

DISPUTE RESOLUTION SERVICE

DRS 7098

Decision of Independent Expert

Mir Internet Marketing, Inc.

and

Steve Morris (an individual)

1. The Parties:

Complainant: Mir Internet Marketing, Inc.

Address: 818 Harrison Street
Suite 205
Oak Park
Illinois
60304
Country: US

Respondent: Steve Morris
Address: 2 Residence Le Scorff Kernascleden
Morbiahn
Morbiahn Brittany
56 540
Country: FR

2. The Domain Name:

seologic.co.uk

3. Procedural History:

- 3.1 The complaint was received by Nominet, on 1 April 2009 (the 'Complaint'). On 2 April 2009, Nominet validated the Complaint and took appropriate steps to notify the Respondent of the Complaint.
- 3.2 A response from the Respondent (the 'Response') was received on 14 April 2009, and the Complainant's reply (the 'Reply') to the Response was received on 21 April 2009. A mediator was appointed on 24 April 2009.

- 3.3 On 1 June 2009, the status of the dispute changed from Mediation to a request under Nominet's dispute resolution service ('DRS') procedure (the 'Procedure').
- 3.4 On 15 June 2009, Dr Russell Richardson was appointed as the expert (the 'Expert') who confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as the Expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual Background

- 4.1 The Complainant holds a registered United States service mark for 'SEO LOGIC'(the 'Mark').¹ It was filed on 27 August 2002, and registered on 8 July 2003. The register entry states that the Mark was first used, 25 January 2002.
- 4.2 The Complainant also holds a registered United Kingdom trademark for 'SEO LOGIC'.² The Complainant submitted a Madrid Protocol application with WIPO, and registered the Mark in the United Kingdom as of 21 June 2007.
- 4.3 The services with which the Mark are used are - computer programming services for increasing Internet traffic to websites, including but not limited to search engine optimization ('SEO') services.
- 4.4 The Complainant registered its www.seologic.com domain name on the 25 January 2002 (based on a search by the Expert of the Registrar's WHOIS database).
- 4.5 Additionally, the Complainant provided evidence that it has sought to protect its Mark and trade name by protective registrations of the Mark in various top level domain name registrations including for example 'SEOLOGIC.NET' and 'SEOLOGIC.NAME'.
- 4.6 The Respondent is an individual who runs a registered business in France.³ According to Nominet's WHOIS database, the Respondent registered the domain name 'seologic.co.uk'(the 'Domain Name') as of 6 January 2007.
- 4.7 The Respondent currently runs his main business through his www.net101.co.uk domain name.

5. Parties' Contentions

Complainant:

- 5.1 In summary, the Complainant argues that the Domain Name should be transferred to it because:

¹ United States Patent and Trademark Office ('USPTO') Registration Number 2,734,898, Serial Number 78-158,289 – in Class 42 (U.S. CLS. 100 and 101).

² United Kingdom Trademark Office ('UKTO') Registration Number M928055, for Class 42 - Computer programming services for increasing Internet traffic to websites.

³ The Siret number being, 49502670000023.

- it has Rights in the Domain Name based on: its continuous use of its Mark in commerce since no later than 25 January 2002; its built goodwill in the Mark and its identifier for the Complainant and its SEO services (as evidenced by a 1 April 2009 printout of Google and YAHOO! internet search engine results for 'seo logic', where the Complainant's domain name "seologic.com" appears as the top-ranked return).
- The Domain Name in the hands of the Respondent is an "Abusive Registration" in that the Respondent most likely registered the Domain Name with full knowledge of the Complainant's Mark/name, seeking to:
 - a) confuse or likely confuse Internet users into thinking that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant; and/or,
 - b) redirect to the Respondent internet search engine traffic using the search term 'seo logic'.

Each of those actions being unfairly detrimental to the Complainant's Rights, as that term is defined in Nominet's Procedure and DRS policy (the 'Policy').

- The Respondent registered the Domain Name as of 6 January 2007; five years after the Complainant registered the Mark with the USPTO, widely promoted the Mark as a search term on the Internet for the Complainant's SEO business, and built goodwill in the Mark/name (and associated domain name) in a specialised, niche market.
- The Respondent uses "SEO Logic" as its trade name in the website attached to the Domain Name (the 'Website').
- As the Respondent on the Website claims expertise in the mechanisms of search engines and website search returns, it can be reasonably assumed that the Respondent at least performed basic Internet search engine searches of 'seo logic' and 'seologic' domain names prior to it adopting its trade name and registering the Domain Name.
- As the Complainant's website appears as the top-ranked search result in Google and YAHOO!, the Respondent would have had to have been aware of the Complainant's presence in the SEO services field when the Domain Name was registered and chose its trade name.
- As such, the Respondent's decision to register the Domain Name and his use of the Complainant's trade name was a knowing act of taking on the Complainant's online business identity by adopting an unprotected similar UK domain name.
- Also, the Respondent has not taken any steps to register or otherwise legitimately protect its use of the Mark. The Website uses no trademark identifiers evidencing that the Respondent is making a legal claim to the Domain Name and the Website does not identify any organization or individual responsible for it.
- In this way, the Respondent's adoption of the Complainant's identity and the Respondent's anonymous website is designed so when potential

customers input “seo logic” in search engines, search engine users will navigate to the Website rather than that of the Complainant.

- Thus, the Respondent’s intent is to confuse visitors seeking SEO services into navigating to the Website and sending business inquiries to the Respondent rather than the Complainant.

Respondent’s response:

5.2 In summary, the Respondent argues that the Complaint should not succeed because:

- The Complainant has had an opportunity to register the Domain Name to secure it; the fact that they did not proves negligence on their part.
- Since registration of the Domain Name (over two years ago), the Respondent has risen to position three on *google.co.uk* using the search term ‘seo France’. Further, using *google.co.uk* search for ‘seo logic’, the Website is currently in fifth position.
- The Respondent’s objective in registering the Domain Name was and is to offer services to the French system.
- The Respondent registered the Domain Name without a prior search of domain names, as he wanted it as an ancillary company to his “Net101 business”; this being “the only reason that the word SEO was included in the Domain Name”. The only other word he could think of at that moment was ‘logic’, being that it is logical to have SEO carried out on a website to gain higher rankings.
- The Respondent is resident in France, and the Domain Name and services operate entirely from France. Therefore, the Complainant’s UK and US trademarks are irrelevant to his activity in France. Also, as the Complainant does not hold a French trademark, the Respondent can use the Domain Name in France.

There is also reference to a potential claim for defamation against the Complainant, based on the bringing of the Complaint. The Expert does not consider this relevant to his consideration of the Complaint. Additionally, the Expert does not consider that it can be defamatory to bring a complaint to Nominet, in line with Nominet’s published Policy and Procedure.

Complainant’s Reply:

5.3 The Complainant replied as follows, in summary:

- The Respondent admits in his response that he competes with the Complainant (e.g. by reference to the Respondent being fifth in a *google.co.uk* search for ‘seo logic’, the Complainant’s Mark and trade name). As such, the Respondent seeks business traffic from people entering “SEO LOGIC” in search engines.
- Although the Respondent claims ignorance of the Mark/name, at the instant he registered the Domain Name, the Respondent most likely knew of the Mark/name. This is because the Respondent claims on the

Website and in his Reply expertise in search engines. The Complainant is now, and has been for years, the first search engine match on Yahoo, Google, MSN, and other major search engines for the phrase “seo logic”.

- Simply entering 'seologic.com', the Complainant's .com web-address, into a browser navigation bar, an almost universal action when considering a domain name registration, would have alerted the Respondent to the Complainant's use. Given that, it is probable that the Respondent did do this simple research of “SEO LOGIC” prior to spending money to register the Domain Name.
- In any event, given the Respondent's admitted Internet skills, the Respondent must have known of the Complainant's use of 'SEO LOGIC' no later than very shortly after the Domain Name's registration, when he created the Website, yet the Respondent persisted in using the Domain Name.
- The Respondent claims that the Complainant negligently failed to register the Domain Name before the Respondent did so, inferring that such failure makes the Respondent's registration and use of the Domain Name acceptable. There is no basis for this argument in the Policy.
- The Respondent claims that, because: he is a resident of and business owner in France; the domain and services operate entirely from France; and, the Complainant does not hold a French trademark - this action should not affect him. Section 2 of the Policy states otherwise.

There is also a reply to the defamation claim; again, this is not relevant to the consideration of the Complaint by the Expert.

6. Outstanding formal/procedural issues

6.1 In relation to the matter raised by the Respondent of jurisdiction of the Expert to consider the Complaint, Nominet's Policy at paragraph **2 a.** states that:

“A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Procedure, that [the Complainant has Rights in a name or mark identical or similar to the Domain Name and the] Domain Name, in the hands of the Respondent, is an Abusive registration.”

6.2 The Policy at paragraph **1** defines a Respondent as:

“the person (including a legal person) in whose name or on whose behalf a [d]omain [n]ame is registered.”

6.3 As the Respondent has registered a domain name administered by Nominet, he is subject to the terms and conditions of Nominet's DRS.⁴ Therefore, the Expert, as appointed in accordance with the Procedure, has jurisdiction to consider the Complaint brought by the Complainant against the Respondent.

⁴ <http://www.nominet.org.uk/registrants/aboutdomainnames/legal/terms/>.

- 6.4 Additionally, the exhibit the Complainant used to evidence the use of the Domain Name by the Respondent (referred to as Exhibit F) was not a print-out of the Website content as of 1 April 2009, but a link to that content. When the Expert clicked on the Domain Name as part of his consideration of the Complaint (30 June 2009), he was directed to the Respondent's www.net101.co.uk website rather than the Website content.
- 6.5 Noting that the Complaint did not refer to this directing in the Complaint, the Expert asked the Complainant to send him a copy of the Website content as of 1 April 2009. The Complainant was unable to do so, so the Expert asked the Respondent to (both requests being pursuant to section **13a** of the Procedure). The Respondent in reply put the Website back online as of 1 April 2009.
- 6.6 The Expert did not consider it necessary to seek further comments on the site put back online by the Respondent, as he considers that this is the Website the Complainant and Respondent refer to in their submissions.

7. Discussions and Findings

General

- 7.1 To succeed in its application, the Complainant has to prove pursuant to paragraph **2** of the Policy, on the balance of probabilities (that the Complainant's case is more likely than not to be the true version⁵), that:
- (i) it has Rights in respect of a name or mark identical or similar to the Domain Name (paragraph **1** of the Policy); **and**,
 - (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration (paragraph **1** of the Policy).
- 7.2 Taking each of these limbs in turn:
- i) Complainant's Rights*
- 7.3 Paragraph **1** of the Policy defines 'Rights' as including, but not being limited to: "rights enforceable under English law." Also, the Complainant must have the rights at the time of the complaint.⁶
- 7.4 As set out at paragraph 4.2 above, the Complainant has trademarked SEOLOGIC in the U.K. It has also registered SEOLOGIC as a US trade mark (see paragraph 4.1 above).⁷
- 7.5 As to whether the Complainant has generated any goodwill in the Mark/name, the Expert notes that the Complainant as of 1 April 2009 ranked first in Google and YAHOO! Searches. As such, there is a measure of goodwill in that anyone looking for an SEO provider who conducts his/her search using these search engines will be provided first with links to the Complainant's .com website.

⁵ <http://www.nominet.org.uk/disputes/drs/legalissues/>.

⁶ See for example, Nominet Appeal decision, *ghd*, DRS No. 03078, at page 9, para 9.2.2.

⁷ Registered on 30 January 2008, No 005515581.

- 7.6 As such, the Expert considers that the Complainant has Rights in respect of the Mark/name, SEO LOGIC.
- 7.7 The next question is whether the Domain Name is identical or similar to the Complainant's Rights i.e. the Mark/name SEO LOGIC. Disregarding the generic *.co.uk* suffix, the Expert considers that the Domain Name is identical to the Complainant's Rights.⁸
- 7.8 Therefore, given these factors, as well as the fact that the requirement to demonstrate "Rights" is not a particularly high threshold,⁹ the Expert considers that the Complainant has Rights in the Mark/name SEO LOGIC, which is identical to the Domain Name.

ii) Abusive Registration

- 7.9 Paragraph 1 of the Policy defines "Abusive Registration" as a domain name which either:

"i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or

ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights;"

- 7.10 *In relation to (i) above* – the Domain Name was registered by the Respondent on 6 January 2007, over three years after the Complainant first registered it as a US trademark (being the 8 July 2003).
- 7.11 As the Complainant and Respondent both provide Internet search services, on the balance of probabilities, the Expert considers it likely that the Respondent would have known of the Complainant at the time the Domain Name was registered.¹⁰
- 7.12 This is because, in agreement with the Complainant, it would be reasonable to assume that the Respondent would have conducted at least a *.com* search of SEO LOGIC prior to registering it as the Domain Name; especially given that he works in the provision of search engine services.
- 7.13 Therefore, relevant to this consideration is whether by doing so, the Respondent sought to do so primarily: "for the purpose of unfairly disrupting the business of the Complainant" (per paragraph 3 a. i. C. of the Policy). (The Expert does not consider there are any other factors that could evidence that the *registration* of the Domain Name was an Abusive Registration.)
- 7.14 Again, on the balance of probabilities, the Expert considers that, given:

⁸ See for example, Nominet decisions, *privilege.co.uk*, DRS No. 3806 and *HolidayAutos.co.uk*, DRS No. 05516.

⁹ See for example, Nominet appeal decision, *seiko-shop*, DRS No. 00248, at page 17.

¹⁰ The Expert notes that for the purpose of this limb: "there have been several decisions under the DRS Policy stating categorically that knowledge of the Complainant's trade mark at the relevant time is crucial to a successful complaint." (see for example Page 10, Nominet appeal decision, *Maestro* DRS No. 04884, 13 December 2007).

- the Complainant had registered its U.S. Mark on the 8 July 2003;
- the Complainant had a .com domain name at the time of the registration by the Respondent of the Domain Name;
- the Complainant and the Respondent are in effect competitors; and,
- the Complainant and the Respondent are experts in the field of SEO searches;

the Respondent registered the Domain Name with the likely intention to exploit the Complainant's reputation in the Mark/name for his own financial benefit; through hoping to attract web-users, who would be looking for the Complainant, to the Website.

7.15 As such, the Expert considers that the *registration* of the Domain Name did take unfair advantage of and/or was unfairly detrimental to the Complainant's Rights.

7.16 *In relation to (ii) above* – this said, in any event, the Expert considers that the Domain Name has subsequently been *used* in a manner which has taken unfair advantage of and/or was unfairly detrimental to the Complainant's Rights.

7.17 Paragraph 3 of the Policy sets out a *non-exhaustive* list of factors, which may be evidence that the Domain Name is an Abusive Registration. In this case, the Complainant refers in substance to the factor set out at paragraph **3 (a) (ii)** of the Policy, which states that:

“[there may be evidence of an Abusive Registration if there are] Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.”

7.18 The Complainant makes three points in this respect:

- that web-users are confused into thinking that the Website belongs to the Complainant (relying on the goodwill of the Complainant as evidenced by Google and YAHOO! Search print-outs, dated 1 April 2009, where the Complainant's website appeared first).
- Secondly, that the Respondent has not sought to protect its use of the Mark.
- Thirdly, that the Respondent 'scores' his traffic against that of the Complainant (as evidenced for example by the Respondent's claim he is third on the *google.co.uk* search using SEO France as the search term).

7.19 The Expert considers that, on the balance of probabilities, such evidence is sufficient to show that there has been likely confusion in the use of the Domain Name; in that people or businesses accessing the Website would

consider that the Website and attached Domain Name were *registered to, operated or authorised by, or otherwise connected with the Complainant*.

- 7.20 The Website, as provided by the Respondent, is headed “Seologic” and throughout the Terms and Conditions on the site, reference is made to Seologic e.g. in the definitions section and under the General heading (where it states that “Seologic will carry out work only where an agreement is provided [...]”). Given the Complainant’s Rights in the Mark/name and associated business goodwill and reputation, the Expert considers it likely that web-users would access the Website expecting it to be that of the Complainant.
- 7.21 Such web-users attempting to locate the Complainant via the Website, would likely have been initially confused into thinking that the Website was either that of the Complainant or somehow linked to the Complainant. The Expert notes that the Respondent’s attempts to distinguish the name on the Website’s home page by reference to adding “France” to “Seologic”. However, the Expert does not consider such reference is enough to clarify different ownership. Subsequently, a web-user would still consider the Website to be at least connected with the Complainant.
- 7.22 Also, as mentioned, the Expert accessed the Website as of 30 June 2009 and was re-directed at that time to the Respondent’s www.net101.co.uk website. In such circumstances, any visitors redirected to the Respondent’s website in this way after accessing the Website would not have arrived there had it not been for the similarity between the Domain Name and the Complainant’s Rights. In this way, the Respondent took unfair advantage of the Complainant’s Rights.
- 7.23 It does not assist the Respondent’s case that someone accessing the Website might soon realise his or her mistake by the fact that s/he is linked to the website of a different provider and look for the Complainant’s website.¹¹ The detriment to the Complainant would have already occurred by the initial confusion in that the Complainant would have lost web traffic as a consequence and potential business revenue.
- 7.24 Therefore, by reference to paragraph **3 (a) (ii)** of the Policy, the Expert considers that the Respondent has been using the Domain Name in a way which has, or is likely to have,¹² confused people or businesses into believing that the Domain Name is registered to the Complainant. Such confusion was unfairly detrimental to and took unfair advantage of the Complainant because of potential lost business and re-direction.
- 7.25 The Expert has considered whether there is any evidence/arguments before him which may be relevant to his consideration whether the Domain Name is *not* an Abusive Registration. In relation to this, the Expert notes the *non-exhaustive* list of factors set out at paragraph **4** of the Policy which may provide such evidence.
- 7.26 The Respondent in effect argues that, in reference to:

¹¹ See, for example, Nominet decision, *champagne*, DRS No. 4479, at page 14.

¹² See Nominet decision, *wwwnortonfinance*, DRS No. 05265.

“[Paragraph 4 a. i.] Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has: **A.** used or made demonstrable preparations to use the Domain Name [...] in connection with a genuine offering of goods or services; [...] and, **C.** made legitimate non-commercial or fair use of the Domain Name;”

- 7.27 The Respondent attempts to explain why he chose the Domain Name and used the Mark on his website, in that he wanted it: “as an ancillary company to [his] Net101 business.” He claims that he chose SEO logic as it is logical to have SEO carried out on a website to gain higher rankings.
- 7.28 The Respondent also points out that since registration of the Domain Name (over two years ago), the Respondent has risen to position three on *google.co.uk* using the search term ‘seo France’. Further, using *google.co.uk* search for ‘seo logic’, the Respondent is currently in fifth position.
- 7.29 The Expert notes that the Respondent was using the Mark/name as the Website’s homepage heading, when offering the same or substantially similar computer services. Also, when the Respondent used the Website to direct web traffic to its *net101.co.uk* domain name, the Respondent was not using the Website for the provision of services but as a re-direction page. Such use is in the Expert’s opinion evidence that the Domain Name is not being used fairly or legitimately.
- 7.30 As such, the Expert considers that, notwithstanding the arguments put forward by the Respondent as summarised in paragraph 5.2 above, the Domain Name has been *used* in a manner which was unfairly detrimental to and took unfair advantage of the Complainant’s Rights.

8. Decision

- 8.1 The Expert finds, on the balance of probabilities, that the Complainant has Rights in a name which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed: Russell Richardson

Dated: 14 July 2009