

DISPUTE RESOLUTION SERVICE

D00020740

Decision of Independent Expert

Mr Andrey Ternovskiy

and

Jack Frere

1. The Parties

Complainant: Mr Andrey Ternovskiy
Apartment 243D
5 Tower Road
Silema
1600
Malta

Respondent: Jack Frere
206 Kd Tower
Cotterells
Hemel Hempstead
HP1 1AU
United Kingdom

2. The Domain Name

<chatroulettenew.co.uk>

3. Procedural History

26 October 2018 11:49 Dispute received
26 October 2018 12:45 Complaint validated
26 October 2018 12:51 Notification of complaint sent to parties
26 October 2018 13:45 Response received
26 October 2018 13:45 Notification of response sent to parties
31 October 2018 01:30 Reply reminder sent
31 October 2018 09:55 Reply received
31 October 2018 09:55 Notification of reply sent to parties
31 October 2018 09:56 Mediator appointed
05 November 2018 09:52 Mediation started
10 December 2018 15:34 Mediation failed
10 December 2018 15:35 Close of mediation documents sent
12 December 2018 09:26 Expert decision payment received

The Expert has confirmed that he is independent of each of the parties and that to the best of his 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 into question his independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant is an entrepreneur and the founder and operator of an online chat website named “Chatroulette”.

The Complainant is the owner of numerous trademark registrations for the mark CHATROULETTE, including for example European Union Trade Mark number 008944076 for the word mark CHATROULETTE, registered on 4 December 2012 in Classes 35, 38 and 42.

The Respondent registered the Domain Name on 29 June 2016.

The Domain Name has resolved to a GoDaddy parking page containing links to websites offering a variety of goods and services.

5. Parties’ Contentions

Complaint

The Complainant states that he founded his website in 2009, when he was 17 years old, with the unique objective of facilitating random video chatting. He registered the domain name <chatroulette.com> in November 2009. He states that the “roulette” concept was connected with the thrill of unpredictability and that he

coined a name that captured the idea and mission of his business. The Complainant states that the website quickly gained 500 visitors per day, which by January 2010 had increased to 50,000 per day or 1.5 million users per month. The Complainant submits that his website is one of the most popular in the world and exhibits press coverage about the site including articles from The New York Times and The New Yorker. The Complainant states that owing to the success of the site it has inevitably spawned numerous copycat sites and that it has suffered in particular from clone sites and cybersquatters wishing to exploit its popularity.

The Complainant submits he has Rights in respect of a name or mark which is identical or similar to the Domain Name. He contends that his trademark CHATROULETTE is distinctive and non-generic and that that the Domain Name contains that trademark in its entirety. He submits that anyone seeing the Domain Name will inevitably assume it to be connected with the Complainant.

The Complainant submits that the Domain Name in the hands of the Respondent is an Abusive Registration. He contends that the Respondent is not licensed or authorised to use the CHATROULETTE mark, has no independent rights in it and would not be capable of using it to offer any goods or services without misrepresenting a connection with the Complainant. He contends that the Respondent registered the Domain Name many years after the trademark CHATROULETTE had gained significant popularity and can only have been registered in order to take unfair advantage of the goodwill attaching to that trademark.

The Complainant submits that, by using the Domain Name for the purpose of a parking page, the Respondent is either making no legitimate use of it or alternatively using it to generate revenue from pay-per-click links on the basis of the goodwill that attaches to the Complainant's trademark. The Complainant states that either of these alternatives would be evidence of an Abusive Registration. The Complainant also submits evidence of cease-and-desist correspondence sent to the Respondent's registrar in September 2018 which he states has been ignored.

The Complainant requests the transfer of the Domain Name.

Response

The Respondent submits that he purchased the Domain Name, and others, three years ago and that they are legally his property. He says that he had understood that the Complainant had closed his website down. He invites the Complainant to make an offer to purchase his websites.

Reply

The Complainant relies on the Response as an admission that the Respondent was aware of his trademark CHATROULETTE. He denies that his website has ever been closed down. He notes that the Respondent refers to multiple domain names and states that he would be prepared to make an offer to the Respondent, but not of any sum in excess of the costs of the relevant DRS proceedings.

6. Discussions and Findings

This matter falls to be determined under the terms of the Nominet Dispute Resolution Service Policy (“the Policy”).

Under paragraph 2 of the Policy:

“2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:

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

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration

2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”

Under paragraph 1 of the Policy the term “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.”

Also under paragraph 1 of the Policy, the term “Abusive Registration” means 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. is being or has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”

Paragraph 5 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 8 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant is the owner of registered trademark rights in the name and mark CHATROULETTE. The Expert finds on the evidence that this trademark is distinctive of the Complainant’s online chat website and that it has no meaning in

commerce other than to refer to that business. The Domain Name comprises the whole of the Complainant's trademark CHATROULETTE together with the generic suffix "new", which does not in the view of the Expert serve in any significant manner to distinguish the Domain Name from the Complainant's trademark. Accordingly, the Expert finds that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

Noting again the distinctive nature of the Complainant's trademark CHATROULETTE and its notoriety as evidenced by the material exhibited by the Complainant, the Expert can conceive of no reason why the Respondent would have registered the Domain Name otherwise than in the knowledge of, and to take unfair advantage of, the goodwill that attaches to the Complainant's trademark. While the Respondent states that he believed the Complainant's website had shut down, there is no evidence to support any such belief and that fact would not in any event entitle the Respondent to appropriate the goodwill in the trademark in question. The Respondent has failed to put forward any effective answer to the Complainant's claims and the Expert concludes in the circumstances that the Domain Name was both registered and has been used in a manner which took unfair advantage of the Complainant's Rights. In the view of the Expert, the Domain Name is inherently misleading in that it constitutes an impersonation of the Complainant. The Expert further finds that the Respondent has used the Domain Name for the purpose of redirecting Internet users to sponsored links, and that he 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 (paragraph 5.1.2 of the Policy). The Expert therefore finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7. Decision

The Expert has concluded 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 an Abusive Registration. The Complaint therefore succeeds and the Expert directs that the Domain Name, <chatroulette.new.co.uk>, be transferred to the Complainant.

Steven A. Maier
Independent Expert

17 December 2018