

DISPUTE RESOLUTION SERVICE

D00015390

Decision of Independent Expert

Infusion Software, Inc.

and

Mr Mark Sutherland

1. The Parties:

Complainant: Infusion Software, Inc.
1260 South Spectrum Boulevard
Chandler
Arizona
85286
United States

Respondent: Mr Mark Sutherland
57 Esslemount Avenue
Aberdeen
AB25 1SS
United Kingdom

2. The Domain Name(s):

infusionsoft.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 January 2015, the Dispute was received.

21 January 2015, the Complaint was validated.
21 January 2015, the Notification of the Complaint was sent to the Parties.
09 February 2015, a Response reminder was sent to the Respondent.
12 February 2015, no Response was received.
12 February 2015, the Notification of no response was sent to the Parties.
13 February 2015, the Expert decision payment was received.

4. Factual Background

- 4.1 The Respondent registered the Domain Name on 25 April 2014.
- 4.2 The Complainant is the owner of numerous trademark registrations worldwide¹ for marks that consist of or contain the name *infusionsoft* (the 'Name'), including CTM Reg. No. 010,265,171, registered on 17 February 2012 and CTM Reg. No. 010,653,863, registered on 13 July 2012 (the 'Mark').
- 4.3 The Complainant's website is www.infusionsoft.com.

5. Parties' Contentions:

The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

- 5.1 In summary, the Complainant submitted that the Domain Name should be transferred to it for the reasons below.

The Complainant's Rights

- The Complainant submitted that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- The Complainant submitted that it provides sales and marketing automation software for small businesses that combines customer relationship management ('CRM'), e-mail marketing and e-commerce services.
- The Complainant stated that it is a privately held company which was founded in 2001 and now has annual revenue in the millions and has more than 600 employees in offices in the United States and the United Kingdom, serving 27,000 customers in more than 100 countries.

¹ The Complaint provided evidence of trade mark registrations also in the U.S., Australia and Canada.

- The Complainant stated that it has been ranked on the "*Inc. magazine 500/5000 list for eight years*" and that it had received numerous awards (the Complainant provided a link to the list of awards on its website at <http://www.infusionsoft.com/news/awards>).
- In light of the above, the Complainant submitted that it has Rights in the Name/Mark.
- The Complainant submitted that the Name/Mark is "*identical or similar to*" the Domain Name as it contains the Name/Mark in its entirety "*disregarding the .co.uk suffix*".

Abusive Registration

- The Complainant submitted that the Domain Name, in the hands of the Respondent, is an Abusive Registration as the Domain Name has been used and/or was registered or otherwise acquired in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.
- The Complainant stated that the Respondent is using the Domain Name in connection with a monetised parking page with links to websites which provide services "*identical to those offered by Complainant*", including links labelled "*Web Based CRM Software*", "*Sales CRM*" and "*CRM for Small Business*".
- The Complainant submitted that the Respondent has no connection with the Complainant or its business, and the Domain Name is an Abusive Registration under the Policy, mentioning specifically paragraphs 3. a. i. B. (that the Respondent registered the Domain Name as a blocking registration) and 3 a. i. C. (that the Respondent registered the Domain Name for the purpose of unfairly disrupting the Complainant's business).
- The Complainant submitted that the Domain Name has been used to misdirect those potentially seeking the Complainant's website to the websites of the Complainant's competitors which, if those links are followed, would "*in all probability*" generate 'click-through' income for the Respondent.
- The Complainant further submitted that, were the Respondent to argue that the parking page associated with the Domain Name was created or maintained by the Registrar (in this case, the operator of the Website's parked page) and thus not it, "*the Respondent is unlikely to be able to escape responsibility for the behaviour of that third party.*" (The Complainant quoted the Nominet Experts' Overview, at paragraph 4.7 in support.²)

² www.nominet.org.uk/sites/default/files/drs_expert_overview.pdf.

- The Complainant submitted that the Domain Name was chosen to be registered by the Respondent because of its association with the Complainant and its products and services, and it is difficult to conceive of any other reason for choosing the Name, which is distinctive.

The Complainant quoted various domain name cases in support of the above submissions, all of which the Expert noted.

The Response:

- 5.2 No response to the Complaint was provided by the Respondent.

6. Outstanding formal/procedural issues

- 6.1 Although Nominet sent the Complaint to the Respondent as mentioned in section 3 above, no response has been provided by the Respondent to the Complaint. As no exceptional circumstances have been raised by the Respondent as to why no response has been received, the Expert has proceeded to a Decision (as per paragraph 15 b. of the Nominet DRS Procedure (the 'Procedure')).
- 6.2 While noting paragraph 15 c. of the Procedure (which states that in such circumstances, the Expert will draw such inferences as he considers appropriate), the Expert has drawn no inferences from the Respondent's failure to respond in this case, and has based his Decision on the facts and evidence before him.
- 6.3 It is important to note that the Complainant does not automatically receive the remedy it has requested merely because the Respondent has not responded to the Complaint (see, for example, Nominet DRS *equazen.co.uk* (DRS 02735) decision).

7. Discussions and Findings

General

- 7.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the Policy that, on the balance of probabilities³:

"i. [it] 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."

- 7.2 Addressing each of these limbs in turn:

³ I.e. on the basis that the Complainant's case is more likely than not to be the true version, see <http://www.nominet.org.uk/disputes/drs/legalissues/>.

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

7.3 The Expert considers that, for the reasons set out below, the Complainant has Rights in a name or mark which is identical to the Domain Name.

7.4 Paragraph 1 of the Policy defines 'Rights' 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 Complainant must have the Rights in question at the time of the complaint.⁴

7.5 The Expert notes that, as referred to by the Complainant and summarised at paragraphs 4.2 and 5.1 above, the Complainant is the proprietor of a number of trade mark registrations in respect of the Name. The Expert also notes that the Complainant has been trading since 2001 and considers that, through longevity in the market place, reputation and sales, the Complainant has developed considerable goodwill and reputation in the Name/Mark.

7.6 Given those factors, the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Name/Mark which is identical to the Domain Name. In concluding the above, the Expert has disregarded the domain suffix 'co.uk'.

7.7 Thus, noting the fact that the requirement to demonstrate 'Rights' is not a particularly high threshold (Nominet appeal panel decision, *Seiko-shop* DRS 00248), the Expert considers that the evidence before him is sufficient to establish that, at the time of the Complaint, the Complainant had relevant Rights in relation to the Domain Name.

Abusive Registration

7.8 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.

7.9 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;"

⁴ See for example, Nominet Appeal decision, *ghd.co.uk*, DRS No. 03078, at page 9, para 9.2.2.

- 7.10 *In relation to i. above*, the Expert considers that the Domain Name was an Abusive Registration at the time the Domain Name was registered.
- 7.11 The Policy, at paragraph 3, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Specifically, the Expert considers that the factor set out at paragraph 3 a. i. C. is relevant: namely, where the Respondent has registered the Domain Name primarily "*for the purpose of unfairly disrupting the business of the Complainant;*"
- 7.12 While it may be helpful to consider the Respondent's intentions at the time he registered the Domain Name (or indeed in relation to his subsequent use of the Domain Name), as the Respondent has not replied to the Complaint, the evidence available to the Expert is that provided by the Complainant.
- 7.13 The Expert notes that the Domain Name is made up of two common words added together, "*infusion*" and "*soft*" and the Respondent may have submitted, had he responded to the Complaint, that he came up with the Name of his own accord. However, given the Complainant's Mark and goodwill and reputation in the Name/Mark (including having been established since 2001 and providing sales and marketing automation software for small businesses), the Expert considers that the Respondent would have been well aware of the Complainant and its Name/Mark at the time of his registration of the Domain Name on 25 April 2014.
- 7.14 Indeed, on the balance of probabilities, the Expert considers that the Respondent specifically chose to register the Domain Name with the intention of benefitting from the Complainant's reputation and goodwill to attract to the website he set-up using the Domain Name (the 'Website') users who would be looking for the Complainant and its services (the purpose of which would be to disrupt unfairly the business of the Complainant).
- 7.15 The Complainant also submitted that the Respondent had registered the Domain Name primarily as a blocking registration against the Name/Mark (referencing paragraph 3 a. i. C. of the Policy). However, the Expert does not consider that there is sufficient evidence to support such a submission.
- 7.16 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 7.17 *In relation to (ii) above*, the Expert also considers that the Domain Name was an Abusive Registration as a result of its manner of use by the Respondent.
- 7.18 The Expert considers that paragraph 3 a. ii. of the Policy is relevant, whereby a factor which may be evidence that the Domain Name is an Abusive Registration is:

"Circumstances indicating that the Respondent is using [...] 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;"

- 7.19 As evidenced by the Website print-out provided to the Expert by the Complainant, the Respondent has used the Website as a parking site (which is where a person uses a website to 'park' links to other websites and that person earns revenue when a user clicks on those parked links) with parked links to the services of companies providing "*Web Based CRM Software*", "*CRM for Small Business*": such offerings competing directly with the Complainant and its services.
- 7.20 The Expert considers that, as referenced at paragraph 4. e. of the Policy, while the sale of web traffic "*is not itself objectionable under the Policy*", when deciding whether such sale of traffic is evidence that the Domain Name is a non-Abusive Registration, the Expert will take into account among other things the nature of the advertising links on any parking page associated with the Domain Name. The Expert notes that paragraph 4. e. of the Policy also states that the use of the Domain Name is "*ultimately the Respondent's responsibility.*"
- 7.21 The Expert considers that those users accessing the Website would likely be confused that the services for sale via the parked links are either the Complainant's or are at least endorsed by the Complainant.
- 7.22 The Expert considers that the use of the Domain Name as described has taken unfair advantage of the Complainant's Rights by seeking to rely on the Complainant's goodwill and reputation in the Name/Mark to generate web traffic to the 'parked' websites promoted on the Website and, by doing so, divert potential Complainant customers to competitors' websites. It is also unfairly detrimental to the Complainant as the Complainant will potentially have lost sales income as a consequence of such use.
- 7.23 The Expert has considered whether there is evidence before him to demonstrate that the Domain Name is not an Abusive Registration (noting in particular the above considerations of paragraph 4. e. of the Policy) but does not consider there is.
- 7.24 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

8. Decision

- 8.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of the Name/Mark which is identical to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive

Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed: Dr Russell Richardson

Dated: 12 March 2015