

DISPUTE RESOLUTION SERVICE

D00014519

Decision of Independent Expert

Amazon Technologies, Inc.; Amazon.com, Inc.; and Amazon
Europe Holding Technologies SCS

and

shi lei

1. The Parties:

Lead Complainant: Amazon Technologies, Inc
2nd Complainant: Amazon.com, Inc.
3rd Complainant: Amazon Europe Holding Technologies SCS
5555 Glenridge Connector
Suite 200
Atlanta
Georgia
30342
United States

Respondent: shi lei
chengguanzhen xiayuantang hubinxincun 36#
shengzhou
zhejiang
312400
China

2. The Domain Name(s):

amazonfirephone.co.uk (the "Disputed Domain Name")

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

14 July 2014 15:11 Dispute received
15 July 2014 09:19 Complaint validated
15 July 2014 09:32 Notification of complaint sent to parties
24 July 2014 08:37 Response received
24 July 2014 08:38 Notification of response sent to parties
29 July 2014 08:36 Reply received
29 July 2014 08:37 Notification of reply sent to parties
29 July 2014 08:38 Mediator appointed
04 August 2014 10:45 Mediation started
19 August 2014 16:06 Mediation failed
19 August 2014 16:06 Close of mediation documents sent
20 August 2014 09:46 Expert decision payment received

4. Factual Background

4.1 The Lead Complainant is an intellectual property holding arm of the well-known Amazon.com website which is operated by the second Complainant. The third Complainant is the European intellectual property holding arm of the Amazon organisation. All three claim shared rights in the names Amazon and Fire Phone. I will refer to them as “the Complainant”.

4.2 The Complaint recites the history and sets out the scope and size of the current commercial activities of amazon.com in some detail. It is unnecessary to recite these matters in this decision. Amazon is an extremely well-known business selling online either itself or as a marketing portal for third party traders a vast range of consumer goods. Amongst those goods are smartphones and related products. The Complaint records that Amazon.com’s most recent reported quarterly net sales were US\$19.74 billion and that it employs 124,600 full and part-time staff.

4.3 The Complainant has many registered trade marks in many jurisdictions for the mark AMAZON including the following UK and EU registrations:

UK registrations

- AMAZON, U.K. Reg. No. UK00002125191, registered on October 26, 2001
- AMAZON.CO.UK, U.K. Reg. No. UK00002243355, registered on August 29, 2003
- AMAZON, U.K. Reg. No. UK00002380807, registered on October 28, 2005
- AMAZON, U.K. Reg. No. UK0002063447A, registered on January 3, 1997

EU registrations

- AMAZON, CTM Reg. No. 7516198 , registered on May 25, 2012
- AMAZON, CTM Reg. No. 4496841, registered on June 26, 2008
- AMAZON, CTM Reg. No. 386276, registered on October 29, 1998
- AMAZON, CTM Reg. No. 2019412, registered on October 29, 1998

4.4 The Complainant is also the proprietor of a number of registrations that contain the mark FIRE and an EU application for registration of the mark AMAZON FIRE filed on 2 April 2014.

4.5 The Complainant is the registrant of the domain name amazonfire.com which was registered in 2002 and is used for goods and services provided under the Fire trade mark as well as its well-known domain names amazon.com and amazon.co.uk which have been registered since 1994 and 1996 respectively and are used for the conduct of the Complainant's business.

4.6 Since September 2011 the Complainant has been selling a tablet version of its highly successful Kindle e-reader under the name Kindle Fire. In April 2014 the Complainant announced the launch of the Amazon Fire TV products providing online access to a wide range of TV content, videos and games. It had been known for some time that the Complainant had been developing a smartphone. The Complainant gives examples of press reports in May 2013, October 2013 and March 2014, the second of which expressly mentions the "FireOS" as being part of the project. The third press report gives the likely date of the launch as being between three and six months after its publication.

4.7 The Complainant publicly announced the launch of the Amazon Fire Phone on 18 June 2014 since when it has been extensively marketed and widely available.

4.8 The Respondent does not explain what, if any, business he (or she) is engaged in or why the Disputed Domain Name was registered. The Complainant asserts that the Respondent is the registrant of many domain names which are confusingly similar to the Complainant's registered trade marks including examples such as amaoznpayments.com, amazoncolections.com, amazonfirewear.com, amazonfirewatch.com and so on. The Complainant has brought successful Complaints through the UDRP in relation to at least some of these domains.

4.9 The Respondent registered the Disputed Domain Name on 2 April 2014. He does not say why the Disputed Domain Name was registered on that date (which corresponds to the date of application by the Complainant for the EU registration of the mark Amazon Fire) or for what purpose.

4.10 The Complainant asserts and the Respondent does not dispute that the Disputed Domain Name has at some point been used as a parking page on which advertising for products and services competing with those of the Complainant have appeared. The Respondent says that this has now ceased.

5. Parties' Contentions

5.1 The Complainant asserts that the Disputed Domain Name is abusive because it has misdirected people looking for the Complainant's goods or services when operating as a parking page. The Complainant also says that the Disputed Domain Name is part of pattern of registrations of domains confusingly similar to its trade marks and that it should be presumed that the Respondent was acting in bad faith when it registered the Disputed Domain Name. Further the Complainant says that the Disputed Domain Name is abusive because it was registered either as a blocking registration or to disrupt the Complainant's business.

5.2 The Respondent does not directly respond to these allegations in his very brief response. He says that the Disputed Domain Name was registered before the Complainant publicly announced the launch of the Amazon Fire Phone and that he is therefore the legitimate holder of it. He says that the Complainant could have announced its

smartphone under another, different name. He says that Amazon is the common name for the well-known river and refers to the Complainant's unsuccessful application to ICANN for a new generic Top Level Domain ".amazon" as showing that this is what Amazon means.

6. Discussions and Findings

6.1 The version of the DRS Policy relevant to the present dispute is version 3 which relates to complaints lodged after 29 July 2008.

Paragraph 1 of that policy defines an 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”

6.2 Paragraph 1 of the DRS Policy also defines “Rights” for the purposes of this procedure as including but not limited to those enforceable under English law. Under Paragraph 2 of the DRS Policy a complainant must show on the balance of probabilities

- (a) that it has Rights in a name or mark identical or similar to the Domain Name; and
- (b) that the Domain Name in the hands of the Respondent is an Abusive Registration.

6.3 Paragraph 3 of the DRS Policy identifies a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The relevant factors for the purposes of the present case are

- “(a)i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
- A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
 - B. as a blocking registration against a name or mark in which the Complainant has Rights;

C. for the purpose of unfairly disrupting the Business of the Complainant;

ii. 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;

iii 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;

...

The remaining factors are not relevant in the present case. I have accordingly taken the above factors into account in reaching my conclusions.

6.4 Clause 4 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. These include the following which are relevant to the present case:

“(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 or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

B. been commercially known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

...

6.5 According to the Appeal Panel decision in the *Seiko* case (DRS 00248) whether a registration is an abusive registration under the DRS Policy is independent of whether a domain name registration is protectable by an action for infringement of trade mark or passing off and should be decided under the terms of the DRS Policy alone. The same decision also makes clear, however, that the Policy is founded on the principle of intellectual property rights which should be taken into account.

6.6 The first question in any DRS complaint is whether the complainant has Rights. As has been said in many cases, the requirement to establish Rights sets a low threshold test. In the present case there is no doubt that the Complainant has relevant trade mark and common law rights in the marks AMAZON and AMAZON FIRE.

6.7 It is equally clear that the Disputed Domain Name is similar to the marks in which the Complainant has Rights.

6.8 Consequently, the present dispute turns on the Respondent's motives and actions in registering the Disputed Domain Name. The Respondent gives little or no information about such matters. I am therefore left to infer them.

6.9 It seems to me to be clear that the Respondent was fully aware of Amazon.com and its business. Equally, he was aware of Amazon's Fire range of products and services. Further, he registered the Disputed Domain Name on the same day that the Complainant applied to register Amazon Fire as a trade mark. This was in a context in which it was well known that the Complainant was developing a smartphone using the Fire OS and there had been publicity indicating that its launch would occur in the reasonably near future. It is a short step from these facts to deducing that it is very likely that the Complainant's smartphone would bear the Fire brand.

6.10 Further context is provided by the fact that the Respondent has also registered a number of domain names containing the word amazon or amazonfire.

6.11 I infer that the Respondent is indeed engaged in a pattern of following the Complainant's marks and registering domain names which correspond to them. I can think of no other way in which the facts before me could have arisen and no legitimate reason for the Respondent to do this. I am therefore also willing to infer that this was done either to block the Complainant's use of them so that the Complainant would be forced to purchase them or to disrupt the Complainant's business in some way by using them in ways which misdirect or confuse members of the public using the Internet.

6.12 The points made by the Respondent are irrelevant. It does not matter whether the Complainant moved to register the domain name first or announce the name of its smartphone first. The Complainant was already using Amazon Fire in relation to related products and

applied to register the mark as a trade mark. I infer that the Respondent saw this and immediately applied to register the Disputed Domain Name in bad faith and in the hope of making some kind of commercial benefit from it. The Disputed Domain Name was then used to direct traffic to competitors of the Complainant. The Respondent's activities are therefore indeed in breach of paragraphs 3(a)(i)(B), 3(a)(i)(C) and 3(a)(iii) of the DRS Policy as the Complainant says. The existence of the Amazon river has no bearing on this dispute and nor does the Complainant's application for the ".amazon" gTLD.

6.13 The Respondent is also engaged in a pattern of registering domain names with the Complainant's trade marks in them. He is plainly a cybersquatter and cannot expect the dispute resolution services of the domain registration systems in which he behaves in this way to stand by and let him retain such domain names in the absence of a coherent and legitimate explanation of his motives and activities.

6.14 Finally, I should note for completeness that the Complainant made a paragraph 13(b) submission noting the fact that its complaint against the Respondent under the UDRP had succeeded and referring to certain findings in the UDRP decision. As will be apparent from the above decision I have noted and taken account of the success of the Complaint as this is a matter of public record. I have taken no account of the reasons for that success as they are not relevant to anything I have had to determine.

6.15 Consequently I find that the Disputed Domain Name is an Abusive Registration under the DRS Policy.

Decision

7.1 I direct that the Disputed Domain Name be transferred to the Lead Complainant Amazon Technologies, Inc.

Signed: Michael Silverleaf

Dated: 12 September 2014