

Nominet UK Dispute Resolution Service

DRS 05366

eBay Inc v. Branko Tojagic

Decision of Independent Expert

1. Parties

Complainant: eBay Inc
Address: 2145 Hamilton Avenue
San Jose
CA
Postcode: 95125
Country: US

Respondent: Branko Tojagic
Address: 59 Common View
Letchworth
Hertfordshire
Postcode: SG6 1BZ
Country: GB

2. Domain Name

ebayuniversity.co.uk ("the Domain Name")

3. Procedural Background

The Complaint was submitted to Nominet on 8 January 2008. Hardcopies were received in full on 10 January 2008 and on the same date the Complaint was validated by Nominet and sent to the Respondent by post and by email to postmaster@[the Domain Name]. The Respondent was informed in this correspondence that he had 15 working days, that is, until 1 February 2008 to file a response to the Complaint.

The Respondent did not file a response and the case did not proceed to the mediation stage. On 4 February 2008, the Complainant paid the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Procedure for the conduct of proceedings under the Dispute Resolution Service Version 2 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 2 ("the Policy"). On 6 February 2008, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as 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. Nominet duly appointed the Expert with effect from 11 February 2008.

4. Outstanding Formal/Procedural Issues

No response

The Respondent has failed to submit a response to Nominet in time in accordance with paragraph 5(a) of the Procedure.

Paragraph 15(b) of the Procedure provides inter alia that "If, in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint."

Paragraph 15(c) of the Procedure provides that "If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate."

In the view of the Expert, if the Respondent does not submit a Response the principal inference that can be drawn is that the Respondent has simply not availed himself of the opportunity to attempt to demonstrate that the Domain Name is not an Abusive Registration. This does not affect the primary requirement upon the Complainant, on whom the burden of proof rests, to demonstrate Abusive Registration, nor does it in the Expert's view entitle an expert to accept as fact all uncontradicted assertions of the Complainant, irrespective of their merit.

5. The Facts

The Complainant is the owner of well-known online marketplaces including www.ebay.com and www.ebay.co.uk (the largest such marketplace in the UK) which allow registered users to offer, sell and buy goods in a variety of price formats such as fixed price and auction-style. The Complainant has been trading in the style 'EBAY' since 1995.

The Complainant is the proprietor of the following registered trade marks in the UK:-

Number	Trade mark	Classes	Filing Date	Registration Date
GB 2185144	EBAY (Word)	35	22 December 1998	8 December 2000
GB 2221802	EBAY (Word)	38, 41	9 February 2000	3 November 2000
GB 2185146	ebay (Word & Device)	35	22 December 1998	29 December 2000
GB 2221698	ebay (Word & Device)	38, 41	9 February 2000	9 February 2001

The Complainant uses EBAY as its core brand and 'house' mark in conjunction with other elements to designate related services and sub-brands. One such service and sub-brand is EBAY UNIVERSITY, in terms of which the Complainant runs day long educational classes for different skill levels of users of its various services. The Complainant holds eBay University days approximately four times per year across the UK. While the classes are run directly by the Complainant's staff, the eBay University days are co-ordinated by a company called The Conference People.

The Respondent registered the Domain Name on 27 April 2007. At the date of this Decision, the web page associated with the Domain Name pointed to a registrar's parking page carrying advertising relating to the registrar of the Domain Name.

On 27 June 2007, the Respondent sent an email to a Mr Robert Enfer of The Conference People offering the Domain Name for sale. On 4 July 2007 a member of the Complainant's staff replied to the Respondent advising of the Complainant's various trade marks and seeking certain undertakings from the Respondent regarding use of the Domain Name. The Respondent replied on the same date offering to sell the Domain Name to the Complainant and requesting further contact to discuss this. On 13 July 2007 a member of the Complainant's staff replied to the Respondent proposing reimbursement of the Respondent's registration fees in respect of the Domain Name in return for its transfer to the Complainant. On 16 July 2007 the Respondent replied requesting a further week to seek advice. On 24 July 2007 a member of the Complainant's staff wrote to the Respondent applying a deadline of 25 July 2007 for a substantive reply from the Respondent.

A telephone call was held between the Complainant's staff and the Respondent on 24 July 2007 during which it appears that the Respondent asserted that he had incurred legal fees of £1,000 regarding the Domain Name. On 25 July 2007 the Respondent wrote to the Complainant requesting that the Complainant reimburse his registration fees and legal fees whereupon he would transfer the Domain Name. The Complainant issued transfer paperwork to the Respondent on 27 July 2007 and indicated that it would be prepared to reimburse the Respondent's registration fees but that each side should bear their own legal costs. On 1 August 2007 the Respondent replied that he was on holiday and would deal with the matter on his return. On 24 August 2007 the Complainant requested confirmation from the Respondent that the transfer documentation had been completed but received no reply from the Respondent.

6. The Parties' Contentions

Complainant

In summary, the Complainant's contentions are as follows:-

Rights

The Complainant relies on its registered trade marks in the mark EBAY. The Complainant also relies on common law rights. The Complainant asserts that, by virtue of its use of the name since 1995, EBAY is now known as one of the world's most famous online shopping experiences and that it is the world's largest online trading community. The Complainant states that the EBAY brand is one of the most distinctive on the Internet, that the public associates the EBAY 'family' of marks with the Complainant and that the EBAY brand has had extensive press coverage, press releases and advertisements. The Complainant also submits that it has spent and generated significant revenue in relation to the development and marketing of the EBAY mark.

Abusive Registration

The Complainant asserts that there is no legitimate purpose for which the Respondent has registered the Domain Name and that it is inconceivable that the Respondent did not have actual knowledge of the Complainant's rights when registering the Domain Name. The Complainant submits that the sole reason for the Respondent's registration of the Domain Name was to take advantage of the Complainant's reputation or to sell the domain name to the Complainant.

In correspondence, the Respondent stated that he had no intention to operate, trade from or sell the Domain Name to a third party. The Respondent has made no legitimate, non-

commercial or fair use of the Domain Name, has no rights or legitimate reason for registration and cannot demonstrate the registration of the Domain Name is not abusive. It is not possible to conceive of any plausible actual or contemplated active use of the Domain Name by the Respondent that would not be illegitimate.

The Complainant has not consented to the Respondent's use of the Domain Name.

Policy: 3(a)(i)(A)

The Respondent has registered the Domain Name for the purposes of selling, renting or otherwise transferring or selling 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. The Respondent states in correspondence that he has no intention of operating or trading from the Domain Name and is offering no legitimate services from it. There is no valid explanation for his registration of the Domain Name.

Policy: 3(a)(i)(B)

The Respondent has registered the Domain Name as a blocking registration against a name or mark in which the Complainant has rights, namely the Complainant's registered and unregistered rights in EBAY.

Policy: 3(a)(ii)

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 to the Complainant. It is clear that the registration of this Domain Name will serve to confuse people due to eBay's famous reputation, the Complainant's trade mark being comprised in the Domain Name, the Complainant's substantial unregistered rights in EBAY and also the fact that the Complainant has an eBay University. The Respondent's initial email was sent to the Managing Director of The Conference People, the Complainant's chosen event partner for the eBay University events. This in itself suggests that the Respondent may have been aware of the Complainant's University programme as detailed on the eBay University pages of www.ebay.co.uk.

Passing Off

The Respondent's registration of the Domain Name gives rise to a claim of passing off. *British Telecommunications plc v One in a Million Ltd (1999) 1 (CA)* found that registration of a domain name in itself amounted to passing off. The Domain Name contains EBAY, the trade mark in which the Complainant owns the goodwill, amounting to a misrepresentation which will result in third parties associating the Domain Name with the Complainant and the Complainant's business.

Respondent

The Respondent has not filed a response.

7. Discussion and Findings:

General

In terms of paragraph 2(b) of the Policy the primary onus is on the Complainant to prove to the Expert on balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely that:

(i) The Complainant has Rights in respect of a name or mark which is 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

Paragraph 1 of the Policy provides that Rights "includes, but is not limited to, rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business". Accordingly there are three questions to consider - (1) whether the Complainant has Rights in the name or mark; (2) if the Complainant does have Rights, whether the name or term in which it has these is wholly descriptive of its business; (3) if not wholly descriptive, whether the name or mark is identical or similar to the Domain Name.

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Under English Law, rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or unregistered rights such as the entitlement to bring a claim for passing off to protect goodwill inherent in any such name or mark.

Complainant's Rights in the mark EBAY

The Complainant is the proprietor of UK registered trade marks in respect of the word EBAY (and various devices incorporating the word) as set out in the facts at section 5. above. In the Expert's view these are quite sufficient for the Complainant to establish Rights in the name or mark EBAY for the purposes of the Policy. The Complainant also claims common law rights in the mark by virtue of the goodwill it has built up since 1995 whereby, it asserts, EBAY is now known as one of the world's most famous online shopping experiences. The Expert is satisfied that the Complainant has established substantial goodwill and consumer recognition in the mark EBAY and indeed in the Expert's view this mark is exclusively referable to the Complainant and is likely to be instantly recognisable as such to the vast majority of Internet users in the UK.

The second question for the Expert is whether the mark is wholly descriptive of the Complainant's business, namely the operation of an online marketplace. In the Expert's view the mark EBAY is not wholly descriptive of such services.

The remaining question therefore is whether the mark is identical or similar to the corresponding domain name. The first (.uk) and second (.co) levels of the Domain Name can be disregarded as being wholly generic. The Expert is then left with a comparison between the mark EBAY and the third level part of the Domain Name 'ebayuniversity'. This amounts to the combination of the generic word 'university' with the Complainant's mark. In the Expert's view, the mark EBAY is the dominant and distinctive component of the Domain Name. The addition of the generic and purely descriptive word 'university' does nothing to distinguish the Domain Name from the Complainant's EBAY mark. In these circumstances, the Expert finds that the mark EBAY is similar to the Domain Name.

Abusive Registration

Is the Domain Name, in the hands of the Respondent, 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 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."

A non-exhaustive list of factors which may constitute evidence of Abusive Registration is set out in paragraph 3 of the Policy.

The Complainant's submissions focus on (1) the Respondent's approach to and correspondence with the organisers of the eBay University days and subsequently with the Complainant regarding sale of the Domain Name; (2) the fact that the registration of the Domain Name constitutes a blocking registration against a name or mark in which the Complainant has rights; (3) the potential for confusion arising from the Respondent's registration of the Domain Name; (4) the fact that the registration gives rise to a claim of passing off; and (5) generally, the fact that the Respondent must have been targeting the Complainant's mark given its distinctiveness on the Internet and the lack of any apparent legitimate purpose on the part of the Respondent for the Domain Name.

In the Respondent's initial email of 27 June 2007 (addressed to the managing director of The Conference People and written exactly two months after the date of registration of the Domain Name) he states "...I noticed that you guys deal with ebayuniversity sessions etc and was hoping you might be able to point me in the right direction in my request to sell [the Domain Name] to ebay or the likes?" According to the Complainant's email of 24 July 2007 following up a telephone conversation of the same date, the Respondent sought to be reimbursed both for his registration fee and £1,000 allegedly incurred in legal expenses. Meanwhile, the Respondent states in his email to the Complainant of 16 July 2007 "...I did not purchase [the Domain Name] to trade from nor to sell on to a 3rd party."

The Expert agrees with the Complainant that the Respondent's initial email is highly indicative of a primary purpose on the part of the Respondent to sell the Domain Name to the Complainant or a competitor of the Complainant as contemplated by paragraph 3(a)(i)(A) of the Policy. The terms of the Complainant's email to the Respondent reporting the telephone conversation between the parties of 24 July 2007 indicate that the price being sought by the Respondent exceeded his out of pocket costs and that the Respondent had stated that he was also in discussion with third parties regarding a possible sale.

It is clear that the Complainant's brand is well known on the Internet and the Expert agrees with the Complainant that it is most unlikely that the Respondent could have registered the Domain Name without knowledge of the Complainant's rights in the EBAY mark. The Expert considers that the Complainant's argument on this point is strengthened by the fact that the Respondent's initial approach was to the company co-ordinating the Complainant's eBay University days as this points to specific knowledge on the Respondent's part of the Complainant's activities under that name. Furthermore, although the parties engaged in email correspondence for an extended period, at no point did the Respondent give any indication of having any alternative purpose for his registration of the Domain Name, nor has he done so by way of a response in the present case. All of these circumstances taken together are, in the Expert's view, highly indicative of Abusive Registration.

With regard to blocking, the wording of paragraph 3(a)(i)(B) of the Policy contemplates a respondent having registered a domain name primarily to block a name or mark in which a complainant has Rights. In the present case, there is no evidence that this was the Respondent's *primary* purpose, notwithstanding the fact that the Complainant is effectively blocked as an inevitable consequence of the Respondent's registration of the Domain Name. Indeed, given the Expert's observations above, the evidence points the other way, namely to a primary purpose connected with the sale of the Domain Name.

With regard to confusion, the Policy at paragraph 3(a)(ii) calls for 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. There is no evidence produced by the Complainant that the use of the Domain Name has caused confusion. However, many decisions under the Policy have recognised that a demonstration by a complainant of a

likelihood of confusion caused by a domain name may be sufficient to constitute Abusive Registration (bearing in mind that the factors in paragraph 3 of the Policy are expressed to be non-exhaustive). In the present case, the Expert is satisfied that the use of the Domain Name would be inherently likely to lead to confusion due to (1) the incorporation in the Domain Name of the Complainant's well known mark which the vast majority of UK Internet users will associate exclusively with the Complainant and (2) the fact that the additional word 'university' in the Domain Name gives rise to a more specific association with the nationwide training days named eBay University which the Complainant holds for users of its services. The Expert therefore considers that this likelihood of confusion is also indicative of Abusive Registration.

With regard to the Complainant's submission that the activities of the Respondent constitute passing off, the Expert does not accept that this on its own is relevant to the question of Abusive Registration under the Policy. The Complainant's submission is similar to those occasionally made by complainants alleging trade mark infringement on the part of a respondent. The nature of such submissions was considered by the Appeal Panel in the case of *Seiko UK Limited v Designer Time/Wanderweb* (DRS 00248) and it is worth reproducing the relevant passage here:-

The question of trade mark infringement is, as both parties (and the Expert) agree, one for the courts to decide. The question of abusiveness is for the Expert to decide. The two jurisdictions co-exist alongside each other, and no doubt there will be considerable overlap. However there may well be factual scenarios in which an abusive registration under the Policy would not be an infringement of trade mark under the 1994 Act, and where an infringement of trade mark under the 1994 Act would not be an abusive registration under the Policy. The safest course for parties and Experts is simply to address the terms of the Policy.

The Expert considers that the general principle expressed in this passage may be applied in a similar manner to the submissions of the Complainant on the issue of passing off. The Complainant requires to provide evidential support for its submissions and to address the terms of the Policy, rather than seeking to rely upon propositions (and legal precedent) in the manner commonly deployed in litigation before the court. In the Expert's view, a mere assertion that a complainant has a claim for passing off together with the citation of legal authority is not capable of demonstrating Abusive Registration in terms of the Policy.

That said, the Expert considers that the Complainant has made out a case of the circumstances contemplated by paragraph 3(a)(i)(A) of the Policy and that in addition there is a real likelihood that any use of the Domain Name would confuse people or businesses into believing that the Domain Name is connected with the Complainant. Accordingly, the Expert is satisfied that the Complainant has proved on balance of probabilities that the Domain Name constitutes an Abusive Registration in the hands of the Respondent.

8. Decision

The Expert finds that the Complainant has proved that it has Rights in a mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name be transferred to the Complainant.

Andrew D S Lothian

21 February 2008