

DISPUTE RESOLUTION SERVICE

DRS 07693

Decision of Independent Expert

Kelly's Storage Limited

and

Overs International Limited
(on behalf of a non trading individual)

1. The Parties:

Complainant: Kelly's Storage Limited
Address: Slyfield Green Industrial Estate
Westfield road
Guildford
Surrey

Postcode: GU1 1SB
Country: GB

Respondent: Overs International Limited
(on behalf of a non trading individual electing privacy)
Address: Ashcombe Court, Woolsack Way
Godalming
Surrey

Postcode: GU7 1LQ
Country: GB

2. The Domain Name:

kellysstore.co.uk ("Disputed Domain Name")

3. Procedural History:

02 September 2009: Complaint received, validated and notified to parties

04 September 2009: Response received and notified to parties

04 September 2009: Reply received

09 September 2009: Notification of Reply sent to parties

09 September 2009: Commencement of mediation phase

20 September 2009: End of mediation phase

25 November 2009: Expert decision payment received

1 December 2009: Expert appointed.

Capitalized terms used in this decision have the meaning given to them in the Nominet Dispute Resolution Service (“DRS”) Policy and Procedure, Version 3 of July 2008 (“the Policy” and “the Procedure” respectively).

4. Factual Background

The Complainant is in the self storage and removals business. It has traded since 1999/2000 under its company name, Kelly’s Storage Limited, and variations on the same including; Kelly’s, Kelly’s Storage Solutions, Kelly’s Self Store. It also trades under and by reference to its own domain name, kellystore.co.uk, and has used that name to promote its business on the internet since February 2001.

The Disputed Domain Name was registered on 1 August 2008. The named Respondent purportedly holds the Disputed Domain Name on behalf of an individual registrant who has elected privacy for WHOIS purposes.

The Complainant says the Disputed Domain Name resolves to a website advertising the business of Overs International and its self storage services.

The Complainant submitted evidence of the webpage to which the Disputed Domain Name resolved on 2 September 2009. The Complainant says Overs International is a competitor.

The Complainant says it asked the Respondent to surrender the Disputed Domain Name by a letter of 26 August 2009, sent by recorded mail, but received no reply.

5. Parties’ Contentions

The Complaint

The Complainant says it has rights in a name or mark identical or similar to the Disputed Domain Name and that in the hands of the Respondent, it is an Abusive Registration.

Rights

The Complainant says it has rights in the name kellystore.co.uk arising from its constant use of that name in trade as a domain name since 2001, protected by the law of passing-off as common law trade mark rights. The Complainant also relies on its use of variations on that name including its company name.

The Complainant provided evidence of use from the internet archive showing the pages live at its domain since 2001. It also provided leaflets, brochures and advertisements from 2000, 2002, 2006 and 2009 and extensive evidence of its use of the names on its packaging and get up and on its vehicles.

Abusive Registration

The Complainant says the Disputed Domain Name in the hands of the Respondent is Abusive as it was registered for the sole purpose of unfairly disrupting the Complainant's business and is now used to cause disruption and confusion.

The Complainant says its name is distinctive of and referable to the Complainant and the Respondent, a direct competitor, had knowledge of the Complainant and its trade names as it employs former employees of the Complainant and therefore registered the Disputed Domain Name solely to disrupt business by diverting customers and potential customers from the Complainant's website to a site advertising the Respondent and linking to its home site.

It says confusion likely arises from the similarity but that at least one client of the Complainant, who misspelt the Complainant's email address, was actually confused and submitted evidence of the same. The Complainant says the name is not descriptive nor is there any other legitimate reason for the Respondent to have selected it.

The Response

The Respondent says the Disputed Domain Name and many others were registered by a discount service and originally email accounts were not set up. It also says the Disputed Domain Name is "due" to be transferred to a third party company called Kellys Store Limited, company number 07008230. Finally it notes that the Respondent did not reply to the Complainant's recorded letter as it was not given sufficient time.

The Reply

The Complainant says the Respondent's has not rebutted its case and points to the Respondent's defence that it proposes to transfer the Disputed Domain Name to the

third party as demonstrating an attempt to prevent the Complainant acquiring the Disputed Domain Name.

6. Discussions and Findings

General

The DRS is designed as a fast, simple alternative to litigation. Domain names are registered on a first come, first served, basis and a registration will only be disturbed if it is an Abusive Registration.

§ 2(a) of the Policy requires the Complainant to prove 2 elements:

“i. The Complainant 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.”

The Complainant bears the onus of proof and must prove both elements on the balance of probabilities. The DRS’s jurisdiction is limited to these issues and the remedies of cancellation, suspension, transfer or amendment of a domain name.

Rights

The Complainant clearly has common law trade mark rights enforceable at law in name(s) identical and similar to the Disputed Domain Name arising from its extensive use of the name(s) in trade for almost 10 years. The Complainant has more than adequately met its burden of proof as to its common law rights.

For the purpose of assessing similarity between the Disputed Domain Name and the Complainant’s domain name, the former has only one additional letter---an extra s after Kelly, representative of the possessive apostrophe. This does not distinguish it from the Complainant’s domain name and I find the Disputed Domain Name is identical to it.

Ignoring the suffix ‘Limited’ in the company name, the difference is the s for the possessive apostrophe and the ending ‘age’ in storage. I am satisfied the Disputed Domain Name is identical and similar to the Complainant’s common law names and marks.

Abusive Registration

The second element the Complainant must prove under §2(a) of the Policy, is the Disputed Domain Name is an Abusive Registration, as defined in §1 thereof, 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."

§3 of the Policy is an illustrative list of factors, which may evidence an Abusive Registration. Conversely, §4a of the Policy provides a list of factors which may evidence that a registration is not an Abusive Registration. Both lists are non-exhaustive.

The Complainant relies in the Complaint on §3(a)i C (unfair disruption of business) and §3(a) ii (confusion) and it is convenient to deal with these first.

Unfair Disruption

The Complainant says the sole purpose of the Respondent in registering the Disputed Domain Name was to unfairly take advantage of the Complainant's reputation to divert internet users to the Respondent and disrupt the business of the Complainant. The Complainant relies on the abusive intent evident by the use in competing services in the same field of activity and the evidence clearly establishes the parties are competitors.

The Complainant also says the Respondent had direct knowledge from its ex-employees and while no evidence was provided of this assertion, it was not disputed in the Response. Indeed, the Respondent gave no innocent or other explanation for its choice of the name whatsoever.

The Respondent did say it used a discount service for its registrations. If it seeks to suggest it holds a portfolio which accidentally included the Complainant's name it has failed to provide sufficient assertion or evidence of that. Any such claim would also need to directly address the issue of knowledge, on which the Respondent is mute.

Knowledge and intention are pre-requisites for a successful complaint under all heads of §3(a)(i) of the Policy, see *Decision of the Appeal Panel in Verbatim v Toth*, DRS 04331 (31 July 2007) at §8.13. The facts also bring to mind *Chivas Bros Ltd v. D. W. Plenderleith* DRS 00658, where it was said that where a Respondent registers a domain name: (1) identical to a name in respect of which a Complainant has Rights; (2) that name is exclusively referable to the Complainant; (3) there is no obvious justification for the Respondent having adopted that name; and (4) the Respondent has come forward with no explanation for having selected the domain name; it will ordinarily be reasonable to infer that the Respondent registered the domain name for a purpose and that that purpose was abusive.

The Respondent relies on its intention to transfer the Disputed Domain Name to a third party company. Firstly, this is no answer to its purpose in registering the Disputed Domain Name and no explanation for it. Secondly, based on the records in the public domain and available online, I was able to determine that this transferee company was incorporated on 3 September 2009—the day after the DRS Complaint was served by Nominet on the Respondent. This is very unlikely to be a coincidence. §5(C)v of the Procedure requires respondents to state that the contents of responses are both true and complete. I very much doubt the Respondent has properly given that statement here and that we have the complete story of the Respondent's involvement with this new company.

It may be the adoption of that company name could be the subject of an objection by the Complainant under the Company Names Adjudication Rules and of a complaint to the Office of Fair Trading under the Business Protection from Misleading

Marketing Regulations 2008. The Complainant may also be able to restrain its use by the law of passing-off. These rules and the DRS Policy on Abusive Registration all have at their core consumer protection and the prevention of conduct in bad faith which deceives consumers and wrongly profits from the hard earned trade reputations of others.

The Respondent also says originally it did not also set up email accounts in connection with the Disputed Domain Name. It deliberately fails to clarify the current position. The evidence on client confusion suggests email addresses were set up at the Disputed Domain Name as no 'non-deliverable' message was generated. I infer email accounts were set up. This is a very deliberate step taken by the Respondent to harvest the fruits of its disruption and crosses the line delineating generally acceptable commercial behaviour.

I find that the Respondent had the requisite knowledge of the Complainant and also the intention to free-ride on its reputation, goodwill and marketing and divert its custom. The Complainant has discharged its burden of proof and made out unfair disruption.

Confusion

The Complainant's case is that the Respondent in registering the Disputed Domain Name and by its use unfairly takes advantage of the Complainant's names as the similarity of the Disputed Domain Name to the Complainant's names and the Respondent's use in relation to competing services is in itself likely to confuse the public who may think the Respondent or its site is connected, authorized or sponsored by the Complainant.

See *National Westminster Bank plc v. Harry Planet*, DRS 3291 (7 March 2006) and *Warren James Jewellers Limited v. David Allan*, DRS 3706 (28 July 2006) ("the nature of this type of typo-squatting is to seek to take advantage of typing errors by Internet users, and the Expert considers that it is natural to conclude that Respondent intended there to be confusion which would lead a customer or potential customer into believing that the domain name is registered to, operated or authorized by the Complainant, because there is no other reason for the web pages to exist than for people to visit them").

Based on the evidence discussed above and in particular the evidence as to the email accounts, I also find that confusion is made out.

The Complainant also relies in the Reply on §3(a)(i)(A) (for sale to a competitor) and (B) (blocking) but in these circumstances there is no need to go on to these grounds.

7. Decision

For the reasons described above I find the Complainant has rights in names and marks identical and similar to the Disputed Domain Name and that in the hands of the Respondent, it is an Abusive Registration and order the Disputed Domain Name to be transferred.

Signed: Victoria McEvedy

Dated: 7 December 2009