

DISPUTE RESOLUTION SERVICE

DRS 19380

Decision of Independent Expert

Chrome River Technologies, Inc.

and

Mr Yang HongJuan

1. The Parties

Complainant: Chrome River Technologies, Inc.
5757 Wilshire Blvd
Suite 270
Los Angeles
CA
90036
United States

Respondent: Mr Yang HongJuan
No.4 ZhuLin Road,Futian District
Shenzhen
518000
China

2. The Domain Name

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

3. Procedural History

The Complaint was filed with Nominet on 5 October 2017. Nominet validated the Complaint on 9 October 2017 and notified the Respondent by post and by email, stating that the Response had to be received on or before 30 October 2017. The Response was filed on 30 October 2017 and Nominet notified the Response to the parties on the same day. Nominet notified the Complainant that a Reply had to be received on or before 6 November 2017. The Respondent's Reply was received on 31 October 2017 and the mediator was appointed on the same day.

The Informal Mediation procedure started on 6 November 2017 and failed to produce an acceptable solution for the parties and so on 30 November 2017 Nominet informed the Complainant that it had until 14 December 2017 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 13 December 2017 the Complainant paid Nominet the required fee.

On 18 December 2017 the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he was independent of each of the parties and that, to the best of his knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of such a nature as to call in to question his independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant, Chrome River Technologies Inc., is a software as a service company (SaaS) based in Los Angeles, California, and was founded and incorporated in 2007. Its subsidiary, Chrome River International Limited, was established in the United Kingdom on 19 June 2009. Chrome River specializes in providing automated expense reporting and invoice automation software. Its website is available at www.chromeriver.com (the domain name <chromeriver.com> was registered on 14 February 2007).

The Complainant has supplied evidence of trade mark rights in CHROME RIVER, including:

- United Kingdom Trade mark No. UK00002469404 for CHROME RIVER, registered on 23 May 2008 (in classes 35 and 36); and
- United States Trade mark No. 3509394 for CHROME RIVER, registered on 30 September 2008 (in classes 35 and 36).

The Respondent is an individual, Mr. Yang HongJuan, based in Shenzhen, China.

The Domain Name was registered by the Respondent on 14 January 2014 and is currently resolving to a page with sponsored links and offering the Domain Name for sale.

The Respondent has previously been a respondent in seven (7) other Nominet DRS decisions, namely, DRS18867, DRS18863, DRS18171, DRS18025, DRS14289, DRS12682 and DRS12473. In all seven (7) cases, the domain names were ordered to be transferred to the respective complainant.

5. Parties' Contentions

Complaint

The Complainant's Rights

The Complainant asserts that it was established in 2007 and has adduced evidence that it has trade mark rights in CHROME RIVER since 2008. The Complainant has also provided evidence that since 2007 it has been using the domain name <chromeriver.com> which it registered on 14 February 2007.

Abusive Registration

The Complainant asserts that the Domain Name is an Abusive Registration because it was registered by the Respondent on the same day that the Complainant's venture capital funding of 17 million US dollars was publicly announced. The Complainant further states that the fact that the Domain Name is parked and is offered for sale suggests that the Respondent has no real intention of using the Domain Name.

The Complainant highlights that the Respondent had previously registered other domain names immediately following various announcements of venture capital funding of other US technology firms. The Complainant points out that the Respondent owns more than three hundred (300) domain names, many of which are .CO.UK variants of .COM domain names owned by established US technology firms. In this regard, the Complainant argues that the Respondent has registered these domain names in order to profit from their resale either to their rightful trade mark owners or to their competitors.

The Complainant states that the Respondent has a history of registering domain names for the purpose of cybersquatting, and has been forced to transfer domains in seven (7) Nominet disputes, namely, cases DRS18867, DRS18863, DRS18171, DRS18025, DRS14289, DRS12682 and DRS12473. Furthermore, the Complainant contends that in each of these Nominet disputes, the Respondent has raised the same argument: "The Respondent registered the Domain Name for one project, which has not yet started, so it parked the Domain Name temporarily. The Respondent has a detailed plan to use the Domain Name in the near future." For this reason, the Complainant believes that this pattern of behaviour of the Respondent is only meant to extort money from their rightful trade mark owners.

Finally, the Complainant concludes that its claim is fair and reasonable as a result of both the factual evidence relating to the timing of the Domain Name and the Registrant's pattern of abusive domain name registrations, and therefore requests the transfer of the Domain Name.

Response

The Respondent contends that he registered the Domain Name on 14 January 2014 for future online services and that the Domain Name consists of a combination of commonly used words. The Respondent explains that as his services are not yet online, he parked the Domain Name to earn some income.

The Respondent argues that the word combination "chrome river" is his own original creation and is not a generic term. The Respondent further claims that, although he does not have any trade mark rights in these terms, domain names may be registered on a "first-come, first-served" basis.

The Respondent asserts that the Complainant does not have rights in the Domain Name. In this regard, the Respondent asserts that the Complainant only registered its trade mark in classes 35 and 36 and, furthermore, he highlights that there are other entities that have registered trade marks combining the words "river" and "chrome". Thus the Respondent argues that the Complainant may not prevent others from registering and using the words "chrome" and "river", "chromeriver" or "riverchrome" in other classes. The Respondent affirms that he has a right to use the Domain Name in relation to other classes of goods and services.

The Respondent also submits that the Domain Name is not an Abusive Registration. In this regard, the Respondent denies knowledge of the Complainant before registering the Domain Name and states that he registered the Domain Name "for the good wish usage". The Respondent also argues that the terms "chrome" and "river" are commonly used in the English language and do not exclusively belong to the Complainant. The Respondent also submits that the Complainant has not provided any evidence showing that the term "Chrome River" is commonly associated with the Complainant or that "Chrome River" was recognized by the public in the UK prior to the registration date of the Domain Name.

The Respondent further submits that he does not wish to sell the Domain Name and that he has reserved it "for future online services". The Respondent further asserts that whilst the Domain Name is currently parked, the content on the parking page is not the Respondent's true intention but rather is automatically generated.

The Respondent claims that he did not proactively promote to sell the Domain Name to any party, and did not contact anyone to sell the Domain Name, including the Complainant. The Respondent argues that this illustrates the fact that he registered the Domain Name for his own use.

The Respondent states that he registered other .UK domain names for his own personal use and that he parked them to earn some income. The Respondent asserts that none of this has affected the business activities of other parties including those of the Complainant.

Finally, the Respondent asserts that the Complainant is guilty of reverse domain name hijacking. In this regard, the Respondent argues that the Complainant's ownership of the domain name

<chromeriver.com> does not automatically generate rights in the domain name <chromeriver.co.uk>. The Respondent further argues that the Complainant is a big company that is bullying the Respondent who is an individual. The Respondent requests that the Expert rejects the Complainant's request.

Reply

The Complainant submits that the Respondent is not being truthful and that his responses are not made in good faith. In this regard, the Complainant highlights the fact that the Domain Name was registered on 14 January 2014, the exact same date that a major investment in the Complainant's company was publicly announced, which the Complainant finds coincidental beyond belief. The Complainant further highlights the fact that the Respondent has been found to have made abusive domain name registrations under similar circumstances (i.e. further to funding announcements) in other cases, such as DRS18867 and DRS18863.

The Complainant further asserts that while "chrome" and "river" are two common words in the English language, combining them in this order results in a distinctive term that would not be used in everyday conversation. The Complainant points out that the term "chrome river" only refers to one thing, and that is the name of its company and software. The Complainant further argues that the fact that another entity has registered the name "River Chrome" is irrelevant to this dispute.

The Complainant stresses that it is a 10 year old global organization with more than 1 million users and that a simple Google search on the day that the Domain Name was registered would have yielded results referring to the Complainant. The Complainant further stresses that while Chrome River is a brand which may not be as known to the general public as other brands like Apple or Nike, it is nevertheless a highly successful business-to-business organization which is well-regarded in the industry.

The Complainant holds that the Respondent's claim that he did not actively promote to sell the Domain Name is false, as there is a notice on the parking page offering the Domain Name for sale. The Complainant also submits that it had contacted its registrar, GoDaddy, who then contacted the Respondent with regards to acquiring the Domain Name, and the Respondent offered the Domain Name for sale at 9,500 US dollars.

The Complainant also adduced evidence that after filing the Complaint on 9 October 2017, the Complainant received an unsolicited email from GoDaddy stating that the Respondent had reduced the sale price of the Domain Name to 5,000 US dollars, which, according to the Complainant, contradicts the Respondent's claim that he does not wish to sell the Domain Name.

The Complainant highlights that the Respondent owns three hundred twenty-eight (328) domain names and that most are .CO.UK versions of .COM domain names owned by established entities. The Complainant further points out that these domain names are also being used as parking pages containing sponsored links. The Complainant further highlights that the Respondent has had almost four (4) years to launch a project in relation to the Domain Name but has failed to do so. The Complainant believes that the aforementioned facts are an indication of the Respondent's intent to sell the domain names to their rightful owners or their competitors.

The Complainant further contends that the Respondent's claims of corporate bullying and reverse domain hijacking are absurd.

The Complainant submits that the Respondent's claims have no merit, in view of the Respondent's pattern of abusive registration and the decisions against him in cases which almost identically mirror this case. The Complainant further asserts that the Respondent's reasons for registering the Domain Name are not credible and that the timing of his other domain name registrations suggests a clear pattern of intent. Finally, the Complainant states that the Respondent's claims to rights in the Domain Name are exaggerated and that the Complainant is the rightful owner of the Domain Name.

6. Discussions and Findings

Under paragraph 2.1 of the Policy, for the Expert to order a transfer of the Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, that:

"2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration."

The Complainant's Rights

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"*.

The Expert is satisfied that the Complainant has relevant Rights in CHROME RIVER based on the Complainant's trade mark registrations (as listed above). It is irrelevant whether the Complainant's trade mark registrations are limited to certain classes of goods or services as what is important is that the Complainant's Rights are legally enforceable. See paragraph 2.2 of Nominet Experts' Overview. (*"What is required for a Complainant to prove that he/she/it "has rights" in paragraph 2(a)(i) of the Policy? As indicated above, the relevant right has to be an enforceable right (i.e. a legally enforceable right). Bare assertions will rarely suffice. The Expert needs to be persuaded on the balance of probabilities that relevant rights exist... If the right arises out of a trade mark or service mark registration, a copy of the registration certificate or print out from the registry database will suffice together with, in the case of a licensee, evidence of the licence"*).

Furthermore, the Policy also requires that the name or mark in which the Complainant has Rights must be identical or similar to the Domain Name. The Complainant's CHROME RIVER trade mark is clearly recognizable at the third level in the Domain Name. It is accepted practice under the Policy that the ".co.uk" suffix may be discounted. Therefore the Expert finds that the Domain Name is identical to a trade mark in which the Complainant has Rights.

The Expert finds that the Complainant has Rights in respect of a name which is identical to the Domain Name and so the Expert finds that paragraph 2.2.1 of the Policy is satisfied.

Abusive Registration

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

A complainant must prove one or both of these on the balance of probabilities. In the present case, based on the arguments and evidence on record, the Expert finds that the Domain Name was both registered and used in a manner which takes unfair advantage of, and is unfairly detrimental to, the Complainant's Rights.

As far as (i) above is concerned, in order to assess whether the Domain Name was registered or otherwise acquired in a manner which, at the time of registration, took unfair advantage of or was unfairly detrimental to the Complainant's Rights, it is necessary to determine whether the Respondent was aware of the existence of the Complainant and its Rights at that time and, furthermore, with the aim of taking advantage of such Rights (see DRS 4331 (<verbatim.co.uk>)). In this regard, the Expert notes that the Respondent has denied knowledge of the Complainant and its Rights at the time of registration of the Domain Name and justifies his choice on the basis that the Domain Name consists of common terms. Furthermore, the Respondent argues that the Complainant has not provided any evidence to show that its trade mark is known by the public in the UK.

The Expert is not persuaded by the Respondent's claim that he was unaware of the Complainant's Rights and that the Domain Name was his own independent "creation". In this regard, paragraph 5 of the Policy provides a non-exhaustive list of factors which may be evidence of an "Abusive Registration", including:

5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name."

The Expert notes that the Domain Name consists of an exact match of the Complainant's trade mark. The Respondent argues that the Domain Name consists of descriptive or generic terms and that they are not exclusively associated with the Complainant. The Expert is not persuaded by the Respondent's arguments. Whilst the terms "chrome" and "river" may be generic or common by themselves, the combination of these terms is not a usual one. Furthermore, the Respondent has offered no explanation of his choice of this unusual combination. The Expert therefore finds that, on balance, it is highly unlikely that the Respondent arrived at this combination of terms on his own. Furthermore, the Complainant's trade mark appears to enjoy

a considerable degree of reputation, as strongly indicated by the fact that in 2014, at the time of registration of the Domain Name, the Complainant had raised 17 million US dollars in a funding round, as shown by the evidence submitted by the Complainant. In addition, the Respondent's justification for registering the Domain Name for its descriptive value is simply not credible, particularly in light of the timing of registration. In this regard, the Complainant has put forward evidence demonstrating that the Respondent registered the Domain Name precisely on the same day that it was widely publicized that the Complainant had raised 17 million US dollars in a funding round. Given the timing of registration, the Expert is of the view that the Respondent's registration of the Domain Name identically reproducing the Complainant's trade mark cannot be purely coincidental but rather a strong indication of the Respondent's awareness of the Complainant at the time of registration and that he registered the Domain Name for its trade mark value, as opposed to any descriptive value it may have. For the sake of completeness, it is irrelevant that a third party owns a trade mark consisting of a combination of the terms "river" and "chrome" (i.e. "riverchrome"). It is also irrelevant whether the Complainant's trade mark is known or not by the public at large as what is important is that the Respondent himself had knowledge of the Complainant's Rights at the time of registration.

Based on the facts and evidence on record, in particular the nature of the Domain Name itself, which consists of an exact match of the Complainant's trade mark, and the timing of registration, the Expert is convinced, on balance, that the Respondent registered the Domain Name in full knowledge of the Complainant's Rights and that he did so in order to take advantage of such Rights, as shown by the Respondent's subsequent use of the Domain Name (as explained below).

The Expert therefore finds that the Domain Name was *registered* in a manner which takes unfair advantage of, and is unfairly detrimental to, the Complainant's Rights, in accordance with (i) above.

As far as (ii) above is concerned, paragraph 5 of the Policy provides that the following may be evidence of an "Abusive Registration":

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 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;

The Expert is of the view that the Respondent's use of the Domain Name to resolve to a parking page offering the Domain Name for sale constitutes Abusive Registration within the meaning of paragraph 5.1.1.1 of the Policy. The Expert notes that the Respondent appears to have a large portfolio of domain names that also appear to be parked. Whilst engaging in the practice of trading in domain names for profit and holding a large portfolio of domain names is not of itself illegitimate and constitutes one of the defences that may be invoked by a respondent to demonstrate that the disputed domain name is not an Abusive Registration, in accordance with paragraph 8.4 of the Policy, it may be abusive when the domain name in question is identical or

similar to a trade mark and there are strong indications, as in the present case, that it was acquired for its trade mark value as opposed to its descriptive value.

The Expert is not convinced by the Respondent's claim that he does not wish to sell the Domain Name and that he had parked it for his "future online services". The Respondent has not provided any evidence to support his future plans for the Domain Name. Furthermore, as the Complainant pointed out, the Respondent has had almost four (4) years to launch his project in relation to the Domain Name but has failed to do so.

The Expert also rejects the Respondent's claim that the content on the parking page, including the link offering the Domain Name for sale, is automatically generated as it is well established that the Respondent is responsible for the content appearing on the associated website. Furthermore, the fact that the Respondent did not approach the Complainant to sell the Domain Name is irrelevant as the offer to sell the Domain Name appearing on the website is sufficient to demonstrate the Respondent's real intentions for the Domain Name. In addition, the enquiries via GoDaddy constitute further evidence that the Domain Name was for sale.

The Expert therefore finds that the Domain Name is being *used* in a manner which is taking unfair advantage of, and is also unfairly detrimental to, the Complainant's Rights, in accordance with (ii) above.

Importantly, there is a presumption of Abusive Registration that the Respondent has failed to rebut, as set out in paragraph 5.3 of the Policy: *"There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the complaint was filed. This presumption can be rebutted (see paragraphs 8.1.4 and 8.3)."* In this case, the Complainant has put forward evidence showing that the Respondent has been found to have made Abusive Registrations in around seven (7) DRS cases, and at least four (4) of these have been within the last two (2) years, including two cases under similar circumstances (i.e. following a funding announcement), namely DRS 18867 (<kespry.co.uk>) and DRS 18863 (<dollarhaveclub.co.uk>). The Respondent, however, had an opportunity to respond with regards to this evidence but chose not to do so. Based on the foregoing, the Expert finds that the Respondent has failed to rebut the presumption of Abusive Registration set out in the Policy and, as a result, the Expert finds that the Respondent's pattern of abusive domain name registrations in other cases is strongly indicative of Abusive Registration in the present case.

For the sake of completeness, paragraph 4 of the Policy provides a non-exhaustive list of circumstances which may be evidence that the Domain Name is not an Abusive Registration but, as discussed above, none of those circumstances would seem to assist the Respondent.

In conclusion, the Expert has considered the admissibility, relevance materiality and weight of the evidence adduced as a whole and is satisfied that the Complainant has succeeded in proving, on the balance of probabilities, that the Domain Name is an Abusive Registration in accordance with Paragraph 5 of the Policy.

7. Decision

In view of the foregoing findings, namely that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that said Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name <chromeriver.co.uk> be transferred to the Complainant.

Signed: David Taylor

Dated : 15 January 2018