

## **Dispute Resolution Service**

**DRS 15914**

### **Decision of Independent Expert**

**Pak Cargo Service UK Limited**

and

**Glenley Limited**

#### **1. Parties**

Complainant : Pak Cargo Service UK Limited  
Laynes House  
526-528 Watford Way  
London  
NW7 4RS  
United Kingdom

Respondent : Glenley Limited  
71-75 Shelton Street  
Covent Garden  
London  
WC2H 9JQ  
United Kingdom

#### **2. Domain Name**

pakcargoservice.co.uk (the "Domain Name")

### **3. Procedural Background**

On 9<sup>th</sup> May 2015 the Complaint was lodged with Nominet UK Limited (“Nominet”) and validated on 11<sup>th</sup> May 2015. On 11<sup>th</sup> May 2015 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising it to log into its account to view the details of the Complaint, and giving it 15 business days within which to lodge a Response on or before 2<sup>nd</sup> June 2015.

On 26<sup>th</sup> May 2015 the Respondent responded. On 26<sup>th</sup> May 2015 Nominet informed the Complainant that the Response was available to be viewed via the Complainant’s online services account, and inviting it to Reply to the Response on or before 2<sup>nd</sup> June 2015. On 2<sup>nd</sup> June 2015 the Complainant replied, and Nominet informed the Respondent that the Reply was available to be viewed via the Respondent’s online services account. Mediation documents were generated for the Complaint, and mediation commenced on 5<sup>th</sup> June March 2015. Mediation was unsuccessful and concluded on 24<sup>th</sup> June 2015.

On 2<sup>nd</sup> July 2015 the Complainant paid the appropriate fee for a Decision to be made by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 14<sup>th</sup> July 2015 Mr. Niall Lawless (“the Expert”) was appointed to act as Expert in this dispute, he is required to give his Decision by 4<sup>th</sup> August 2015. Mr Lawless has confirmed that he knew of no reason why he could not properly accept the appointment, and knew of no matters which ought to be drawn to the attention of the parties which might appear to call in to question his impartiality and -/- or independence.

### **4. Outstanding Formal -/- Procedural Issues**

There are no outstanding formal or procedural issues.

### **5. Factual background**

The Complainant, Pak Cargo Service UK Limited, is a UK Private Limited Company incorporated on 11<sup>th</sup> May 2011. The Complainant specialises in the transportation of parcels between the United Kingdom and Pakistan (including Azad Kashmir). It is the proprietor of a Great Britain and

Northern Ireland Trade Mark No. 2592907 registered in respect of *“Collection and delivery of parcels and goods from UK to Pakistan and vice versa”*. The Respondent is Glenley Limited, a company providing internet services for the website at the disputed Domain Name. The Respondent registered the Domain Name on 13<sup>th</sup> January 2015.

## 6. The Parties' contentions

### The Complainant

The Complainant seeks transfer of the Domain Name. The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration because:-

- The organisation benefiting from the Domain Name is a counterfeit and false company.
- The Respondent's use of the Domain Name is an infringement of the Complainant's trademark rights.
- The Respondent's use of the Domain Name is causing confusion.
- The Respondent's use of the Domain Name is abusive because it is disrupting the business of the Complainant.

### The Respondent

Whereas the Domain Name is “pakcargoservice.co.uk”, in its Response the Respondent refers to “pakcargoservices.co.uk”. The Expert accepts this as a typographical error. The Respondent says that the Domain Name is not an Abusive Registration because:-

- The organisation benefiting from the Domain Name is not a counterfeit or fraudulent company.
- The Respondent's use of the Domain Name is not an infringement of the Complainant's trademark rights.
- There is no risk of confusion because the website the Domain Name resolves to is not remotely similar to the Complainant's website.
- The Respondent has never taken work away from the Complainant.

## 7. Discussions and Findings

### 7.1 General

Nominet's DRS Policy requires that for a Complaint to succeed the Complainant must prove to the Expert on the balance of probabilities that:-

- 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.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. 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.

The Complainant is required to prove to the Expert that the Complainant has Rights in respect of a name or mark identical or similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration; both elements must be present.

## 7.2 Complainant's Rights

The Complainant is Pak Cargo Service UK Limited, a UK Private Limited Company. The Complainant is the proprietor of a Great Britain and Northern Ireland Trade Mark No. 2592907 "Pak Cargo Service UK" registered in respect of "*Collection and delivery of parcels and goods from UK to Pakistan and vice versa*". The Complainant operates a UK country-level domain "www.pakcargo.co.uk". The Complainant's company name and its Trade Mark include all the Domain Name elements such as "pak", "cargo" and "service".

Because of the above, I decide that the Complainant has Rights in respect of a name or mark that is similar to the Domain Name.

## 7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy, but it does not state under which part (s) of the Policy. Under

Paragraph 3 - Evidence of Abusive Registration - guidance is given as to what factors may evidence that the Domain Name is an Abusive Registration.

“A non-exhaustive list of factors which may evidence that the Domain Name is an Abusive Registration is as follows :-

3(a)(i). Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily :-

3(a)(i)(A). 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;

3(a)(i)(B). as a blocking registration against a name or mark in which the Complainant has Rights; or

3(a)(i)(C). for the purpose of unfairly disrupting the business of the Complainant;

3(a)(ii). Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant ...”

#### The Complainant's trademark

The Complainant says that the Respondent's use of the Domain Name is an infringement and misuse of the Complainant's trademark rights.

As a Nominet Expert, I am not under duty to consider whether the Respondent's activities amount to a violation of the Complainant's trademark. Expert Decisions are to be determined by reference to Nominet's DRS Policy and not the law in respect of trademark infringement, for example as decided in Deutsche Telekom AG v Lammtara Multiserve Limited Appeal Decision (DRS 05856).

If trademark infringement is a pressing concern, the Complainant has an option of pursuing the matter in Court which it has not done. It is not the role of Nominet's DRS to act as a potential substitute for litigation in relation to all domain name disputes, but only those falling within the narrow confines of the Policy.

### Confusion

The Complainant says that its customers are being confused and misinterpreting the Respondent's website for the Complainant's website and because of this, the Complainant is losing new and regular business.

The Respondent says that its website pages are not remotely similar to the Complainant's website pages. The Respondent says that there are only minor similarities, and that it did not intend these to take work away from the Complainant.

Word-of-mouth advertising is important for every business, and it is where a happy customer can guide other new customers to a business. Good customer experience and service prompts this form of free advertising. In niche communities of customers, it can be an especially significant mechanism for generating revenue.

The chronology of relevant events in this dispute is that on 11<sup>th</sup> May 2011 the Complainant, Pak Cargo Service UK Limited, was incorporated as a UK Private Limited Company. On 2<sup>nd</sup> December 2011, its Trade Mark No. 2592907 in respect of *"Collection and delivery of parcels and goods from UK to Pakistan and vice versa"* was registered. The Complainant had been conducting business for a number of years before 13<sup>th</sup> January 2015, when the Respondent registered the Domain Name.

Under the Policy one of the factors which may evidence that the Domain Name is an Abusive Registration is circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

In style, the Complainant and Respondent's websites are different, but they are similar in content. On their websites, the Complainant and the Respondent emphasise that they offer low-cost transportation of parcels between the UK and Pakistan. The Complainant says that it is *"the cheapest and reliable company"*. The Respondent says that it has *"the cheapest rates on sending cargo to Pakistan"*.

Notwithstanding that the Complainant has not provided any evidence of actual confusion or lost business, I accept that this is likely to have happened. The Complainant and the Respondent offer the same service to a niche market with a connected community of customers where good will and reputation will be particularly important. I have no doubt that when a prospective customer searches the internet for Pak Cargo Service UK Limited, and finds the Domain Name, it is likely to be confused into believing that he or she is doing business with the Complainant.

The Domain Name benefits from the prominence of the Complainant's brand and reputation as it would have existed on 13<sup>th</sup> January 2015, when the Domain Name was registered. The Domain Name is "pakcargoservice.co.uk". The choice of the Domain Name components such as "pak", "cargo" and "service" was not random.

Before registering the Domain Name, the Respondent would have conducted an internet search to look for competitors, their website addresses and websites.

The Domain Name is being used to offer services similar to those offered the Complainant and because of that, I do not doubt that the Domain Name is being used in a way that has confused or is likely to confuse people into believing that the Domain Name is operated by or connected with the Complainant.

Given the services it wanted to provide, it is clear the Respondent's choice of the Domain Name components was rational. The descriptive nature of the Domain Name does not differentiate the Respondent's business from the Complainant's business. To the contrary, the Domain Name describes the services provided by the Complainant. The Respondent registered the Domain Name irrespective of and reckless to what confusion its use might result in.

I decide on the balance of probabilities that even in the absence of evidence of actual confusion, the Respondent is using the Domain Name in a way that has confused and will confuse people or businesses. Therefore under the test in Nominet's DRS Policy 3(a)(ii) in the control of the Respondent the Domain Name is an Abusive Registration.

In light of this finding, it is unnecessary for me to address the Complainant's contention that the Respondent's use of the Domain Name is disrupting its business.

#### 7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name identical or similar to the Domain Name and that the Complainant has proved, on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

#### **8. Decision**

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name be transferred to the Complainant.

**Niall Lawless, Nominet Expert**

**14<sup>th</sup> July 2015**