

DISPUTE RESOLUTION SERVICE

D00020454

Decision of Independent Expert

Nutanix, Inc

and

Mr Malcolm Johnson

1. The Parties:

Lead Complainant: Nutanix, Inc
Nutanix, Inc
1740 Technology Drive
San Jose
CA
95110
United States

Respondent: Mr Malcolm Johnson
Montalvo Avenue 18
Belmopan
00000
Belize

2. The Domain Name(s):

<nutanix.co.uk>

3. Procedural History:

3.1 The procedural history of this matter is as follows:

26 July 2018 18:59 Dispute received
30 July 2018 13:10 Complaint validated
30 July 2018 13:15 Notification of complaint sent to parties
16 August 2018 02:30 Response reminder sent
21 August 2018 10:47 Response received
21 August 2018 10:47 Notification of response sent to parties
27 August 2018 02:30 Reply reminder sent
29 August 2018 14:53 Reply received
29 August 2018 14:54 Notification of reply sent to parties
03 September 2018 15:47 Mediator appointed
03 September 2018 17:56 Mediation started
19 September 2018 16:33 Dispute resolved during mediation
23 October 2018 10:14 Dispute opened
23 October 2018 10:16 Mediation failed
23 October 2018 10:16 Close of mediation documents sent
29 October 2018 10:56 Expert decision payment received

- 3.3 I have confirmed to Nominet that I am independent of each of the parties. I have further confirmed that 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.

4. Factual Background

- 4.1 The Complainant is a company established under the laws of Delaware. It also has three offices in the United Kingdom. It was founded in 2009 and is engaged in the business of computing, database management, and data centre infrastructure management software, which are all undertaken under the "Nutanix" name. Its United Kingdom operations are conducted through a subsidiary, Nutanix Limited. It also operates a website to promote its business from the domain name <nutanix.com>.
- 4.2 In the six years prior to 2017 the Complainant sold products and services worth US\$2 billion.
- 4.3 The Complainant is the owner of various trade marks that either comprise or incorporate the term "Nutanix". These include:
- (i) EU Registered Trade Mark no 013680103 for the word mark "NUTANIX" in classes 9, 41 and 42, applied for on 26 January 2015 and registered on 20 August 2015; and

(ii) EU Registered Trade Mark no 016985384 for the word mark "NUTANIX" in classes 37 and 42 applied for on 13 July 2017 and registered on 14 November 2017.

- 4.4 The Domain Name was registered on 18 November 2017. The Domain Name was registered in the name of one "Yury Korkts" who provided an address in Belarus.
- 4.5 As at 3 January 2018 a webpage operated from the Domain Name that displayed sponsored searches but also prominently displayed a panel which declared that the Domain Name was for sale for a price of £19,500.
- 4.6 On 8 January 2018 the Complainant's US attorneys sent a letter before action addressed to Mr Korkts. There was no response to that letter but it would appear that by at least 23 January 2018, the Domain Name had been transferred into the name of the Respondent. The registered address for the Respondent would suggest that he is an individual located in Belize.

5. Parties' Contentions

Complaint

- 5.1 The Complainant provides details of its business and registered trade marks. It also claims common law rights under the law of passing off.
- 5.2 The Complainant also sets out the history of the Domain Name and provides a Domain Name Tools print out that suggests that as at 26 July 2018 it was listed for sale for US\$17,456.
- 5.3 The Complainant contends that save for the ".co.uk" suffix, the Domain Name is identical to its trade marks. Further, it contends that the history of the Domain Name and how this has been used demonstrates that the Domain Name has been registered primarily for the purposes of sale to the Complainant, as a blocking registration, and/or for the purpose of unfairly disrupting the Complainant's business.
- 5.4 The Complainant also contends that the Domain Name falls within the scope of paragraph 5.1.6 of the Policy in that it:

"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."

- 5.5 In this respect, it claims that the term “Nutanix” is unusual, highly distinctive and is unknown in ordinary language.

Response

- 5.6 The Respondent has put in a response that is essentially only a few lines in length. It reads as follows:

“Hi, sorry, im [sic] travelling,
I suppose i need to write here something - domain bought for
personal use and it is my nickname.
I think I dont heard [sic] ever that name before.
I want to use it for my personal site.”

Reply

- 5.7 In its Reply the Complainant observes that no evidence is submitted by the Respondent to support the contention that “Nutanix” is a nickname. It also submits further evidence to the effect that as at 21 August 2018 the Domain Name was being offered for sale through Sedo’s Domain Marketplace for €15,000 with a minimum offer of €90.

6. Discussions and Findings

- 6.1 To succeed under Nominet’s Dispute Resolution Service Policy, the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy) and second, that the Domain Name is an Abusive Registrations in the hands of the Respondent (paragraph 2.1.2 of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2.2 of the Policy).
- 6.2 Abusive Registration is defined in paragraph 1 of the Policy as follows:

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

Complainant's Rights

- 6.3 I accept that the only sensible reading of the Domain Name is as the term "Nutanix", in which the Complainant has registered trade mark rights, combined with the "co.uk" second and top level domain. Given this, I accept that the Complainant has rights in respect of a trade mark that is similar to the Domain Name. Indeed, this does not appear to be contested by the Respondent. It follows that the Complainant has demonstrated paragraph 2.1.1 of the Policy.

Abusive Registration

- 6.4 I do not accept the Respondent's claim that the term "Nutanix" is his nickname. That is an inherently improbable contention and as the Complainant observes, no evidence is submitted in support of that claim. Further, the Respondent's contention that the Domain Name was acquired for his own personal use is inconsistent with the evidence filed by the Complainant that both before and after the Complaint was filed the Respondent has actively sought offers for the Domain Name.
- 6.5 These conclusions, the extent of the Complainant's business, and the fact that the term "Nutanix" has no obvious meaning other than as the name of the Complainant's business, means that I have no hesitation in concluding that the Domain Name has been registered, acquired or held by the Respondent with the intention to take unfair advantage of the Complainant's rights. I also hold that it is most likely that the intention in this case was to sell, rent or otherwise transfer 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. This is activity that falls within the scope of paragraph 5.1.1.1 of the Policy.
- 6.6 Further, I accept that the words "exact match" used within paragraph 5.1.6 of the Policy encompasses the situation where a domain name is identical to a complainant's mark save for the "co.uk" suffix. Therefore, I also agree with the Complainant that this is a case that falls within the scope of paragraph 5.1.6 of the Policy.
- 6.7 It follows that the Complainant has demonstrated that paragraph 2.1.2 of the Policy applies in this case.

7. Decision

- 7.1 I, therefore, find that the Complainant has Rights in a name which is similar to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I, therefore, determine that the Domain Name be transferred to the Complainant.

Signed

Dated 5th November 2018