

DISPUTE RESOLUTION SERVICE

D00011211

Decision of Appeal Panel

Tumblr Inc.

and

Paul Guerin

1. The Parties:

Complainant:

Tumblr, Inc.
35 East 21st Street
6th Floor
New York, NY
10010
United States

Respondent:

Mr Paul Guerin
13 allée ile de Bourdi
St-Nazaire
Loire Atlantique
44600
France

In this decision, for simplicity's sake, we propose to maintain the terminology as used at first instance. The Complainant remains "the Complainant" and the Respondent/Appellant remains "the Respondent".

2. The Domain Name:

<tumblr.co.uk> ("the Domain Name")

3. Procedural History

For present purposes it is sufficient to relate that the Complaint was filed on 13 April 2012 and was sent to the Respondent on 17 April 2012. The Respondent failed to file a Response. That the Respondent was duly notified is clear from Nominet's file and the Respondent has not contended otherwise; indeed evidence provided by the Complainant includes confirmation that the Respondent did receive the Complaint.

As was its right where there has been no response, the Complainant elected for a summary decision and on 11 May 2012 paid the appropriate fee to Nominet.

The Expert issued a summary decision on 16 May 2012 and directed that the Domain Name be transferred to the Complainant.

Nominet notified the Respondent of the decision on 21 May 2012 and on 1 June 2012 the Respondent notified Nominet of his intention to appeal and paid the appropriate fee to Nominet. The Appeal Notice was received by Nominet on 28 June 2012 and duly sent to the Complainant. On 5 July 2012 the Complainant filed its Appeal Response.

On 11 July 2012 Tony Willoughby, Nick Gardner and Claire Milne (the undersigned, "the Panel") were appointed to the Appeal Panel. Each member of the Panel has individually confirmed to Nominet 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."

The Panel was appointed to provide a decision on or before 22 August, 2012. This process is governed by version 3 of the *Procedure for the conduct of proceedings under the Dispute Resolution Service* ("the Procedure") and the Decision is made in accordance with version 3 of the *Dispute Resolution Service Policy* ("the Policy"). Both of these documents are available for inspection on the Nominet website (<http://www.nominet.org.uk/disputes/drs>).

4. The Nature of This Appeal

The Policy §10a provides that: *"the appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters"*.

The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits.

In addition to the decision under appeal, the Panel has read the Complaint (with annexes), the Appeal Notice and the Appeal Response.

5. Formal and Procedural Issues

The Nominet DRS is a procedure which is intended to provide a fast and relatively low-cost resolution of domain name disputes. It provides that the Expert may grant a summary determination in favour of the Complainant in circumstances where there is no Response filed, subject to the following provisions (Policy paragraph 7c):

"The Expert will only grant a request for summary decision where he or she is satisfied that:

[Nominet has] sent the complaint to the Respondent in accordance with paragraphs 2 and 4 of the Procedure;

The Complainant has, to the Expert's reasonable satisfaction, shown that he or she has Rights in respect of a name or mark which is identical or similar to the Domain Name and the Domain Name is an Abusive Registration; and

No other factors apply which would make a summary decision unconscionable in all the circumstances."

It accordingly follows that a Respondent who has received notice of a Complaint and, for whatever reason, fails to respond, does so at the risk of a decision being reached against him, including if appropriate adverse inferences being drawn by the Expert. The question then arises as to whether such a Respondent should be entitled to appeal. Allowing a Respondent to do nothing and then to appeal where a decision is reached against him runs the risk of undermining the simplicity of the DRS system and is also unfair to a Complainant who is then put to further time and (in all likelihood) not insignificant expense to deal with the Appeal. It also delays the entire process which may itself cause further unfairness to the Complainant.

Nevertheless it is clear that the Procedure envisages that there are potentially some circumstances where such an appeal is permissible. Paragraph 5(f) of the Procedure explicitly provides that:

"f. If the Expert grants the Complainant's application for a summary decision ... the normal procedures as to ... appeal, under paragraph 18, shall apply."

However Paragraph 18(f) of the Procedure provides that an Appeal Notice "should contain no new evidence or annexes". This clearly cannot be the case in circumstances where there was no original Response. The Procedure provides a mechanism that allows this problem to be overcome because paragraph 18(h) provides that "The Panel should not normally take into consideration any new evidence presented in an appeal notice or appeal notice response, unless they believe that it is in the interests of justice to do so."

This would appear to indicate that such an appeal may be entertained where the Panel considers it is in the interests of justice to do so. This is consistent with the approach that Panels have adopted in previous cases.

In DRS Case No. 5861 <greengiant.co.uk> the Respondent claimed not to have received the original Complaint. The Panel was not satisfied this was clearly the case but concluded there was no disadvantage to the Complainant in allowing the Appeal to proceed.

In DRS Case No. 10075 <philosophy.co.uk> the Panel stated:

"A more fundamental question is whether this Appeal should be entertained at all, given the failure of the Respondent to comply with the time limits set down by the Procedure. Time limits are important. If the Policy and the Procedure are to provide the desired swift and efficient alternative to litigation, time limits need to be adhered to."

The Respondent's representative's excuse for failing to adhere to the time limits raises a number of questions, but the Panel sees no merit in exploring that aspect any further. The fact of the matter is that the failure to comply was in substance relatively trivial, although the subsequent correspondence has led to a delay of several weeks."

The Panel concludes that in all the circumstances of this case, as a matter of natural justice, it would be unjust for this Appeal not to proceed on the basis of all the materials now before the Panel."

In that case the Panel found in favour of the Respondent and recognised that a significant injustice would be caused if the Respondent were to be deprived of a domain name it had paid substantial sums for where the use in question was not, in the Panel's view, abusive.

The Panel in the present case considers that is the correct approach. In order for an Appeal to be entertained in circumstances where it is clear a Respondent has deliberately not responded to the original Complaint, the Respondent has to show more than just an arguable case, namely that there will be a significant injustice if the original decision is allowed to stand.

In the present case the Respondent clearly received the original Complaint and he does not contend otherwise. His appeal notice is extremely short. The Respondent fails in his Appeal Notice (a) to give any explanation for his failure to respond to the Complaint (contrast the position in the <greengiant.co.uk> and <philosophy.co.uk> cases cited above) and (b) to challenge any of the facts and matters asserted in the Complaint upon which the Expert's decision was based. The only explanation for the Respondent's failure is found in an email the Complainant has annexed to its response to the Appeal. In this email (which is to the Complainant's legal advisers), the Respondent states

"With that in sight, we could not but appeal to Nominet's decision — a surprise to us given the weak case presented by your client which we thought would be dismissed thus why we did not respond to it".

That is not in the Panel's view a satisfactory explanation and does not provide any compelling reason why the interest of justice should allow the Appeal to proceed. Respondents who form their own view on the merits of their case and decide not to bother to explain them to the Expert do so at their peril. For this reason alone the Panel would reject the Appeal. However, in reaching this conclusion the Panel has also considered the merits of the case, and concluded that the Respondent does not have a case that would succeed even if the Appeal did proceed. Hence the Panel is fully satisfied that no injustice results in rejecting this Appeal. The Panel's reasoning in this regard is set out below.

This appeal therefore fails doubly – both on procedural grounds and on its merits. Although it is preferable that, where possible, disputes under the Policy should be dealt with on substantive grounds rather than technicalities, future Panels faced with appeals which appear to have been used as substitutes for initial responses may well simply dismiss those appeals out of hand.

6. The Facts

Much of the following has been taken from the Complaint, supported by documentary evidence annexed to the Complaint. None of it has been challenged by the Respondent.

The Complainant is a Delaware corporation that owns and operates a microblogging and social sharing platform, which it first launched in 2007 under the "Tumblr" name.

The Complainant is the proprietor of a number of trade mark registrations covering the TUMBLR mark including United States Trade Mark Registration No. 3714214 filed 27 October 2008, registered 24 November 2009, TUMBLR (standard character mark) in classes 41 and 45 for electronic publishing services and various Internet based social networking services.

On 31 July 2009 the Respondent registered the Domain Name and identified himself to Nominet as a non-trading individual, thereby enabling his contact details to be omitted from the publicly available Whois database.

By 31 July 2009, the Tumblr blogging network had over 10 million unique visitors per month. By that time, Tumblr had developed worldwide recognition having been featured in media articles throughout the United States, the United Kingdom, and the rest of the world.

The Respondent is also the proprietor of a number of other domain names including: <zendesk.ch> corresponding to Zendesk, Inc.'s ZENDESK mark; <twitter.am> and <twitter.st> corresponding to Twitter, Inc.'s TWITTER mark; <tinychat.it> corresponding to Tinychat Co.'s TINYCHAT mark; <cityville.ch> corresponding to Zynga Inc.'s CITYVILLE mark; <foursquare.dk> corresponding to Foursquare Labs, Inc.'s FOURSQUARE mark; and <craigslist.st> corresponding to Craigslist, Inc.'s CRAIGSLIST mark.

On 23 March 2012, the Respondent's website merely advertised that the tumblr.co.uk domain name was for sale and that banner advertising on the webpage was available for purchase. It also indicated that the site was receiving "over 2000 visitors per month".

On 26 March 2012, the Complainant emailed the Respondent notifying the latter of the former's rights in the Domain Name and offering to purchase the Domain Name for \$500.00 USD. In response, the Complainant received an email from contact@domainsforsalebyowner.com observing that the Complainant's United States Trade Mark registration for the TUMBLR mark post-dated registration of the Domain Name by several months and stating that their client was willing to transfer the Domain Name for \$20,000 USD.

On 09 April 2012, the Respondent's website featured nothing but the email address, 'contact@tumblr.co.uk'.

Currently, the Domain Name resolves to the Respondent's site at www.tumbler.co.uk. The webpage indicates only that in about 55 days the site will become the UK's No 1 spot for the online purchase of tumblers.

7. The Parties' Contentions

The Complainant points to its TUMBLR trade mark registrations (see section

6 above for details of the US registration) and contends that it has rights in a name or mark which is identical to the Domain Name (absent the generic '.co.uk' suffix).

The Complainant contends that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complainant contends that it was registered with knowledge of the existence of the Complainant's service offering and with the intention of obtaining a high price from the Complainant for its transfer (paragraph 3.a.i.A of the Policy). Further the Domain Name was registered as a blocking registration to prevent the Complainant reflecting its TUMBLR trade mark in a '.co.uk' domain name (paragraph 3.a.i.B of the Policy). Further the Respondent registered the Domain Name as part of a pattern of registering domain names featuring the well-known trade marks of others, he having no apparent connection with the owners of the trade marks in question (paragraph 3.a.iii of the Policy).

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Domain Name.

The Complainant's Response to the Respondent's Appeal Notice essentially repeats the contentions of the Complaint and makes observations on the content of the Respondent's Appeal Notice, which will be dealt with by the Panel under the next section (section 8 below).

The Respondent did not respond to the Complaint.

In his Appeal Notice the Respondent states that his main basis for the appeal is the pecuniary damage that will be caused to his <tumbler.co.uk> business, which he says is (or is to be) a site providing for the online sale of tumblers, if the Domain Name is taken from him. He says that there are statistics to support this claim, but does not produce them to the Panel.

He says that he registered the Domain Name to anticipate typosquatters and to benefit from visitors mis-typing his <tumbler.co.uk> domain name. By way of support for this, he says that if one types his brand, "tumbler", into the Google search engine, the first URL to come up is the Complainant's. He points out that many companies register mis-spellings of their names as domain names to address this issue. He cites Google (<goggle.com>), Facebook (<facebok.com>) and Twitter (<twittr.com>). He concludes: "Why should high profile companies be allowed to register and in some cases win <<typo>> disputes involving their websites and not www.tumbler.co.uk?"

8. Discussion and Findings

The factual background to the reasoning below is to be found in section 6

above.

In previous cases where respondents have appealed experts' decisions, not having responded to the original complaint at first instance, they have been keen to provide explanations as to why they did not file a response and why, therefore, adverse inferences should not be drawn against them for having done so (paragraph 15(c) of the Procedure). In this case the Respondent has provided no such explanation. Evidence provided by the Complainant however points strongly to the Respondent simply having decided not to respond.

Another unusual aspect of this case is that the Respondent has not challenged any of the evidence of the Complainant as set out in the Complaint.

In order for the Complainant to succeed it must (pursuant to Paragraph 2 of the Policy) prove to the Panel, on the balance of probabilities, **both** that:

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

the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

The meaning of 'Rights' is clarified and defined in the Policy in the following terms:

Rights means rights enforceable by the Complainants, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;

There is no dispute between the parties that the Complainant has trade mark rights in respect of the mark TUMBLR although the Respondent notes that the Complainant's registered trade mark rights post-date registration of the Domain Name by a few months.

Accordingly, the Panel finds that the Complainant has rights in respect of a mark which (absent the generic '.co.uk' suffix) is identical to the Domain Name.

The date of the acquisition of relevant rights by the Complainant is not a matter of any relevance to this, the first element of the Policy, but it can be of relevance to the second element, namely as to whether or not the Domain Name is an Abusive Registration within the meaning of the Policy. It is convenient therefore to assess at this stage whether as at the date of registration of the Domain Name the Complainant had any enforceable rights in respect of the name or mark "Tumblr".

The Complainant has produced a wealth of material in the form of independent online statistics and press comment to demonstrate to the satisfaction of the Panel that as at 31 July, 2009 when the Respondent registered the Domain Name the Complainant had established a significant reputation and goodwill in respect of its "Tumblr" service offering. As indicated at section 6 above, by 31 July, 2009, the "Tumblr" blogging network had over 10 million unique visitors per month. It was a relatively new service, but over the preceding 18 months or so it had experienced rapid growth.

The Panel is satisfied that as at the date of the registration of the Domain Name the Complainant had common law or unregistered trade mark rights in respect of the "Tumblr" name/mark.

It remains for the Panel to determine whether the Domain Name, in the hands of the Respondent, is an Abusive Registration.

An Abusive Registration is defined in the Policy as follows:

Abusive Registration means a Domain Name which either:

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 Complainants' Rights; OR

has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainants' Rights;

An important first question when considering this issue is as to whether the Respondent was aware of the existence of the Complainant's "Tumblr" social networking service when he registered the Domain Name. The Complainant asserts that he was so aware and the Respondent has not denied it. Indeed, the Panel is confident that the Respondent must have been aware of the Tumblr social networking service at that time. As will be apparent from section 6 above, the Respondent is "Internet-savvy" and has a particular interest in online trading.

However, merely being aware of the Complainant's brand is not enough to enable the Complaint to succeed. It could be that the Respondent has a concurrent right or legitimate interest in respect of the name.

The Respondent has explained that his reason for registering the Domain Name was to protect what he claims is his online tumbler business from the activity of typosquatters and to ensure that those Internet users mis-typing his business's name into a web browser will nonetheless get to the site for which they are looking, namely his site at www.tumbler.co.uk to which the Domain Name resolves.

In the Appeal Notice he cites the example of other companies such as Google, Facebook and Twitter which register as domain names mis-spellings of their

names. His Appeal Notice concludes:

"Why should high profile companies be allowed to register and in some cases win <<typo>> disputes involving their websites and not www.tumblr.co.uk?"

The answer to that question is straightforward. "Tumblr" is a trade mark of someone else (i.e. the Complainant) whereas Goggle, Facebok and Twittr (the examples he cites) are not, so far as the Panel is aware. If they are, the Respondent should have drawn it to the Panel's attention. He has not.

The Respondent's explanation for having registered the Domain Name presupposes the existence of his online www.tumblr.co.uk tumblr trading business. The Respondent has produced no evidence of any such business. He has a domain name, <tumblr.co.uk>, but the site to which it is connected is not a trading site and it appears to be the case that it is only recently that the Domain Name has resolved to that site. As at 23 March, 2012 the website to which the Domain Name resolved merely advertised that the Domain Name was for sale and that banner advertising on the webpage was available for purchase. It also indicated that the site was receiving "over 2000 visitors per month".

While the Respondent claims to be a trader, the Panel notes that the Nominet Whois database records the Respondent as having certified himself to be a non-trading individual. He has not produced any evidence at all to demonstrate he really has, or intends to launch, a business devoted to the sale of tumblers. In circumstances where the Respondent wishes the Panel to accept this is the reason his appeal should be allowed it is incumbent upon him to have done so.

Additionally, the Complainant has produced evidence to show that the Respondent has registered domain names corresponding to the well-known trade marks of other companies, with which he has no apparent connection. The Respondent could have provided an explanation if he had responded to the Complaint and the Panel would certainly have expected him to provide an explanation when he filed his Appeal Notice. No explanation has been forthcoming. The domain names cited by the Complainant are <zendesk.ch> corresponding to Zendesk, Inc.'s ZENDESK mark; <twitter.am> and <twitter.st> corresponding to Twitter, Inc.'s TWITTER mark; <tinychat.it> corresponding to Tinychat Co.'s TINYCHAT mark; <cityville.ch> corresponding to Zynga Inc.'s CITYVILLE mark; <foursquare.dk> corresponding to Foursquare Labs, Inc.'s FOURSQUARE mark; and <craigslist.st> corresponding to Craigslist, Inc.'s CRAIGSLIST mark. Clearly none of these names have any connection with either a business selling tumblers nor, so far as the Panel can determine, any other legitimate business the Respondent may have.

Finally, while the Respondent contends that the Domain Name is of significant financial importance to his business, a business about which the Panel has no

information, it is a fact that when the Complainant offered to acquire the Domain Name for \$500 USD, the Respondent responded by seeking \$20,000 USD.

When all is taken into account the Panel strongly believes that the Respondent's explanation is not to be relied upon and that his purpose in registering the Domain Name was to encourage the Complainant to pay a substantial sum of money for it. Uppermost in his mind was the value attributable to the Domain Name by reference to the Complainant's trade mark. That means the domain name is an Abusive Registration

9. Decision

The Panel rejects the Appeal on the basis that the Respondent has failed to show that the interests of justice should permit the Appeal to proceed when he chose not to respond to the original Complaint. The Panel also concludes that the Respondent's case does not succeed on its merits and that the Domain Name is an Abusive Registration. Accordingly the Panel affirms the decision of the Expert and directs that the Domain Name be transferred to the Complainant.

Signed:

Tony Willoughby

Claire Milne

Nick Gardner

Appeal Panel

26 July 2012