

Nominet UK Dispute Resolution Service

DRS Number 02974

The Carphone Warehouse Limited -v- Keith Szlamp

Decision of Independent Expert

1. Parties

Complainant Type: Business
Complainant: The Carphone Warehouse Limited
Address: 1 Portal Way
London
Postcode: W3 6RS
Country: GB

Respondent: Keith Szlamp
Address: The Old Bank
The Quadrant
Hoylake
Wirral
Postcode: CH47 2EE
Country: GB

2. Domain Name

carfonewarehouse.co.uk ('the Domain Name')

3. Procedural Background

The complaint from Mr Youann Fouquet, on behalf of the Complainant, was lodged electronically with Nominet on 16 September 2005. Nominet wrote to both parties informing the Respondent of the complaint on 16 September 2005.

No response was received from the Respondent.

On 12 October 2005 Nominet wrote to both parties inviting the Complainant to refer the matter for an expert decision by 26 October 2005. Nominet received the fee for an expert decision and on 25 October 2005 invited Claire Milne to act in the case. On 26 October 2005 Claire Milne, the undersigned ('the Expert'), confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in this case and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality. Her appointment as Expert in the case was dated 1 November 2005.

4. Outstanding Formal/Procedural Issues (if any)

None.

5. The Facts

Annex numbers refer to annexes to the complaint submitted by the Complainant.

The Complainant has traded under the name 'Carphone Warehouse' since 1991 (Annex 2). It, or its wholly owned subsidiaries, registered the trade mark 'Carphone Warehouse' in the UK in 1999, in Ireland (as 'The Carphone Warehouse') four times between 1995 and 2000, and in the European Community twice between 2002 and 2004 (Annex 2).

The Complainant registered the domain names 'carphone-warehouse.co.uk' and 'thecarphonewarehouse.co.uk' in 1997 and 1999; it also registered very similar names in the '.com', '.net', '.biz', '.info' and '.tv' domains (Annex 3). It is also the registered owner of domain names containing variations of 'Carphone Warehouse' in the '.co.uk' domain and other domains that it has recovered from third parties (Annex 3).

The Respondent registered the Domain Name on 6 June 2004 (Annex 1). The web site for the Domain Name ('the Web Site') is a portal linking to web sites that offer goods and services related to, and in many cases competing with, those of the Complainant. The Web Site does not mention Carphone Warehouse (Annex 5).

On 6 June 2004 the Respondent registered several domain names consisting of well-known names of cars prefixed by 'www' and followed by '.co.uk'. The web sites for these domain names are portals linking to web sites that offer goods and services related to cars (such as insurance). They have the same look and feel as the Web Site (Annex 7).

The Complainant advertises its name heavily (Annex 4). It has achieved very high brand awareness that is typically higher than that of its competitors in the UK (Annex 4).

The Complainant wrote a letter on 22 March 2005 to the Respondent asking him to stop using the Domain Name (Annex 6). The Respondent did not reply or stop using the Domain Name.

6. The Parties' Contentions

Complainant

1. The Complainant has Rights in the name 'Carphone Warehouse'; it has traded under, and been registered under, this name for many years and has invested heavily in making the name well-known.
2. The Respondent has not been authorised by the Complainant to use this name or its trade mark.
3. The Respondent has no legitimate interest in this name.
4. The Respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant.
5. The Respondent is using the Domain Name in a way that has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant.
6. There is a pattern of the Respondent registering domain names corresponding with well known names or trade marks in which the Respondent has no apparent rights. This registration of the Domain Name is part of that pattern.

Respondent

The Respondent has not responded.

7. Discussion and Findings:

General

The Nominet Dispute Resolution Service Policy ('the Policy') paragraph 2 requires that for a complaint to succeed the Complainant must demonstrate, on the balance of probabilities, that both

- 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.

Complainant's Rights

The Complainant has supplied evidence that the Complainant has Rights in the name 'Carphone Warehouse' in the UK through its trade mark (Annex 2). The Complainant is widely known by that name in the UK (Annex 4).

The Domain Name has a component after '.co.uk' differing from the trade mark of the Complainant only by replacing 'ph' by 'f' and 'w' by 'wh'. These changes make little phonetic difference to the name and could easily be arrived at by mis-spelling. Consequently, in my view, the Domain Name is similar to domain names formed from 'Carphone Warehouse' by appending '.co.uk'.

Abusive Registration

The Nominet Dispute Resolution Service Policy ('the Policy') paragraph 1 defines Abusive Registration to be 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.

The Complainant has based the complaint on clause ii.

Paragraph 3(a) of the Policy provides a non-exhaustive list of factors that may be evidence that the Domain Name is an Abusive Registration. Paragraph 4(a) of the Policy sets out a similar list of factors that may be evidence that the Domain Name is not an Abusive Registration. As these lists are non-exhaustive, the overriding consideration is the applicability of the definition of Abusive Registration. The discussion below deals with relevant factors in the lists as well as the applicability of the definition in general.

Evidence for Abusive Registration

3(a)(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.

The existence of confusion from using the Domain Name is difficult to establish. However, I consider that the potential for confusion is clear, because of the similarity between the Domain Name and a domain name of the Complainant and the similarity between the goods and services offered by the Complainant and the goods and services offered by the web sites to which the Web Site links.

3(a)(iii): The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.

The Complainant has demonstrated that there is such a pattern: even on the same day as registering the Domain Name the Respondent registered domain names that could be confused with well-known brand names and that lead to web sites which, like the Web Site, acted as portals to web sites that offered goods and services related to those of the well-known brand names.

What is more, on the same day as registering the Domain Name the Respondent registered 'whitards.co.uk', which has been transferred after dispute resolution to Whittard of Chelsea (DRS 02297).

The Respondent appears to use the Domain Name only because of its similarity to a domain name of the Complainant: internet searches do not show other uses of 'Carfone' and 'Wharehouse' by the Respondent. The value of the Domain Name derives almost entirely from the business activities of the Complainant in making its brand name well-known. I take the view that the advantage derived in using the Domain Name is 'unfair', as it has not been authorised by the Complainant.

I also accept that the use of the name by the Respondent could be unfairly detrimental to the rights of the Complainant, as it could divert sales away from the Complainant to suppliers mentioned on the Web Site. The Complainant has not presented evidence to establish that this has happened, but such evidence is even harder to find than evidence of confusion.

Evidence against Abusive Registration

The Respondent has not responded to Nominet or replied to the letter from the Complainant.

8. Decision

I find that the Complainant has Rights in a name or mark that is similar to the Domain Name. I find that the Domain Name, in the hands of the Respondent, is an Abusive Registration. I direct that the Domain Name be transferred to the Complainant.

Claire Milne

4 November 2005