

## **DISPUTE RESOLUTION SERVICE**

**D00020424**

### **Decision of Independent Expert**

Dell Inc

and

Elite Phones and Computers

#### **1. The Parties**

Complainant: Dell Inc  
One Dell Way  
Round Rock  
Texas 78682  
United States

Respondent: Elite Phones and Computers  
190A Church Street  
Manchester  
M30 0LZ  
United Kingdom

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

<dellrepairer.co.uk>

#### **3. Procedural History**

19 July 2018 10:47 Dispute received  
20 July 2018 13:59 Complaint validated  
20 July 2018 14:07 Notification of complaint sent to parties

08 August 2018 02:30 Response reminder sent  
13 August 2018 12:00 Response received  
13 August 2018 12:01 Notification of response sent to parties  
16 August 2018 02:30 Reply reminder sent  
17 August 2018 17:33 Reply received  
17 August 2018 17:33 Notification of reply sent to parties  
22 August 2018 16:01 Mediator appointed  
24 August 2018 14:36 Mediation started  
19 September 2018 16:05 Mediation failed  
19 September 2018 16:05 Close of mediation documents sent  
20 September 2018 10:00 Expert decision payment received

The Expert has confirmed that he is independent of each of the parties. To the best of his knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question his independence in the eyes of one or both of the parties.

#### **4. Factual Background**

The Complainant is a corporation located in Texas, United States. It is an information technology supplier providing products, services and support worldwide.

The Complainant is the owner of trademark registrations for the mark DELL including but not limited to the following:

- United Kingdom trademark number 2344330 for the word mark DELL, registered on 3 December 2004 for goods and services in various Classes including “maintenance and repair of computer hardware” in Class 37
- European Union Trade Mark number 83345 for a figurative mark DELL registered on 26 March 1998 for goods and services in various Classes including “maintenance and repair of digital computers” in Class 31 (“the Figurative Mark”)

The Domain Name was registered on 9 January 2015.

The Domain Name has resolved to a website at “www.dellrepairer.co.uk” which has offered repair services in connection with the Complainant’s products.

#### **5. Parties’ Contentions**

##### **The Complaint**

The Complainant states that it was founded in 1984 and currently services customers in 180 countries with net revenue in 2015 in excess of USD 54 billion. It states that it

offers products and services under its DELL marks that include computer repair services and refers to dedicated websites providing customer support. It states that it has built up considerable goodwill in the DELL marks and exhibits evidence of its promotional use of the marks and of awards and accreditations received. It submits that, as a result of its use of the DELL trademarks and also numerous domain names including the term “dell”, the mark has become highly distinctive of the Complainant’s products and services and is uniquely identified with the Complainant by members of the public.

The Complainant submits that it has Rights in respect of a name or mark which is identical or similar to the Domain Name. It refers to its DELL trademark and states that the Domain Name wholly incorporates that mark together with the descriptive term “repairer”. It contends that the addition of this term does not detract from the confusing similarity between the Domain Name and its trademark, particularly in circumstances where the Complainant itself offers repair services.

The Complainant submits that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complainant submits that the Respondent has used the Domain Name for the purposes of a website which not only infringes its rights in the trademark DELL but also infringes its copyright in the Figurative Mark. The Complainant exhibits screenshots from the Respondent’s website dated 6 January 2018 which prominently feature the Figurative Mark. The Complainant contends that the Domain Name itself suggests an association with the Complainant which does not exist and that the Respondent further misrepresents a connection with the Complainant by its use of the website described above.

The Complainant further argues that, according to a reverse Whois search, the Respondent is also the registrant of <blackberryrepairing.uk>, <appleservicecenter.co.uk> and <sonyrepairservice.co.uk> which indicates a pattern of bad faith registrations. It includes a further allegation that the Domain Name was acquired for the purpose of selling it to the Complainant for a sum in excess of its out-of-pocket costs directly related to the Domain Name.

The Complainant requests the transfer of the Domain Name.

### **The Response**

The Respondent states that one of its designers unknowingly included a logo that was similar to the Figurative Mark and that the logo on its website has now been changed.

The Respondent also states that it includes a disclaimer on its website stating that it is not affiliated with the Complainant in any way. It adds that responds to enquiries by advising that it is not affiliated with any brands.

The Respondent states that the Domain Name was available for registration and that it had the right to buy it. It submits that there are numerous similar domain names in use to which the Complainant has not objected, including <delllaptoprepairs.co.uk>, <dellrepairuk.co.uk>, <dell.laptop-repaircentre.co.uk> and many others.

The Respondent states that it has no intention to mislead customers or to sell the Domain Name, but only to provide a high quality independent repair service.

The Respondent states that it has invested in the Domain Name and will transfer it if the Complainant pays the cost that has been incurred.

### **The Reply**

The Complainant acknowledges that the Respondent has removed the Figurative Mark, but states that it is still using a confusingly similar logo (although this does not appear in the Complainant's exhibits) as well as numerous references to the DELL trademark on its website.

The Complainant submits that the disclaimer to which the Respondent has referred can only be found by clicking a link at the bottom of the website homepage and then only after reading through other disclaimers. It adds that, based on a reviews of archived pages at "www.archive.org", the Respondent's website included no such disclaimer on 31 January 2018 and it is to be inferred that it was only placed there in response to the present proceedings.

The Complainant submits that the Respondent's reference to paying the cost that has been incurred in connection with the Domain Name supports its contention that the Respondent is attempting to sell the Domain Name for an excessive sum.

## **6. Discussion and Findings**

This matter falls to be determined under the terms of the Nominet Dispute Resolution Service Policy ("the Policy").

Under paragraph 2 of the Policy:

*"2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:*

*2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

*2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration*

*2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities."*

Under paragraph 1 of the Policy the term "Rights":

*“... means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.”*

Also under paragraph 1 of the Policy, the term “Abusive Registration” means 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. is being or has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”*

Paragraph 5 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 8 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

### **Rights**

The Complainant has established that it is the owner of a registered trademark DELL. The Domain Name comprise the Complainant’s mark DELL together with the term “repairer”. The Expert accepts the Complainant’s submission that this descriptive addition is not effective to distinguish the Domain Name from the Complainant’s trademark, and is indeed suggestive of services relating to the Complainant’s trademarked goods. The Expert therefore finds that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

### **Abusive Registration**

The Respondent does not deny that it registered the Domain Name with reference to the Complainant’s trademark DELL, but submits that it is legitimately offering independent repair services in connection with the Complainant’s goods.

In certain limited circumstances, a reseller of trademarked goods or a provider of services may legitimately incorporate a trademark into a domain name used for the resale of the goods or provision of the services in question. As discussed in paragraph 4.8 of the Nominet Dispute Resolution Service Experts’ Overview, Version 2:

*“It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.”*

However:

“A registration will be abusive if the effect of the respondent’s use of the domain name is falsely to imply a commercial connection with the complainant.”

In this case, the Expert does not consider the Domain Name to be inherently misleading and finds that it is a name that could legitimately be used by an independent party offering repair services in connection with the Complainant’s products. The Expert also notes that the Respondent appears actually to offer repair services for the Complainant’s products on its website and that it does not use the website to refer to any other trademark owner’s goods. However, the Expert accepts the Complainant’s evidence that, prior to the issue of these proceedings, the Respondent prominently displayed the Figurative Mark on its website and that it did not until recently include any relevant disclaimer making clear that it was not affiliated with the Complainant. The Expert also finds that the disclaimer the Respondent now includes is insufficient to make it immediately clear to a visitor to the Respondent’s website that the Respondent is not connected with the Complainant.

In these circumstances, the Expert concludes that the Respondent has used the Domain Name falsely to imply a commercial connection with the Complainant and in a manner 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 (paragraph 5.1.2 of the Policy).

The Expert therefore finds that the Domain Name in the hands of the Respondent is an Abusive Registration.

## **7. Decision**

The Expert has concluded that the Complainant 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. The Complaint therefore succeeds and the Expert directs that the Domain Name, <dellrepairer.co.uk>, be transferred to the Complainant.



**Steven A. Maier**  
Independent Expert

1 October 2018