

## DISPUTE RESOLUTION SERVICE

D00015140

### Decision of Independent Expert

j2 Global Holdings Limited

and

Another.com Limited

#### 1. The Parties:

Complainant:

j2 Global Holdings Limited

Arthur Cox Building, Earlsfort Terrace, Dublin 2

Dublin

Ireland

Respondent:

Another.com Limited

Montagu Pavilion

8 - 10 Queensway

Gibraltar

Gibraltar

PO BOX 575,

Gibraltar

#### 2. The Domain Name:

keepitsafe.co.uk

#### 3. Procedural History:

- 3.1 I 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 to 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.

### 3.2 Timeline

01 December 2014 16:31 Dispute received  
02 December 2014 09:44 Complaint validated  
02 December 2014 09:53 Notification of Complaint sent to Parties  
19 December 2014 01:30 Response reminder sent  
24 December 2014 09:16 No Response Received  
24 December 2014 09:16 Notification of no Response sent to Parties  
06 January 2015 12:33 Expert decision payment received

## 4. Factual Background

4.1 The Complainant is part of the j2 Global Inc. group of companies which provide cloud based computer services around the world.

4.2 The Complainant is the owner of a number of trade mark applications and registrations for and/or incorporating the mark "KEEPITSAFE" in the United Kingdom, Germany, Spain, Canada and other countries around the world. The Complainant is also the owner of three Community Trade Mark applications for figurative marks all of which incorporate the word "KeepItSafe". Each of these applications has been opposed by a third party.

4.3 The Domain Name was registered on 12 January 2000.

## 5. Parties' Contentions

### The Complainant

5.1 The Complainant's contentions are summarised as follows:

#### Rights

5.2 The Complainant asserts that j2 Global Inc. is the parent company of j2 Cloud Services, Inc and that the Complainant is a wholly owned subsidiary of j2 Cloud Services, Inc. The Complainant contends that its predecessor in title was Keepitsafe Data Solutions Limited, a company incorporated in Ireland on 26 November 2007. According to the Complainant, Keepitsafe Data Solutions Limited is in the process of being wound up and all of its assets were transferred to j2 Global Ireland Limited, whose parent company is the Complainant. The Complainant contends that there is a licence in place between j2 Global Ireland Limited and the Complainant that covers trade mark usage.

- 5.3 The Complainant contends that one of the businesses within the j2 Global Inc. group of companies operates under the trade mark “KeepItSafe”, providing data protection services to businesses.
- 5.4 The Complainant asserts that its KeepItSafe mark has been in use in the United Kingdom since 2008.
- 5.5 The domain name <www.keepitsafe.com> was registered on 5 January 2004. The Complainant contends that it is the owner of this domain name but that the registrant of this domain name is j2 Global Communications, Inc. According to the Complainant, this company has been renamed as j2 Cloud Services, Inc. and is part of the j2 Global Inc. group.
- 5.6 The Complainant contends that it also owns a large number of other relevant domains incorporating its “KeepItSafe” trade mark or variations thereof.

#### Abusive Registration

- 5.7 The Complainant contends that there is no relationship between the Complainant and the Respondent. The Complainant claims that it has not authorised the Respondent to use its trade mark.
- 5.8 The Complainant claims that the Domain Name is not currently in use and does not appear to have ever been in use.
- 5.9 The Complainant asserts that the Respondent is using the Domain Name primarily for the purposes of selling it for valuable consideration in excess of the Respondent’s costs associated with registering it.
- 5.10 The Complainant contends that it has made a number of attempts, spanning several years, to purchase the Domain Name from the Respondent. The most recent of these attempts was made in January 2014, but in response to the Complainant’s email enquiry the Complainant received an auto-generated reply from the Respondent stating that:
- “Most of the domains at another.com are part of a large movie community project launching in 2014, and therefore not for sale at any reasonable amount. We have sold a few domains, but prices are always above £7500. If you are still interested at the price you can reply to this email with an offer.”*
- 5.11 The Complainant contends that after internal consultation, it replied to say that it would be willing to pay £7500 for the Domain Name but no more, in order to secure the .co.uk domain name corresponding with its registered trade mark.
- 5.12 The Complainant received a reply from the Respondent stating that the Domain Name was not available at that price and that although *“the domain is not actually on the market...we’re not able to let it go unless we get a significantly higher offer”*. The Complainant contends that these two

statements are contradictory. The same email referred to the Respondent having already turned down an offer of double the amount that the Complainant had offered. All of this supports the Complainant's contention that the Domain Name was registered primarily for the purposes of selling it for valuable consideration.

- 5.13 The Complainant argues that the Respondent's refusal to sell the Domain Name for a reasonable amount constitutes an attempt to block the Complainant from registering the Domain Name in which it has rights, and that this unfairly disrupts the Complainant's business.
- 5.14 According to the Complainant, whilst only the Respondent can know what its motive was at the point of registering the Domain Name, its subsequent conduct is clearly unfair and has resulted in the Domain Name being currently "abusive".
- 5.15 The Complainant contends that there has never been any use of the Domain Name since its registration on 12 January 2000. Whilst it is acknowledged that, in accordance with paragraph 3(b) of the DRS Policy a lack of use of a Domain Name is not in itself evidence that it is abusive, the situation here involves a lack of use for nearly 15 years.
- 5.16 The Complainant's earliest registered interest in the trade mark "keepitsafe" dates from the registration of the domain name <www.keepitsafe.com> in 2004. Whilst this postdates the date of registration of the Domain Name, it is noted from the DRS guidance on what constitutes an abusive registration and from the DRS Experts Overview that this is not necessarily determinative.
- 5.17 The Complainant argues that the Respondent's lack of use of the Domain Name for nearly 15 years, coupled with its behaviour during purchase discussions, point towards the Domain Name currently being an Abusive Registration.
- 5.18 The Complainant contends that the Respondent is the owner of hundreds of domain names. The Complainant acknowledges that the mere registration of domain names and their lack of use may not, in itself, constitute abuse. However, the Complainant asserts that the sheer numbers of domains registered means the Respondent is able to block and control the desired Internet addresses of many third parties.

### The Respondent

- 5.19 The Respondent did not file a Response.

## **6. Discussions and Findings**

### General

- 6.1 The Complainant is required under paragraph 2(b) of the Policy to prove to the Expert, on the balance of probabilities, that:
- (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.
- 6.2 Where no Response has been received, as is the case here, it is still necessary for the Expert to be satisfied that the elements necessary to establish the Complainant's Rights and to make a finding of Abusive Registration are present in order for the Complainant's case to succeed.

### Complainant's Rights

- 6.3 Paragraph 1 of the Policy provides that 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*". Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.
- 6.4 Further, it is well accepted that the question of whether the Complainant has Rights falls to be considered at the time that the Complainant makes its Complaint and is a test with a low threshold to overcome.
- 6.5 The Complainant is the owner of some trade mark registrations which incorporate the term "KeepItSafe" in its entirety. The majority of these registrations are prefixed by a device. However, the "KeepItSafe" word element covered by these registrations is in my opinion sufficiently dominant for the Complainant to have Rights in respect of "KeepItSafe".
- 6.6 Accordingly, on the basis of the Complainant's trade mark registrations that incorporate the word mark "KeepItSafe", I find that the Complainant has Rights in the mark "KeepItSafe" and that this mark (disregarding the .co.uk suffix) is identical to the Domain Name.
- 6.7 Although the Complainant has made out its case on Rights, it is however worth noting that the Complainant also seeks to rely on numerous domain name registrations incorporating the mark "keepitsafe" to establish that it owns rights in the term. However, in a number of cases the registrant of these registrations is not the Complainant. For instance, the registrant of the domain name <www.keepitsafe.com> is j2 Global Holdings, Inc.
- 6.8 In addition and for the sake of completeness, but again not fatal to the Complainant's case on Rights, I note that all of the trade mark registrations that incorporate the word mark "KeepItSafe" as adduced by the Complainant in its evidence appear to postdate registration of the Domain Name. This is, however, a relevant factor to consider when assessing the second limb of the Policy, namely whether the Domain Name, in the hands

of the Respondent, is an Abusive Registration and I will therefore address this point under the Abusive Registration section of my decision below.

### Abusive Registration

- 6.9 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 took unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.
- 6.10 The Policy provides for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.

### Abusive Registration under Paragraph 1(i) of the Policy

- 6.11 Paragraph 3(a)(i) of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under paragraph 1(i) of the Policy, as follows:

*“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;”*

- 6.12 The Complainant seeks to rely on all three of the above circumstances to prove its case on Abusive Registration. However, it is important to note that Paragraph 3(a)(i) of the Policy relates to the Respondent’s motives at the time of registration (or other acquisition) of the Domain Name and therefore, for any of the circumstances listed under paragraph 3(a)(i) to apply, it follows that the Complainant must establish that the Respondent had knowledge of the Complainant and/or its rights at the time that the Respondent registered or otherwise acquired the Domain Name.

- 6.13 The Complainant has not submitted any evidence to show that it (or indeed any of the companies within the same group as the Complainant) had established any form of rights in respect of the mark “KeepItSafe” prior to the date of registration of the Domain Name by the Respondent. The evidence that the Complainant has submitted in respect of its rights can be grouped into three categories:
- trade mark registrations and applications for the mark “KeepItSafe” (the majority of those in figurative form with a device mark prefixing the term “KeepItSafe”);
  - domain name registrations incorporating the term “keepitsafe”; and
  - contentions that the mark “KeepItSafe” has been used in the course of trade since 2004, to provide data protection services to businesses.
- 6.14 In respect of the trade mark registrations, trade mark applications and domain name registrations referenced by the Complainant in its Complaint and supporting material, all of these appear to postdate the date of registration of the Domain Name by the Respondent.
- 6.15 The Complainant’s evidence in support of its contentions regarding use of the mark “KeepItSafe” in the course of trade since 2004 is extremely limited. Other than bare assertions that the Complainant has built up rights and goodwill in its “keepitsafe” trade mark since 2004, and that this mark has been used in the UK since 2008, the Complainant has provided (i) a Certificate of Incorporation dated 26 November 2007 for a company incorporated in Ireland named Keepitsafe Data Solutions Limited, (ii) copies of two invoices dating from 2008 to a UK customer, each of which bear the mark “keepitsafe” at the top of the invoice, (iii) copies of two media articles from 2009 (both from the Irish press) referencing the “KeepItSafe” name and (iv) printouts from the Internet Archive Wayback Machine dating back to 2008 showing use made of the <www.keepitsafe.com> domain name. There is no evidence to support any use of the mark “KeepItSafe” prior to registration of the Domain Name by the Respondent.
- 6.16 Even though there is no Response in this case (and therefore the Respondent has not provided any evidence of its own to address whether or not it was aware of the Complainant and/or its rights, or what its motives were, at the time of registration of the Domain Name), it is for the Complainant to establish, on the balance of probabilities, that the Respondent was aware of the Complainant and/or its rights at the time of registration of the Domain Name in order for there to be an Abusive Registration under Paragraph 1(i) of the Policy.
- 6.17 There is no evidence before me to make a finding that, on the balance of probabilities, the Respondent was aware of the Complainant and/or its rights at the time of registration of the Domain Name. The following statement in the Complaint supports this:

*“...only the Respondent can know what its motive was at the point of registering the Domain Name.”*

- 6.18 The Complainant cannot therefore rely on any of the circumstances listed in paragraph 3(a)(i) of the Policy to prove its case on Abusive Registration and accordingly I find that the Domain Name, in the hands of the Respondent, is not an Abusive Registration under paragraph 1(i) of the Policy.

Abusive Registration under Paragraph 1(ii) of the Policy

- 6.19 Paragraph 1(ii) of the Policy addresses use of the Domain Name post registration. There is a non-exhaustive list of factors under the Policy which may be evidence that the Domain Name is an Abusive Registration, including paragraph 3(a)(ii) which states:

*“Circumstances indicating that the Respondent 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.”*

- 6.20 In the event that the Complainant seeks to rely on the circumstances set out in paragraph 3(a)(ii) of the Policy it is for the Complainant to satisfy the Expert, on the balance of probabilities, that those circumstances apply in the case.
- 6.21 The Complainant has submitted no evidence of actual confusion of people or businesses believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant. Indeed, the Complainant contends that there has never been any use of the Domain Name.
- 6.22 Turning then to a whether there is a likelihood of such confusion in this case, paragraph 3.3 of the Experts’ Overview<sup>1</sup> provides guidance on the meaning of “confusing use” referred to in paragraph 3(a)(ii) of the Policy in order to assist parties to a DRS dispute on the type of considerations that the Expert may take into account to determine whether or not paragraph 3(a)(ii) of the Policy applies.
- 6.23 Taking the two principles set out in paragraph 3.3 of the Experts’ Overview that are relevant to the facts and circumstances in this case and applying them to this case I find the following:

A. Does mere registration of the Domain Name constitute unfair use?

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<sup>1</sup> The Experts’ Overview is a document promulgated by Nominet’s panel of Experts which deals with a range of issues that come up in DRS disputes and provides parties to DRS disputes with helpful guidance in respect of the Policy and Procedure.



- 6.24 There is no evidence to show that the Respondent has used the Domain Name, beyond mere registration of it on 12 January 2000 and two slightly differing parking pages, one of which references “*another.com email*” and the other which states “*Enquiries about this domain? Email us at: domains@another.com*”. In correspondence with the Complainant, the Respondent mentions that most of the domain names it holds are part of a large movie community project launching in 2014. On the one hand therefore, the Respondent has not, on the evidence before me, made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods and services.
- 6.25 On the other hand however, the “KeepItSafe” mark comprises three common and generic English words, namely “Keep”, “It” and “Safe” and that there is nothing unusual in the juxtaposition of these words (which together form a commonly understood phrase in the English language) and so the term “KeepItSafe” has a descriptive nature about it. Aside from the various trade mark and domain name registrations that the Complainant (and others in the same group of companies) holds, there is insufficient evidence to suggest that the mark is well-known. Accordingly, the Complainant’s rights in the term may be relatively weak and in any event (as noted above) the Complainant has provided no evidence to suggest that the Respondent was actually aware, or should have been aware, of the Complainant and/or its Rights in the mark “KeepItSafe” prior to or at the date of registration of the Domain Name.
- 6.26 It is likely that the Respondent would have become aware of the Complainant and its alleged rights in respect of the “KeepItSafe” mark when the Complainant first contacted the Respondent. There is nothing in the Complaint or its supporting material to specify exactly when this contact was first made, or indeed what was communicated to the Respondent at that time. The Complainant contends that it has made a number of attempts, spanning several years, to purchase the Domain Name from the Respondent. The only material submitted by the Complainant (as an annexure to its Complaint) and relevant to this point is a copy of an email chain between the Respondent and the Complainant, which spans several dates over January 2014, in which the Complainant seeks to purchase the Domain Name and makes a reference to its UK trade mark.
- 6.27 In light of the above and based on the evidence before me, I conclude that the mere registration of the Domain Name by the Respondent in this case does not constitute unfair use.

#### B. Initial Interest Confusion

- 6.28 Initial interest confusion is the concept whereby Internet users are likely to visit the Respondent’s site in the expectation of finding the

Complainant, for example in response to a search engine request or an educated guess as to the Complainant's domain name.

- 6.29 In this case, the Domain Name comprises in its entirety, but disregarding the .co.uk suffix, the Complainant's "KeepItSafe" mark which suggests a possibility of a finding of initial interest confusion. However, as noted above, the Complainant has provided very little evidence of its use of the mark and on the face of it (absent more evidence of use of the mark by the Complainant and association between the mark and the Complainant's goods and/or services) the mark is a relatively weak one given its descriptive nature.
- 6.30 I am therefore unable to find, on the balance of probabilities, that Internet users would, upon visiting the Respondent's website, expect to find the Complainant, or a website operated or authorised by, or otherwise connected with the Complainant.
- 6.31 Further, I have found that the Respondent was not aware of the Complainant at the time of registration of the Domain Name. In such circumstances, the Respondent should be entitled to hold onto the Domain Name and use it, even if it causes initial interest confusion, unless the Respondent has subsequently (post registration of the Domain Name) done something to take advantage of or exploit its position once it became aware of the Complainant's Rights.
- 6.32 The Complainant has not shown that the Respondent has made any change to the use of the Domain Name or done something to take advantage of or to exploit its position since it became aware of the Complainant's Rights.
- 6.33 As noted above, the website to which the Domain Name resolves, appears to have only ever promoted the Respondent's contact details, along with an indication to visitors to the website that the Respondent may be willing to sell the Domain Name. This willingness to consider a potential sale is supported by the Respondent's correspondence with the Complainant, although the Respondent makes it clear in that correspondence that it is not prepared to sell the Domain Name at the price offered by the Complainant.
- 6.34 The offering of a domain name for sale (even for valuable consideration in excess of the Respondent's out-of-pocket costs directly associated with acquiring or using the Domain Name) and the holding of a large portfolio of domain names are not unlawful activities in themselves. In this regard, paragraph 4(d) of the Policy states that:
- "(d) Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits."*

- 6.35 Paragraph 4(d) of the Policy needs however to be balanced against paragraph 3(a)(iii) which states that:

*“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.”*

#### Pattern of Registrations

- 6.36 The Complainant contends that the Respondent is the owner of hundreds of domain names and that whilst the mere registration of domains and their lack of use may not, in itself, constitute abuse, the sheer numbers of domains registered results in a situation where the Respondent is able to block and control the desired Internet addresses of many third parties.
- 6.37 Paragraph 3.5 of the Experts’ Overview provides parties to a DRS case helpful guidance on what is meant by a “*pattern*” and what is meant by “*and the domain name is part of that pattern*” in paragraph 3(a)(iii) of the Policy. It notes that there is a divergence of views among Experts as to what constitutes a pattern for this purpose.
- 6.38 In light of the circumstances of this case, I find that the Respondent has not fallen foul of paragraph 3(a)(iii) or, put another way, that the Complainant has failed to successfully make out its case in respect of paragraph 3(a)(iii).
- 6.39 There is no evidence that the Domain Name is linked to the other domain names that the Complainant alleges are owned by the Respondent, either by establishing such link by way of the names in the Respondent’s portfolio or in their dates of registration.
- 6.40 Further, as discussed above, the Complainant’s Rights are relatively weak and, on the basis of the evidence submitted, the Complainant’s “KeepItSafe” name could not be said to be a well-known name or mark.
- 6.41 Accordingly, I find that on the balance of probabilities the Domain Name, in the hands of the Respondent, is not an Abusive Registration under paragraph 1(ii) of the Policy.

## **7. Decision**

- 7.1 I find that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name.
- 7.2 For the reasons set out above I do not find that that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7.3 I direct that no action be taken in relation to the Domain Name.

**Signed Ravi Mohindra Dated 2 February 2015**