

DISPUTE RESOLUTION SERVICE

D00015955

Decision of Independent Expert

WordPress Foundation

and

Aishwin Vikhona

1. The Parties:

Lead Complainant: WordPress Foundation
200 Brannan Street, Suite 511
San Francisco
California
94107
United States

Respondent: Aishwin Vikhona
Plot No.5-6-60, Vikhona Niwas
Aurangabad
Maharashtra
431001
India

2. The Domain Name(s):

wordpress-developer.co.uk

3. Procedural History:

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.

21 May 2015 00:42 Dispute received

21 May 2015 13:25 Complaint validated

21 May 2015 13:36 Notification of complaint sent to parties

10 June 2015 02:30 Response reminder sent

15 June 2015 11:41 No Response received

15 June 2015 11:41 Notification of no response sent to parties

19 June 2015 13:47 Expert decision payment received

Following my review of the Complaint and the Exhibits thereto, it became apparent that one of the Exhibits, Exhibit G which related to correspondence between the parties concerning an offer to sell the Domain Name, was not as described in the Complaint and in fact Exhibit F had been duplicated. I therefore issued an instruction pursuant to paragraph 13 of the DRS Procedure that the Complainant should be asked to provide the correct Exhibit, and that it be served on the Respondent who should be given the opportunity to file observations restricted to that new Exhibit. The correct Exhibit G was duly provided by the Complainant and served on the Respondent, who did not file any observations.

4. Factual Background:

The Complainant has provided an open-source self-hosted blogging and internet tool under the trade mark WORDPRESS, since at least March 2003. Open-source software is commonly understood to be software that is freely licensed to use, copy, study or change in any way and the source code is openly shared.

The Complainant asserts that by 2008 its website wordpress.com was ranked number 31 in the world by Alexa.com for traffic with 90 million monthly page views and it is currently ranked at number 25 in visitor traffic as assessed by Quantacast.com. It has also received widespread publicity in the press and various awards and as a result it has become famous and widely recognised by consumers.

The Complainant is the proprietor of various trade mark registrations including Community Trade Mark number 5101068 for the development of computer hardware and software in Class 8, with effect from 29 May 2006.

The Domain Name was registered by the Respondent on 23 May 2013.

On 12 February 2015, Mr Akshay contacted the Complainant as the Respondent's representative. He offered to sell the Domain Name to the Complainant. Further correspondence took place and on 9 March 2015 the purchase price for the Domain Name was identified as £400, however no transaction was concluded and on 12 March 2015 Mr Akshay notified the Complainant that the Domain Name was no longer available at that price and that the price would increase in the future. Negotiations thereafter broke down.

The Complainant alleges that the webpage to which the Domain Name is pointed is a copy of or a 'spoof' of a third-party website which offers domain names for sale.

5. Parties' Contentions

a. The Complaint

The Complainant asserts that the Domain Name is similar to its trade mark WORDPRESS, as it replicates the Complainant's unique and world-famous mark exactly with the mere addition of a hyphen and the word "developer". Because the Complainant offers resources to support developers of its products, it would be natural for internet users to add the word "developer" when typing the Complainant's domain when they are seeking genuine branded products and services.

It is alleged that the Domain Name is an Abusive Registration on the following grounds:

1. It is likely to confuse people or businesses into believing that it is operated, authorised by or connected with the Complainant. The use of the word “developer” enhances confusion because customers will expect to see the use of that word in relation to an authorised website. Even if no sustained likelihood of confusion exists, because visitors to the site will realise that the website is not official, initial interest confusion will have occurred because the visitor will only have been taken to the site because the domain name indicates that it will lead to an official site. The use of a copy or spoof home page will enhance the likelihood of confusion or prolong initial interest confusion and may encourage visitors to attempt to make a purchase from the website.

2. The Respondent is not legitimately connected with or authorised by the Complainant and the use of the Domain Name falsely implies such.

3. The Respondent is not making fair use of the Domain Name. The purported sale of domain names at the webpage to which the Domain Name is pointed is far too tenuous a connection with the Complainant’s services to be fair. The Respondent is promoting or attempting to earn affiliate revenue from the goods and services of others unrelated to the Complainant and the use of the Domain Name undermines the value of the Complainant’s mark by giving the false impression that the Complainant has authorised the Respondent’s activities.

4. The Respondent registered the Domain Name for the purpose of selling, renting or otherwise transferring it to the Complainant or a competitor for valuable consideration in excess of its out-of-pocket expenses as evidenced by the communications with Mr Akshay.

b. The Response

No Response or additional submission was filed.

6. Discussions and Findings

a. General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name; and
- (ii) the Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

Notwithstanding the failure by the Respondent to file a Response, the burden of proof as set out above remains on the Complainant. However, the Expert is entitled to take into consideration when making his determination that the Respondent, despite having the opportunity to do so, has not availed himself of the opportunity to rebut the allegations that have been made by the Complainant.

b. Complainant's Rights

The DRS Policy defines Rights as follows:

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

In my view the Complainant has shown that it has Rights as a result of its trade mark registration(s) and as a result of the goodwill that it has created from the extensive use and promotion of the mark WORDPRESS.

For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which rights are claimed, one should ignore the .co.uk suffix. The comparison is therefore between 'WORDPRESS' on the one hand and 'WORDPRESS-DEVELOPER' on the other. The use of a hyphen is of little or no consequence to a comparison and in my opinion given that the word 'WORDPRESS' is the more distinctive part of the name the word 'DEVELOPER' is descriptive, the Complainant has established that they have Rights in a mark identical or similar to the disputed Domain Name.

c. Abusive Registration

I now go on to consider the extent to which the disputed Domain Name is an Abusive Registration.

The Complainant asserts that the Domain Name is an Abusive Registration for the reasons identified above.

The Policy defines an 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"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration.

The first three grounds identified above accord with paragraphs 3(a)(ii) ('causing or likely to cause confusion), 4(a)(i)(B) ('Respondent [not] commonly known by the name' and 4(a)(i)(C) ('Respondent [not] making fair use of the Domain Name') of the Policy respectively. At the heart of each of these grounds of complaint is the proposition that the Respondent is not authorised to use the Complainant's mark and that such use is likely to lead visitors to the Respondent's website to believe that the website is authorised or connected to the Complainant. There have been a large number of cases pursued via the DRS which have involved domain names which use a complainant's well known mark with the addition of a word that implies that the domain name is authorised, and where the additional word does nothing to disabuse visitors to the respondent's website. The Complainant here cites DRS Case No 9988 (Barclays Plc v Realm Solutions Inc) where the domain name in issue was <barclaysjobs.co.uk>. The expert said as follows:

"The Respondent says that its use of the portmanteau word 'barclaysjobs' is descriptive and by implication that no initial interest confusion would have occurred. However, the Expert finds that initial interest confusion is very likely to have occurred among a substantial number of visitors to the web site hosted at the address www.barclaysjobs.co.uk. It is not difficult to see how a person looking for a job at Barclays would type the words 'Barclays' and 'jobs' into a search engine. The likelihood is that the name of the Respondent's web site would be shown on such a search. The person conducting the search would have believed that the Domain Name advertised jobs at Barclays, that it was in some way connected to the Complainant, and that the Domain Name was not merely a descriptive term for available jobs at Barclays."

In DRS Case 7991 (Toshiba v Power Battery Inc), where the domain name in issue was <toshiba-laptop-battery.co.uk>, the Appeal Panel identified the following criteria relating to the use of well-known trade marks by resellers:

"1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.

2. *A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.*

3. *Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.*

4. *Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website."*

The panel in that case concluded that the domain name *per se* was not abusive, but that the use of the domain name in connection with the sale by the respondent of competing products to those of the complainant, took unfair advantage of its rights.

In the present case, the Respondent has adopted the Complainant's well-known trade mark within the Domain Name and merely added a hyphen and the word 'developer'. Given the notoriety of the Complainant's mark and the use of the word 'developer' which is a natural association with the Complainant's products, I think it very likely that the Respondent would have been aware of the Complainant and the use of its mark when he registered the Domain Name. However, it seems to me that this is a case which can be distinguished from those such as <barclaysjobs.co.uk>. The Complainant provides open-source software, which by definition is developed by others. In my view people who see the Domain Name are unlikely to assume, as contended for by the Complainant, that the Domain Name is authorised by or associated with the Complainant and nor do I think that such use will confuse or is likely to confuse people. In that respect I note that the Complainant has not provided any evidence of confusion. Whilst it refers to the content of the website being a spoof or copy of a third party website, I do not find that the evidence goes far enough to enable me to conclude that such is the case and even if that were so, I do not think that the content which relates to the sale of domain names generally is abusive in the circumstances. In that regard I refer to paragraph 4(d) of the Policy which provides that the trade in domain names for profit is a lawful activity and that each case must be reviewed on its merits.

The fourth ground relied upon relates to paragraph 3(a)(i)(A) of the DRS Policy which is set out below:

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

i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

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;”

In my opinion, the correspondence between the Complainant and the Respondent’s representative show that there is a strong likelihood that the Domain Name was registered primarily with the intention of selling it to the Complainant for valuable consideration in excess of the costs that the Respondent will have incurred in registering or using it. I am mindful that the allegation in this regard was made in the Complaint and despite being given the opportunity to rebut that allegation both in a Response and by additional observations on the missing Exhibit G, which goes to the heart of this allegation, the Respondent has chosen not to do so.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name which is to the Domain Name <wordpress-developer.co.uk> and the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds.

Signed: Simon Chapman

Dated: 21 July 2015