

## **DISPUTE RESOLUTION SERVICE**

**D00020771**

### **Decision of Independent Expert**

PostNet

and

james shotton

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

Complainant: PostNet  
Denver  
Colorado  
United States

Respondent: james shotton  
Cheltenham  
United Kingdom

#### **2. The Domain Name(s):**

post-net.co.uk (“the Domain Name”).

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

The Complaint was submitted to Nominet on 31 October 2018 and was validated and notified to the Respondent by Nominet on 02 November 2018. The Respondent was informed in the notification that it had 15 working days, that is until 23 November 2018 to file a Response to the Complaint.

On 21 November 2018, Nominet sent a reminder of the due date for the Response to the Respondent. The Respondent did not file a Response. On 26 November 2018, Nominet

notified the Parties that no Response had been received and, pursuant to section 12 of Nominet's Dispute Resolution Service Policy Version 4 ("the Policy"), invited the Complainant to pay the fee for referral of the matter for an expert decision. On 6 December 2018, the Complainant paid the fee for a full expert decision. On 14 December 2018, Andrew D S Lothian, the undersigned ("the Expert"), confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 18 December 2018.

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

The Respondent has failed to submit a response to Nominet in time in accordance with section 7.1 of the Policy.

Section 24.8 of the Policy provides that "If, in the absence of exceptional circumstances, a Party does not comply with any provision in this Policy, or any request by us or the Expert, the Expert will draw such inferences from the Party's non-compliance as he or she considers appropriate."

In the view of the Expert, if the Respondent does not submit a response, the principal inference that can be drawn is that the Respondent has simply not availed itself of the opportunity to attempt to demonstrate that the Domain Name is not an Abusive Registration. This does not affect the primary requirement upon the Complainant, on whom the burden of proof rests, to demonstrate Abusive Registration on the balance of probabilities, nor does it in the Expert's view entitle an expert to accept as fact all uncontradicted assertions of the Complainant, irrespective of their merit.

#### **5. Factual Background**

The following information is derived from the Complaint and Annexes, together with the Complainant's websites at "www.postnet.com" and "www.postnetfranchises.com" which were referred to in the Complaint. The Complainant notes that the corresponding domain names have been in existence since March 1995 and June 2000 respectively.

Founded in 1992, the Complainant is a business to business franchising company which provides customised print, marketing and shipping solutions to small businesses in the USA and internationally. The Complainant has 700 locations across North, Central and South America, Africa and Australia. In 2017, the Complainant was acquired by MBE Worldwide which is the owner of the Mail Boxes Etc. brand and business concept internationally with the exception of the USA and Canada. The combined entity has 2,500 locations in 44 countries. A Statement of Foreign Entity Authority dated 23 October 2018 and issued by the Secretary of State of the State of Colorado, USA, shows that the Complainant has traded as PostNet International Franchise Corporation in Colorado since 2 May 2005.

The Complainant is the proprietor of a large variety of registered trade marks in multiple countries worldwide for the word mark POSTNET and related figurative logos, most notably for present purposes (1) UK registered trade mark no. 2135191 for the word mark POSTNET filed on 9 June 1997 and registered on 12 June 1998 in classes 35 and 38 (photocopying, secretarial and electronic bureau services); and (2) United States registered trade mark no. 1801313 for the word mark POSTNET filed on 22 August 1991 and registered on 26 October

1993 in classes 35, 36, 38, 39 and 42 (photocopying, secretarial and answering services; printing brokerage services; electronic bureau services; courier, postal and mail box rental services; and desktop publishing/printing services).

The Domain Name was registered on 8 October 2015. Little is known regarding the Respondent, who did not respond to the Complaint. The Respondent appears to be a private individual with an address in Cheltenham, UK. The Domain Name points to a website promoting a business named "Postnet". This website states that "Postnet" is one of the largest independent postage consultancies in the UK and indicates that its business is the auditing of mail functions, provision of mailroom services, managed services for marketing collateral and packets/parcels, negotiation of effective postal rates and postal audits.

On 12 February 2016, the Respondent applied for a UK registered trade mark under no. 3149406 for the word mark POSTNET for postage services in class 39. The Complainant notes that it opposed the Respondent's application on 11 March 2016. On 24 April 2017, the Respondent withdrew the said application.

The Complainant's logo has the following appearance:-



The Respondent's logo has the following appearance:-



## **6. Parties' Contentions**

### **Complainant**

The Complainant asserts that the Domain Name is almost identical to the Complainant's trade mark and to its business/company name, adding that the latter has been in use since 2 May 2005. The Complainant submits that the dash inserted in the Domain Name is insufficient to exclude the risk of confusion between the Complainant's POSTNET trade mark and the Domain Name itself.

The Complainant states that the Domain Name is actively used for a website offering postal services/shipping solutions which are the same services offered by the Complainant. The Complainant states that the Respondent's logo constitutes an infringement of its rights and that such logo also makes unauthorised use of the '®' symbol. The Complainant notes that it has never authorised the registration of domain names or trade marks composed of or similar to its trade mark.

The Complainant asserts that the Respondent has traded unlawfully on the Complainant's goodwill by directing users to his own commercial website. The Complainant contends that this constitutes use of the Domain Name in a way which takes unfair advantage of and/or is unfairly detrimental to the Complainant's Rights. The Complainant submits that it is

significant that the Respondent did not reply to its communications and requests following the filing of its opposition to the Respondent's trade mark application and that the Respondent then withdrew such application.

The Complainant notes that the Domain Name was registered long after the Complainant's trade marks were filed both internationally and in the UK. The Complainant adds that this is a further indication that the Respondent could not have ignored the existence of the Complainant's mark at the time of registration of the Domain Name.

### **Respondent**

The Respondent did not file a Response and has not replied to the Complainant's contentions.

## **7. Discussions and Findings**

### **General**

In terms of section 2.2 of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in sections 2.1.1 and 2.1.2 of the Policy, namely 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.

### **Complainant's Rights**

Section 1 of the Policy provides that 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".

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

On this topic, the Complainant relies upon its POSTNET registered trade marks described in the factual background section above and asserts that these are almost identical to the Domain Name. The Respondent does not take issue with the Complainant's assertions on this subject.

The Expert is satisfied that the Complainant's UK POSTNET trade mark constitutes a right enforceable by the Complainant under English law. This is sufficient for the purposes of the Policy. The Complainant has also cited its United States trade mark for POSTNET and the Expert notes for completeness that an overseas right can constitute a relevant right within the definition of Rights under the Policy (see section 1.5 of the Experts' Overview Version 3 ("Experts' Overview)). The information provided by the Complainant regarding its United States trade mark was partially incomplete in that it did not include the original registration date. The Expert considered it expedient to conduct a simple online enquiry of the relevant trade mark database to obtain this detail which the Expert has noted in the factual background section above (see section 18.1 of the Policy and section 5.10 of the Experts' Overview).

Comparing the POSTNET marks to the third level of the Domain Name, the Expert notes that these are alphanumerically identical save for the insertion of a dash or hyphen between the elements 'post' and 'net' in the Domain Name. The Expert considers that this additional character does not render the Domain Name dissimilar from the Complainant's mark as it merely acts as a separator. It does not give rise to a new word, different appearance or alternative meaning. In these circumstances, the third level of the Domain Name is similar to a name or mark in which the Complainant has Rights. The first and second levels of the Domain Name (taken together, constituting the suffix .co.uk) are typically disregarded for the purposes of comparison under the Policy on the grounds that these are wholly generic and required for technical reasons only.

Accordingly, the Expert finds that the Complainant has proved on the balance of probabilities that it has Rights in the mark POSTNET within the meaning of the Policy and that such mark is similar to the Domain Name.

### **Abusive Registration**

Section 1 of the Policy defines "Abusive Registration" as 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

This general definition is supplemented by section 5.1 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Section 8.1 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

The Complainant's main contention is that the use of the Domain Name constitutes an Abusive Registration in accordance with the general definition that this takes unfair advantage of or is unfairly detrimental to the Complainant's Rights. More specifically, the Complainant notes that the use of the Domain Name gives rise to a risk of confusion with the Complainant and its mark, effectively a submission in terms of section 5.1.2 of the Policy.

The Complaint is limited in detail as to the Parties' activities but the Complainant has also placed its two websites, and the website associated with the Domain Name, into evidence and accordingly the Expert has reviewed each of these. The Expert notes that there is a similarity in the choice of the red and white colours of the Parties' logos and use of the word 'postnet', noting in particular that the Respondent's logo removes the dash separator which is present in the Domain Name. The Expert also notes that the Respondent has chosen to place the '®' symbol into its logo which the Complainant challenges on the grounds that the Respondent does not have a registered trade mark. This on its own is liable to cause some confusion as the Complainant is the proprietor of multiple POSTNET registered trade marks and indeed the evidence shows that the Complainant successfully opposed the Respondent's attempt to register a corresponding mark in the UK.

The Expert agrees with the Complainant that there is some overlap between the postage/shipping services offered by the Parties. This is of particular significance to the Complainant because the core of its business is to offer franchises of postage/shipping centres. The Respondent does appear to offer an additional service in the form of postage consultancy, however it has not chosen to explain why, if at all, this might lessen the risk of confusion. To the Expert's eyes, and in the absence of any such explanation, the additional service does not appear to differentiate the Parties' businesses from each other. The manner of use of the Domain Name to solicit customers for services which conflict with the Complainant's core business is likely in the Expert's opinion to confuse people or businesses into believing that the Domain Name is connected with the Complainant.

The evidence shows that the Complainant has built a significant business and is actively seeking franchisees internationally. From this, the Expert assumes that the Complainant wishes to establish franchises in the UK although there is no evidence that there are any currently operating. The Complainant holds a longstanding registered trade mark in the UK for bureau services relevant to its franchisees and a wider ranging United States trade mark covering postage and courier services. The ultimate essence of any franchise business is the goodwill and strength of the brand which attracts new franchisees to a ready-made business opportunity. In other words, the Complainant's Rights are of central importance to the continued expansion of its business.

The Expert considers that the present use of the Domain Name is likely to cause unfair detriment to the Complainant's Rights due to the confusion that will be caused by the Respondent's activities via the promotion of its own shipping/postal services on the corresponding website. The Domain Name is very similar to the Complainant's mark and business name, while the name used in the Respondent's logo is identical to these. Potential franchisees of the Complainant are likely to be confused as to whether the Respondent is the Complainant and, in particular, whether the Complainant has extended its services into postage consultancy.

The Respondent has known of the Complainant and its activities, which pre-date the Respondent's own activities by a substantial margin, at least since the Complainant opposed the Respondent's trade mark application in March 2016. One might also take the view that the operator of a business describing itself as the largest independent postal consultancy in the UK, as the Respondent does, would more probably than not have been aware of the Complainant and its activities at an earlier date and, in particular, before the date of registration of the Domain Name. In these circumstances, the Respondent is unlikely to have been able to rely upon section 8.1.1.1 of the Policy, in other words to assert that it had used the Domain Name in connection with a genuine offering of goods or services before being aware of the Complainant's cause for complaint.

In any event, according to the Complainant's assertions, which are not denied by the Respondent, the Respondent has made no effort to communicate with the Complainant or to take any steps to reduce the likelihood of confusion which his activities are causing. Neither, despite the matter having been firmly placed in issue by the Complainant, has the Respondent made any attempt in the present proceeding to argue that his Domain Name and corresponding website do not cause confusion and/or that his services can be distinguished from the services offered by the Complainant. The Respondent has simply 'gone to ground' yet has persisted in maintaining the Domain Name and website in the face of the Complainant's concerns.

In all of these circumstances, the Expert finds that the Domain Name is being used in a manner which has been unfairly detrimental to the Complainant's Rights and consequently that the Domain Name, in the hands of the Respondent is an Abusive Registration.

## **8. Decision**

The Expert finds that the Complainant has proved that it 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. The Expert therefore directs that the Domain Name be transferred to the Complainant.

**Signed** .....

Andrew D S Lothian

**Dated** 21 December, 2018 .....