

DISPUTE RESOLUTION SERVICE

D00015585

Decision of Independent Expert

Consolidated Artists B.V.

and

Mr Garth Piesse

1. The Parties:

Complainant: Consolidated Artists B.V.
Jan Leentvaarlaan, 1
3065DC
Rotterdam
Netherlands

Respondent: Mr Garth Piesse
PO Box 181
Palmerston North
Manawatu
4440
New Zealand

2. The Domain Names:

mango.co.uk
mango.uk

3. Procedural History:

On 04 March 2015 the Dispute was received and validated by Nominet and notification of the complaint was sent to both parties. On 23 March a Response was received and notification sent to both parties. On 26 March a reply reminder was sent and by 31 March no reply had been received and Nominet appointed a mediator. On 07 April mediation started and failed

and the close of mediation documents were sent to both parties. On 17 April a complainant full fee reminder was sent and on 20 April an Expert decision payment was received. The Expert - Tim Brown - was appointed on 24 April.

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

4. Factual Background

4.1 The Complainant

The Complainant is a multinational business which designs, manufactures and markets women's and men's clothing and accessories. The Complainant has over 13,000 employees and operates 2,731 stores in 205 countries worldwide. Its first store was established in 2000.

4.2 The Respondent

The Respondent is an individual operating from an address in Manawatu, New Zealand.

The WHOIS database shows that <mango.co.uk> was registered on 12 August 2013 and <mango.uk> was registered on 05 July 2014.

5. Parties' Contentions

5.1 Complainant

The Complainant's contentions are as follows:

5.1.1 Rights

The Complainant says that it is the registrant of a number of registered trade marks and has exhibited copies of the undernoted marks from the relevant databases:

MANGO. Registration number: 003360815. Classes: 3,9,14,16,18,25,35. Jurisdiction: European Union. Filing date: 18/09/2003.

MANGO. Registration number: 009850785. Classes: 3,9,14,18,25,35. Jurisdiction: European Union. Filing date: 29/03/2011.

MANGO. Registration number: 005880935. Classes: 41,43,44. Jurisdiction: European Union. Filing date: 20/04/2007.

MANGO. Registration number: 00002594683. Class: 43. Jurisdiction: United Kingdom. Filing date: 20/04/2007

The Complainant has also exhibited a list of 260 related domain names which it owns that are made up of, or include, the term MANGO. To further support its contentions the Complainant has exhibited some evidence of its international advertising campaigns and a print out of the first page of results for the term MANGO from the search engine Google.

5.1.2 Abusive registration

The Complainant contends that the Respondent does not own any registered marks for the term MANGO in the United Kingdom or any other major jurisdiction and notes it has not granted the Respondent any licence or authorisation to use its trademarks. Equally, it notes the Respondent's name does not contain the term MANGO.

To support its initial contentions, the Complainant references a number of decisions relating to the concept of legitimate interest under and in terms of the Uniform Domain Name Dispute Resolution Policy (UDRP) noting *"... as it is nowadays the organization that more doctrine about domain names disputes accumulates"* [sic.]

The Complainant observes that the Domain Names resolve to a website where they are offered for sale. The Complainant says that it attempted to buy the domain name <mango.co.uk> through the website and received an email from the Respondent noting *"mango.co.uk would be in the six figure value range. Happy to discuss further if this is within your budget"*. Copies of the email correspondence have been exhibited by both parties.

The Complainant contends that £100,000 *"...is much higher than that corresponding to the domain name on the market price, which would be between 45 to 100 pounds approximately."*

The Complainant avers that the Respondent's registration of the Domain Names illegitimately obstructs the Complainant from access to the Internet under its own trade marks and trading name.

The Complainant has exhibited a screenshot from the website at "domaintools.com" which shows that the Respondent is associated with approximately 18,000 other domain names, though these are not detailed or listed. The Complainant suggests that this can be considered a pattern of registrations where the Respondent is the registrant of domain names which correspond to well known names and trade marks in which the Respondent has no apparent rights.

5.2 Respondent

The Respondent's contentions are as follows:

5.2.1 Rights

The Respondent accepts that the Complainant has rights in the term MANGO but says that the Complainant has not established any particular degree of public recognition of the mark in any relevant country as at the time that the Respondent acquired the Domain Names.

5.2.2 Abusive registration

The Respondent sets out that he is in the business of buying, selling and monetising generic domain names and, as a result, owns many domain names. The Respondent observes that Paragraph 4d of the Policy notes that *"trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities."*

The Respondent claims that he bought <mango.co.uk> on 8 November 2013 as he thought it was an attractive domain name to own as it consisted of a single dictionary term relating to the eponymous fruit. The Respondent observes that he also has registered a number of other fruit-related domain names including <greenpapaya.co.uk>, <boysenberry.co.uk>, <grape.co.nz> and <berry.co.nz> and has exhibited WHOIS print outs to support this.

The Respondent notes that he subsequently bought <mango.uk> on 05 July 2014 by virtue of his priority rights as owner of <mango.co.uk> in order to hold both domain names as "a pair".

The Respondent notes that he was not aware of the Complainant and contends that the Complainant has not provided any meaningful evidence that it is indeed an "internationally famous multinational" and claims that there was no reason he should have heard of the Complainant when he registered the Domain Names.

The Respondent goes on to note that the Complainant's ownership of 260 related domain names is irrelevant; observes that the Complainant does not appear to be active in New Zealand (and has exhibited screenshots from the Complainant's website to show this) and in any event, the Respondent notes he does not buy the "...young trendy fashion clothing and accessories" offered by the Complainant and has had no reason to frequent its shops.

The Respondent says that the Complainant's evidence of its marketing activities consist of only undated images with the Complainant's logo and notes the Complainant has failed to identify the country or media where these images appeared. Equally, the Respondent suggests that the Complainant's exhibited search results from Google were conducted from Spain in 2015 and therefore have little relevance to the Respondent's alleged awareness of the Complainant when it registered <mango.co.uk> in 2013.

Making reference to the decision in DRS 4331 (verbatim.co.uk), the Respondent contends that the Complainant has not demonstrated that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Names. Even if it were aware of the Complainant's activity, the Respondent says such knowledge of the MANGO term would have been irrelevant in any case and makes reference to the appeal decision in DRS 4884 (maestro.co.uk).

The Respondent contends that the Domain Names each comprise a single ordinary English dictionary word and says that their meaning as a kind of fruit has obviously not been displaced by an overwhelming secondary meaning and there is no evidence of abuse.

Turning to the potential sale of the Domain Names, the Respondent contends that there is nothing objectionable about offering a domain name for sale where the domain name was not acquired for the purpose of sale to the complainant. The Respondent has supported its contentions with observations made by other experts in DRS 359 (parmaham.co.uk) and DRS 3078 (ghd.co.uk).

The Respondent denies he bought the Domain Names for the purpose of sale to the Complainant and that he is "...fully entitled to demand whatever price he likes for the Domains." The Respondent further contends that it is disingenuous for the Complainant to claim that the market price for <mango.co.uk> would be "...between 45 to 100 pounds approximately". The Respondent suggests that the Complainant is referring to the registration fee for the Domain Name <mango.co.uk> but notes that is not available and the market value for this highly attractive single-word generic domain name is whatever a buyer is prepared to pay.

The Respondent contends that the Complainant set out to deceive the Expert; noting that having quoted paragraph 3a(i)A of the Policy, the Complainant sought to give the impression that the Respondent offered <mango.co.uk> for sale to the Complainant at £100,000 observing that the Complainant said "...we received an e-mail...". The Respondent says that the Complainant did not mention that the Respondent was responding to an enquiry from a Sergi at "jurase@jurase.com". The Respondent observes there is no website at <jurase.com> and that the enquiry made no mention of the Complainant or its lawyers. The Respondent

says that the Complainant doctored its evidence by removing the 'to:' field containing the "jurase@jurase.com" email address.

The Respondent denies that the Domain Names were registered as blocking domain names and suggests that the Complainant's contentions that the Domain Names form part of a pattern of domain names corresponding to well know names and trade marks is "...*plainly absurd*".

Finally, the Respondent contends that the doctoring of evidence, noted above, constitutes Reverse Domain Name Hijacking.

6. Discussions and Findings

6.1 Rights

The Complainant has exhibited a number of registered trade marks for the term MANGO from a number of different jurisdictions, all of which pre-date the registration of the Domain Names.

As is customary in DRS proceedings the <.co.uk> and <.uk> suffixes are only needed for technical reasons and can be ignored for the purposes of comparing a mark to a domain name. It is therefore clear that the Complainant has demonstrated that it has Rights which are identical to the Domain Names.

6.2 Abusive registration

The Complainant has said that the Domain Names are Abusive Registrations for three main reasons. Firstly, the Respondent is not licensed or authorised to use the Complainant's MANGO trade mark. Secondly, the Respondent's offer to sell the Domain Name <mango.co.uk> for a six figure sum indicates an Abusive Registration. And, thirdly, that the Respondent's registration of circa 18,000 domain names is indicative that the Domain Names were Abusive Registrations.

In my view, the Complainant is incorrect on all three of its major contentions.

Taking the first point, I have referred to paragraph 4.9 of the Experts' Overview (version 2) which is a document put together by Nominet's panel of Experts which deals with a range of issues that come up in DRS disputes. It is published on Nominet's website at: http://www.nominet.org.uk/sites/default/files/drs_expert_overview.pdf.

Paragraph 4.9 asks "Can use of a purely generic or descriptive term be abusive?" and notes:

Yes but, depending on the facts, the threshold level of evidence needed to establish that this is the case is likely to be much higher. It may well often depend upon the extent to which such a term has acquired a secondary meaning, which increases the likelihood that any registration was made with knowledge of the rights that existed in the term in question. In many such cases where there is little or no evidence of acquired secondary meaning the Respondent is likely to be able to show that the domain name in question has been arrived at independently and accordingly cannot have been as a result of an Abusive Registration. A helpful discussion is found in DRS 04884 (maestro.co.uk) where the Appeal Panel observed "Where a domain name is a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive, if it is to be held to be an Abusive Registration under the DRS Policy"

Having reviewed the contentions and evidence before me, the Complainant has not put forward anywhere near sufficient or persuasive evidence to show that the term MANGO has acquired a strong secondary meaning. The Complainant has simply not proven how the Domain Names could have been registered to target it or its Rights.

In terms of the Complainant's second major contention, I observe that the Complainant approached the Respondent with an offer to purchase the Domain Name <mango.co.uk> and the Respondent replied that *"mango.co.uk would be in the six figure value range. Happy to discuss further if this is within your budget."*

It is commonly known in the domain name industry that generic, dictionary words tend to have a high value irrespective of any potential secondary meaning. This has been acknowledged in several previous DRS cases, such as DRS10075 (philosophy.co.uk) and DRS4884 (maestro.co.uk).

Registrants of such domain names are under no obligation to sell their domain name or even enter into negotiations with potential buyers. Equally, should they choose to enter into negotiations with a buyer, registrants are at liberty to start negotiations at any price they wish. Mere negotiations to sell a domain name made up of a generic, dictionary word are not and should not be indicative of an Abusive Registration in and of themselves.

The Complainant's third major contention - that the Respondent holds circa 18,000 domain names - is not indicative that the Domain Names were Abusive Registrations.

The Complainant has merely made an assertion that the Domain Names form part of a pattern of registrations which correspond to well known names or trade marks in which the Respondent has no apparent rights, per Paragraph 3.a.iii of the Policy. The Complainant has not provided any examples of any domain names registered by the Respondent or explained why the Domain Names form part of such a pattern. The Complainant's contentions and evidence fall a long way short of proving its case on the balance of probabilities.

Finally, I observe that paragraph 4.d. of the Policy notes that *"Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities."* In the absence of any evidence to the contrary, I consider that in terms of the Domain Names the Respondent is engaged in entirely permissible activity within the context of the Policy.

I therefore find that the Domain Names are not Abusive Registrations in terms of the Policy.

6.3 Reverse Domain Name Hijacking

The Respondent has asked that I make a finding of Reverse Domain Name Hijacking ("RDNH") in terms of Procedure paragraph 16.d on the grounds that the Complainant "doctored" its evidence. Paragraph 1 of the Procedure defines RDNH as *"...using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name"*.

I have closely examined the limited correspondence and materials exhibited by the parties in the context of the missing "jurase@jurase.com" 'to:' field in the Complainant's exhibit. I have also examined the Complainant's contentions on this point and considered how much it relied on the enquirer's identity to make its case. I take the view that even if the Complainant has not presented its evidence with entirely clean hands, it did not make any significant material difference to its contentions or to my decision, so I choose not to make a finding of RDNH on these grounds.

However, I have considered the Respondent's request in broader terms. RDNH is not common under the DRS. Nominet's search facility only shows five cases in the last thirteen

years in which a finding of RDNH has been granted and I have reviewed these in light of the parties' contentions.

The sequence of events in the present case appears to show that the Complainant attempted to buy <mango.co.uk> from the Respondent. When these negotiations failed the Complainant started proceedings under the DRS. As I have noted, the Complainant has relied on bare assertion and has provided a paucity of evidence to support its arguments.

Even a cursory reading of the Policy, Procedure and extensive guidance on Nominet's website would quickly show that a matter concerning a clearly generic, dictionary term would require a higher standard of argument and evidence than is perhaps common. That the Complainant has failed to come anywhere close to providing sufficient argument or evidence is, in my view, strongly indicative that the Complainant pursued this dispute in frustration at the Respondent's unwillingness to sell <mango.co.uk> for a price it was willing to pay, rather than because of the merits of its position in terms of the Policy's requirements.

I conclude that the Complainant brought a speculative complaint in bad faith in an attempt to deprive the Respondent of the Domain Names. I therefore determine that the Complainant has engaged in Reverse Domain Name Hijacking.

7. Decision

Having determined that the Complainant has not demonstrated that the Domain Names were Abusive Registrations, I order that no action be taken regarding the Domain Names. Furthermore, I find that the Complaint was brought in bad faith in an attempt at Reverse Domain Name Hijacking.

Signed Tim Brown

Dated 5th May 2015