

DISPUTE RESOLUTION SERVICE

D00009384

Decision of Independent Expert

Incisive Financial Publishing Limited

and

Party Domain Limited

1. The Parties:

Lead Complainant: Incisive Financial Publishing Limited
32-34 Broadwick Street
London
Greater London
W1A 2HG
United Kingdom

Respondent: Party Domain Limited
Unit 30
Corringham Road Industrial Estate
Gainsborough
Lincolnshire
DN21 1QB
United Kingdom

2. The Domain Name(s):

clickz.co.uk

3. Procedural History:

14 December 2010 11:58 Dispute received
16 December 2010 08:32 Complaint validated
16 December 2010 08:37 Notification of complaint sent to parties

10 January 2011 09:59 Response received
10 January 2011 09:59 Notification of response sent to parties
13 January 2011 13:00 Reply received
18 January 2011 10:12 Notification of reply sent to parties
18 January 2011 10:12 Mediator appointed
27 January 2011 17:06 Mediation started
14 February 2011 16:22 Mediation failed
14 February 2011 16:25 Close of mediation documents sent
23 February 2011 14:30 Expert decision payment received

4. Factual Background

The Complainant

The Complainant is part of a group of companies, which trade under the name Incisive Media. This group provides business-to-business information through the publication of various print titles, such as Legal Week, Computer Active, Post and Risk, on-line publications, including Your mortgage.co.uk and clickz.com, and various conferences and events.

According to the group's website, Incisive Media was founded in 1994. Incisive Media has acquired various businesses in this field since then, including the business operated through the clickz.com website in 2005 ("the Clickz Website").

According to the internet archiving website found at www.archive.org, the first page impression on the Clickz Website was made on 10 December 1997, and has been in use ever since then. The Clickz Website now operates as a specialist online marketing site which enables subscribers to access business information and content.

"Clickz" is the subject of numerous trade mark registrations in various jurisdictions. This includes the UK (no. 2245420) in Class 35 (organising and conducting of trade shows); Class 41 (organising and conducting of conferences and seminars for business purposes); and Class 42 (design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information provided online from a computer database or the Internet; creating and/or maintaining websites; hosting the websites of others).

The application for the UK mark was filed on 13 September 2000. The registered proprietor is Incisive Interactive Marketing LLC ("IIM"). IIM is said to be a wholly owned subsidiary of Incisive Media Limited ("IML"). The Complaint states that IML is authorised to file this complaint, though in fact it has been brought in the name of the Complainant.

The Respondent

The Respondent is Party Domain Limited, an online supplier of party costumes, accessories and related goods. Party Domain is also given as the trading name of Pams of Gainsborough (“Pams”), which appears to operate a diverse range of businesses, including the importation of wholesale fancy dress costumes and related goods to retail and online traders, and services relating to domain names.

The disputed domain name, clickz.co.uk (“the Domain Name”) was registered by the Respondent on 23 December 1999. According to the Response, Pams joined Nominet in 1999, and has registered a number of domains that were intended to be used in connection with its business as an importer and wholesaler of party goods.

On entering the URL www.clickz.co.uk, a user is taken to a holding page with the Respondent’s stylised logo in the top left hand corner, accompanied by the following text:

“Information Page

This website is part of the Party Domain Group and will be developed further into an information or ecommerce website.

Please See More Information Below:

Please visit this ecommerce website below to purchase products:

- *Party Supplies*
- *Party Themes*

We look forward to hearing from you!”

The “Party Supplies” and “Party Themes” text constitute hyperlinks to the Respondent’s businesses operating from the URLs www.partysuppliesuk.co.uk and www.allparty.co.uk respectively.

On 3 November 2010 the Complainant wrote to the Respondent to inform the Respondent of its connection with the Clickz Website. The letter stated that the Domain Name was not being used and asked the Respondent to clarify its intentions in relation to the Domain Name. A Mr Grays of Pams responded by email the same day stating:

“Our registration predates yours by a couple of years and our intentions are of no concern to you”

The Complainant replied later that day as follows:

“Your intentions are very much of concern to us because one of the Incisive group companies, Incisive Interactive Marketing LLC, is the owner of the registered UK trademark no. 2245420, which grants class 42 rights in respect of the clickz word

mark. The scope of the registration includes “design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information provided online from a computer database or the Internet; creating and/or maintaining websites of others”.

In the circumstances, please would you indicate what your intentions are in relation to the www.clickz.co.uk website?”

The Complainant sent a further email chasing for a response, which received the following reply dated 10 November 2010 from Mr Lydon, acting on behalf of the Respondent:

“Adam Gray has sent me the e-mails you have been sending to him regarding clickz.co.uk.

Adam is a very busy manager in our e-commerce department. Your e-mails are an unwelcome intrusion and I want you to stop sending them.

Adam has given you a clear and succinct answer.

We are members of Nominet and very familiar with the DRS. We would welcome the opportunity to establish our rightful ownership of the clickz.co.uk domain so please go ahead with your proposed complaint. Please do not feel you have to wait until the 17th to do so. I am sure you are aware that you will have to establish that our ownership constitutes an “abusive registration”.

We will counter claim that in fact you are attempting a “reverse hijack” of our rightful ownership of clickz.co.uk.

Some facts for you to consider:

We registered clickz.co.uk in 1999, from what I can see you purchased clickz.com in 2005.

We operate in very different industries.

Your trademark registration alone does not allow you to bully us off the clickz.co.uk registration.

I am unsure what outcome you had hoped for Mr Rubenstein but understand that the tone of your e-mails ensured that it would not be a positive one.”

5. Parties’ Contentions

The Complainant’s contentions

The Complainant asserts that the Clickz Website was first used in 1997 by Ann and Andy Bourland. Evidence for the date of first commencement of the Clickz Website

is provided in the Complaint in the form of a first page impression date of 10 December 1997 found at www.archive.org.

According to the Complainant, the Bourlands subsequently sold the rights to the Clickz Website to a business known as Meckler Media, which was ultimately acquired by Incisive Media in 2005.

The Complainant says that a considerable amount of goodwill under the Clickz brand has been developed, and that revenues earned by Incisive Media attributable to products and services marketed under the Clickz name currently stand at over \$3million, of which about \$600,000 is generated in the UK as a result of use of the Clickz trade mark. The Complainant says that there are about half a million subscribers to Incisive Media's clickz services throughout the world, about 70,000 of whom are based in the UK.

The Complainant alleges that the Clickz Website and associated rights have been in continuous operation since December 1997, and that this predates the Respondent's date of registration.

The Complaint contains details of trade mark registrations in a number of territories including the UK, Denmark, France, Norway, Russia, Spain, Sweden, Taiwan, USA, Belgium, Netherlands and Luxembourg.

The Complainant alleges that the disputed domain name is identical to the Clickz registered trade marks; alternatively, confusingly similar.

The Domain Name is alleged to be an Abusive Registration on the following grounds.

First, the Domain Name has never been used to promote the Respondent's trade, or as a distribution channel for its business. It alleges that adverse inferences ought to be drawn from this inactivity in relation to the legitimacy of the Respondent's rights and interest in the Domain Name and the absence of any trade marks corresponding to the Domain Name.

Secondly, that "bad faith" is evidenced by the Respondent's unwillingness (a) to explain its intentions in relation to the use of the Domain Name in correspondence despite the Complainant's invitation, or (b) to engage in a discussion about the Domain Name. The same accusation is made as a result of the Respondent's familiarity with the terms of the complaints procedure.

Thirdly, as the Respondent has been put on notice by the Complainant of its interests and trade mark rights, it is alleged that the Respondent is attempting to hijack the Domain Name, and, concomitantly, to usurp the Complainant's ability to exercise the rights conferred on it by its trade mark registrations.

Fourthly, it is alleged that the Complainant's business has been disrupted as its ability to leverage UK revenues from the Domain Name has been prejudiced, and in doing so the Respondent's activities are detrimental to those rights.

The Respondent's contentions

The Respondent says that prior to receiving the email it received on 3 November 2010, it had never heard of the Clickz Website or come across it in its business dealings.

The Respondent believes that it had every right to correspond in the manner it did as it was not under any obligation to disclose its website plans.

The Respondent refers to the fact that the Complainant purchased the Clickz Website in 2005. It believes the substance of the Complainant's argument is that the Respondent has not developed the Domain Name. The Respondent asserts that the failure to develop a web domain is not a ground for losing it. The Respondent alleges that the Complainant group own 1308 domains and it doubts whether they have all been "developed".

The Respondent asserts that it and Pams operate in an entirely different industry from the Complainant. It refers to the fact that all of their internet activity is focused on promoting their e-commerce websites in the Fancy Dress and Party industry. The Respondent maintains that when it develops the Domain Name in the future it will be aimed at promoting its business.

The Respondent alleges that it has never attempted to profit from the Clickz.com brand or their web presence.

The Respondent alleges that the Complainant is attempting to reverse high jack the Domain Name which the Respondent registered in good faith in December 1999.

The Complainant's Reply

The Complainant says that the Respondent's description of the correspondence is misleading. It goes on to suggest that the Respondent appears unaware of the legal rights afforded by a trade mark registration. Although the Nominet dispute resolution process is not governed entirely by trade mark law, in the Complainant's submission it is influenced by it inasmuch as the Complainant must demonstrate that it has rights in the domain name in dispute.

The Complainant says that the Respondent has not attempted to dispute its entitlement to trade mark registrations protecting the clickz name, nor the acquisition of the Clickz Website. The Complainant asserts that the Respondent cannot maintain its registration if it infringes trade mark rights or if it fails to make any effective use of the Domain Name for an unlimited period of time. By its own admission, the Registrant has no clear strategy for using the domain in the near future.

The Complainant asserts that the registration is abusive because of the Respondent's responses to date, coupled with the fact that the Domain Name incorporates a trade mark having little or no connection to the Respondent's corporate or trading name or any of the products or services in which it trades.

According to the Complainant the position the Respondent has taken is detrimental to the Clickz trade marks since they cannot be properly exercised via the internet in the territory in which they are registered.

The Complainant sees a further parallel with trade mark law in that trade mark registrations can be revoked for non-use for public policy reasons. In this instance, the Complainant contends the Domain Name has not been used throughout by the Respondent, and that this inactivity, together with the prejudice caused to the Clickz trade mark, should not be permitted to continue.

6. Discussions and Findings

Under paragraph 2 of the Policy, the Complainant is required to prove to the Expert on the balance of probabilities that (a) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and (b) the Domain Name, in the hands of the Respondent, is an Abusive Registration.

An Abusive Registration is defined in paragraph 1 of the Policy as a Domain Name which either (a) 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 (b) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Rights are defined under paragraph 1 of the Policy as:

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

The first question that needs to be decided is whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name. The Complainant is not the registered proprietor of the trade mark alleged to be reflected in the Domain Name. No evidence has been provided with the Complaint which expressly explains the nature of its interest in the trade mark, or the goodwill which has been generated by its use in the UK (and elsewhere). However, I believe it is tolerably clear that the Complainant has permission to file the Complaint on behalf of the Incisive Media group and that it is permitted to use the Clickz trade mark in the UK. Bearing in mind that the threshold level for establishing Rights under the DRS is not high, I therefore find that the Complainant has satisfied this test.

The next issue to be determined is whether or not the Domain Name, in the hands of the Respondent, is an Abusive Registration. This means either that it was registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or that the Domain Name has subsequently been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. A non-exhaustive list of factors which

may be evidence that the Domain Name is an Abusive Registration under the Policy is as follows:

- 1 *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
 - 1.1 *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;*
 - 1.2 *as a blocking registration against a name or mark in which the Complainant has Rights;*
 - 1.3 *or for the purpose of unfairly disrupting the business of the Complainant;*
- 2 *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.*
- 3 *The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .auk 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 Respondent has denied any knowledge of the Clickz Website, or of the Clickz brand, prior to receiving the letter of complaint. The Complainant does not appear to dispute this, and there is no evidence in the Complaint to suggest the Respondent was cognisant of these matters at the time of registration. There is nothing before me to show that the Clickz name was widely known at the time of the Respondent's registration. The circumstances of the Respondent's registration do not therefore amount to an Abusive Registration in my view.

Has the Domain Name been used in a manner which amounts to an Abusive Registration? The Complainant says that the Domain Name has never been used to promote the Respondent's trade, or as a distribution channel for its business, and that adverse inferences ought to be drawn from this inactivity in relation to the legitimacy of the Respondent's rights and interest in the Domain Name and the absence of any trade marks corresponding to the Domain Name. However, the Policy makes it clear that failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration. I do not believe that a finding of abusive conduct should be inferred from the Respondent's inactivity in this regard.

Nor do I believe the position the Respondent has adopted in correspondence when asked about its intentions in relation to the use of the Domain Name, or its apparent familiarity with the terms of the Nominet's complaints procedure amounts to, or enables me to infer, an Abusive Registration. Of course, while the Complainant is perfectly free to make enquiries of the Respondent in this respect, I

do not regard the content of the Respondent's correspondence at all exceptional given (a) that it is a "the first to file" system (b) the fact that the Respondent was unaware of the Complainant's Clickz brand prior to receiving the letter of complaint and (c) the circumstances surrounding both the Respondent's initial registration and subsequent use. In this regard, it is important to note that the Domain Name was registered in 1999 well before the filing date of the Clickz UK registered trade mark. In my view the Respondent was perfectly entitled to respond as it did. I do not believe the Complainant's criticisms in that regard have any real substance.

The Complainant asserts that because the Respondent was notified of its "Clickz" interests and trade mark rights, the Respondent thereafter sought to "hijack" the Domain Name, and has frustrated the Complainant's ability to exercise the rights conferred on it by its trade mark registrations. The Complainant says its business has been disrupted because its ability to develop UK revenues from the Domain Name has been prejudiced, and in doing so the Respondent's activities are detrimental to those rights. I have not been provided with any evidence that the Respondent's use of the Domain Name changed on receipt of the letter of Complaint. There is nothing in the evidence which might indicate that the Respondent has at any time sought to exploit, or ride-on the coat-tails, of the reputation of the Clickz brand, whether before or after the Complainant's letter of complaint. As I have mentioned, the Respondent registered the Domain Name before the date on which the Complainant acquired registered trade mark rights in the UK. There is nothing before me from which I could infer that the Complainant had acquired unregistered rights in the UK in the name "Clickz" prior to the Respondent's registration. I have not been provided with any evidence from which I could reasonably conclude that the Respondent has at any point tried to take unfair advantage of, or cause detriment to, the Complainant's Rights.

In its Reply, the Complainant asserts that the Respondent cannot maintain its registration if it infringes trade mark rights or if it fails to make any effective use of the Domain Name for an unlimited period of time. I have already dealt with the Respondent's failure to use the Domain Name and found it unobjectionable in the circumstances of this case. As to the former point, while it may be true that use of a domain name which infringes a registered trade mark, is very likely to amount to an Abusive Registration, I do not believe the evidence before me establishes trade mark infringement in any event.

While I agree with the Complainant that the Domain Name incorporates a trade mark having no connection to the Respondent's corporate or trading name or any of the products or services in which it trades, on the facts of this dispute I find nothing abusive about the circumstances surrounding the Respondent's initial registration or subsequent use for the reasons set out above.

As to the Complainant's analogy with the cancellation provisions under the Trade Marks Directive, there is no equivalent provision under the DRS. Indeed, as I have previously mentioned, the Policy makes it clear that failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.

In my view, the Respondent's use of the Domain Name does not amount to an Abusive Registration.

Finally, the Respondent has alleged that the Complainant has attempted to reverse domain name hijack the Domain Name. Under the DRS Procedure this is defined as using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name.

I have seen nothing in the evidence to suggest that the Complainant acted in bad faith in bringing this Complaint. The evidence before me suggests that the Complainant had a genuine belief that the Respondent's use of the Domain Name amounted to an Abusive Registration, and that it was entitled to have its allegations tested under the DRS.

7. Decision

In the light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is not an abusive registration, I direct that no action be taken.

Cerryg Jones

25 March 2011