

**NOMINET UK DISPUTE RESOLUTION SERVICE**

**DRS 0187**

**Pickfords Limited –v- Anglo Continental Limited**

**Decision of Independent Expert**

**1. Parties**

Complainant: Pickfords Limited  
Address: Heritage House  
345 Southbury Road  
Enfield  
Middlesex  
Postcode: EN1 1UP  
Country: GB

Respondent: Anglo-Continental Limited  
Address: 119-123 Hackford Walk  
Stockwell  
London  
Postcode: SW9 0QT  
Country: GB

**2. Domain Name**

4pickfords.co.uk (“Domain Name”)

**3. Procedural Background:**

The Complaint was lodged with Nominet on 9 January 2002. Nominet validated the Complaint and notified the Respondent of the Complaint on 14 January 2002 and informed the Respondent that it had 15 days within which to lodge a Response. The Respondent failed to respond. Mediation not being possible in those circumstances, Nominet so informed the Complainant and on 22 February 2002 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

On 22 February 2002, Cerryg Jones, the undersigned, (“the Expert”) confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

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

No response has been received from the Respondent. Clause 5a of the Procedure for the Conduct of Proceedings under the Dispute Resolution Service ("the Procedure") requires the Respondent to submit a Response to Nominet within 15 days of the date of the commencement of proceedings under the Procedure. Paragraph 15b of the Procedure provides, amongst other matters that if, in the absence of exceptional circumstances, a Party does not comply with any time period laid down in this Policy or the Procedure, the Expert will proceed to a Decision on the Complaint. Paragraph 16a provides that the Expert will decide a Complaint on the basis of the Parties' submissions, the Policy and the Procedure. There is no evidence before the Expert to indicate the presence of exceptional circumstances; accordingly, the Expert will now proceed to a Decision on the Complaint and notwithstanding the absence of a Response.

Paragraph 15c of the Procedure provides that if in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or the Procedure, the Expert will draw such inferences from the Party's non-compliance as he or she considers appropriate.

#### **5. The Facts**

The Complainant is well known for the transportation and delivery of goods. The trade mark PICKFORDS was registered in the UK under No. 1285667 on 1 October 1986 in Class 39. The Complainant also has registrations consisting of or incorporating the word PICKFORDS in the UK under Nos. 1285669, 1349621, 2100867, 1285666, 1285668 and 1509949. The Complainant states that it has also registered PICKFORDS in a number of countries and has provided a detailed schedule listing such registrations. The Complainant asserts that revenue figures relating to the trade mark PICKFORDS during the year 2000 have amounted to £78,000,000 in the UK and would be significantly higher if figures from all the countries are included. However, no evidence is provided to substantiate this assertion.

A WHOIS search shows that on 18 January 2000 the Respondent registered the Domain Name for Lee Bartlett and Nii Larnyoh.

On 28 February 2001 the Complainant, through its representatives, Boulton Wade Tennant wrote to the Respondent drawing attention to its rights in the trade mark PICKFORDS and requesting transfer of the Domain Name. The Respondent did not reply. On 26 March 2001 the Complainant instigated the Nominet dispute resolution policy then in force. Under the previous policy Nominet had a discretionary power to cancel the registration or suspend the delegation of a domain name. The Complainant invoked the policy on the basis that the Domain Name was likely to be used in a manner likely to cause confusion to internet users.

On 4 July 2001 Nominet informed the Complainant that in its view the Domain Name was not being used in a manner likely to cause confusion. On 16 July 2001 in accordance with the rules then in force, Nominet received a written request on behalf of the Complainant for the case to be passed to an independent expert for a written recommendation to either confirm or revoke its decision. The independent expert held that a sufficient risk of potential confusion would arise in the event that the Respondent attempted to transfer the domain name

and that Nominet should prevent any such transfer. On that basis the expert recommended that Nominet review its decision.

Having examined the reasoning of the expert's recommendation, Nominet decided not to suspend delegation or cancel registration of the Domain Name as that was not necessary in its view to implement the expert's recommendation to prevent the transfer of a Domain Name to a third party. Nominet advised the parties by letter on 23 August 2001 that an attempt to transfer the Domain Name by the Respondent would result in a review of Nominet's decision of 4 July 2001 with the consequence that the delegation of the Domain Name might be suspended or the registration cancelled and the transfer prevented. Despite several letters written to the Respondent by Boulton Wade Tennant, Nominet and the independent expert at no time did the Respondent reply.

## **6. The Parties' Contentions**

### Complainant

The Complaint is very short and reads as follows:

The Complainant asserts that the Domain Name is identical or similar to the name and mark in which it has rights. The Complainant asserts extensive rights and trade mark protection for PICKFORDS and registrations consisting of or incorporating PICKFORDS.

The Complainant alleges that the Domain Name is an Abusive Registration because the Respondent has no rights or legitimate interests in the Domain Name as it is not connected with the Complainant and has no authority, license or permission from the Complainant to use its trade name, trade marks or service marks, including the PICKFORDS mark to identify the Domain Name, website or services provided by the Respondent.

The Complainant asserts that the Respondent's primary motivation for registering the Domain Name is to draw upon the goodwill associated with PICKFORDS that has been developed by and paid for by the Complainant, to prevent the Complainant from registering the Domain Name for its own use and/or to use the Domain Name at some point to attract potential customers by causing them to believe that the Respondent has some sort of affiliation with, or sponsorship by the Complainant.

The Complainant further asserts that there is no evidence of actual or contemplated good faith use by the Respondent of the Domain Name and it has no legitimate interest in the Domain Name. In the Complainant's submission, the Respondent has been and is engaged in trade mark infringement and cyber squatting in violation of Sections 10 and 56 of the Trade Marks Act 1994.

### Respondent

As explained above, the Respondent has not responded

## 7. Discussion and Findings:

### General

Paragraph 2 of the Policy requires that for the Complainant to succeed it has to prove to the Expert on the balance of probabilities that it 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.

### Complainant's Rights

The Complainant in this case has asserted that is the proprietor of registered trade mark rights in the name or mark PICKFORDS. The Domain Name comprises the name or mark 4pickfords and the suffix .co.uk. In assessing whether or not a name or mark is identical or similar to a domain name, it would not usually be appropriate to take into account the domain suffix. On the basis of the evidence submitted, it is clear that the Complainant has rights in the word PICKFORDS.

Advocate General Jacobs in *S.A.Societe LTJ Diffusion-v-SA Sadas* (Case C-291/00) in an Opinion delivered on 17 January 2002 has stated that the concept of identity between mark and sign in Article 5 (1)(a) of the Trade Marks Directive covers identical reproduction without any addition, omission or modification other than those which are either minute or wholly insignificant. The Expert does not regard the addition of the number "4" as minute or wholly insignificant. In reaching that conclusion, the Expert has also taken into account the concept of "added matter," a concept well known to trade mark lawyers in this jurisdiction. In the Expert's view, the Domain Name is not identical to PICKFORDS.

However, the dominant and distinctive part of the Domain Name is PICKFORDS. Accordingly, the Expert finds that the Complainant has rights in respect of a name or mark which is similar to the Domain Name.

### Abusive Registration

The Complainant also has to show that the Domain Name is an Abusive Registration. Paragraph 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. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3 of the Policy. However, these factors are only examples of conduct which may be evidence that a Domain Name is an Abusive Registration.

It is not asserted that the Respondent has given false contact details. Accordingly, the only potentially relevant factors are contained in subparagraphs 3 i, ii and iii of the Policy that is:

- i "Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:

- A. primarily 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;
  - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
  - C. primarily for the purpose of unfairly disrupting the business of the Complainant;
- ii Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
  - iii In combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making Abusive Registrations.

Paragraph 3 i A is inapplicable as the Complainant has not provided any evidence that the Respondent's motivation has been to sell, rent or otherwise transfer the Domain Name to the Complainant or a competitor of the Complainant.

Similarly, paragraph 3 i B is also inapplicable; the Complainant has not presented any evidence to suggest that the Respondent's motivation has been to stop the Complainant using the Domain Name or that the Complainant would otherwise have sought to acquire it, were it not for the Respondent's conduct.

Paragraph 3 i C is also immaterial to this Complaint; although the Complainant objects to the Respondent's registration of the Domain Name, no evidence has been provided to the Expert to suggest that the underlying purpose is to disrupt the Complainant's business.

Paragraph 3 ii requires evidence of actual confusion that the Domain Name is being used by the Respondent in a way which has confused people or businesses into believing that the Domain Name is connected with the Complainant. No such evidence of use or confusion has been submitted. There is no evidence that the Domain Name is in use for email or website purposes.

It is not asserted in the Complaint that the Respondent has engaged in a pattern of making Abusive Registrations. This omission is very surprising given that the Complaint exhibited a letter dated 17 August 2001 from the Complainant's representative to the independent expert appointed under the previous policy which contains this very allegation. However this letter is not specifically referred to in any of the Complainant's submissions. The letter in question enclosed a schedule listing all the domain names allegedly registered by the Respondent that incorporate well known trade marks such as Porsche, Sainsbury and Nike to name but a few. All the domains in the list contain the prefix "4" in question and end with the domain suffix co.uk. It would have been a simple task for the Complainant's representative to have exhibited WHOIS searches substantiating the Respondent's other registrations or to have made this allegation in the Complaint yet no such evidence or allegation has been put forward in this Complaint. The Expert has carried out WHOIS searches in relation to ten of the many domains listed in the schedule and all of these are registered to the Respondent. The Expert

can attach very little weight to this however given the paucity of evidence and failure to address this factor in this Complaint.

If the factors set out in Paragraph 3 were an exhaustive list of matters which could amount to an Abusive Registration, the Complainant would not succeed. However, the factors are not comprehensive; an Abusive Registration includes a Domain Name which has been registered in a manner which at the time when the registration took place took unfair advantage of or was unfairly detrimental to the Complainant's Rights. Accordingly, it is necessary to consider whether the Respondent's registration of the Domain Name can be so categorised.

The Complainant makes the submission that the Respondent's motive is to draw upon the Complainant's goodwill and/or to use the Domain Name at some point in the future to attract potential customers by causing them to believe that the Respondent has some sort of affiliation with or sponsorship by the Complainant. It is implicit in both assertions that this will be detrimental to the Complainant's rights; it should be remembered that any such detriment must be shown to be unfair in order to succeed in a Complaint. The Expert agrees that the Respondent's registration of the Domain Name is capable of being unfairly detrimental to the Complainant's trade mark rights, but the point is not clear and the Complainant has made no effort to substantiate that submission. On the evidence before him, the Expert is not prepared to hold that the Domain Name is an Abusive Registration on that ground.

The Complainant also contends that there is no legitimate reason which could account for the Respondent's registration. There could be a number of reasons why the Respondent has registered the domain but the Expert agrees with the Complainant that it is difficult to think of any credible explanation which does not involve a finding that the principal intention of the Respondent is to benefit from the registration given that it incorporates a name in which the Complainant has established trade mark rights.

The fact that the Respondent has been given no permission or authority to register the name creates a presumption that the registration takes unfair advantage of the Complainant's rights, given the Complainant's trade marks predate the Respondent's registrations of the Domain Names, are well known and established and the high degree of similarity between the trade mark and the Domain Name. The Expert agrees that the circumstances leading to the registration of the Domain Name are indicative of relevant abusive conduct. In the hands of the Respondent the Domain Name constitutes an illegitimate exploitative threat.

In the view of the Expert the Respondent has a case to answer on the basis that in registering the Domain Name the Respondent took unfair advantage of the Complainant's rights.

Paragraph 4 of the Policy explains how the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration. The onus is ordinarily upon the Complainant to prove on a balance of probabilities that the Domain Name is in the hands of the Respondent an Abusive Registration; but where the Expert has found (as here) that the Complainant has made out a prima facie case and that the Respondent has a case to answer, the Respondent's failure to provide an answer will lead in the great majority of cases to a finding of abusive conduct.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration on the basis that it was registered in a manner which, at the time when the registration took place, took unfair advantage of the Complainant's rights.

8. **Decision**

In view of the foregoing findings, namely that the Complainant has rights in respect of 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 directs that the Domain Name, 4pickfords.co.uk, be transferred to the Complainant.

Cerryg Jones  
Cerryg Jones

15 March 2002  
Date