

DISPUTE RESOLUTION SERVICE

D00009218

Decision of Independent Expert

eHarmony, Inc.

and

Mr Stephen Warr

1. The Parties:

Complainant: eHarmony, Inc.
2nd Floor 888, East Walnut Street
Pasadena, California
91101
United States

Respondent: Mr Stephen Warr
1 Quantock View Washford
Watchet
Somerset
TA23 0NJ
United Kingdom

2. The Domain Name(s):

eharmonyswingers.co.uk

3. Procedural History:

- 3.1 On 25 October 2010 a Complaint was filed with Nominet in accordance with the Nominet UK Dispute Resolution Service Policy (“the Policy”). Nominet validated the Complaint and sent a copy of the Complaint to the Respondent on 26 October 2010 advising the Respondent that the Complainant was using Nominet’s Dispute Resolution Service to complain about the registration and use of the Domain Name, and allowing the Respondent 15 working days in which to respond to the Complaint.
- 3.2 No response was received, and on 26 November 2010 the Complainant paid the relevant fee to Nominet in order for the matter to be referred to an independent expert for a full decision. On 1 December 2010 Bob Elliott was duly appointed as Expert.

4. Factual Background

- 4.1 The Complainant is a Californian company which provides a service in the online dating, matchmaking and relationship market. It was founded by a clinical psychologist, Dr Neil Clark Warren in 2000, and has since attracted more than 33 million users to its online services, including more than one million registered users in the United Kingdom.
- 4.2 The Complainant uses scientific methods to establish the key dimensions of compatibility, which its research shows to be the foundation for long-term relationship success.
- 4.3 The Complainant owns a number of registrations for the EHARMONY trade mark, within the EU, the United States, and many other countries throughout the world. Its priority date for its EU EHARMONY trade mark is November 2004, and it commenced commercial use of the EHARMONY trade mark in the United Kingdom in 2000.
- 4.4 The Respondent registered the Domain Name on 24 June 2009, and has since used it for the purposes of a website which directs consumers to commercial dating websites, featuring adult-oriented content, and graphic images. The home page of the website promotes the website as “ADULTSFANTASY” with the greeting “welcome to adultsfantasy, so many people have sexual fantasies, why not meet swingers and people who have fantasies to fulfil, it can change your life forever, you are one step away, turn your dreams into reality. Join now it could be fun!!!”.
- 4.5 The Complainant’s lawyers have apparently written to the Respondent repeatedly in respect of the Domain Name, but the Respondent has not agreed to transfer the Domain Name voluntarily.

5. Parties’ Contentions

The Complainant’s submissions

Rights

- 5.1 The Complainant relies upon its extensive user base, evidence of its reputation through articles from the British press, and its trade mark registrations (including the Community Trade Mark referred to above). It says that the Domain Name is “virtually identical and/or similar to” its trade mark, comprising its “famous and distinctive” trade mark, along with the generic term “swingers”. It says that “swingers” refers to a type of casual sexual relationship between individuals, and which could therefore be said to be linked to the Complainant’s own online dating services “in the broadest sense of the term” (whilst pointing out that “swinging” is completely at odds with the Complainant’s goal of “engendering monogamous, long-term relationships between deeply compatible individuals”).

Abusive Registration

- 5.2 The Complainant says that it is no accident that the Respondent chose to incorporate the EHARMONY mark in his eharmonyswingers.co.uk Domain

Name, because the Complainant's business is one of the world's fastest growing and most successful online relationship services. The Respondent is said to have been aware of this, and to have wished to make an improper benefit from association with the Complainant's business.

- 5.3 As such, the Complainant says that the Respondent's registration and use of the Domain Name falls within paragraph 3.a.ii of the Policy, as one of a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration, namely "circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant".
- 5.4 The Complainant contends that consumers will mistakenly access the Respondent's site when searching for the Complainant, and once at the site, they will believe that the website is a "spin-off" or affiliated version of the Complainant's eHarmony service for swingers. The Complainant points to the difference between what it says is the distinctive part of the Domain Name (eHarmony) and the non-distinctive and "weak" element of the Domain Name, "swingers". The addition of the generic term does not suffice to differentiate it from the Complainant's mark, trade name and domain name.
- 5.5 The Complainant believes that it is a reasonable inference that the Respondent's purpose of registration and use of the Domain Name was to disrupt or create confusion with the Complainant's business for the purposes of his own financial gain.
- 5.6 The Complainant also relies upon a pattern of unlawful behaviour, as set forth in paragraph 3.a.i of the Policy ("the Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under.uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern"). In support of this contention, the Complainant relies upon the Respondent's registration of the corresponding eharmonyswingers.com domain name, which the Respondent has used in connection with a different pornographic swinger site. The Complainant has already successfully filed a complaint under the UDRP against the Respondent, resulting in the transfer of that domain name to it.
- 5.7 Addressing the requirements under paragraph 2.a.ii of the Policy, in terms of either registration or use which takes unfair advantage of or is unfairly detrimental to the Complainant's Rights, the Complainant says that this is "beyond reasonable dispute". Given the Complainant's "tremendous commercial success" and wide user base, the Respondent is said to be "preying on the Complainant's customers as well as other Internet users with complete disregard for the consequences to the Complainant's reputation, and is trading on the goodwill of the EHARMONY mark simply to make extra profits. The offensive images and content displayed on the Respondent's adult website tarnish and dilute the famous EHARMONY mark and erode the goodwill associated therewith".
- 5.8 The Complainant seeks the transfer of the Domain Name to itself.

The Respondent's submissions

- 5.9 The Respondent has not replied. The Complaint includes what appears to be an example of correspondence from the Respondent, in which the Respondent suggests that the Complainant should have bought every EHARMONY domain name available, and that as the Complainant does not cater for "swingers", he considers it was legal and above board for him to have bought the Domain Name.

6. Discussions and Findings

- 6.1 In order to succeed in these proceedings, paragraph 2.b of the Policy requires the Complainant to prove on the balance of probabilities that both elements of the test set out in paragraph 2.a are present, namely that :
- i. the Complainant has Rights in respect of names or marks which are identical or similar to the Domain Name; and
 - ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

- 6.2 The extent of the Complainant's trading reputation, and its registered trade mark rights clearly demonstrate that it has Rights in respect of EHARMONY. The Expert accepts the Complainant's argument that the addition of "swingers" to that mark is the addition of a generic term, and a "weak" part of the Domain Name, which does not differentiate from the Complainant's EHARMONY mark. The Expert therefore finds that the Complainant has Rights in respect of the name or mark EHARMONY which is similar to the Domain Name.

Abusive registration

- 6.3 The Complainant has to show that the Domain Name is an Abusive Registration. 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 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.
- 6.4 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3.a of the Policy. Paragraphs 3.a.ii and 3.a.iii are relied upon by the Complainant as set out above.
- 6.5 The Expert finds that the Complainant has made out a strong case in relation to paragraph 3.a.ii, as to confusion between the Domain Name and its trade mark, and the likely mistaken impression which would be gained by consumers. Although, as the Complainant points out, "swinging" is at odds with a goal of engendering long-term relationships, there is a link between the respective activities of the Complainant and the Respondent, in the sense of

both being related to online dating services. Although it may be that some consumers would appreciate the distinction between the nature of the parties' respective services, and not be confused, in the Expert's view there is clearly the potential for such confusion. The Complainant has not produced any actual evidence of confusion. However, although the Respondent has previously suggested in correspondence that there is a difference between the respective activities of the parties, he has not chosen to take part in these proceedings, leaving the Complainant's submissions unchallenged.

- 6.6 The Complainant still needs to make out its own case, even if there is no formal response, but only on the balance of probabilities. In the Expert's opinion, it has done so in respect of the factor set out at paragraph 3.a.ii of the Policy, and none of the relevant mitigating factors in paragraph 4 applies. The registration and use of the Domain Name, in the hands of the Respondent, is therefore an Abusive Registration within the terms of the Policy.
- 6.7 Given that finding, it is not strictly necessary for the Expert to make any finding in respect of the Complaint based upon 3.a.iii of the Policy. However, for the sake of completeness, the Expert would record that he does not consider that registering the same name as both .com and .co.uk domain names at the same time is, without evidence of other similar registrations, a "pattern" of such behaviour, for the purposes of the Policy. He would have rejected the Complaint if that were the only factor relied upon.

7. Decision

- 7.1 The Expert finds that the Complainant has Rights in the name EHARMONY which is similar to the Domain Name.
- 7.2 The Expert further finds that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration, and therefore directs that the Domain Name should be transferred to the Complainant.

Signed: Bob Elliott

Dated 15th December 2010