

Dispute Resolution Service

D00009012

Decision of Independent Expert

Javari

and

Amazon Europe Holding Technologies SCS

1. Parties

Complainant : Javari

One Irving Place 2-12H

New York, NY

10003

USA

Respondent : Amazon Europe Holding Technologies SCS

65, boulevard Grande-Duchesse Charlotte

Luxembourg City

1331

Luxembourg

2. Domain Name

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

3. Procedural Background

On 6th September 2010 the Complaint was lodged with Nominet UK Limited (“Nominet”) and it was validated on 7th September 2010. On 9th September 2010 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising it to log into their account to view the details of the Complaint and giving it 15 working days within which to lodge a Response and which was to be on or before 30th September 2010.

The Respondent responded on 30th September 2010 and on the same day Nominet informed the Complainant that the Response was available to be viewed via the Complainant’s online services account. The Complainant replied to the Response on 7th October 2010 and on 8th October 2010 Nominet informed the Respondent that the Reply was available to be viewed via the Respondent’s online services account. Mediation documents were generated for the Complaint and mediation first commenced on 12th October 2010. Mediation was unsuccessful and concluded on 1st December 2010.

The Complainant failed to pay for a Decision by an Expert by 15th December 2010 and on 30th December 2010 the Respondent paid the appropriate fee pursuant to paragraph 8 b Nominet’s Dispute Resolution Service (DRS) Procedure.

On 31st December 2010 Mr. Niall Lawless (“the Expert”) was selected and on 5th January 2011 appointed to act as Expert in this dispute. On 10th January 2011 Nominet wrote to the Parties *“The Expert has confirmed that whilst he is willing and able to provide an expert decision in this dispute, he does use the Internet for shopping and has from time to time bought products from Amazon. Whilst he does not consider that this fact would give rise to any conflict of interest or partiality on his part, he has asked that the parties are informed of this fact and be given an opportunity to request an alternative expert.*

If the parties would like an alternative expert please could they inform Nominet by 14th January 2011?”

On 17th January 2011 the Respondent replied that it did not consider there to be any conflict and was content for the Expert to decide this dispute. No reply was received from the Complainant.

The Expert confirms that he has no conflict of interest as between the Parties and he is required to give his Decision by 31st January 2011.

4. Outstanding Formal / Procedural Issues

There are no outstanding formal or procedural issues.

5. Factual background

The Complainant is Javari (legal status unknown). On 29th May 1998 Dr. Jennifer Arlene Stone PhD (London) registered the domain name javari.com. On 17th April 2001 Dr. Stone registered the business name javari.com in New York. The business certificate is inscribed with the motto "*javari is a river on the border of Peru and Brazil and it flows into the Amazon*".

Amazon Inc. is a large multinational company and one of the world's leading on-line retailers. It appears from the WhoIs record that the Domain Name was originally registered on 10th July 2007. On 28th August 2008 Amazon bought the Domain Name from a third party and it is currently registered to Amazon Europe Holding Technologies SCS.

In 2006 and subsequently there were unsuccessful negotiations between the Complainant and the Respondent regarding the acquisition by Amazon of the domain name javari.com.

The Complainant says that the Respondent's registration and use of the Domain Name is abusive and seeks suspension of the Domain Name.

6. The Parties' contentions

The Complainant

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under Nominet's Dispute Resolution Service Policy (the "Policy") because:-

- It violates the Complainant's common law trade-mark, intellectual property, and copyright of "javari.com".
- The registration of the Domain Name dilutes the brand of "javari.com".
- The Respondent's use of the Domain Name is detrimental to the Complainant's intellectual standing and reputation.
- With the Respondent's financial and legal resources its registration of the Domain Name has effectively inhibited the Complainant selling the domain name "javari.com" for a fair price to a

third party. This is because any bona fide third party would be concerned at becoming involved in trade-mark litigation with the Respondent.

The Respondent

The Respondent says that the Domain Name controlled by it is not an Abusive Registration under Nominet's DRS Policy because :-

- The name JAVARI has been used for many years as the name of the Javari River and it denies that the Complainant owns any "rights" in the name Javari as defined in Nominet's DRS Policy.
- The Complainant does not own any trade-mark registrations for javari.com in the United Kingdom or elsewhere.
- The Respondent's use of the Domain Name to sell clothing, footwear and related accessories reflects its Community Trade Mark number 7185713 for JAVARI and is entirely lawful.
- Its use of the Domain Name to sell its goods and services targeted primarily to customers in the UK and Europe is far removed from the Complainant's use of the domain name javari.com and does not interfere in any way with the Complainant's business.
- The Complainant cannot enjoy "common law" rights in the Domain Name in the UK unless it is using javari.com in the UK to sell clothing, footwear and related accessories to the extent that goodwill attaches to the name in the eyes of customers.
- The Complainant's registration of the business name javari.com in New York does not give it any enforceable rights in the United Kingdom or any rights as defined in Nominet's DRS Policy.

7. Discussions and Findings

7.1 General

The Policy requires that for a Complaint to succeed the Complainant must prove to the Expert on the balance of probabilities 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.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. 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.

The Complainant is required to prove to the Expert that the Complainant has Rights and that the Domain Name in the hands of the Respondent is an Abusive Registration; both elements must be present.

7.2 Complainant's Rights

The Complainant has registered the business name javari.com in New York, and conducts business over the internet using domain name "javari.com". Because of that I decide that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name.

7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy, but it does not state under which part of the Policy. Under Paragraph 3 - Evidence of Abusive Registration - guidance is given as to what factors may evidence that the Domain Name is an Abusive Registration.

"A non-exhaustive list of factors which may evidence that the Domain Name is an Abusive Registration is as follows :-

3(a)(i). Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily :-

3(a)(i)(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;

3(a)(i)(B). as a blocking registration against a name or mark in which the Complainant has Rights; or

3(a)(i)(C). for the purpose of unfairly disrupting the business of the Complainant;

3(a)(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”.

Common law trade-mark, intellectual property, and copyright

The Complainant says that the Domain Name is an Abusive Registration because it violates the Complainant’s common law trade-mark, intellectual property, and copyright of “javari.com”.

As a Nominet Expert I am not under duty to consider whether or not the Respondent’s activities amount to a violation of the Complainant’s common law trade-mark, intellectual property, and copyright of “javari.com”. Expert Decisions are to be determined by reference to Nominet’s DRS Policy and not the law in respect of trade-mark, intellectual property, and copyright; for example, in respect of trade-mark infringement, as decided in Deutsche Telekom AG v Lammtara Multiserve Limited Appeal Decision (DRS 05856).

Registration, transfer and selling of the Domain Name

Nominet operates a "first-come, first-served" system of domain name registration and there is no requirement for the Respondent to show that it has Rights in the name (unlike the Complainant who must prove that).

On 18th August 2008 the Respondent acquired the Domain Name from a third party. As dealing in domain names is a perfectly legitimate activity (*per se*) there is nothing improper with this.

Whereas the Expert accepts that the Complainant researched the availability of the domain name “javari.com” and discovered that it was available for registration, and which it then undertook, any assertion that the Complainant discovered the name JAVARI is incorrect. The Expert accepts that Amazon selected the name JAVARI with reference to the Javari River which as a tributary of the Amazon River is clearly linked. The Respondent was perfectly entitled to do so.

The Complainant also says that with the Respondent's financial and legal resources its registration of the Domain Name has effectively inhibited the Complainant selling the domain name "javari.com" for a fair price to a third party. This is because any bona fide third party would be concerned at becoming involved in trade-mark litigation with the Respondent.

Market price is the economic price for which a good or service is offered in a marketplace. Although it may well be that the Respondent's use of the Domain Name has an adverse effect on the market price that the Complainant may subsequently be able to agree for "javari.com", this is not evidence of Abusive Registration and does not concern the Expert in making this Decision.

Diluting the brand of "javari.com"

The Complainant says that the Domain Name is an Abusive Registration because the registration dilutes the brand of "javari.com" which is devoted to high end paperbacks, arts, film and digital books and iTunes Apps. The Complainant says that the Respondent's use of the Domain Name is detrimental to its reputation for high quality intellectual books and films relating to art, film studies and psychoanalysis.

The Respondent says that as it uses the Domain Name to sell clothing, footwear and related accessories and as the Complainant uses "javari.com" for selling publications and iTunes Apps, giving the term dilution its normal trade mark meaning (detriment to the distinctive character of a mark with reputation) dilution cannot take place.

The Complainant has not identified which if any part of Nominet's Policy dilution of the "javari.com" brand would constitute Abusive Registration and it offers no evidence to support its assertions. The Complainant has not persuaded me on the balance of probabilities that dilution (if any) is a determining factor which demonstrates that the Respondent's registration and use of the Domain Name is abusive and which warrants suspension of the Domain Name.

Detriment to the Complainant's intellectual standing and reputation

The Complainant says that the Domain Name is an Abusive Registration because the registration is detrimental to the Complainant's intellectual standing and reputation. For example, it says that this is because the Respondent's use of the Domain Name and its advertising support for it has resulted in "javari.com" being demoted when the name "javari" is searched for using Google.

The Respondent says that in respect of “natural” search rankings the algorithms used by Google are complex and take into account a number of factors such as the relevance of the search term to a given website, location of the internet user, frequency of use and quality of the website construction.

Google search results pages include both “organic” search results and paid “advertisement” results. Google says that advertising with it won't affect a website's presence in its search results as it never accepts money to include or rank sites in its search results, and it costs nothing to appear in its organic search results.

Search Engine Optimisation is often a key part in the development of a website and in many firms considered as a separate discipline from graphic design, coding and database development. The success of the website is often measured by how high it is in the search engine rankings and the Expert says that it should not be any surprise that with the technical resources at the Respondent's disposal that its websites will rank competitively when searched for. This is simply the e-commerce market place at work.

The Complainant has not persuaded me on the balance of probabilities that because the Respondent's use of the Domain Name has demoted javari.com in search engine rankings that this is a determining factor which demonstrates that the Respondent's registration and use of the Domain Name is abusive and which warrants suspension of the Domain Name.

Prior dealings

Finally, the Complainant says that in 2001, Dr. Stone sent an e-mail to Jeff Bezos the CEO of Amazon to inform him of her discovery of the "javari" name, a river tributary of the Amazon. In respect of that the Respondent says that in common with other high profile business people Mr. Bezos receives an extraordinary amount of unsolicited e-mail and it is inconceivable that Dr. Stone's 2001 e-mail would have resulted in Amazon adopting the Domain Name to retail clothing and footwear several years later. I accept this to be the case.

In 2006 and subsequently there were unsuccessful negotiations between the Complainant and the Respondent regarding the acquisition by Amazon of the domain name javari.com. I have carefully considered the information provided and decide that it is not relevant in making this Decision.

The Complainant is unhappy that the negotiations between the Respondent and it did not result in a financial payment which it considered acceptable. Some insight into the Complainant's motivation in making this complaint seeking suspension of the Domain Name using Nominet's DRS is provided in Dr. Stones 7th September 2010 e-mail to Nominet which says that *"the "suspension" option might encourage them (the Respondent) to resolve the issue in hand, long in the making"*.

7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name. However the Complainant has not proved, on the balance of probabilities, that the Domain Name in the control of the Respondent is an Abusive Registration.

8. Decision

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is not an Abusive Registration, the Expert directs that no action is required.

Niall Lawless, Nominet Expert

31st January 2011