



DISPUTE RESOLUTION SERVICE

D00019209

Decision of Independent Expert

Synack, Inc.

and

Jake Knox

1. The Parties:

Complainant: Synack, Inc.
1600 Seaport Blvd #170
Redwood City
CA 94063
California
94116
United States

Respondent: Jake Knox
5 Marlowe Court
Leeds
West Yorkshire
LS25 1PR
United Kingdom

2. The Domain Name:

synack.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 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.

13 September 2017, the Dispute was received.

13 September 2017, the Complaint was validated.

13 September 2017, the Notification of the Complaint was sent to the Parties.

13 September 2017, the Response was received.

13 September 2017, notification of the Response was sent to the Parties.

18 September 2017, the Reply reminder was sent.

19 September 2017, the Reply was received.

19 September 2017, notification of the Reply was sent to the Parties.

19 September 2017, the Mediator was appointed.

22 September 2017, mediation started.

06 December 2017, the Dispute was resolved during mediation.

20 June 2018, mediation failed, the Dispute was reopened.

20 June 2018, close of mediation documents sent.

02 July 2018, the Complainant full fee reminder was sent.

03 July 2018, the Expert decision payment was received.

4. Factual Background

4.1 The Respondent registered the Domain Name on 4 July 2016.

4.2 The Complainant is the registered proprietor of a European Union ('EU') trade mark for the word "SYNACK" (No 015469571) (Class 42 – computer security consultancy), registered on 26 September 2016 (the application having been filed on 24 May 2016).

4.3 The Complainant was founded in 2013 and provides cybersecurity products and services to customers.

5. Parties' Contentions

The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

5.1 In summary, the Complainant submitted that the Complaint should succeed for the reasons below.

The Complainant's Rights

- The Complainant submitted that it has Rights in respect of a name or mark which is identical to the Domain Name, in that it is the registered owner of the EU trade mark "SYNACK" (the '**Mark**'), and that it has traded under the name "SYNACK" (the '**Name**') since 2013.
- The Complainant stated that it markets and sells cyber security services under the name "SYNACK." Further, the Complainant stated that it goes to "*great efforts to develop its brand and create marketing information which promotes the [Complainant] and its products and services.*"
- The Complainant submitted that it has a "*global reputation in the cybersecurity industry*", "*close to one hundred employees and works with a global team of independent researchers*", and a strong online presence where it uses its website (www.synack.com) and blog (synack.com.blog) to market itself and recruit the independent researchers to work for it.
- The Complainant submitted that it has a global reputation in the cybersecurity industry, including the United Kingdom, and exhibited various news articles, one of which pre-dates the registration of the Domain Name, that references the Complainant and its business.
- Therefore, it submitted, "*based on its employees, its outreach to global customers (including those in the United Kingdom), its use of independent researchers (including some of which are based in the United Kingdom) and coverage in the United States and United Kingdom press*", it has established a global reputation.

Abusive Registration

- The Complainant explained that the Respondent is using the Domain Name to direct web-traffic to *blog.synack.co.uk*, which the Respondent uses to run his computer security blog (the '**Blog**').
- The Complainant submitted that the Domain Name used by the Respondent is identical to the Name and Mark, and therefore it has the right to prohibit the Respondent from using the Name/Mark in connection with its operation of the Blog and the Domain Name.

- The Complainant submitted that, under section 5.1.2 of the DRS Policy, the use of the Domain Name by the Respondent is an Abusive Registration as it has, or will likely, confuse people or businesses into believing that the Domain Name and the Blog are registered to, operated or authorised by, or otherwise connected with the Complainant.
- The Complainant stated that such confusion is based on *“the fact the Domains and the name of the Registrant’s Blog is identical to the Company’s Trademark”*, and the subject matter of the Blog which is predominantly related to the field of computer security topics, including *“security testing”*, which is the focus of the Complainant’s products and services.
- The Complainant submitted that:
 - such confusion will cause harm to its business by drawing customers and independent researchers to the Respondent’s Blog instead of the Complainant’s website, and the Complainant will lose the opportunity to establish business relationships with those customers and recruit independent security researchers who would otherwise be engaging with the Complainant;
 - the continued use of the Domain Name by the Respondent will damage the Complainant’s brand and marketing efforts by publicly disseminating information which conflicts or is otherwise incompatible with the Complainant’s brand and marketing efforts; and,
 - the Complainant’s customers *“expect a certain quality of product and service when they see the”* Mark and any use of the Mark by the Respondent *“will diminish the strength of the connection between the [M]ark and the [Complainant], thereby decreasing the value of the Company’s services and products in the eyes of the Company’s customers and diminishing the prospects of the Company’s future growth.”*
- Additionally, the Complainant submitted that, under 5.1.6 of the DRS Policy, the use of the Domain Name by the Respondent is an Abusive Registration because the Domain Name is an exact match for the Mark in which the Complainant has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.
- The Complainant submitted that the Respondent has no reasonable justification for the use of the term Synack in connection with its Blog, noting that the Name “SYNACK” has no independent meaning in computer security other than with respect to the Complainant.

- In support, the Complainant explained that SYNACK has a meaning in general network computing relating to how a network connection is established between two computers, being the method used by the Transmission Control Protocol ('TCP') to set up a connection over an Internet Protocol ('IP') based network.
- [To request and verify a network connection, the client, Host A, requests a connection by sending a *syn* (synchronise) message to the other person's server, Host B, which responds by sending a *syn-ack* message back (acknowledging) that request. The client then responds with an *ack* message, establishing the connection. (It is sometimes called a 'three way handshake')]
- The Complainant stated that this meaning is *"entirely limited to general network computing and has no independent meaning within the computer security industry."* Further, the Complainant stated that Google Search results, which it exhibited, *"show the top hits relate to the Complainant."*

The Respondent's Response

5.2 In summary, the Respondent submitted that the Domain Name should not be transferred to the Complainant for the reasons set out below.

The Complainant's Rights claim

- The Respondent submitted that the Complainant does not have Rights in respect of a name or mark which is identical to the Domain Name.
- The Respondent submitted that he was not aware of the Complainant prior to its contact with him in March 2017 and that, in his view, the Complainant's *"presence in the UK verges on non-existent."*
- The Respondent explained that the Blog *"is a personal site aimed at IT professionals and although it is a general IT blog, there is a clear leaning towards Networking and Security."*
- The Respondent submitted that the Name "SYNACK" was *"derived from its relevance to networking and security products such as firewalls"* which he deals with in his *"day to day job"*, as TCP is a major part of such networking and the relevance of *"TCP and SYNACK when troubleshooting or debugging issues within networking and certain security products is well founded."*
- He stated that he *"strongly believe[s] this is reasonable justification for the use of SYN ACK as it was wholly derived from its relevance."*

The Complainant's Abusive Registration claim

- The Respondent noted that he had *"confirmed with Nominet that [a] Trademark does not give a right to the registration of a domain."* He also noted that *"trademark disputes are valid when both parties are using the disputed name in the course of trade, which I am not doing. I do not generate any income from this website and sell no services through it."*
- The Respondent made submissions in relation to matters raised in the DRS Policy, noting that in relation to:
 - paragraph 5.1.1.1, he has *"no intention of selling, renting or otherwise transferring this domain"* as he is *"making use of this domain myself for running a personal blog."*
 - paragraphs 5.1.1.2 and 3, he was *"unaware of the complainant prior to their engagement in this matter and [he has] no intention of disrupting their business. [He has] proposed suggestions such as a disclaimer stating we are not affiliated which was refused. [I]t's clear to anyone that we are not linked."*
 - paragraph 5.1.2, he is not *"offering any services that we are not affiliated with the complainant"* and that *"[t]he logo and general look of the site is vastly different from that of the complainant."* He further stated that he had *"offered to settle this by displaying a disclaimer confirming we are not affiliated with the complainant, which has been refused."*
 - paragraph 5.1.6 while the Respondent accepted that the Domain Name *"is an exact match"*, *"this alone does not constitute an abusive registration"* and that he had provided a valid reason for using *"SYN ACK"* for which the Complainant *"has little/no reputation or presence in the UK."*
- The Respondent further stated that *"TCP/SYN ACK is far more widespread than the [Complainant] suggests and a vast majority of applications on the internet require TCP/SYN ACK and it's relevance in networking and security products such as firewalls (the topic of some of my blog posts) is well known."*

Complainant's Reply

5.3 In summary, the Complainant replied that:

- In relation to the submission that the Complainant does not have a presence in the United Kingdom, the Complainant submitted that whether it *"has a presence in the United Kingdom to be irrelevant to the dispute at hand. The question is whether the Company has any right which the Registrant is abusing."*
- The Complainant disputed the Respondent's claim regarding the nature of the Blog, that it *"is a general IT blog"*, and submitted that the Blog is *"primarily focused on computer security topics"*, being organised by subject areas, including headings for *"Security"*, *"Networking"*, *"Administration"* and *"Scripts"*, and posts address activities which the Complainant provides to its customers.
- The Complainant also disputed the Respondent's claim that he has a reasonable justification to use *"Synack"* as the name of the Blog, referencing various search results showing that a search of the term *"SYNACK"* and *"security"* or *"computer security"* on Google generates lists of hits related to the Complainant. The Complainant stated that there *"is no reason why someone would name their computer security blog Synack unless they were referring to the [Complainant]."*
- The Complainant questioned the relevance of whether the Respondent is engaged in a commercial active as the Complainant is suffering a harm by the Respondent's use of the Domain Name, whether the Respondent is using it for commercial or non-commercial purposes, and raised again that the use of the Domain Name by the Respondent has caused or is likely to cause confusion in the minds of the Company's customers, independent researchers and the public.
- To the extent that it is relevant as to whether the Respondent is engaged *"in a commercial endeavor"*, the Complainant submitted that the Respondent is engaging in an *"activity that is, or has the potential to be, commercial."* While the Respondent does not have advertisements at present, the Respondent is attracting users to the Blog and the attraction of *"these additional visitors is providing the [Respondent] with the means to sell advertisements in the future or otherwise profit from the operation of the Blog."*
- Finally, the Complainant disputed the Respondent's claim that it has no reputation in the United Kingdom, noting the Complaint where it described *"how [the Complainant] has both a global reputation and a reputation in the United Kingdom"* sufficient to satisfy the reputation requirement to Section 5.1.6 of the DRS Policy.

6. Discussions and Findings

General

6.1 To succeed in the Complaint, the Complainant has to prove that, pursuant to paragraph 2 of the Policy, on the balance of probabilities:

i. [it] 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 Addressing each of these limbs in turn:

Rights in respect of a name or mark which is identical or similar to the Domain Name

6.3 The Expert considers that, for the reasons set out below, the Complainant has shown it has Rights in a name or mark which is identical to the Domain Name.

6.4 Paragraph 1 of the Policy defines “Rights” as:

[...] rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;

6.5 Noting the Complainant’s Mark, the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Mark which is identical to the Domain Name. In concluding the above, the Expert has disregarded the Domain Name suffix “co.uk”.

6.6 The Expert also notes that the Complainant provided evidence of it having a reputation in the Name/Mark, having provided various online news publications which reference the Complainant and the services it provides, and the results of a Google Search. In the Expert’s opinion, so far as ‘SYNACK’ is descriptive (noting the explanation above of how “SYN ACK” is referred to when establishing a computer link), such evidence shows that the Name has acquired a secondary meaning to identify the Complainant and its services.

6.7 The Respondent in various places submitted that the Complainant does not have a reputation in the UK. However, as referenced in Nominet’s DRS Expert Overview (version 3 – para 1.5), while Rights must be enforceable, there is no geographical/jurisdictional restriction to those Rights; therefore, the Rights do not have to be specific to the UK. In any event, the Complainant’s Mark does cover the UK.

Abusive Registration

- 6.8 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.
- 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. 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;*
- 6.10 In relation to the definition of Abusive Registration in sub paragraph (i), the Policy, at paragraph 5, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Specifically, the Expert considers that the factor set out at paragraph 5.1.1.3 (*registered for the purpose of unfairly disrupting the business of the Complainant*) is relevant.
- 6.11 Both the Complainant and Respondent are sophisticated IT users, and the Expert considers that the Respondent would have likely undertaken a search of the Name prior to then registering the Domain Name, and would have found references to the Complainant.
- 6.12 In this regard, the Expert in particular notes the exhibited Wall Street Journal online news article, that predates the registration of the Domain Name, which references the Complainant, how it was set up, and the IT security services it provides.
- 6.13 Indeed, on the balance of probabilities, the Expert considers that the Respondent specifically chose to register the Domain Name with the intention of benefitting from the Complainant's Mark and reputation and goodwill – in order to use the Domain Name for his Blog, the consequence of which being to disrupt unfairly the business of the Complainant.
- 6.14 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 6.15 So far as the definition of Abusive Registration in sub paragraph (ii) is concerned, the Expert considers that the Domain Name was and is an Abusive Registration as a result of its manner of use by the Respondent, for the reasons explained below.

- 6.16 Specifically, the Expert considers that the factor set out at paragraph 5.1.2, 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*), is relevant.
- 6.17 As evidenced to the Expert, the Respondent uses the website connected to the Domain Name (the '**Website**') to run an IT and computer security blog, the Blog. The subject matter of the Blog includes the subject matter of the computer security services provided by the Complainant i.e. put simply, they deal with the same things.
- 6.18 The Expert considers that anyone accessing the Website would likely be confused, noting that the Domain Name is identical to the Complainant's Mark, at least initially (see DRS Experts' Overview (version 3 - 3.3) into thinking that the Website and the discussions and advice therein is the Complainant's or is somehow connected with the Complainant, with the Complainant potentially losing business opportunities by such confusion.
- 6.19 The Expert is not persuaded by the argument that a person accessing the Website would soon realise such a mistake (e.g. because the look of the Website is different to that of the Complainant's or there is a disclaimer); the damage to the Complainant's business would already have been done. Indeed, the Expert considers that it is likely that at least some persons accessing the Website would have done so only because of the Complainant's goodwill and reputation in the Name/Mark.
- 6.20 The Respondent submitted that, as he is not engaged in a commercial activity, the Complainant is not suffering a harm by the Respondent's use of the Domain Name in this way. However, the Expert considers that whether the Respondent is using the Domain Name for commercial or non-commercial purposes is not relevant to the definition of Abusive Registration, which considers whether the Domain Name is being used in a manner which has "*taken unfair advantage of or has been unfairly detrimental*" to the Complainant's Rights.
- 6.21 In this regard, the Expert considers that the use of the Domain Name as described, for the reasons set out above, has taken unfair advantage of and was also unfairly detrimental to the Complainant's Rights by seeking to rely on the Complainant's Mark and goodwill and reputation, confusing web-users looking to access the Complainant's services. Internet users visit web sites either by way of search engines or by guessing the relevant URL, and are likely to access the Respondent's Blog when looking for the Complainant.
- 6.22 In addition, the Expert considers the paragraph 5.1.6 of the DRS Policy is relevant as:
- a) the Domain Name is an exact match for the Name and Mark;
 - b) the Complainant's Mark has a reputation (see paragraphs 6.3 *et seq.* above); and

c) the Respondent has no reasonable justification for having registered the Domain Name.

6.23 In relation to c) above, the Respondent submitted that, as “SYN ACK” is a descriptive term used as part of the TCP networking process, he is justified in using that term as part of his registration and use of the Domain Name. However, the Respondent is not using the term solely in his descriptions of IT networking and matters connected to that, but rather as his ‘shop sign’ on the Website to attract users to his Blog – benefitting from the Complainant’s reputation and goodwill by doing so.

6.24 The Expert has considered whether there is any other evidence before him to demonstrate that the Domain Name is not an Abusive Registration, including whether the Respondent is making fair use of the Domain Name, but does not consider there is. In particular, the Expert notes that the Domain Name is identical to the Complainant’s Name/Mark, registration of the Domain Name does not pre-date the Complainant’s reputation, and the Blog addresses the same subject matter as the services the Complainant provides.

6.25 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant’s Rights.

7. Decision

7.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed: Dr Russell Richardson

Dated: 29 July 2018