

# Nominet UK Dispute Resolution Service

## DRS Number 5121

**Pricerunner AB**

**v**

**Brainfire Group**

## Decision of Independent Expert

### 1. Parties

Complainants: Pricerunner AB  
Address: c/o ValueClick Inc  
30699 Russell Ranch Road Suite 250  
Westlake Village  
Los Angeles  
Postcode: 91362  
Country: United States

Respondent Brainfire Group  
Address: 28 Crowfoot Terrace NW  
PO Box 68229  
Calgary  
Alberta  
Postcode: T3G 3N8  
Country: Canada

### 2. Domain Names

Priceunner.co.uk – registered 13 February 2005.

### 3. Procedural Background

The Complaint was lodged with Nominet on 8 October 2007. Nominet validated the Complaint and notified the Respondent of the relevant Complaint on 8 October 2007 and informed the Respondent that it had 15 days within which to lodge a Response.

No response was received from the Respondent.

On 13 November 2007, a Non-standard submission was received from the Complainants and sent to the Respondent.

No mediation having been possible, on 16 November 2007 the dispute was referred for a decision by an Independent Expert following payment by the Complainant of the required fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

David Flint, the undersigned, ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

#### **4. Outstanding Formal/Procedural Issues (if any)**

The Non-standard submission related to the identity of the party representing the Complainant and the Expert does not consider that this affects the substance of these proceedings.

#### **5. The Facts**

##### **Complainant**

Pricerunner AB is the registered owner, internationally, of the Pricerunner trademark. Respondent has registered a domain name which is confusingly similar to Pricerunner's registered trademark and is likely to lead consumers to believe they are using Pricerunner's web site. Respondent is infringing on Pricerunner's trademark and the registrar, Fasthosts, is facilitating this infringement.

#### **6. The Parties' Contentions**

##### **Complainant**

I confirm that Domain Name(s) in dispute are identical or similar to a name or mark in which I have Rights.

I confirm that Domain Name(s) in the hands of the Respondent is an Abusive Registration.

The Complainant seeks transfer of the Domain Name.

##### **Respondent**

No response was received from the Respondent

#### **7. Discussion and Findings:**

##### **General**

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that 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, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

##### **Complainant's Rights**

In this case the first limb of that task is straightforward. The Complainant is the registrant of a number of trademarks including Community Trademark No: 003908531. In those circumstances the Expert is satisfied that the Complainant does have Rights in respect of a name or mark which is identical or similar to the Domain Name.

### Abusive Registration

This leaves the second limb. Is each Domain Name, in the hands of the Respondent, an Abusive Registration? 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 took unfair advantage of or was 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 is set out in paragraph 3a of the Policy.

The Respondent has been the respondent in a number of other cases (DRS 5063, DRS 4575, DRS 4551, DRS 4001, DRS 3817, DRS 3386, DRS 2908) in which his registration of the name in question has been found to be abusive. Accordingly in terms of paragraph 3 c of the Policy, there is a presumption of Abusive Registration in respect of Brainfire Group. Although this presumption is rebuttable, no attempt so to do has been made.

In the cases immediately before this Expert relevant 'factors' in paragraph 3 are to be found in subparagraph i , which reads 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;
  - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
  - C. for the purpose of unfairly disrupting the business of the Complainant;"

The Expert interprets "as" in sub-paragraph i. B as being synonymous with "for the purpose of". Were it to be interpreted otherwise all domain name registrations would inevitably constitute "blocking registrations" for any later arrival wishing to use the name in question.

The Expert notes that the Domain Name is almost identical to the trademark held by the Complainant; that the Domain Name would be accessed only by a person who had mistyped the Complainant's website name and that the Domain Name is not a word or combination of words which could arise in the English language other than as a typographical error.

Accordingly, the Expert finds that each Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy on the basis that it was registered in a manner which, at the time when the registration took place, took unfair advantage of the Complainant's rights.

The Expert also notes that the Complainant's statement of the facts was very minimal and, had it not been for the inclusion of the trademark documents and a reference thereto in the 53 word Complaint, the Decision might have been different.

## **8. Decision**

**In light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name priceunner.co.uk be transferred to the Complainant.**

David Flint

02 December 2007