Respondent

Organization	YOYO EMAIL

OTHER LEGAL PROCEEDINGS

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

Various proceedings relating to the Respondent and other domain names are mentioned in the decision below.

IDENTIFICATION OF RIGHTS

HomeAway.com, Inc. owns, inter alia, the US federal trademark registration no. 3596177 “HomeAway” (word) with filing date 18 January 2008, enjoying protection for “providing temporary lodging information via the Internet” in international class 43.

LateRooms Limited owns the European Community trademark registration no. 4864955 “LateRooms” (word), filing date 27

January 2006, enjoying protection for various services in international class 43.

Thomas Cook UK Limited owns the European Community trademark registration no. 981951 “Airtours” (with design), filing date 10 November 1998, enjoying protection for various goods and services in international classes 9, 16, 36, 39, and 42.

Amey plc owns, inter alia, the UK trademark registration no. 1509042 “AMEY” (word), filing date 7 August 1992, enjoying protection for various services in international classes 42 and 45.

Rational Intellectual Holdings Limited owns the European Community trademark registration no. 10372258 “POKERSTARS” (word), filing date 26 October 2011, enjoying protection for various goods and services in international classes 9, 16, and 36.

FACTUAL BACKGROUND

HomeAway.com, Inc (“HomeAway”) is a leading company in the vacation rental industry with over 1,000,000 listings on its family of websites. Established through its legal predecessor in 1996, HomeAway has achieved revenue of US$ 447 million in 2014. Operating from its primary website located at www.homeaway.com the site receives over 41 million page views from 32 million travellers that visit the site each month.

Late Rooms Ltd (“LateRooms”) was established in 1999 and functions as a hotel reservations website providing accommodation throughout the world through its primary website located at www.laterooms.com. In 2014/2015 LateRooms generated turnover of € 31 million. The LateRooms brand has utilized a range of social media platforms, reaching over one million users across social media platforms including Google+, Instagram, Facebook and Twitter.

Thomas Cook Group UK Limited (“Thomas Cook”) is part of the Thomas Cook Group plc, and is one of the world’s leading leisure travel companies with sales over £ 8.5 billion in the fiscal year ended 30 September 2014. Following a merger in 2007, Thomas Cook have operated one of the UK’s largest tour operators under the name AIRTOURS.

Amey plc (“Amey”) was founded in 1921, employs over 21,000 people across the UK and has an annual turnover of £ 2.3 billion. Amey is the largest provider of road services in the UK and looks after 41% of the London underground network. In addition, Amey maintains over 100,000 houses throughout the UK on behalf of local authorities and services and maintains over 800,000 street lights. Every year, Amey installs, upgrades and repairs around 300km of clean water pipes and undertakes over 250,000 clean and waste water repair and maintenance jobs across the UK.

Amaya Services Limited (“Amaya”) is a provider of technology-based solutions, products and services in the global gaming and interactive entertainment industries. On 1 August 2014 Amaya acquired 100% of the Rational Intellectual Holdings Limited (“Rational Group”), the world’s largest poker business, including the PokerStars brand for US$ 4.9 billion. Under the direction of its parent company Amaya, Rational Group continues to operate two of the largest online poker sites, including the PokerStars brand, which have dealt an estimated 100 billion poker hands and held over 800 million online tournaments, making them the largest producer of live poker events around the world. With more than 85 million registered players on desktop and mobile devices, the PokerStars brand is the world’s largest real money online poker site based on, among other things, player liquidity.

The disputed domain names are a part of very large number of domain names registered by the Respondent incorporating the trademarks of other companies followed by the <.email> generic Top-Level Domain (“gTLD”). Many of these domain names have already been the subject of proceedings either under the Uniform Domain Name Dispute Resolution Policy („UDRP“) or the Uniform Rapid Suspension System (“URS”), including the CAC cases nos. 100878 British Sky Broadcasting Limited et al. v Giovanni Laporta, Yoyo.Email, 100890 Molton Brown Limited et al. v Yoyo.Email, Giovanni Laporta and 100891 Logitech International S.A. et al. v Yoyo.Email. It should be noted that this list is non-exhaustive and there are numerous other earlier cases against the Respondent that are cited in these CAC decisions. In total the Panel is aware of approximately 60 other UDRP and URS cases involving the Respondent. Most of these cases were decided against the Respondent. The Respondent has only prevailed in two URS decisions, namely the NAF cases no. FA1408001575592 (regarding <eharmony.email>) and FA1404001554808 (regarding <stuartweitzman.email>); the latter domain <stuartweitzman.email>, however, became subject of a subsequent UDRP proceeding in which a transfer of the domain

name from the Respondent to the trademark owner was ordered (WIPO case no. Case No. D2014-1537).

On 29 August 2014 the Respondent filed a complaint in the United States District Court for the District of Arizona against the 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 other domain names incorporating the trademarks of third parties that were not a party to that proceeding. On 5 November 2014, declaratory judgment was delivered regarding the domain name <playinnovation.email> (but not regarding any other domain names for which the Respondent had also sought declarative relief) that was broadly favourable to the Respondent. This judgment, however, was by agreement of the parties and "with no admission of liability by any party".

On 4 September 2014 the Respondent filed a Claim Form in the English Courts against The Royal Bank of Scotland plc. In this proceeding, the Respondent sought to overturn the suspension of the domain names <rbs.email>, <rbsbank.email>, <natwest.email> and <coutts.email> under the URS (notwithstanding the fact that all of these domain names were also included in the list of domain names identified in the Arizonan proceeding mentioned above). The current status of this English proceeding is unknown to the Panel.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainants contend that each of the disputed domain names is either identical or confusingly similar to the respective Complainant's relevant trademark.

The Complainants further contend that the Respondent has never (a) been commissioned to manage the Complainants' email communications; (b) been licensed to use the Complainants' marks for the receipt and transmission of email communications; (c) 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 or promote its services. The Complainants particularly contend that the Respondent's use of third party trademarks in connection with an allegedly planned "certified email service" does not provide a legitimate interest.

The Complainants finally contend that the Respondent has registered and used the disputed domain names in bad faith. Again quoting from a number of previous UDRP decisions, the Complainants primarily argue that the Respondent has registered the domain names in order to prevent the owners of the respective trademarks or service marks from reflecting their marks in the corresponding domain names, and that the Respondent has engaged in a pattern of such conduct. The Complaint also relies on paragraph 4(b)(iii) of the UDRP (alleging that the Respondent has registered the disputed domain names primarily for the purpose of disrupting the business of a competitor) and on paragraph 4(b)(iv) of the UDRP (alleging that the Respondent, by using the disputed domain names, has intentionally attempted to attract, for commercial gain, internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainants' marks as to the source, sponsorship, affiliation, or endorsement).

RESPONDENT:

The Respondent claims that the disputed domain names were registered for a legitimate business purpose, with the good faith intent to comply with all laws, including trademark laws.

The Respondent is highly critical of previous panels that have decided the numerous cases against it. The Respondent believes that its previous Responses have been grossly and deliberately misinterpreted and in some cases both previous complainants and previous panelists have allegedly made facts up. The credibility and competence of UDRP panelists is called into question, and the Respondent also contends that there is a bias among UDRP panelists against the Respondent.

The Respondent emphasizes the fact that The UDRP does not say that every registration of a domain name that knowingly

includes a matching trademark is a violation of the UDRP.

Further, the Respondent refers to the sunrise process whereby trademark 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. According to the Respondent the very existence of a limited sunrise period would suggest there must come a time when all domain names can be purchased legitimately after that period has ended.

As to its (planned) business model, the Respondent states that its offering "is primarily a consumer focused service working on behalf of the sender (consumer) and NOT the receiver. [The Respondent] is the neutral party that sits between sender and receiver and works on behalf of the sender as proof the email has been sent". A verbatim copy of the Respondents description of its service reads:

"The initial idea is to launch the service as a closed software service which means that users can only send emails via the Respondents software, so initially the service works as a back end service where all emails are directed and documented internally by name. At this point domain names are not seen by the general public, however domain names may be used to forward emails to the respective company (recipient). At this point there can be no confusion as to source and origin as the company (recipient) cannot be confused to who they are. Further, there is absolutely no need for recipients (the Complainant) to "sign up" for the Respondent service. (…) The service at some point in the future may be extended so that consumers can send emails via any email client software, the intention is to expand consumer choice. However as long as users sent emails using the Respondents domain names which pass through its owns email servers [the Respondent] could still provide an email certified service when emails are then sent from other software email clients."

The Response initially states that that there has been no use of the disputed domain names to date, and that their intended use is not a trademark use, or public use. Later sections of the Response, however, argue that the disputed domain names "are simply being used to store email metadata", which seems to imply that the disputed domain names are already in active use (not for the operation of a website or in some other visible way, but "internally" for the Respondent's email service as described above). The Respondent states that its service is currently in beta testing and has provided a password to the Panel, inviting it to view the live test site.

The Respondent further states that both the US law firm Traverse Legal and a renowned UDRP panelist "have opined that Respondent's business model and use do not violate trademark law or the UDRP". This legal assessment is supported by an Affidavit from Enrico Schaeffer of Travers Legal.

As to the Arizonan declaratory judgement, the Respondent urges the Panel not to read this as just a consent order or just a stipulation between parties, but 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 disputed domain names in connection with a bona fide offering of services, and 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 UDRP.

The Respondent 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 Complainants have, to the satisfaction of the Panel, shown the domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights (within the meaning of paragraph 4(a)(i) of the UDRP). In each case disregarding the Top Level Domain ".email",

* the domain name HOMEAWAY is identical to the trademark "HomeAway" which is cited above;

* the domain name LATEROOM is confusingly similar and the domain name LATEROOMS is identical to the trademark "LateRooms" which is cited above;

* the domain name AIRTOURS is identical to the trademark "Airtours" which is cited above;

* the domain name AMEY is identical to the trademark "AMEY" which is cited above; and

* the domain name POKERSTAR is confusingly similar and the domain name POKERSTARS is identical to the trademark "POKERSTARS" which is cited above.

To address one of the concerns raised in the Response, it is clear that meeting this requirement of paragraph 4(a)(i) of the UDRP is not sufficient for the Complaint to be successful. As stated in the Response, the UDRP does indeed NOT say that every registration of a domain name that (knowingly) includes a matching trademark is a violation of the UDRP, because the independent additional requirements of paragraphs 4(a)(ii) and (iii) of the UDRP – which are discussed below – must also be met.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the UDRP).

The Panel does not agree with the Respondent's contention that the Respondent has made demonstrable preparations to use the disputed domain names in connection with a bona fide offering of services, namely by providing the email services as described above. The Panel is willing to accept the Respondent's claim that it "has invested tremendous time and money" – i.e. has made demonstrable preparations – to develop its service under the <.email> gTLD. To the extent the Respondent's service makes use of the disputed domain names, however, the Panel does not consider it to be a "bona fide" offering. The Respondent has failed to provide any convincing explanation (or actually any explanation at all) why the disputed domain names might be necessary, or at least helpful, for the operation of its service.

The Respondent argues that merely because there might be other technical ways to operate its service (i.e. ways which would not make use of the disputed domain names) does not mean that its own way of operating the service – which does make use of the disputed domain names – should be regarded as "illegal". The Respondent appears to complain that the panelists deciding against it are forcing the Respondent to use a different technical solution just because the panelists do not "like" the one the Respondent has chosen. But the fact that there evidently seem to be other ways of doing what the Respondent does without having to engage in a wholesale "land grab" of thousands of trademark domain names is a point well worth considering in the assessment whether that activity is "bona fide" or not. Therefore, the fact that the Respondent chose this approach rather than some other requires an explanation. Without such explanation, the Respondent's activity is not "bona fide" (cf. CAC case no. 100891, Logitech International S.A et al. v Yoyo.Email).

The Respondent's argument that it is making a legitimate fair use of its <.email> domain name portfolio, without intent for commercial gain to misleadingly divert consumers or to tarnish the marks at issue., is also unfounded for the same reason. Paragraph 4(c)(iii) of the UDRP explicitly requires either a "legitimate" or a "fair" use of the disputed domain names. As discussed above for the "bona fide" offering of goods or services, there is no "legitimate" or a "fair" use of the disputed domain names if it is entirely unclear why these domain names might be necessary, or at least helpful, for the operation of the Respondent's service.

BAD FAITH

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

Although the requirements for a finding of “bad faith” 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 two URS cases therefore carries little weight when considering the application of the UDRP (cf. CAC case no. 100890, Molton Brown Limited et al. v Yoyo.Email).

Paragraph 4(b)(ii) of the UDRP provides that it shall be considered evidence of both the registration and use of a domain name in bad faith if the Respondent has 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. Absent any other (convincing) explanation for the Respondent's registration of the disputed domain names together with thousands of other trademark domain names under the <.email> gTLD, the Panel finds that the only realistic explanation why these registrations were made is that they were made in order to prevent the Complainants from reflecting their respective marks in corresponding domain names under the <.email> gTLG (cf. CAC case no. 100890, Molton Brown Limited et al. v Yoyo.Email; case no. 100891, Logitech International S.A et al. v Yoyo.Email; and case no. 100878, British Sky Broadcasting Limited et al. v Giovanni Laporta, Yoyo.Email). The “pattern of such conduct” is clearly demonstrated by the numerous URS and UDRP cases against the Respondent regarding its domain names.

The mere fact that it is not entirely clear whether the domain names have already been actively used to date, or whether the Respondent merely plans to do so after further development of its service (which the Respondent says is currently in “beta” testing), does not outweigh this straightforward application of paragraph 4(b)(ii) of the UDRP. The “use” requirement does not necessarily require positive action (cf. CAC case no. 100890, Molton Brown Limited et al. v Yoyo.Email, making reference to various earlier precedents).

The Respondent’s argument based on the fact that the disputed domain names might have been registered in the Sunrise process is unfounded. 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 argument raised by the Respondent boils down to the re-statement 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. This argument 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 (cf. CAC case no. 100891, Logitech International S.A et al. v Yoyo.Email).

The judgment in the Arizonan litigation was entered by consent, contains no reasoning as to the basis for the declarations granted, and only extends to the domain name <playinnovation.email>. The Panel is neither aware of the underlying facts of the corresponding dispute, nor of the parties motives to settle it (or at least part of it), and also has no way to confirm to what extent the judge has actually vetted the parties legal assessment when approving their settlement. As such, the judgement provides no guidance as to the claimed lawfulness of the Respondent’s activities either generally or in relation to the disputed domain names.

Similarly, it is not relevant that a UDRP panelist and the Respondent’s US lawyers, no matter how renowned and respected, may have advised that the Respondent’s activities are legitimate under trade mark law and UDRP. What matters is not whether lawyer A or lawyer B has provided such advice. What matters is the reasoning that leads to either this or to that conclusion, as it is discussed herein.

PROCEDURAL FACTORS

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

The Complaint was submitted by multiple Complainants. Given the fact the Complainants have a common grievance against

the Respondent who has engaged in common conduct that has affected their rights in a similar fashion, the Panel finds that this class complaint is admissible in accordance with Article 4 of the CAC's UDRP Supplemental Rules.

The main body of the Response submitted by the Respondent (already excluding any administrative “overhead” such as the Parties’ names etc.) has a length of 7,170 words and therefore clearly exceeds the 5,000 word limit according to Paragraph 13 of the CAC's UDRP Supplemental Rules. The Panel notes that the Respondent has exceeded the word limit in other cases as well (see, for example, the CAC case no. 101010 regarding <comparethemarket.email>) and should therefore be well aware of its existence. On 15 December 2015 the CAC’s case administrator explicitly informed the Parties about this administrative deficiency of the Response. On 21 December 2015 the Panel informed the Parties that it intended to handle the Response’s administrative deficiency by reading and considering only those parts of it that are compliant with Paragraph 13 of the CAC's UDRP Supplemental Rules, i.e. only the first 5,000 words of the Response. At the same time the Panel invited the Respondent to submit a revised version of the Response that complied with the word limit, which could then be read and considered in its entirety. The Respondent has not reacted to this suggestion. The Panel has therefore proceeded in accordance with its notification of 21 December 2015 and has stopped reading the Response at the end of the second sentence of its “DECLARATORY JUDGEMENT” section. The Panel considers this partial disregard of the Respondent’s legal arguments to be the adequate sanction for the Respondent’s notorious disregard of procedural word limits.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the Respondent’s deliberate registration of thousands of domain names comprising a third party trade mark under the <.email> gTLD was not in connection with a “bona fide” offering of services within the meaning of that term in paragraph 4(c)(i) of the UDRP nor “fair use” under paragraph 4(c)(iii) of the UDRP. It was also bad faith registration and use within the scope of paragraph 4(b)(ii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HOMEAWAY.EMAIL**: Transferred
2. **LATEROOM.EMAIL**: Transferred
3. **LATEROOMS.EMAIL**: Transferred
4. **AIRTOURS.EMAIL**: Transferred
5. **AMEY.EMAIL**: Transferred
6. **POKERSTAR.EMAIL**: Transferred
7. **POKERSTARS.EMAIL**: Transferred

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2016-01-13

Publish the Decision