

# Nominet UK Dispute Resolution Service

**DRS 05296**

**HARRY MENDELSSOHN**

v.

**TRANSAIR PILOT SHOP**  
(a trading style of **TRANSAIR (UK) LIMITED**)

## Decision of Independent Expert

### **1. Parties:**

Complainant: Mr Harry Mendelssohn  
Address: 49-51 Colinton Road  
Edinburgh  
Postcode: EH10 5DH  
Country: GB  
Represented by: McKay Norwell, Solicitors

Respondent: TRANSAIR PILOT SHOP  
Address: Shoreham Airport  
Shoreham by Sea  
West Sussex  
Postcode: BN43 5PN  
Country: GB

### **2. Domain Names:**

(1) harrymendelssohn.co.uk; (2) mendelssohnpilotsupplies.co.uk (“the Domain Names”)

### **3. Procedural Background:**

The Complaint was received by Nominet electronically on 4 December, 2007 and in hardcopy on 5 December, 2007. Nominet checked the complaint and, following completion of an outstanding validation formality, duly informed the Respondent, by both letter and by e-mail on 6 December, 2007, noting that the Dispute Resolution Service had been invoked and that the Respondent had 15 days (until 2 January, 2008) to submit a Response. A Response was received on 24 December, 2007. Nominet informed the Complainant accordingly on 27 December, 2007, noting that the Complainant then had 5 working days (until 8 January 2008) to submit a Reply. A Reply was duly received. On 9 January, 2008, Nominet invited the parties to use its Voluntary Mediation Service to resolve the dispute within the period 11-25 January, 2008. No mediated settlement was reached and, on 21 February, 2008, Nominet

invited the Complainant to pay the fee to obtain an Expert Decision pursuant to paragraph 7 of the Nominet UK Dispute Resolution Service Policy (“the Policy”). The fee was duly received by Nominet on 27 February, 2008.

It is also relevant to record that, after the initiation of the DRS proceedings in this case, on 11 December 2007, Nominet received Transfer forms in respect of both the Domain Names. The forms themselves had themselves been dated as having been signed on 1 December, 2007, and purported to transfer the Domain Names from the Respondent to a third party individual. No explanation appears to have been given by the Respondent for the apparent delay between signing of the Transfer forms and sending them to Nominet. One of the Transfers was inadvertently processed by Nominet’s Registration Services Department, although the Domain Names should have been locked against transfer upon commencement of the DRS proceedings. Immediately this was noticed, Nominet reversed the inadvertently recorded transfer. The parties were informed of this by Nominet on 27 December, 2007. The Domain Names therefore remained in the Respondent’s name, pending conclusion of the DRS proceedings.

On 28 February, 2008, Nominet invited the undersigned, Keith Gymer (“the Expert”), to provide a decision on this case and, following confirmation to Nominet that the Expert knew of no reason why he could not properly accept the invitation to act in this case and of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality, Nominet duly appointed the undersigned as Expert with effect from 5 March, 2008.

#### **4. Outstanding Formal/Procedural Issues (if any):**

None.

#### **5. The Facts:**

The Complainant, Harry Mendelssohn is evidently the principal of an Edinburgh-based pilot supplies business, which has traded for many years as Harry Mendelssohn Discount Supplies and, more recently, as Mendelssohn Pilot Supplies, nominally operating as “a division of GPS (Europe) Limited” (a Scottish company SC136694 originally incorporated in 1992). The Scottish business operates a website, which is principally accessed at [www.gps.co.uk](http://www.gps.co.uk). The domain name [gps.co.uk](http://gps.co.uk) was evidently registered for the business in December 1996. Mr Mendelssohn also registered the domain name [harrymendelssohn.com](http://harrymendelssohn.com) in February 2000 and the web address [www.harrymendelssohn.com](http://www.harrymendelssohn.com) resolves to the business’ website at [www.gps.co.uk](http://www.gps.co.uk).

Mr Mendelssohn is also the principal of a related Australian business operated through Mendelssohn Pilot Supplies Pty Ltd, which has its own website at [www.ozpilot.com.au](http://www.ozpilot.com.au). The domain name [ozpilot.com.au](http://ozpilot.com.au) was evidently registered by Mr Mendelssohn, in the Australian company’s name, in December 2005.

The Respondent, Transair Pilot Shop, is the trading style of Transair (UK) Limited. It is also a pilot supplies business, with a number of shops at various English airports. It operates a website at [www.transair.co.uk](http://www.transair.co.uk).

From the WHOIS records, the Domain Names [harrymendelssohn.co.uk](http://harrymendelssohn.co.uk) and [mendelssohnpilotsupplies.co.uk](http://mendelssohnpilotsupplies.co.uk) were both registered in the name of Transair Pilot Shop as

registrant on 16 March, 2007, with a registrant's administrative contact email address given as "rmartin@transair.co.uk".

## **6. The Parties' Contentions:**

### **Complainant:**

The Complainant has asserted that:

1. The Complainant has Rights in respect of a name or mark which is identical or similar to each of the Domain Names (Policy Paragraph 2a(i)); and
2. Each of the Domain Names, in the hands of the Respondent, is an Abusive Registration (Policy Paragraph 2a(ii)).

In support of its case, the Complainant says:

The Complainant has rights in the domain name because it includes within it the personal name of the Complainant, which has been his personal name since birth.

The Complainant has been engaged in the business of selling pilot supplies under his own name since 1987. This is a relatively small and specialised market, and there is considerable goodwill attaching to his personal name. He registered his own website under the name [www.harrymendelssohn.com](http://www.harrymendelssohn.com) on 21 February 2000.

The Respondents are one of his competitors. On 16 March 2007 they registered the complained of domain names. Until 29 November 2007 if the complained of domain names were entered on the Internet the customer was taken directly to the Respondents' website. On 28 November 2007 the Respondents emailed to the Complainant, stating that they intended to divert the domain names to the Complainant's own website. They did not offer to transfer ownership of the domain names, and so they retain control of them.

The Respondents have never traded under the name Harry Mendelssohn, and the Complainant has never had any connection with them. Incidentally, the Respondents have also registered domain names [www.mendelssohnpilotsupplies.com](http://www.mendelssohnpilotsupplies.com) and [www.mendelssohnpilotsupplies.org](http://www.mendelssohnpilotsupplies.org).

The domain names in the hands of the Respondents are abusive because they were used by the Respondents in a way which will have confused people into thinking that they were controlled by the Complainant. The Complainant does a great deal of business by way of Internet ordering. Customers wishing to purchase goods from the Complainant will typically enter his name into a search engine. A Google search will bring up the Respondents' domain names, and orders will have been placed to the Respondents by customers in the belief that they were dealing with the Complainant. The only reason why any customers would find themselves on the Respondents' website having entered the complained of domain names is that they intended to do business with the Complainant.

Further, the registrations are one of a series the Respondents have made, which because of their number, type and pattern prove that the Respondent is in the habit of making registrations of domain names which correspond to trade marks or other well known names in which the Respondent has no apparent interest. These other registrations are [www.pooleys.biz](http://www.pooleys.biz), [www.pooleys.org](http://www.pooleys.org), [www.flightstore.biz](http://www.flightstore.biz), [www.flightstore.org](http://www.flightstore.org), [www.adamsaviation.org](http://www.adamsaviation.org), and [www.adamsaviation.info](http://www.adamsaviation.info).

All these are well known business names of competitors supplying the same goods as the Complainant and the Respondents. Again, entering these domain names take the customer to the Respondents' website. Although the complained of domain names no longer connect direct to the Respondents' website, the Respondents retain control and could at any time divert them back to themselves.

The Complainant attached a number of exhibits to the Complaint, including a copy of his Birth Certificate and copies of his solicitor's letter of 28 October, 2007 to the Respondent complaining about the registration of harymendelssohn.co.uk and subsequent emails from the Respondent.

The Complainant requests that the Domain Names should be transferred to it.

**Respondent:**

The Respondent made extensive submissions, reproduced in slightly edited form below:

The Respondent is Transair UK Limited, the trading name of which is Transair Pilot Shop.

Transair UK Limited is a successful Pilot Supplies business selling GPS's, headsets, Books, Software, Clothing to name but a few.

Harry Mendelssohn Discount Sales sells a considerably smaller range of products, focusing mainly on GPS and headsets units – on these items we compete. Harry Mendelssohn manufactures a range of Harry Mendelssohn Headsets, branded "HM" and as a supplier of a huge range of aviation headsets we have considered including these within our future offering.

Disputed Domain Names –

- www.harymendelssohn.co.uk This was acquired by Transair UK Limited in March 2007. The domain name was not owned by anyone, nor had it been since 2004 when Harry Mendelssohn let it lapse.
- www.mendelssohnpilotsupplies.co.uk This was also acquired by Transair UK Limited in March 2007. Again it was not owned, although Transair no longer owns this domain name.

Transair UK Limited does not accept any of the complaints detailed by the Complainant. They are either incorrect and misleading or untrue and these are detailed below. We do however own several other domain names (unrelated to the complainant) that represent product manufacturers or categories to assist with our overall on-line marketing strategy. These domains were purchased legitimately by Transair UK Limited on a "first come first serve" basis and were not previously owned.

The complaints are:

- i. Rights to the domain name – "Harry Mendelssohn" was born Harold Mendelssohn and therefore has no birth right to the name Harry. This name, like all names is also not unique and as such the Complainant has no absolute right to his name. "Harry Mendelssohn" is not the name of a registered limited company. The trading business is named Harry Mendelssohn Discount Sales and is a division of the company GPS Europe Limited.

"Harry Mendelssohn" is importantly the name attached to a range of Aviation Headsets – these being branded "HM Headsets". These products are sold by several other aviation mail order companies (including other competitors of Harry Mendelssohn) and Transair reserve the right to be able to sell these products ourselves. We therefore made the commercial decision that the domain name would be useful to own as it represented the headset product range that we may one day sell.

ii. Competitors in the Pilot Supplies Trade – Transair does compete with Harry Mendelssohn Discount Sales on a proportion of his product offering, but not all products. Similarly, Transair’s own product offering is considerably greater than his and as such we do not compete on in excess of 85% of products that we sell. [www.harrymedelssohn.com](http://www.harrymedelssohn.com) was purchased in 2000 by Harry Mendelssohn. However this is NOT used as the trading domain name for his business. The business name is “Harry Mendelssohn Discount Sales” a division of GPS Europe Limited. It is also important to point out that the business name on his own invoice header is “Harry Mendelssohn Discount Sales” and all derivative domain names of this business are free to buy today including the .co.uk version.

[T]he Harry Mendelssohn website clearly promot[es] his trading web address which is [www.gps.co.uk](http://www.gps.co.uk). There is absolutely NO mention of the domain names that the Complainant is seeking resolution on – and this is simply because he does NOT use them as his main web brand domain. This lack of use of the Complainant’s disputed domain names is further reinforced as Harry Mendelssohn has a subsidiary company in Australia. Again, he does NOT use his name as the domain name, he uses [www.ozpilot.com.au](http://www.ozpilot.com.au). [www.harrymendelssohn.co.uk](http://www.harrymendelssohn.co.uk) was purchased by Transair in March 2007, it having been allowed to lapse by the Complainant in 2004. The fact that this allegedly business critical domain name was allowed to lapse for nearly 3 years before we purchased it indicates how little the Complainant utilises the address within their company. Transair had initially offered Harry Mendelssohn that we would redirect the domain name to his site, but this was rejected out of hand and he issued a formal complaint to Nominet. We have withdrawn this original offer.

iii. Abusive Use of domain names – Transair totally object to this complaint. The Complainant is suggesting that we are attempting to be “passed off” as the Complainant’s company – whereas nothing could be further from the truth. Pilots are not at all confused by the Transair Pilot Shop website, which is clearly nothing to do with Harry Mendelssohn Discount Sales nor do we attempt to confuse them that this is the case. Customers deal with Transair because we are the largest Pilot Supplies company in the UK. Pilots may “Google” Harry Mendelssohn in order to buy an HM Headset and not necessarily because they want to go to his website. Their suggestion that by Googling the name the customer only wants to deal with Harry Mendelssohn cannot be proved and is most likely to be false.

iv. Google Searches and Links – Google search results were annexed to the response –  
For links: [www.harrymendelssohn.com](http://www.harrymendelssohn.com) – result in NO match to documents, proving that the Complainant does not use this domain name to link to other companies.

For links: [www.gps.co.uk](http://www.gps.co.uk) – First result is of course for his trading website and then all the other company links are listed; confirming that the Complainant uses this domain name as his primary business address. Note also that the Complainant’s disputed domain names do not register on this search.

For Harry Mendelssohn – The Complainant’s own website is listed first, as [www.gps.co.uk](http://www.gps.co.uk). Also note that the second company listed is Flightstore (another mutual competitor) who actually sells the HM Headsets product range and this is why he has appeared and why Transair acquired the domain name [www.harrymendelssohn.co.uk](http://www.harrymendelssohn.co.uk).

Also: [www.harrymendelssohn.co.uk](http://www.harrymendelssohn.co.uk) – having done an internet archive search, this domain name was only used by the Complainant for a short 7 month period in 2004, following which it lapsed and remained unwanted until we acquired it in 2007.

v. Trade Mark Rights – Harry Mendelssohn is NOT a registered Trade Mark and therefore Transair has not infringed on the Complainant’s rights as none exist.

vi. Annexed to the Response are copies from current and past advertisements in key aviation magazines which clearly and only promote the domain name [www.gps.co.uk](http://www.gps.co.uk). No other domain name is used by the Complainant, and in the case of his “business sticker” the use of the Harry Mendelssohn domain name is redirected straight to [gps.co.uk](http://gps.co.uk).

a) The registration by the Respondent is not abusive and our continuing ownership of a previously unwanted domain name does not suggest that it will be abusive in the future. We consider that the Complainant has no absolute right to these domain names either from birth

or by mere ownership of a “.com” derivative that is not used in their business. The domain names are variants of a product range available on the market and as a retailer we are entitled to invest in domain names for valid and genuine commercial reasons. Although we do not currently sell these headsets, we have acquired the names on the basis that we may sell them in the future and we have a right to strategically plan forward.

b) Transair have invested in acquiring domain names for various individual products or product ranges or brand categories as part of its genuine and legitimate commercial on-line web marketing.

c) Transair considers that the Complainant is using DRS in bad faith because:

(i) The business trades as Harry Mendelssohn Discount Sales per his commercial invoices.

(ii) The business also trades as Mendelssohn Pilot Supplies

(iii) The business uses the www.gps.co.uk as its primary domain name and one that is advertised constantly.

### **The Complainant's Reply**

The Respondent has commented that the Complainant has no right to the name "Harry" since his real name is Harold. This is untrue. The Complainant is known in the trade as Harry, and has been for many years. Accordingly he has rights in that name.

The Respondent has commented that they acquired the complained-of domain names as a legitimate way of selling the Complainant's products. This is misleading. The Complainant has no objection to retailers selling his products on websites which are obviously theirs. His objection is to the Respondent acquiring domain names which gives the false impression that they are owned by the Complainant.

Until 29th November 2007 customers entering the complained of domain names were taken directly to the Respondent's website, where they were invited to buy products other than the Complainant's, which the Complainant could have sold. The Respondent states that the complained of domain names would be "useful to own", and thereby accepts that there is considerable goodwill attaching to the name. They fail to explain why they are entitled to use that goodwill to sell products other than the Complainant's.

The Respondent comments that a Google search carried out now having entered "Harry Mendelssohn" does not bring up the complained of domain names. This is because the respondent has temporarily transferred them to a Sedo Parking website, which can be seen if the complained of domain names are entered. The Respondent could direct these domain names back to their website at any time.

The Respondent comments that the Complainant had originally registered the first complained of domain name, but allowed it to lapse. This is irrelevant. The definition of "Abusive Registration" covers any sort of acquisition of a domain name.

## **7. Discussion and Findings:**

### **General**

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to each of the Domain Names; and that each of the Domain Names, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

## **Complainant's Rights**

The Complainant in this case has asserted principally that it has rights in the name HARRY MENDELSSOHN and that this name is identical or similar to the Domain Names.

In the Expert's view, it would have been desirable for the Complainant to have provided more information to clarify the relationships between his various trading names and the corporate entity GPS (Europe) Limited. The Complaint has been brought nominally on behalf of Mr Harry Mendelssohn in person. The Solicitor's letter annexed to the Complaint refers to their client as "Mendelssohn Pilot Supplies". The attached emails refer to "Harry Mendelssohn Sales, (GPS Europe Ltd.)" and "(Australian Office) Mendelssohn Pilot Supplies", the exhibited invoice, stamp and sticker details refer to "Harry Mendelssohn Discount Sales".

Formally, therefore, it might perhaps have been tidier for the Complainant to have also joined GPS (Europe) Limited as a joint-Complainant if that is the umbrella entity under which Mr Mendelssohn's business(es) are run. However, this is clearly a case where the Complainant has created, developed and run the relevant business(es) under his own name and control. He is effectively as one with the business(es), and shares common design and interest in it or them. His authority to act for and represent them has not been questioned. The relevant business entity(ies) could be formally joined, or deemed to be, if necessary, on that basis.

The Complainant has been in business since 1987 using his own name. In the context of the pilot supplies business, the Complainant has undoubtedly established a substantial reputation and associated goodwill through the use of his name. That he is entitled to claim rights in respect of the use of HARRY MENDELSSOHN in that context is surely indisputable. The Respondent sought to argue that the Complainant's rights would only apply to "Harry Mendelssohn Discount Supplies". That is absurd. Terms like "Discount Supplies" or "Pilot Supplies" are simply generic descriptors – the Complainant's rights arise from the distinctiveness of the Harry Mendelssohn name. The submissions clearly demonstrate that the Complainant's business(es) are distinctively referred to and recognised as "Harry Mendelssohn's" or "Mendelssohn's", which is an unusual surname in itself, and evidently unique in the pilot supplies' business.

Accordingly, for the purposes of the Policy, the Expert concludes that the Complainant does have Rights in this case in respect of a name or mark, [HARRY] MENDELSSOHN which is similar to each of the Domain Names at issue in these proceedings.

## **Abusive Registration**

The Complainant also has to show that each of the Domain Names is an 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors, which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 3a of the Policy. Potentially relevant factors in the present case are as set out in Paragraph 3a(i) B & C:

- B. as a blocking registration against a name or mark in which the Complainant has Rights; or
- C. primarily for the purpose of unfairly disrupting the business of the Complainant.

And in Paragraphs 3a(ii), and (iii):

- ii Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.”
- iii 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;

The factors listed in Paragraph 3 of the Policy are only intended to be exemplary and indicative. They are not definitive. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above. However, in the present case, the Expert believes that the Respondent may be considered to have effectively condemned itself out of its own mouth (or at least in its own written submissions and evidence) with reference to any one of these factors.

At the date of this Decision, it is now nearly ten years since the Court of Appeal, in its leading judgment in the “One In A Million” case (*British Telecommunications plc & Others v. One In A Million Limited & Others*, [1999] FSR 1), condemned the practice of misappropriating trade marks and names in which other parties have rights and registering them as domain names. Such practices have consistently been confirmed as unacceptable in many, many subsequent cases, and in many DRS Decisions.

It is surely incredible that any legitimate business should still be so presumptuous or naive as to believe that it could defend the unauthorised registration and use of a competitor’s names and marks as domain names simply because those domain names were not already registered. The Respondent has claimed that “We therefore made the commercial decision that the domain name would be useful to own as it represented the headset product range that we may one day sell.”, and “The domain names are variants of a product range available on the market and as a retailer we are entitled to invest in domain names for valid and genuine commercial reasons. Although we do not currently sell these headsets, we have acquired the names on the basis that we may sell them in the future and we have a right to strategically plan forward.”

By such specious logic, the Respondent might presume to extend its speculative acquisitions along even grander lines and could go on to register other “derivative domain names” – to use the Respondent’s phraseology, such as perhaps “rolls-royce-engines.co.uk” or “boeingcompany-aircraft.co.uk” (both of which were available for registration at the time of writing), in contemplation of selling such products as well!

The reality, of course, is that the potential availability of a domain name for registration does not mean that any Tom, Dick or Transair is freely entitled to come along and register and use the name, particularly in business, when the underlying name or brand belongs to someone else. The potential for deception, misrepresentation and confusion should be obvious.



The evidence shows that the Domain Names in the present case were used to divert web users to the Respondent's business.

It is also quite possible that the Respondent could or would have received emails sent by potential customers to email addresses <name>@harrymendelssohn.co.uk, or <name>@mendelssohnpilotsupplies.co.uk, and which would have been intended for the Complainant.

On the evidence, the Respondent, as a competitor of the Complainant, has knowingly taken the Complainant's name and used it in the Domain Names for the specific purposes of diverting business from the Complainant and taking unauthorised and unfair advantage of the Complainant's name, reputation and goodwill.

When challenged, the Respondent sought to deflect criticism by offering to redirect the Domain Names to the Complainant's site, but then expressly stated in its Reponse: "We have withdrawn this original offer." Given the Respondent's conduct, the Complainant is surely right to fear the Domain Names could be redirected elsewhere at anytime so long as they remain in the Respondent's control. The risk has been further demonstrated by the Respondent's subsequent attempt to transfer the Domains to a third party and to disclaim responsibility on that basis. In the Expert's view, the evidence also provides grounds to suspect that those purported transfers were most likely a sham and certainly not arms-length transactions – both Domain Names were supposedly to be transferred from the Respondent to a "Robert Martin" – but the original email contact for the Domain Name registrations was also given as "rmartin@transair.co.uk".

The threat to the Complainant's name and goodwill is very similar to that faced by the Claimants in the "One in a Million" case.

The Expert therefore has no hesitation in concluding that the Domain Names were registered and have been used by the Respondent in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights and that both are Abusive Registrations for the purposes of the Policy.

## **8. Decision:**

Having concluded that the Complainant has Rights in respect of a name or mark which is similar to each of the Domain Names and that the Domain Names, in the hands of the Respondent, are both Abusive Registrations, the Expert determines that the Domain Names, harrymendelssohn.co.uk, and mendelssohnpilotsupplies.co.uk should be transferred to the Complainant.

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Keith Gymer

March 19, 2008  
Date