

FUNNY GIRLS

-v-

24 CARAT. CO.UK

Nominet UK Dispute Resolution Service

Funny Girls and 24 Carat.co.uk

DRS 3267

Decision of Independent Expert

1. PARTIES:

Complainant:	Funny Girls
Address:	ITP Leisure Ltd 170 – 176 Talbot Road Blackpool Lancashire
Postcode:	FY1 3AZ
Country:	GB
Respondent:	24 carat.co.uk
Address:	521 Lytham Road Blackpool Lancashire
Postcode:	FY4 1RJ
Country:	GB

2. DISPUTED DOMAIN NAME:

funnygirls.co.uk ("the Domain Name")

3. PROCEDURAL BACKGROUND:

- 3.1. The dispute was entered into the Nominet Dispute Resolution Service (DRS) on 9 March 2005. Hardcopies of the Complaint were received in full by Nominet on 9 March 2005. Nominet validated the Complaint on 14 March 2005 and sent a copy to the Respondent on the same day.

- 3.2. No response was received by the Respondent and therefore informal mediation was not possible.
- 3.3. On 14 April 2005 the Complainant paid the fee to obtain an Expert Decision pursuant to paragraph 6 of the Nominet Dispute Resolution Policy ("the Policy").
- 3.4. On 21 April 2005, Veronica Bailey, the undersigned ("the Expert"), having confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as the Expert in this case and 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, was appointed Expert.

4. OUTSTANDING FORMAL/PROCEDURAL ISSUES:

- 4.1. The Respondent has not submitted a Response to Nominet in time (or at all) in compliance with paragraph 5a of the DRS Procedure for the conduct of proceedings under the Dispute Resolution Service ("the Procedure").
- 4.2. Paragraph 15c of the Procedure provides, that "If, in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint."
- 4.3. Nominet appears to have used all of the available contact details to try to bring the Complaint to the Respondent's attention. There do not appear to be any exceptional circumstances involved and in accordance with paragraph 15c of the Procedure a Decision will be made on the Complaint notwithstanding the absence of a Response.

5. THE FACTS:

- 5.1. The Domain Name funnygirls.co.uk was registered by the Respondent on the 24th July 1999.
- 5.2. Funny Girls is trading name for a burlesque showbar at 5 Dickenson Road Blackpool FX1 2. The trading name Funny Girls has been used for that business for at least 10 years.

- 5.3. The Complainant, Funny Girls, gives its address as ITP Leisure Ltd, 170-176 Talbor Road, Blackpool, Lancashire, FY1 3AZ. A Companies House search reveals that ITP Leisure Ltd is not a company name registered at Companies House.
- 5.4. In the Pink Leisure Limited is a company registered at Companies House with company no. 03075817. In the Pink Leisure Limited has as its registered office address, the same address as the Complainant i.e. 170/176 Talbot Road, Blackpool, Lancashire, FY1 3AZ. In the Pink Leisure Limited although referred to is not the Complainant named in the complaint.
- 5.5. The trade mark "FUNNY GIRLS" was registered at the Office for Harmonisation in the Internal Market (OHMI) on the 23rd May 2001 and has registration number 001538438. The owner of the community trade mark is a director of In the Pink Leisure Limited.

6. THE PARTIES' CONTENTIONS:

Complainant

- 6.1. The Complainant submits that:
- a) In the Pink Leisure Limited has owned and operated the venue "Funny Girls" for over 11 years;
 - b) the Respondent purchased the Domain Name simply for profit and has offered it for sale on their website www.24carat.co.uk for £5,000;
 - c) the Respondent has not used the Domain name since it was purchased in 1999.

Respondent

- 6.2. The Respondent has not submitted a Response.

7. DISCUSSIONS AND FINDINGS

- 7.1. The Dispute Resolution Procedure provides at paragraph 16 a that:

“The Expert will decide the complaint on the basis of the Parties’ submissions, the Policy and the Procedure.”

and at paragraph 3b of the DRS Procedure that:

“Any person or entity may submit a complaint in “accordance with the Policy and this Procedure....”

The Complainant, Funny Girls, is a trading name and as such is not a person or entity. The Complainant’s details do not clearly set out which person or entity is trading as “Funny Girls”. This point is dealt with in more detail below.

Burden of Proof

7.2. Paragraph 2 of the Policy requires that the Complainant prove on the balance of probabilities that:

- (i). it has Rights in a name or mark that is identical or similar to the Domain Name; and
- (ii). the Domain Name, in the hands of the Respondent, is an Abusive Registration (as those capitalised terms are defined in paragraph 1 of the Policy).

Rights

7.3. Rights as defined in paragraph 1 of the Policy “includes, but is not limited, to rights enforceable under English law. However, the Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant’s business”. In determining whether a party has Rights in a domain name the first and second suffixes (.co.uk) should be ignored.

7.4. As has been frequently quoted, the requirement to demonstrate Rights is not a particularly high threshold test. The Appeal Panel found in DRS 00248 Seiko UK Limited v Designer Time/Wanderweb that it was satisfied by showing that the Complainant was duly authorised by the trade mark owner to use the mark and to bring the Complaint.

7.5. A Community Trade Mark is a single trade mark registration valid for all countries in the European Union. As such it gives Rights to the owner of the trade mark which are enforceable in the United Kingdom.

- 7.6. The OHMI Certificate of Registration submitted with the complaint shows that the Community Trade Mark “FUNNY GIRLS” was registered on the 23rd May 2001 with registration number 001538438 but does not show the name of the owner. This trade mark registration post dates the registration by the Respondent of the Domain Name on 24 June 1999.
- 7.7. A Community Trade Mark search carried out by the Expert reveals that the owner of the Community Trade Mark “FUNNY GIRLS” is Joseph Warren Basil Newby and gives an address near Blackpool. Companies House also lists Joseph Warren Basil Newbury as a director of In the Pink Limited.
- 7.8. Whilst the Complainant submits in its complaint that In the Pink Leisure Limited owns and operates the venue “Funny Girls”, owns the trade mark “FUNNY GIRLS” and has submitted the OHIM Certificate of Registration for the “FUNNY GIRLS” trade mark, it has provided no explanation of any link between (i) Mr Newby, the owner of the Community Trade Mark; (ii) In the Pink Leisure Limited; and (iii) the Complainant. Further the Complainant has not submitted or provided evidence that it is licensed to use the Community Trade Mark “FUNNY GIRLS” owned by Mr Newby

Corporate Name/Business Name

- 7.9. The importance of disclosing a corporate name when using a business name has been given legal force by the Business Names Act 1985 which provides that where a company carries on business under a name which “does not consist of its corporate name without any addition other than one so permitted”, it must ensure that its corporate name must appear on all business letters, invoices and receipts issued in respect of the business as well at any premises where the business is carried out.
- 7.10. The Complainant’s details as set out in the complaint refers to the business name “Funny Girls” and gives ITP Leisure Ltd as part of its address. ITP Leisure Ltd is also the name that appears on the Terms and Conditions of Sale on tickets for Funny Girls venue at 5 Dickenson Road, Blackpool submitted with the complaint. ITP Leisure Ltd is not a registered company. It may be that ITP Leisure Ltd is an abbreviation of In the Pink Leisure Limited which is a registered company under the Company’s Act 1985. If this is correct then the name ITP Leisure Ltd is

another trading name used by In the Pink Leisure Limited. There is nothing in the complaint which details the connection between ITP Leisure Ltd and In the Pink Leisure Limited.

7.11. The Expert is obliged to decide the complaint on the basis of the Parties submissions, the Policy and the Procedure (DRS Procedure 16 a). It is not for the Expert to construction the Complainant's case or to amend the Complainant's details provided in the complaint.

7.12. The search of Companies House Name Index gives 6 companies (2 of which are dissolved) that include the initials "ITP" or "I.P.T." as part of the company's registered name. Accordingly I am unable to conclude that ITP Leisure Ltd is one and the same as In the Pink Leisure Limited.

Abusive Registration

8.1. A Domain Name is an Abusive Registration under paragraph 1 of the Policy if it:

- (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 takes unfair advantage of or is unfairly detrimental to the Complainant's Rights;

8.2. In determining whether the Domain Name is an Abusive Registration an assessment must be made whether the registration or subsequent use "took unfair advantage of or was unfairly detrimental to the Complainant's Rights".

8.3. The non-exhaustive list of factors which may be evidence of Abusive Registration is set out in paragraph 3 of the Policy. The most relevant of these to the Complainant's allegations is paragraph 3 a i A are set out below:

3a...

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

A primarily as for the purpose 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 out of pocket costs directly associated with acquiring or using the Domain Name;

8.4. The Registrant at its website www.24carat.co.uk offers numerous domain names for sale including the Domain Name which is listed for sale at £5,000. The Respondent is entitled to register and offer for sale domain names provided that it does not fall foul of the DRS Policy and Procedure. On the evidence submitted by the Complainant I do not find that on the balance of probabilities the Domain Name was purchased primarily for the purpose 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 as required to satisfy the requirements of paragraph 3 a i A of the Policy.

8.5. The Complainant submits that the Respondent has not used the Domain Name since it was acquired in 1999. However, paragraph 3 c of the Policy provides that the failure of the Respondent to use the Domain Name for the purposes of email or website is not in itself evidence that the Domain Name is an Abusive Registration

9. DECISION

For the reasons set out above, the Expert does not find that on the balance of probabilities the Complainant has Rights in the name which is identical to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration and directs that no action be taken in respect of the Domain Name.

Veronica Bailey

6th May 2005

