

## **Nominet UK Dispute Resolution Service**

**DRS Number 05323**

### **Decision of Independent Expert**

#### **1. Parties**

Complainant: CareerBuilder, LLC  
Address: 200 North La Salle Street, Suite 1100  
Chicago, Illinois  
Postcode: 60601  
Country: US

Respondent: 123 Domains Limited  
Address: C/Cecilio  
Metelo 5  
Bajos, Palme De Mallorca  
Postcode: 07003  
Country: ES

#### **2. Domain Name**

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

#### **3. Procedural Background**

The complaint of the Complainant was entered in the Nominet system on 14 December 2007. Nominet validated the complaint on 19 December 2007 and transmitted a copy of the complaint to the Respondent. No response was received from Respondent by the due date of 16 January 2008. Nominet wrote to both parties indicating that no response had been received. On 5 February 2008 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet UK Dispute Resolution Service Policy (the "Policy").

The undersigned (the "Expert") has confirmed to Nominet that I know of no reason why I cannot properly accept the invitation to act as Expert in this case and has further confirmed that I know of no matters which ought to be drawn to the attention of the parties, which might appear to call into question my independence and/or impartiality. The undersigned, Christopher Gibson, was appointed as Expert in this case on 8 February 2008.

#### **4. The Facts**

The Complainant is CareerBuilder LLC, a company that uses the name and trade mark CAREERBUILDER for its business of providing online employment recruiting services. The Complainant has submitted certificates to show that it is the owner of the registered trade mark, CAREERBUILDER (the "Mark"), in various countries including in the United Kingdom, United States, Mexico, Canada and other countries in the European Community. Complainant operates its business on the Internet through websites at [www.careerbuilder.com](http://www.careerbuilder.com) and [www.careerbuilder.co.uk](http://www.careerbuilder.co.uk), with the domain names for these sites having been registered in 1996 and 2002, respectively. Complainant owns additional domain names including: <careerbuilder.org>,

<careerbuilderinc.com>, <careerbuilderit.com>, <careerbuilderpsa.com>, <careerbuildermail.com>, and <careerbuildernetwork.info>.

From the WHOIS records, the Domain Name <careebuilder.co.uk> was registered for the Respondent, 123 Domains Limited, on 6 December 2006. The URL for the Domain Name, [www.careebuilder.co.uk](http://www.careebuilder.co.uk), resolves to a web site containing links to sites providing employment and job listing services.

## **5. The Parties' Contentions**

### Complainant's Complaint

The Complainant contends that the Domain Name in dispute is identical or similar to a name or mark in which it has Rights and that the Domain Name in the hands of the Respondent is an Abusive Registration.

### Complainant Rights:

The Complainant asserts that it has Rights in a name and mark which is identical or similar to the Domain Name. As noted above, the Complainant has provided documentary evidence of Rights in the Mark, CAREERBUILDER, both in the United Kingdom and elsewhere. The Complainant's submits that its trade mark rights, dating from 1996, pre-date the Respondent's registration of the Domain Name in December 2006. The Complainant states that during the last eleven years it has expended significant time, money and effort to establish public recognition of its Mark, so that the Mark will identify Complainant as a provider of quality services in the employment recruitment industry. As result of these efforts, Complainant asserts that its Mark has become one of its most valuable assets. Complainant has established substantial goodwill in the Mark through promotion, advertising and use of the Mark and, as a result, it has become distinctive and well recognised in employment recruiting throughout much of the world.

The Complainant asserts that the Domain Name is confusingly similar to its name and Mark, explaining that they are essentially identical, visually, phonetically and in connotation and commercial impression. The Domain Name features a slight variation that differs by the omission of the letter "r" and can be considered as a so-called typographical error case. In Complainant's view, this misspelling is designed to take advantage of Internet users who either mistype or do not know the correct spelling of Complainant's Mark. Thus, use of the Domain Name is likely to confuse the public into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with, the Complainant, and that services offered at the website associated with the Domain Name are connected with, or endorsed by, the Complainant. The Complainant states that Respondent has no rights or legitimate interests in the Domain Name, has no connection or affiliation with Complainant, and has received no license or consent to use the Complainant's Mark in the Domain Name or in any other manner.

### Abusive Registration:

The Complainant contends that the Respondent was aware of the Complainant when it registered the Domain Name, as evidenced by the fact that Respondent's website has included at least one link to the Complainant's websites at [www.careerbuilder.co.uk](http://www.careerbuilder.co.uk) and [www.careerbuilder.com](http://www.careerbuilder.com). The Complainant further asserts that Respondent knew of and sought to capitalise from the repute and value of the Complainant's Mark and the high traffic volume to the Complainant's site at

[www.careerbuilder.co.uk](http://www.careerbuilder.co.uk), by creating a website using the Domain Name that contains hyperlinks to online employment-related search engines and other third party websites in direct competition with Complainant. By registering the Domain Name and misdirecting users who are seeking Complainant's website, the Respondent is making a clear attempt to leverage use of the Complainant's Mark, reaping commercial gain for the Respondent and/or for the benefit of competing on-line recruitment services companies which are not sponsored or endorsed by or affiliated with Complainant. Diverting Internet users to such third party websites for commercial advantage constitutes bad faith use of the Domain Name. The Complainant also contends that the Respondent's use of the Domain Name dilutes the distinctive qualities and goodwill associated with the Mark.

The Complainant states that it has already successfully prosecuted claims against previous owners of similar domain names. Examples of these cases include: CareerBuilder, LLC v. NextS Business Development; Case No. D2005-1117, (WIPO December 12, 2005) (transferring <careersbuilder.net> to Complainant); CareerBuilder, LLC v. Names for sale, Case No. D2005-0186, (WIPO April 20, 2005) (transferring <careersbuilder.com> to Complainant); CareerBuilder LLC v. Karen Vithe, Case No. D2004-0370, (WIPO August 3, 2004), (transferring <careersbuilder.com> to Complainant); CareerBuilder, Inc. v. John Zuccarini, Case No. D2002-0282, (WIPO May 21, 2002) (transferring <careerbuilder.com> to Complainant); CareerBuilder, LLC. v. Azra Khan, Case No. D2003-0493, (WIPO August 5, 2003) (transferring <careeerbuilder.com> to Complainant); CareerBuilder, Inc. v. Amcore & Company For sale domains \$250 or best offer, Case No. D2003-0872, (WIPO December 18, 2003) (transferring <careerbulder.com> to Complainant); CareerBuilder, Inc. v. John Morgan, Case No. D2003-0907, (WIPO January 13, 2004) (transferring <carerbuilder.com> to Complainant).

The Complainant notified Respondent of the complainant's rights on 1 August 2007, when it sent a cease and desist letter to the Respondent. The letter informed Respondent that Complainant had existing rights in the Mark and that Respondent had registered the confusingly similar Domain Name. Complainant requested undertakings from Respondent, including immediately ceasing to use the Domain Name. The Complainant also demanded that Respondent execute a deed of assignment in relation to the Domain Name. The deadline for replying to the letter was 15 August 2007 and the Respondent never replied. The Complainant contends that the Respondent's refusal to respond and/or relinquish the Domain Name after receiving notice of the alleged infringement of Complainant's Mark demonstrates that Respondent has no intention of respecting or recognising Complainant's Mark or its rights, thereby demonstrating that Respondent is acting in bad faith.

#### Respondent's Response

The Respondent has not responded, and therefore has raised no challenge to any of the facts and statements submitted by the Complainant.

### **6. Discussion and Findings:**

#### General

In order to succeed in these proceedings, paragraph 2(b) of the DRS Policy requires the Complainant to prove on the balance of probabilities that both elements of the test set out in paragraph 2(a) are present:

- i. the Complainant 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.

### Complainant's Rights

The Complainant has submitted documentary evidence to establish that it has Rights in its CAREERBUILDER name and Mark, which pre-date the Respondent's registration of the Domain Name. The Domain Name contains the distinctive part of the Complainant's Mark, omitting only the single letter "r". The Mark CAREERBUILDER is distinctive both in the placement of the words "career" and "builder" together and through its acquired goodwill and reputation in relation to online employment recruiting services. The Domain Name is therefore similar to a name or mark in which the Complainant has Rights. The Complainant has established the first element of the test in paragraph 2(a) of the DRS Policy.

### Abusive Registration

As to whether the Domain Name registration is abusive in the hands of the Respondent, paragraph 1 of the DRS 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."

The Expert should take into account all relevant facts and circumstances in determining whether the Domain Name is an Abusive Registration.

The Expert is persuaded by the Complainant submissions that the Domain Name registration and use is abusive. First, the Expert agrees with the Complainant's contention that the Respondent was aware of the Complainant's name and Mark at the time it registered the Domain Name in 2006. By that time, the Complainant had acquired reputation and goodwill its Mark, which had been used widely in commerce since 1996. Moreover, the Domain Name is virtually identical to the Complainant's Mark, with the omission only of the single letter "r" where it would normally be placed if "careebuilder" was spelled correctly.

Second, the Domain Name resolves to a web site with links to other third-party search engines and sites in direct competition with the Complainant's business of providing on-line recruitment services. The Respondent's site is clearly taking advantage of the Complainant's reputation and goodwill developed in on-line commerce. When considered in view of the circumstances discussed above, the Expert finds that Respondent registered and has used the Domain Name as an Abusive Registration.

Accordingly, the Panel finds on the balance of probabilities that the Domain Name, in the hands of the Respondent, is an Abusive Registration

## **7. Decision**

The Expert finds that the Complainant has Rights in respect of a name or mark which is similar or identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name, <careebuilder.co.uk>, be transferred to the Complainant.

Christopher Gibson  
29 February 2008