

DISPUTE RESOLUTION SERVICE

DRS 07039

Decision of Independent Expert

RecycleBank LLC

and

Mark Adams

1. The Parties:

Complainant: RecycleBank LLC.
Address: c/o Jonathan A Fallon
Maldjian & Fallon LLC
365 Broad Street
Third Floor
Red Bank
New Jersey

Postcode: 07701
Country: United States

Respondent: Mark Adams
Address: 3DWeb Online Services
PO Box 399
Tunbridge Wells
Kent

Postcode: TN2 9JW
Country: United Kingdom

2. The Domain Name(s):

recyclerewards.co.uk
recyclebank.co.uk

3. Procedural History:

1. A copy of the Complaint was received in full by Nominet on 21st March 2009. Nominet validated the Complaint and notified the Respondent of the Complaint.
2. No Response has been received and therefore informal mediation was not possible.
3. On 30th April 2009 the Complainant paid the fee to obtain the expert decision pursuant to paragraph 21 of the procedure for the conduct of proceedings under the Nominet Dispute Resolution Service (“the Procedure”)
4. On 30th April 2009, Nick Phillips, the undersigned (“the Expert”), confirmed to Nominet that he knew no reason why he could not properly accept the invitation to act as the 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 question his independence and/or impartiality.
5. The Respondent has not submitted a response to Nominet in time (or at all) in compliance with paragraph 5(a) of the Procedure.
6. Paragraph 15(b) of the Procedure provides, inter alia, that “if, in the absence of exceptional circumstances, a party does not comply with any time periods laid down in the policy of this procedure, the Expert will proceed to a decision on the Complaint”.
7. Nominet appears to have used all of the available contact details to try to bring the Complaint to the Respondent’s attention. Consequently, there do not appear to me to be any exceptional circumstances

involved and I will therefore proceed to a decision on the Complaint notwithstanding the absence of a Response.

4. Factual Background

1. The Complainant is RecycleBank LLC.
2. The Respondent is Mark Adams who trades as 3DWeb Online Services.
3. The Complainant is the registered proprietor of two U.S federal trademark registrations for which include or consist of the mark RECYCLEBANK namely:
 - U.S Reg. No. 3,335,977 for RECYCLEBANK
 - U.S Reg. No. 3,335,978 for RECYCLEBANK (and design)

Both marks have a filing date of 1st November 2004 and both were registered on 13th November 2007. The “first use” date given for both is 28th February 2005.

4. The Complainant has made applications for further trade mark registrations in the U.S. and internationally including at least three Community Trade Mark Applications for marks containing or consisting of the words “RECYCLEBANK” and “RECYCLEREWARDS”. These were all filed after the two US registrations referred to above and are all in the application stage.
5. The Complainant is the proprietor of 45 domain names, the majority of which contain or consist of the word “recyclebank” or variations thereof. The domain names owned by the Complainant include:
 - i. Recyclebank.com
 - ii. Recyclebank.net
 - iii. Recyclebank.org
 - iv. Recyclerewards.com

- v. Recyclerewards.net
 - vi. Myrecyclebank.co.uk
 - vii. Recyclebanker.co.uk
 - viii. Recyclebanking.co.uk
6. The Complainant's business concerns, inter alia, encouraging people to recycle their rubbish by offering points or rewards linked to the volume of rubbish recycled. These points or rewards once earned can be exchanged for goods and services.
 7. The Respondent's business is primarily a web development consultancy and advertises itself as specialising in the, "...use of quality generic domain names".
 8. The Domain Names were first registered by the Respondent, Mark Adams. Recyclebank.co.uk was first registered on 27th December 2004 and recyclerewards.co.uk was first registered on 2nd March 2006.
 9. The Complainant first wrote to the Respondent on 27th February 2009, seeking the transfer of the Domain Names but received no reply. This letter was sent to the address given for 3D Web Online Services on its website rather than the address on the "WHOIS" search.
 10. On 4th March 2009 the Complainant attempted to contact the Respondent again through the "contact" section of the 3D Web Online Services website. No reply was received.
 11. Both the Domain Names are linked to "parking pages" which contain a number of links to other businesses many of which are in the recycling field and both sites invite enquiries from anyone interested in buying either Domain Name.

5. Parties' Contentions

The Complainant's Submissions:

1. The Complainant owns two US trade marks for the mark RECYCLEBANK and has made applications to register the mark RECYCLEREWARDS along with a number of other related marks.
2. The Complainant owns at least 45 domain name registrations including recyclebank.com, recyclerewards.com and variations thereof.
3. The Complainant has attempted to contact the Respondent to inquire about the domain names in dispute but to this date no response has been received.
4. The Complainant asserts that it has rights in the marks as the proprietor of registered trade marks and a multitude of pending applications.
5. The Complainant submits the Domain Names are inherently likely to lead people to believe the Complainant is connected with the Domain Names as the Domain Names are exactly the Complainant's marks.
6. The Complainant states it has no connection with the Respondent and has never authorised or licensed the use of its RECYCLEBANK or RECYCLEREWARDS marks to the Respondent in any way, including the use as part of a domain name. Therefore the Respondent has no rights or legitimate interest in the Domain Names.
7. The Complainant asserts that the Respondent is a cybersquatter by definition and in the business of obtaining abusive registrations. It submits that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well known trade marks in which the Respondent has no apparent rights, and the Domain name is part of that pattern.

8. The Complainant submits that the Domain Names were registered in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

The Respondent's Submissions:

The Respondent has not filed a Response and therefore there are no submissions to consider.

6. Discussions and Findings

Rights

General

1. Under paragraph 2 of the Dispute Resolution Service Policy ("the Policy") the Complainant is required to show, on the balance of probabilities, that;
 - (1) *it has rights in respect of a name or mark which is identical or similar to the Domain Names; and*
 - (2) *the Domain Names in the hands of the Respondent are an Abusive Registration.*

Complainant's Rights

2. The first question I must answer is therefore whether the Complainant has proved on the balance of probabilities that it owns Rights in a name or mark that is identical or similar to the Domain Names.
3. The Policy defines rights as including but not limited to “...rights enforceable under English laws.” This has always been treated in decisions under Nominet DRS as a test with a low threshold to overcome and I think that that must be the correct approach.
4. The Complainant has two US registered trade marks which consist of or contain the word RECYCLEBANK, one of which is for the word RECYCLEBANK alone. It also has a number of pending applications for marks consisting of or containing the word RECYCLEBANK. Further it has a large portfolio of domain names many of which consist of or contain the word “recyclebank” or variations thereof.
5. In the circumstances I have no difficulty in finding that the Complainant has Rights in the name or mark RECYCLEBANK.
6. In relation to RECYCLEREWARDS the Complainant has no registered trade marks although it does have a number of trade mark applications. It does however own the domain names, recyclerewards.com, recyclerewards.net and recyclerewards.ca. There is however an absence of information or evidence in the Complaint about the use of RECYCLEREWARDS.
7. The position with RECYCLEREWARDS is therefore more difficult. I am not prepared to conclude that the existence of trade mark applications, as opposed to granted registrations, is enough to give the Complainant Rights. However given the low threshold test for Rights under the Policy I am prepared to conclude that the fact that the Complainant owns domain names which consist of this word

and uses these domain names to operate live websites which promote its business is enough to give the Complainant Rights.

8. I must now decide whether the names or marks in which the Complainant has Rights are identical or similar to the Domain Names. On this issue, ignoring as I must do the first and second level suffixes, the Domain Names are identical to the names or marks RECYCLEBANK and RECYCLEREWARDS and therefore I find that, on the balance of probabilities, the Domain Names are identical or similar to names or marks in which the Complainant has Rights.

Abusive Registration

9. Having concluded that the Complainant has Rights in names or marks which are identical or similar to the Domain Name, I must consider whether the Domain Name constitutes an Abusive Registration. Abusive Registration is defined in the Policy as

*“... a domain name which either
(a) was registered or otherwise acquired in the 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
(b) has been used in a manner which took unfair advantage of, was unfairly detrimental to the Complainant’s Rights.”*

This definition allows me to consider whether the Domain Names constitute Abusive Registrations at any time and not, for example, just the time of registration/acquisition.

10. Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may evidence that a domain name is an Abusive Registration. It is worthwhile setting out paragraph 3 of the Policy in full:

- “3. *Evidence of Abusive Registration*
- 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;*
 - 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;*
 - ii. *Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;*
 - iii. *The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;*
 - iv. *It is independently verified that the Respondent has given false contact details to us; or*
 - v. *The domain name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:*
 - A *has been using the domain name registration exclusively; and*
 - B *paid for the registration and / or renewal of the domain name registration.*
- b. *Failure on the Respondent’s part to use the Domain Name for the purposes of e-mail or a website is not in itself evidence that the Domain Name is an Abusive Registration.*
- c. *There shall be a presumption of Abusive Registration if the complainant proves that Respondent has been found to have made an Abusive Registration in three (3) or more Dispute Resolution Service cases in the two (2) years before the complaint was filed. This presumption can be rebutted.”*

11. Paragraph 3a of the Policy is a list of non-exhaustive factors which may be evidence that the Domain Names are an Abusive Registration. It is however also relevant to consider in broader terms whether the Domain Names constitute Abusive Registrations within the definition set out in the Policy.

12. The Complaint is a slightly curious document because it appears to have been drafted, originally at least, more with the UDRP, rather than Nominet's DRS Policy, in mind. The Complainant's case, however, is in essence that the Complainant has Rights in the marks or names RECYCLEBANK and RECYCLEREWARDS and that the Domain Names are inherently likely to lead people to believe that the Complaint is connected with the Domain Names. The Complaint also addresses a range of potential defences that may be open to the Respondent and points to the Respondent's "habit" of obtaining domain name registrations containing other well known trade marks as establishing a pattern of abusive registrations under Paragraph 3(a)(iii) of the Policy.

13. It is well established that in order for the Complainant to establish Abusive Registration it must show that the Respondent had knowledge of its Rights either at the time of registration or at the time of the conduct complained of. The one exception to this is in a Complaint based on giving false contact details under Paragraph 3 (a)(iv) which is not alleged here. This, and other principles, are set out in the Appeal Panel's decision in *Verbatim Ltd v Michael Toth DRS04331*,

"In this Panel's view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:

- (1) *First, some knowledge of the Complainant and/or its brand/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.*

- (2) *Secondly, 'knowledge' and 'intention' are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i)*

- (3) *Thirdly, 'intention' is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.*
- (4) *Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv)), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.*
- (5) *Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.*
- 8.14 *Accordingly, in the view of this Panel, for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name."*

14. The Appeal Panel in Verbatim also referred to the decision in *rileys.co.uk DRS 04769* and it is worth reproducing a short extract from that decision as follows:-

"The onus is on the Complainant to make out its case. Is the Complainant so famous that the Respondent must have had the Complainant in mind when registering the Domain Name and for the abusive purposes alleged by the Complainant, namely to damage the Complainant's business or to extort money from the Complainant?"

The Complainant has made no attempt to demonstrate to the Expert the fame of the Complainant's brand. There are no details of its business over the years, nothing in the way of sales figures or promotional or advertising material. Accordingly, the Expert is simply not in a position to make any inference adverse to the Respondent on that basis.

Is there anything else about the Respondent's behaviour meriting an adverse inference to be drawn? The Respondent from its own submissions appears to have suffered previously under the Nominet DRS Policy, but there are no details in the papers before the Expert; nor are there any details of any other obviously objectionable domain names in the Respondent's portfolio of domain names. They may exist (the Expert does not know), but there is no evidence to that effect before the Expert."

15. In this case there is a complete absence of information in the Complaint about how well used or well known RECYCLEBANK and RECYCLEREWARDS are. My own feeling is that neither mark is very well known, certainly in the UK, although I accept that I am to a degree acting as my own witness and particularly that I cannot speak in any way about how well known these names or marks are outside the UK. They are certainly not the kind of marks which one would immediately recognise as household names. In the absence of anything more tangible from the Complainant, I do not see how I can conclude anything else.
16. However, both RECYCLEBANK and RECYCLEREWARDS are by no means words in everyday use in the English language albeit that they do both consist of two ordinary words put together. It could be said that both marks or words are mildly descriptive and given the increasing interest in the promotion of recycling and of green issues, it is not terribly surprising to see this kind of combination used although the exact choice or formulation of these words expressions is not, to my mind at least, a particularly obvious one.
17. Considering first the Respondent's registration of the Domain Names one relevant issue in this case is that of timings. The Respondent registered recyclebank.co.uk on 27th December 2004 and recyclerewards.co.uk on 2nd March 2006.
18. The Complaint does not contain any information about the Complainant's business other than its ownership of trade marks and

19. The Respondent's registration of recyclebank.co.uk does post-date the Complainant's US trade mark registration for the word RECYCLEBANK which was filed on 1st November 2004 although interestingly it pre-dates the Complainant's stated date of first use of this mark which is given as 28th February 2005. In relation to RECYCLEREWARDS the Respondent's registration of recyclerewards.co.uk pre-dates the Complainant's earliest trade mark application for this mark (US Application no. 77385607 filed on 31st January 2008) by almost two years.
20. These dates and the complete lack of any evidence about the Complainant's historic use of either mark makes this a difficult case to decide.
21. The Respondent registered recyclebank.co.uk just under 2 months after the Complainant filed its US trade mark registrations for RECYCLEBANK. This is slightly suspicious and I could therefore speculate that this was done opportunistically by the Respondent in order to take unfair advantage of a mark that had just appeared on the USPTO database and/or with knowledge of the Complainant's business. However, and as I have said, there is absolutely nothing in the Complaint to suggest that the Respondent would have known about the Complainant's mark and indeed the date of first use given by the Complainant to the USPTO actually post dates the Respondent's registration of the domain name recyclebank.co.uk.
22. In relation to recyclerewards.co.uk the Complainant's position is even more difficult. There is no evidence whatsoever that the

Complainant used the mark RECYCLEREWARDS prior to the Respondent registering recyclerewards.co.uk and indeed the Complainant's earliest trade mark application for this mark post-dates the Respondent's domain name registration by over two years.

23. Under the Policy it is of course not just relevant to consider whether the Domain Names amounted to Abusive Registrations as at the time of registration or acquisition. It is also relevant to consider whether the Domain Names have been used in a manner which took unfair advantage of, or were unfairly detrimental to the Complainant's Rights.

24. The Complainant does not provide any details about the Respondent's historic use of the Domain Names. However, the Respondent's current use of the Domain Names is to link to a parking page which advertises a range of recycling type goods and services which do not appear to be obviously connected to either the Complainant or the Respondent. The use of such parking pages is not of course automatically objectionable under the Policy and this is set out in Paragraph 4(e) of the Policy. There is no evidence to suggest that the Respondent has selected the links on the parking page in order to take advantage of the Complainant's Rights. Indeed, given the nature of the Domain Names and given the fact that they both contain the word "recycle" it is not surprising that the kind of links that have been generated on the parking page relate to business' whose offering is in the field of recycling. Without any evidence that what the Respondent is doing is actually taking unfair advantage of the Complainant's Rights, causing unfair detriment to the Complainant's Rights or indeed even that the Respondent would have known about the Complainant's Rights, I do not think that this use justifies a finding of Abusive Registration.

25. I am aware of the two recent decisions of the Appeal Panel which I should refer to before going any further. These are the decisions in *My Space v Total Web Solutions DRS 04962* and *Oasis Stores Limited v Mr J Dale DRS 06365*. These cases both involved situations where the respondent had registered a domain name in good faith independently of the complainant but had subsequently gained an advantage because of the use which the complainant subsequently made of that domain name without any action on behalf of the respondent.
26. In both cases the Appeal Panel found for the respondent and its reasoning can be summarised in the following extract from the MySpace decision:
- “... the registration of domain names is still a first-come-first-served system and the Panel is reluctant to place any duty on a registrant, who has merely had the good fortune (or maybe ill fortune) to register a name in good faith, which subsequently, through no fault of his own, acquires notoriety, provided that he does nothing actively to exploit his position”.*
27. In the absence of any evidence to the contrary from the Complainant, it seems to me that this is more or less the situation in this case. I accept that the fact that the Respondent’s first Domain Name, i.e. recyclebank.co.uk was only registered a month or so after the Complainant first filed for a US trade mark application for RECYCLEBANK and that the fact that the Respondent has ended up with two Domain Names which contain two of the Complainant’s trade marks exactly is suspicious. However, ultimately that evidence on its own is not enough for me to make a finding of Abusive Registration. Fundamentally, there is absolutely no evidence that the Respondent would have known about the Complainant’s Rights either at the time of registration or otherwise. Evidence of use of its marks from the Complainant may well have addressed this but nothing at all has been included in the Complaint. Also, the nature of the Domain Names means that it is certainly well within the

realms of possibility that the Respondent would have come up with these names independently.

28. The only other point that I would deal with separately, although ultimately it in itself must stand and fall on the basis of the Respondent's knowledge, or otherwise, of the Complainant's Rights, is the Complainant's allegation that the Respondent has acted contrary to Paragraph 3(a)(iii) of the Policy, and has engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Names are part of that pattern.

29. In making this allegation, the Complainant points to the fact that the Respondent has registered a number of domain names comprising of/and including the well known trade marks of others. Examples given by the Complainant are *goldenarches.co.uk*, *beverleyhillscop.co.uk*, *bigbrothertv.co.uk*, *popidol4.co.uk*, *forestgump.co.uk*, *phonenames4u.co.uk* and *netnames4u.co.uk*. The Respondent has been involved in at least one other case under Nominet DRS. This was the *decision* in *maestro.co.uk* DRS 04884 which the Respondent won on appeal. In *Maestro* the complainant made essentially the same point, in relation to this alleged pattern of Abusive Registrations.

30. Like the Appeal Panel in *Maestro* while I accept that the domain names listed out above may well form part of a pattern the Domain Names are different. They are names which the Respondent could quite conceivably have come up with on his own and there is no evidence that the Respondent would have known about the Complainant's Rights. Indeed *recyclebank.co.uk* was registered before the Complainant's "first use" date on its earliest US trade marks and *recyclerewards.co.uk* was registered some two years

31. Further, the Respondent openly trades in the use (and presumably therefore sale) of generic Domain Names. There is inherently nothing wrong with this and while some of the names in the Respondent's portfolio may be objectionable it is likely that the Respondent will own or have owned many that are not. Indeed, if I had a full list of all the domain names owned by the Respondent and could consider these objectionable registrations in the context of a far greater number of registrations that may well cast a very different light on the alleged "pattern".
32. Additionally, the two Domain Names were registered over a year apart.
33. However, the existence of clearly objectionable domain names in the Respondent's portfolio does put this Complaint in a slightly different light and causes me to scrutinise the Respondent more carefully. It may well be that the Respondent was up to no good when it registered the Domain Names and that it did so opportunistically in full knowledge of the Complainant's Rights. The evidence to support such a finding is however very thin indeed. In relation to recyclebank.co.uk it would involve me being satisfied that (on the basis of no use by the Complainant) the Respondent was aware of the Complainant's US trade mark applications for RECYCLEBANK almost as soon as they were filed. In relation to recyclerewards.co.uk there is simply no evidence at all.
34. The position in relation to recyclerewards.co.uk is therefore clear cut. I do not see how I can do much else but find for the Respondent. In relation to recyclebank.co.uk the position is more marginal and my decision is very difficult. However on balance I do not think that there is quite enough here to find Abusive Registration and I will

find for the Respondent in relation to this domain name as well. I would re-iterate that if the Complainant had focussed more on the requirements of the Policy and had at the very least included some evidence of use of its marks then my decision may have been very different.

35. I therefore find on the balance of probabilities, that while the Complainant has proved that it has Rights in names or marks which are identical or similar to the Domain Names, it has failed to prove that either Domain Name is an Abusive Registration in the hands of the Respondent.

7. Decision

For the reasons set out above I find, on the balance of probabilities, that the Complainant has Rights in names or marks which are identical or similar to the Domain Names, but that the Complainant has failed to show that the Domain Names in the hands of the Respondent are Abusive Registrations. I therefore direct that no action should be taken in relation to the Domain Names.

Signed: Nick Phillips

Dated: 28 May 2009