

DISPUTE RESOLUTION SERVICE

D00022621

Decision of Independent Expert

NetEarth UK Ltd

and

Mr Alexander Caan

1. The Parties:

Lead Complainant: NetEarth UK Ltd
Suite 5, 7th Floor
5 Greenwich View Place
London
E14 9NN
United Kingdom

Respondent: Mr Alexander Caan

2. The Domain Name(s):

netearth.co.uk

3. Procedural History:

I can 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

04 May 2020 14:50 Dispute received

05 May 2020 12:01 Complaint validated
05 May 2020 12:17 Notification of complaint sent to parties
26 May 2020 02:30 Response reminder sent
28 May 2020 08:39 Response received
28 May 2020 08:39 Notification of response sent to parties
28 May 2020 09:32 Reply received
28 May 2020 09:34 Notification of reply sent to parties
02 June 2020 14:44 Mediator appointed
15 June 2020 10:19 Mediation started
29 June 2020 16:07 Mediation failed
29 June 2020 16:07 Close of mediation documents sent
06 July 2020 09:47 Expert decision payment received

4. Factual Background

The Complainant (and its subsidiary companies) provide internet-related services, including domain name registration services, under the signs NETEARTH and NETEARTH ONE. The Complainant is an accredited Nominet Registrar.

Community Trade Mark 74296570 (“the CTM”), for NETEARTH, was applied for on 17 November 2008 and registered on 16 June 2009.

The Domain Name was registered on 30 March 2020. At the date of making the Decision the website page at the Domain Name is not being used: a message appears to the effect that the IP address could not be found.

5. Parties’ Contentions

The Complainant submits that it has Rights by reason of the following:-

- The Complainant and its subsidiaries offer internet related services, including domain name registration services, under the signs NETEARTH and NETEARTH ONE;
- The Complainant is an accredited Nominet Registrar;
- The Complainant owns the CTM;
- The Complainant and its subsidiaries own a number of domain names which consist of, or incorporate, the mark NETEARTH;
- The Respondent appears blank under WHOIS;
- The Domain Name was registered on 30 March 2020.

The Complainant submits that the Domain Name is an Abusive Registration by reason of the following:-

- The Respondent has no rights or legitimate interests in respect of the disputed domain name;
- The Respondent is a direct competitor of the Complainant and is not, and has never been, connected to the Complainant and is not licensed or permitted to use the CTM;
- It is “utterly inconceivable” that the Respondent was unaware of the Complainant and its rights in the NET EARTH mark, given that the Respondent has operated in the same commercial field for a number of years.

Response

The Respondent submits as follows:-

- The Complainant’s accusations are false. The Respondent is neither a direct competitor, nor has he ever operated in the same commercial field.
- The Domain Name was registered in good faith and will be used in such manner that there is no confusion with the Complainant.
- The Respondent has no prior connection to the Complainant.
- It is inaccurate and misleading to state that the Respondent has worked in the same field as the Complainant for a number of years. That statement is made without proof.

Reply

The Reply is brief but somewhat difficult to understand (and therefore summarise) so I reproduce it here in full:-

“Please confirm registrant name and address to Nominet as per the Nominet terms and conditions, as Nominet has not been able to validate, nor can I find surname and address combination verifiable by many online (and paid) sources.

With regards to your reply, the name has been registered by a dropcatcher, as Nominet no longer publishes WHOIS information and the uniqueness of the word, you would not be surprised by my original points. Furthermore the actual word is trademarked.”

6. Discussion and Findings

Under paragraph 2 of the Nominet Dispute Resolution Policy (“the Policy”) the Complainant must prove, on the balance of probabilities, that:-

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Does the Complainant have the requisite Rights?

The Policy defines Rights as those:-

“enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

In utilising the Dispute Resolution Service, the Complainant has identified itself as NetEarth UK Ltd. However, the opening text of the Complaint states:-

“The Complainant and its subsidiary companies (Integrated Data Communications Limited) provide Internet-related services in the Americas, Asia and Europe markets under the names NetEarth and NetEarthOne.”

This poorly worded sentence may be understood in two ways: either that the Complainant is NetEarth UK Ltd and its subsidiary is Integrated Data Communications Limited (IDCL) or a claim that the Complainant is IDCL. Since the Complainant identified itself, at the outset of this DRS process, as NetEarth UK Ltd, I prefer the former interpretation and will proceed on that basis.

This is a live issue because the Complainant submits that it is the proprietor of the CTM. However, inspection of the CTM Register reveals that the proprietor is recorded as IDCL. The Complainant provides no evidence to support the bare assertion that IDCL is a subsidiary company. That said, the Respondent does not challenge the Complainant’s assertion in this regard.

A trade mark registration is sufficient to establish the requisite Rights. However, the question here is whether I am prepared to overlook the apparent mistake made regarding ownership of the CTM, accept the bare assertion that IDCL is a subsidiary of the Complainant and find that the ownership of the trade mark registration by IDCL provides the Complainant with enforceable Rights.

In the absence of any challenge to the Complainant's assertion I am reluctantly prepared to accept the bare assertion that IDCL is a subsidiary of the Complainant. The nature of a subsidiary is obviously that it is wholly owned, and therefore under the control of, its parent company. I am therefore also prepared to accept that such ownership and control over IDCL (and therefore the CTM) enables the Complainant to rely upon the CTM.

As an aside, it is of course possible for a Complainant to have Rights which do not arise by reason of a trade mark registration. Such rights might arise, for example, through the use of made of a sign. In this regard, the Complainant has asserted use of the signs NETEARTH and NETEARTH ONE but in the absence of further information and supporting evidence the Complainant falls far short of establishing Rights arising through use of the mark.

By virtue of the afore mentioned trade mark registration, owned by its subsidiary, I find that the Complainant has enforceable rights in the mark NETEARTH as required by the Policy.

Is the name/mark in which Rights are claimed identical/similar to the Domain Name?

The Complainant has Rights in the mark NETEARTH. The Domain Name is www.netearth.co.uk. It is clear that the Rights subsist in a mark identical to the Domain Name.

Having established that the Complainant has satisfied paragraph 2.1.1 of the Policy, I turn to the question of whether the requirement of paragraph 2.1.2 is satisfied, namely, whether the registration is abusive.

Is the Registration Abusive?

The 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) is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Before dealing with this issue, I wish to address my understanding of the Complainant's case. It seems that the Complainant was, and remains, unaware of the identity of the Respondent and yet has made clear submissions regarding the nature of the Respondent's business and its knowledge of the Complainant. The Respondent is recorded as the Registrant at Nominet, but it seems that the Complainant has not submitted a Data Release Request Form in order to receive that information. In order to try and understand the Complaint, I checked the WHOIS record myself and noted that under the Registrar details appears the name Aaron Clifford and the website

address www.dbcatch.co.uk. I have visited that website and it appears to offer dropcatching services. I can surmise that the Complainant, in the absence of knowledge regarding the identity of the Respondent, has treated the Registrar as the Respondent. That would make sense, to some extent, of the Complainant's submissions. That said, I am not prepared to make a Decision based upon my own supposition because I may be entirely wrong. Fortunately, I am able to reach a Decision without doing so.

In order to show that a domain name amounts to an Abusive Registration under i) above, a Complainant generally needs to show (on the balance of probabilities) that the Respondent was, or should have been, aware of the Complainant and/or its rights in a name or mark identical or similar to the domain name at the time it was registered.

Here, the Complainant suggests that it is "utterly inconceivable" that the Respondent did not know of the Complainant or its rights in NETEARTH. In making this submission, the Complainant relies on the fact that the Respondent has "operated in the same commercial field for a number of years". It also appears to rely on the "uniqueness" of its mark but such reliance appears to be in combination with the Respondent's alleged knowledge of the Complainant. Even if I am wrong on this last point, and the Complaint does rely solely on the "uniqueness" of the mark, that alone would not be sufficient to support a finding of an abusive registration.

The Respondent denies that he operates, or has operated, in the same field as the Complainant. Although the Respondent does not explicitly deny that he knew of the Complainant or its Rights, I infer that this is his position. I am reluctant to make such inference but am prepared to do so in circumstances where the Respondent is (as far as I am aware) not legally trained and is responding to a fairly ill-defined Complaint.

I am therefore faced with two opposing arguments: the Complainant says that the Respondent knew of it; the Respondent says he did not. It is of course for the Complainant to prove its case (on the balance of probabilities) and, since it has produced no supporting evidence, it fails to do so.

There remains the question of whether the Respondent should have known (ie had constructive knowledge) of the Complainant's Rights. In order to succeed in such argument, the Complainant will generally have to show that its mark is well-known. The Complainant does not provide any evidence in this regard and I cannot therefore find that the Respondent should have known of the Complainant's Rights.

In the Reply, the Complainant submits that the Domain Name has been registered by a drop-catcher. The Respondent has not had the opportunity to respond to that allegation, but it is immaterial. The activity of drop-catching is not in itself objectionable and without further evidence (eg that the mark is well-known) that would not render the registration abusive.

In the absence of any actual or constructive knowledge the Respondent cannot have had the necessary intent for the registration of the Domain Name to have been abusive within the meaning of paragraph i) above.

Turning now to (ii), and the issue of whether the use being made of the Domain Name renders it an Abusive Registration. There is no complaint in this regard. Nevertheless, I would still be prepared to make such finding if it appeared justified on the basis of the material before me. In this instance, there is no material before me that would justify such a finding. I have not been provided with evidence of any use made of the Domain Name and indeed, at the time of making this Decision, the Domain Name is not being used. Under paragraph 5.2 of the Policy, failure to use a Domain Name for a website is not in itself evidence of an Abusive Registration.

7. Decision

I conclude that the Complainant has Rights in a mark which is identical to the Domain Name but has failed to show that the Domain Name is an Abusive Registration. The Domain Name will therefore remain with the Respondent.

Signed

Dated

30 July 2020

Catherine Slater