

DISPUTE RESOLUTION SERVICE

D00019037

**Decision of Independent Expert
(Summary Decision)**

My World Trademarks London Ltd

and

Another.com Limited

1. The Parties:

Complainant: My World Trademarks London Ltd
53 - 55 Uxbridge Road, Santon House
London
W5 5SA
United Kingdom

Respondent: Another.com Limited
Montagu Pavilion
8 - 10 Queensway
Gibraltar
PO BOX 575,
Gibraltar

2. The Domain Name:

ilovelondon.co.uk

3. Notification of Complaint

I hereby certify that I am satisfied that Nominet has sent the complaint to the Respondent in accordance with section 3 and 6 of the Policy.

Yes No

4. Rights

The Complainant has, to my reasonable satisfaction, shown rights in respect of a name or mark which is identical or similar to the domain name.

Yes No

5. Abusive Registration

The Complainant has, to my reasonable satisfaction, shown that the domain name *ilovelondon.co.uk* is an abusive registration

Yes No

6. Other Factors

I am satisfied that no other factors apply which would make a summary decision unconscionable in all the circumstances

Yes No

7. Comments (optional)

I would like briefly to explain why I have refused the Complainant's application and its request that the domain name be transferred to it.

The Complainant has a UK registered trade mark dating from 2011 in a stylised device form set out below.



The heart device is a common alternate for the word 'love' and I am satisfied that most people would read the trade mark as a stylised version of "I Love London". Although it is a common generic phrase and the heart device and overall style are important features of the trade mark, the registration does give the Complainant some rights in those words and it is clearly identical or similar to the domain name.

The Complainant says in its complaint that it is “*working hard, since the registration of our trademarks, on a mobile app and website for the travel sector, especially for London and are now very close to launch our products.*” So the Complainant has not yet commenced trading using its registered trade mark and does not claim any other use rights in addition to it.

However, the registration of the domain name predates the registration of the trade mark by more than 12 years. The Complainant says the domain name remained dormant for over a decade but now resolves to the holding page shown below promising “*property news and special offers for homeowners in London and surrounding areas*”.



The Complainant says this holding page appeared on 20 June 2017, the same day that the Respondent replied to emails of 2 June 2017 and 20 June 2017 from the Complainant enquiring about an amicable transfer of the domain name. The reply simply said “*Would love to help you - but the domain has been sold*”. This email exchange followed an earlier email from the Complainant to the Respondent in January 2017 saying that it wanted to purchase the domain name. That email resulted in what was stated to be an automatically generated response the same day saying the domain name was not likely to be for sale but inviting a ‘best offer’ over £7,500.

The Complainant cannot say that the domain name “*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*” for the purposes of the DRS as the registration predated those Rights by many years.

The generic phrase “I love London” as a domain name could legitimately be put to a very wide range of uses without infringing the Complainant’s registered trade mark rights in its stylised device version of that phrase. The Complainant says that the previous hosting of the domain name by the Respondent infringes

its trade mark registration in class 42 for “*creating, maintaining and hosting the web sites of others and hosting of websites and software applications*”. But no details have been provided by the Complainant of any hosting activity by the Respondent using the domain name and, in any event, any such hosting activity could well predate the trade mark registration and therefore potentially be an “earlier right” for the purposes of trade mark law.

Alternatively, the Complainant says the new use of the domain name in relation to "home owner services" will infringe the trade mark registration in class 43 for the "*provision and reservation of temporary accommodation and lodging facilities, hotels, motels, boarding houses and the provision of information thereto.*" But it is far from clear that the use of the domain name per se in relation to the provision of property news and special offers to home owners (i.e. owners of property as a permanent home) in and around London would be similar to and cause confusion with the Complainant’s stylised device trade mark registered for services relating to hotels and other temporary accommodation or otherwise be 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 the circumstances, on the evidence provided by the Complainant, I am not satisfied on the balance of probabilities that the use now being made of the domain name as outlined above is use “*in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights*”.

Accordingly, the Complainant has failed to prove that the domain name is an Abusive Registration for the purposes of the DRS.

8. Decision

I refuse the Complainant’s application for a summary decision. The domain name registration will therefore remain with the Respondent.

Signed:

Chris Tulley

Dated: 7 August 2017