

# DISPUTE RESOLUTION SERVICE

**DRS 18767**

## Decision of Independent Expert

The Rocket Science Group, LLC

Complainant

and

Bristol Superstore

Respondent

### 1 The Parties

Complainant:	The Rocket Science Group, LLC
Address:	512 Means Street, Suite 404 Atlanta United States

Respondent:	Bristol Superstore
Address:	Flat 6, 34 Balls Pond Road London N1 4AU United Kingdom

### 2 The Domain Name

*mailshrimp.co.uk* (the "Domain Name").

### 3 Procedural History

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,

which need be disclosed as being of such a nature as to call into question my independence in the eyes of one or both of the parties.

12 April 2017	Dispute received
13 April 2017	Complaint validated
13 April 2017	Notification of complaint sent to parties
5 May 2017	Response reminder sent
5 May 2017	Response received
5 May 2017	Notification of response sent to parties
9 May 2017	Reply received
9 May 2017	Notification of reply sent to parties
16 May 2017	Mediator appointed
16 May 2017	Mediation started
21 July 2017	Mediation failed
21 July 2017	Close of mediation documents sent
28 July 2017	Expert decision payment received

## 4 Factual Background

- 4.1 The Domain Name was registered by the Respondent on 26 March 2017 for a period of 12 months.
- 4.2 The Complainant is an email marketing business which trades under the name Mailchimp. In January 2017 the Complainant launched an advertising and marketing campaign based on soundalikes of its trading name, including MailShrimp, JailBlimp and KaleLimp.
- 4.3 The Domain Name currently points to a website ostensibly offering shrimp related electronic cards in return for a charitable donation to Breast Cancer Now.

## 5 Parties' Contentions

### Complaint

- 5.1 The Complainant is an email marketing business incorporated in the United States. It was founded in 2001. It trades under the name Mailchimp. By 2014, it was sending over 10 billion emails per month on behalf of its users. Currently, more than 15 million businesses and people around the world use its email marketing platform.
- 5.2 It owns numerous trade mark registrations for MAILCHIMP. Copies of those registrations are exhibited to the Complaint. It also owns the *mailchimp.com* domain name.
- 5.3 In January 2017, the Complainant launched "*an elaborate and innovative marketing campaign*" in the course of which it produced products, events and videos "*that played off its MAILCHIMP name but did not directly reference the brand in a significant way*". As part of that teaser campaign, the Complainant created three short films: *MailShrimp*, *JailBlimp* and *KaleLimp*. Those films were screened in various cinemas in the US.
- 5.4 The Complainant subsequently rolled out other elements of the marketing campaign, none of which, to the uninitiated, was immediately associated with the Mailchimp brand, save that they all featured the Mailchimp logo, a drawing of a chimpanzee, known as Freddie. Such ostensible product launches, in the food, film, fashion and beauty sectors, included, by way of example, a line of potato crisps called FailChips and an anti-aging beauty treatment called SnailPrimp. They all directed consumers to Mailchimp's website. Further, when users entered the relevant

soundalike terms, such as MailShrimp, into search engines, the search engine would ask whether they meant Mailchimp.

- 5.5 The Complainant explains that the same campaign featured on its website, which included the following text:

*"Officially, of course we are Mailchimp. But if you couldn't tell by now, we are not so concerned with what people call us. We'd much rather show you who we are. Because we believe the best way to build relationships with customers, fans, or anyone else is to be yourself. For us, that means having some fun with our name."*

- 5.6 The website included hyperlinks relevant to the search term that had been used. For example, clicking on MAILSHRIMP directed to the website *www.mailshrimpfilm.com* which featured a short film about a singing shrimp.

- 5.7 The Complainant says that the campaign generated significant traffic to its website, including from the UK, and including to the *mailshrimpfilm.com* website, totalling 33,924 "sessions" between 17 January and 31 March 2017. The advertising campaign was also promoted on billboards in the UK and the US. An example is provided. The Complainant also exhibits press coverage of the campaign.

- 5.8 As a result of this advertising campaign, the Complainant contends that it *"has acquired protectable goodwill in the rhyming names used in the campaign, including but not limited to MAILSHRIMP, such that these names are exclusively associated with the Complainant and no other."*

- 5.9 Accordingly, the Complainant's case is that it has unregistered rights in the 'MailShrimp' name which is identical to the Domain Name.

- 5.10 In addition, and in the alternative, it contends that its registered MAILCHIMP trade mark is similar to the Domain Name.

- 5.11 As to Abusive Registration, the Complainant puts its case on two bases.

- 5.12 First, it says that the Domain Name was primarily registered for the purpose of selling, renting or otherwise transferring it to the Complainant at a price greater than the Respondent's costs, i.e. as envisaged in paragraph 5.1.1.1 of the DRS Policy (the "Policy"). It explains that approximately one month after the launch of the teaser phase of the advertising campaign referred to above, the Complainant revealed that it was the entity behind the advertising, thereby linking the Mailshrimp name to it. It says that it was shortly after this announcement that the Respondent registered the Domain Name.

- 5.13 On that day, a director of the Respondent, James Levine, sent an email to an employee of the Complainant in the following terms:

*"I have purchased mailshrimp.co.uk and have directed it towards your competitor's website. It is the main video from your advert campaign. I have contacted news outlets and they will be running news stories about this very soon. If you wish to purchase the domain name from me, it is available for sale."*

- 5.14 A copy of Mr Levine's email is exhibited to the Complaint, as are extracts from the Companies House entries for the Respondent identifying Mr Levine as sole director of the Respondent.

- 5.15 While the position appears subsequently to have changed, at the time of filing the Complaint, the Complainant says that the Domain Name was still redirecting to the website of a competitor, Benchmark Email.
- 5.16 Secondly, the Complainant contends that the Domain Name was primarily registered unfairly to disrupt its business, i.e. as envisaged in paragraph 5.1.1.3 of the Policy, because customers searching for *mailshrimp.co.uk* will be directed to its competitor's website.
- 5.17 Finally, the Complainant submits that the Domain Name was registered by the Respondent "*in full knowledge of the Complainant's business and trade marks and with a clear intention of taking advantage of the Complainant's goodwill in order to obtain money by deception. The Complainant became aware of the Respondent's misuse of their MAILSHRIMP mark when they received the aforesaid email.*"

#### Response

- 5.18 The Response is fairly brief. It begins with an apology by the Respondent "*for any problems caused to Mailchimp as a result of the forwarding of my domain.*" The Respondent says that this was never intended to be permanent, "*but only a temporary situation whilst I created the website for my mailshrimp website for mailing shrimp e-cards for charity. It was a mistake but now I have undone the redirect and my shrimp website is fully set-up. I would hate for this mistake to affect my ability to raise money for charity.*"
- 5.19 The Respondent resists transfer of the Domain Name on two bases.
- 5.20 In the first place, it asserts that the Domain Name "*is currently being used legitimately and for a legitimate, non-abusive purpose*", presumably in reliance on paragraph 8.1.1.1 of the Policy. In support of this assertion, the Respondent says that the Domain Name is currently being used for a website which raises donations for the charity Breast Cancer Now: "*It is a website set up whereby donors will receive an e-card of a shrimp. They are also able to sign up for monthly emails of a cute shrimp sent every month free.*"
- 5.21 The Respondent says that he has already received several donations and exhibits a screenshot which appears to evidence six donations all made on 4 May 2017 in sums varying between £1 and £10.
- 5.22 The Respondent further enjoins the Complainant to make a donation to Breast Cancer Now and to "*start helping others rather than harassing individuals trying to do some good in the world. But no pressure on them, the aim of this response is not to get a donation from Mailshrimp but instead to protect my domain name.*"
- 5.23 Secondly, the Respondent asserts that: "*Mailshrimp as a phrase is not currently attached to any trade mark registered with the UK Intellectual Property Office*" and that there is therefore "*nothing stopping me from using Mailshrimp as a phrase or domain*".
- 5.24 Finally, the Respondent explains that it is "*hoping to do some great things for Breast Cancer Now over the next few months with it.*"

#### Reply

- 5.25 The Complainant asserts that, following the filing of its Complaint, the Respondent has changed its use of the Domain Name and, instead of redirecting the Domain Name to a competitor, has set up a website to raise donations for charity, whereby donors receive shrimp e-cards. However, the Complainant asserts that this "*has been contrived solely for the purposes*

*of defending the Complaint. The domain name is not being used in connection with a genuine offering of services. The mailshrimp.co.uk domain does not link to Breast Cancer Now. The so-called donations all post-date the filing of the Complaint. The amounts are low and are made on the same day, most likely by the Respondent or under his direction."* The Complainant further states that it is no longer possible to make donations through the website.

- 5.26 It therefore submits that the Respondent is acting disingenuously and is simply seeking to disguise its true intention in registering the Domain Name "*which is to solicit money from the Complainant*".
- 5.27 Further, the Complainant exhibits a further email from the Respondent "*asking if the Complainant wishes to purchase the domain from the Respondent*". It says that email was sent after the Complaint was filed and therefore demonstrates that the Respondent is simply seeking to extract money from it. It contends that the recent change in usage of the Domain Name does not demonstrate that it is not an Abusive Registration because such use postdates the filing of the Complaint and has been contrived specifically for the purpose of defending the Complaint under the DRS and does not therefore constitute use in relation to a genuine offering of services.

#### Request for further statement from the Respondent

- 5.28 On 1 August 2017, pursuant to paragraph 17.1 of the Policy, this Expert made the following request for a further statement from the Respondent through the good offices of Nominet:

*"Pursuant to paragraph 17.1 of the DRS Policy, I should be grateful if the Respondent would within seven days provide a further statement (together with any evidence on which it wishes to rely) answering the following questions, which arise principally in light of submissions made by the Complainant in its Reply:*

*1 On what date did the Respondent begin operating the shrimp postcard website currently at URL [www.mailshrimp.co.uk](http://www.mailshrimp.co.uk)?*

*2 Have any further donations been made after those dated 4 May 2017 annexed to the Response, and, if so, in what amounts and on what dates?*

*3 Have any sums been paid by the Respondent to Breast Cancer Now in respect of donations made through the Respondent's website at [www.mailshrimp.co.uk](http://www.mailshrimp.co.uk) and, if so, in what amounts and on what dates?"*

- 5.29 Nominet relayed that request to the Respondent on 2 August. No response was received within the seven days, or at all.

## **6 Discussions and Findings**

### General

- 6.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2).

- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

*"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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

### Complainant's rights

- 6.3 Paragraph 2.1.1 of the Policy requires the Complainant to prove that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". "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*" (paragraph 1).
- 6.4 As mentioned, the Complainant puts its case on Rights on two bases: first, that its MAILCHIMP registered trade mark is similar to the Domain Name, and, secondly, that it has common law rights in the 'Mailshrimp' name which is identical to the Domain Name.
- 6.5 As the proprietor of numerous registered trade marks in MAILCHIMP, the Complainant plainly has Rights (as defined) in that mark.
- 6.6 As to similarity, the Experts' Overview makes clear in paragraph 2.3 that proving the existence of Rights in the relevant name or mark "*is intended to be a relatively low-level test ... The objective behind the first hurdle is simply to demonstrate a bona fide basis for making the Complaint*".
- 6.7 Mailshrimp is aurally and visually very similar to the registered mark. In addition, conceptually (to adopt the "global appreciation" test in *Sabel v Puma*) both names comprise the word MAIL conjoined with the name of a creature, albeit that one is a crustacean and the other a primate.
- 6.8 Further, the reason that the two names are both visually and aurally so similar is that Mailshrimp is identical to Mailchimp but for changing one letter and adding another. It therefore also comes very close to being a case of 'typo-squatting', where numerous Experts have found domain names to be similar to the mark or name in which the Complainant has Rights.
- 6.9 Accordingly, the Complainant has demonstrated the requisite degree of similarity between the MAILCHIMP mark and the Domain Name.
- 6.10 Secondly, the Complainant in any event claims rights in the 'Mailshrimp' name itself by virtue of the recent advertising campaign referred to paragraphs 5.3 to 5.7 above. There is not a little irony about the fact that, having based an entire advertising campaign on variants of its trading name and "*having some fun with our name*" and asserting that "*we are not so concerned with what people call us*", the Complainant now asserts rights not only in its registered mark but in those variants used in its advertising campaign, including for these purposes the 'Mailshrimp' name, "*such that these names are exclusively associated with the Complainant and no other*".
- 6.11 Nonetheless, having regard in part to the similarity between the Mailshrimp name and the MAILCHIMP registered mark, as set out above, and in part to the manner in which the Complainant used the Mailshrimp name in its advertising campaign, both in its teaser phase and in its reveal phase when the link to Mailchimp was disclosed, for the purposes of the Policy at least, the Complainant probably just about gets home on Rights in the 'Mailshrimp' name.
- 6.12 Given that a name or mark will ordinarily be regarded as identical to the domain name if, at the third level, and ignoring the presence of hyphens and the absence of spaces and ampersands

they are the same (Experts' Overview, paragraph 2.3), the Mailshrimp name is identical or similar to the Domain Name.

- 6.13 Accordingly, on either case advanced by the Complainant, it has succeeded in proving that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.

#### Abusive registration

- 6.14 As set out in section 5 above, the Complainant puts its case on Abusive Registration on two bases.
- 6.15 Paragraph 5.1.1.1 of the Policy includes as a factor which may be evidence that the Domain Name is an Abusive Registration circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily for the purposes of selling, renting or otherwise transferring it to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's out-of-pocket costs directly associated with acquiring or using the domain name.
- 6.16 The Complainant relies on the email sent to it by James Levine of the Respondent "*shortly after*" the Complainant revealed itself as being the entity behind the teaser advertising campaign. However, no actual chronology is provided.
- 6.17 The email in question appears to have been sent on 26 March 2017. As noted above, the Domain Name was also registered on 26 March 2017.
- 6.18 The Complainant says that the teaser phase of the advertising campaign launched "*in January this year*", that "*a month or so later*" the Complainant revealed that it was behind the campaign, and that "*it was shortly after this announcement*" that the Respondent registered the Domain Name.
- 6.19 Even assuming that the advertising campaign was not launched until the end of January, the latest that the reveal could have taken place, on the Complainant's case, would have been in late February or early March. It is therefore difficult to see how the Domain Name could have been registered "*shortly after this*".
- 6.20 Further, the press cuttings exhibited in Annex 5 to the Complaint in any event demonstrate that the identity of the advertiser had in reality been revealed some time earlier. An article in advertising magazine *Creative Review*, for example, disclosed on 24 January 2017 that Mailchimp was behind the campaign. However, it makes the point that "Mailchimp aren't mentioned at all", so it may be the case that the identity of the advertiser was known within the advertising community but not more widely. Similarly, an article in *The Drum* (also an advertising trade publication) of 21 February 2017 makes it plain that Mailchimp is behind the campaign. An article to similar effect was published in *The Guardian* on 27 February 2017.
- 6.21 Accordingly, even allowing for the fact that the Respondent might not have been aware of reports in the advertising trade media, such as *The Drum* and *Creative Review*, on any view the cat, or perhaps the chimp, was out of the bag by the end of February, when it was published in *The Guardian*. That was a month before the Domain Name was registered by the Respondent and the email sent by it to the Complainant.
- 6.22 However, probably not a great deal turns on the timing. The terms of Mr Levine's email are clear enough. He says expressly that he is redirecting the Domain Name to the website of a competitor of the Complainant. He adds that he has contacted news outlets and that "*they will be running news stories about this very soon*". Whether or not the latter statement was true,

the implication is plainly that if the Complainant does not pay up, the Respondent will ensure that the Complainant is the subject of adverse publicity.

- 6.23 In its Response, the Respondent admits to (and apologises for) having redirected the Domain Name to a competitor's website, though it contends that this "*was never intended to be permanent*". That assertion carries little weight. It is tolerably clear, certainly on the balance of probabilities, that the Respondent was simply seeking to maximise its leverage (i.e. both by disrupting the Complainant's business and by the threat of adverse publicity) with a view to extracting payment from the Complainant for the Domain Name.
- 6.24 Accordingly, the Complainant succeeds in proving Abusive Registration under this head.
- 6.25 Paragraph 5.1.1.3 of the Policy includes as a factor which may be evidence that the Domain Name is an abusive registration circumstances indicating that the Respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the Complainant's business.
- 6.26 Given that the Respondent admits to having redirected the Domain Name to the website of a competitor of the Claimant, some disruption may have occurred. However, the Complainant has not particularised, let alone provided any evidence of, any such unfair disruption.
- 6.27 Nor has it explained the basis on which it contends that such disruption was the primary purpose for which the Domain Name was registered by the Respondent. Indeed, given that it argues (successfully) that the Domain Name was primarily registered for the purpose of selling it to Complainant, it is difficult to see how it could also have been registered primarily for another purpose. It seems more likely that any unfair disruption was ancillary to the principal or primary purpose of pressurising the Complainant into making a payment in return for transfer of the Domain Name.
- 6.28 The Respondent's defences are weak. The change of use after the filing of the Complaint has all the hallmarks of an attempt to justify registration *ex post facto*. The Respondent has not denied that it set up the shrimp e-card website only after the Complaint was filed, despite having been invited to clarify the chronology by way of a further statement pursuant to paragraph 17.1 of the Policy. On that basis alone, it is doubtful that the Respondent could rely on paragraph 8.1.1.1 of the Policy, i.e. evidence that the Domain Name is being used in connection with a genuine offering of goods or services.
- 6.29 Further, notwithstanding the Expert's invitation, the Respondent has failed to provide any evidence whatsoever that the website is in truth being used to raise donations for the charity Breast Cancer Now. The Complainant's scepticism as to the genuineness of the apparent donations, given the low number, the modest amounts and the fact that they were all made on the same day, would appear to be justified, again particularly in light of the Respondent declining to clarify the position by way of a further statement.
- 6.30 Accordingly, the Respondent has failed to demonstrate that the Domain Name is not abusive on that ground.
- 6.31 Yet further, as the Complainant explains in its Reply, the Respondent sent a second email after the Complaint was filed. The Complainant asserts that the email again offered to sell the Domain Name to it. That email, again from Mr Levine of the Respondent, reads in full as follows:

*"I am just sending you an email regarding your recent complaint about my domain name registration mailshrimp.co.uk.*



*I am reaching out because I think it is in your interest to reach an amicable situation as quickly as possible.*

*I understand that reaching a solution through the Nominet Dispute Resolution service may take more than a month due to required response timings.*

*I am interested in resolving this in a matter of days if you are interested in doing so?*

*I look forward to your response.*

*Regards,*

*James".*

- 6.32 The Complainant is therefore not right to say that in that email the Respondent asked if it wished to purchase the Domain Name from it. No such proposal is expressly made in the email. Nonetheless, the Expert accepts that the email in question is certainly capable of bearing an implied meaning to that effect. On that basis, it is further evidence that the Respondent, even after the Complainant had commenced these DRS proceedings, falls foul of paragraph 5.1.1.1 of the Policy.
- 6.33 The Respondent further argues that because Mailshrimp is not registered as a trade mark, there is nothing to stop him using it in the Domain Name. For the reasons set out at paragraphs 6.10 to 6.12 above, however, that contention is without merit.
- 6.34 For these reasons, the Complainant has, on the balance of probabilities, demonstrated Abusive Registration pursuant to paragraph 2.1.2 of the Policy.

## **7 Decision**

- 7.1 The Expert finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration.
- 7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

Signed: **David Engel**

Dated 21 August 2017