

**DISPUTE RESOLUTION SERVICE**

**DRS 07150**

**Decision of Independent Expert**

**Minuteman Press International Inc.**

and

**Rsite Limited**

**1 The Parties**

Complainants: Minuteman Press International Inc.

Address: 61 Executive Boulevard  
Farmingdale, NY

Postcode: 11735

Country: United States of America

Respondent: Rsite Limited

Address: 14 Hassocks Wood Business Centre  
Stroudley Road  
Basingstoke

Postcode: RG24 8UQ

Country: United Kingdom

**2 Domain Name**

[minuteman-print.co.uk]

### **3 Procedural History**

- 3.1 On 23 April 2009 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet received a response from the respondent on 6 May, and the complainant’s reply on 13 May. The dispute was not resolved in mediation. The complainant requested referral of the matter for expert decision under the Procedure, and on 22 June paid the applicable fee.
- 3.2 I, Carl Gardner, was appointed as expert on 30 June 2009. I have made the necessary declaration of impartiality and independence.

### **4 Factual background**

- 4.1 The complainant is an international printing franchise, with over 900 franchises worldwide, about 50 of which are in the UK. It first entered the UK market in 1995.
- 4.2 The respondent registered the domain name on 28 November 2008.

### **5 Parties’ Contentions**

#### *Complainant*

- 5.1 The complainant argues that the domain name has been used for the website of Minuteman Print Limited, which offers products and services similar to those offered by the complainant, and infringes the complainant’s trademarks.
- 5.2 The complainant argues that the domain name was registered for the purpose of selling or otherwise transferring it to the complainant. In support of this it has produced e-mails and a letter from Minuteman Print Limited dated 25 February 2009, 9 and 11 March 2009, and 6 April 2009 in which Minuteman Print Limited offers to sell the domain name to the complainant first for £30,000, then for £16,000. It argues that these amounts clearly exceed the costs of registering or using the domain name.
- 5.3 It argues that at the time of registration the respondent was aware of its rights and took unfair advantage of them by allowing the domain name to be used and the Minuteman Print Limited website to be developed.
- 5.4 It argues that Minuteman Print’s use of the domain name will lead members of the public to believe that it is associated with and the complainant.

#### *Respondent*

- 5.5 The respondent says the domain name was purchased on behalf of Minuteman Print Limited, which is a registered company. The respondent says that company is entitled to the domain name that best reflects its business and name.

- 5.6 The respondent says Minuteman Print Limited does not want to sell the domain name, but offered it to the complainant in return for the cost of rebranding its business. It says this offer was made under duress and as a goodwill gesture.
- 5.7 It denies that the domain name takes unfair advantage of the complainant's rights.

## **6 Discussion and Findings**

### *General*

- 6.1 Under paragraph 2(a) of the Policy a complainant must show on the balance of probabilities that:
- it has rights in respect of a name or mark which is identical or similar to the domain name, and that
  - the domain name, in the hands of the respondent, is an abusive registration.

### *Rights*

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.
- 6.3 The complainant has produced documentary evidence from the Office for Harmonization in the Internal Market of its EU trade mark in respect of the words "Minuteman Press"; documentary evidence from the US Patent and Trademark Office of its service mark in respect of the words "Minuteman Press"; and documentary evidence from the UK Intellectual Property Office of its trade mark including the words "Minuteman Press". It appears the complainant has been in business for many years under the Minuteman Press brand name.
- 6.4 At the third level (i.e. disregarding ".co.uk"), the word "minuteman" comes at the beginning of, and makes up most of, the domain name. It is the dominant element of the domain name, and is the same as the dominant element of the complainant's brand and trade marks. In my view the addition of a hyphen and the word "print" does not make the domain name dissimilar to the complainant's brand. On the contrary: "print" and "press" are both monosyllables beginning with the same combination of consonants, and they have overlapping meanings in the context of commercial printing.
- 6.5 In those circumstances I am satisfied that the complainant has rights in respect of a name or mark which is similar to the domain name.

### *Abusive Registration*

- 6.6 Under paragraph 1 of the Policy, abusive registration means a domain name which either:

- 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
- has been used in a manner which took unfair advantage of or was unfairly detrimental to the complainant's rights.

This definition obviously covers both the time of registration, and later use.

- 6.7 Under paragraph 3(a)(i)(A) of the Policy, it may be evidence of abusive registration if there are 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 for valuable consideration in excess of the costs directly associated with acquiring or using it.
- 6.8 The complainant alleges that the e-mails and letter it has produced from Minuteman Press Limited show that this was its intent. But deciding to sell a domain name after registration, even for profit, is not in itself abusive use; and the e-mails and letter do not prove anything about the respondent's or Minuteman Print Limited's intent at the time of registration.
- 6.9 On the other hand, as I explain at paragraphs 6.17 and 6.18, the respondent has produced little evidence in support of its claim that it registered the domain name on behalf of Minuteman Press Limited in connection with a genuine business.
- 6.10 I therefore make no finding about whether the respondent registered the domain name with the intention that it be sold to the complainant.
- 6.11 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using the domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.
- 6.12 Given that the domain name is so similar to the complainant's name and trade marks, I am satisfied that initial interest confusion is likely between the domain name and the complainant. Any confusion would in my view be likely to be compounded by the fact that the domain name has been used for a website advertising printing services.
- 6.13 In my view therefore, there is a prima facie case that the domain name has been used in a manner which took unfair advantage of the complainant's rights.
- 6.14 It is of course for the complainant to make good its case. However, since I have concluded that a prima facie case has been established, I will now consider what if any answer the respondent has.
- 6.15 Under paragraph 4(a)(i)(c) of the Policy it may be evidence against abusive registration if, before being aware of the complainant's cause for complaint, the respondent has made legitimate non-commercial or fair use of the domain name. However, for the following reasons I do not think this helps the respondent.

- 6.16 First, it is not clear from the evidence before me that the respondent was unaware of the cause for complaint before the domain name was being used for Minuteman Press Limited's website. The respondent in its response says nothing about this; and an e-mail from Martyn O'Brien to the complainant dated 23 February 2009 and produced by the complainant is ambiguous about when precisely the respondent and Minuteman Print Limited knew of the complainant and its business.
- 6.17 Secondly, the respondent has produced nothing to support its claim that the domain name has been used in connection with a legitimate business, except to say that a company has been registered in the name Minuteman Press Limited and to mention a business plan. It does not even say when the company was registered. Such evidence as I do have about the company comes from letters produced by the complainant, in particular a letter dated 6 April 2009 from Minuteman Print Limited which says it has no assets or funds.
- 6.18 The company registration may represent a real and substantial business but on the basis of a company registration alone and the mere mention of a business plan, in the absence of any evidence from the respondent about the company's operations, marketing activity, customer base or employees, I cannot be satisfied of that.
- 6.19 In those circumstances I am satisfied on the balance of probabilities that the domain name, in the hands of the respondent, is an abusive registration.

## **7 Decision**

- 7.1 I find that the complainant has rights in a name or mark which is similar to the domain name; and that the domain name, in the hands of the respondent, is an abusive registration.
- 7.2 The complaint is upheld. I direct that the domain name be transferred to the complainant.

**Signed:** Carl Gardner

**Dated:** 21 July 2009