

DISPUTE RESOLUTION SERVICE

DRS09824

Decision of Independent Expert

Maplin Electronics Limited

and

Colours Limited

1. The Parties

Complainant: Maplin Electronics Limited
Address: Maplin National Distribution Centre
PO Box 534
Manvers
Rotherham S63 3DH
Country: United Kingdom

Respondent: Colours Limited
Address: Midtown Building
Suite 3
Charlestown
NV
Country: Saint Kitts and Nevis

2. The Domain Name

maplon.co.uk (“the Domain Name”)

3. Procedural History

- 3.1 On 20 April 2011 the complaint was received and notification of it was sent to the Respondent at the e-mail addresses dn18372@gmail.com (which appears to be the contact e-mail address for the Respondent on Nominet’s records) and postmaster@maplon.co.uk. Delivery failed to the postmaster address. On 21 April 2011 the complaint was sent to the Respondent by Royal Mail special delivery. On 13 May 2011 the Respondent was reminded by e-mail, using the two addresses, that the deadline for responding to the complaint was 17 May 2011. The Respondent has failed to respond to the complaint. On 19 May 2011 the Complainant requested a full expert decision.
- 3.2 On 31 May 2011 Patricia Jones (“the Expert”) confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in DRS 09824 and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties which might call into question her independence and/or impartiality.

4 Factual Background

- 4.1 The Complainant is a large, specialist electronic supplier and retailer which has traded as MAPLIN since 1972. It sells over 15,000 products by catalogue and from over 170 retail stores across the UK.
- 4.2 The Complainant is listed in the London Financial Times "Fast Track" of Britain's top private companies, was ranked 176th in the Top Track 250 for 2009 and 46th in the Profit Track 100 for 2010 on the strength of profit growth of 60.56% per annum, profits of £22.2 million and sales of £203.6 million in 2008.
- 4.3 The Complainant operates a transactional web site at maplin.co.uk. In 2009 its site was ranked 7th in the Hitwise UK Online Performance Awards based on market share of visits of UK websites in the Shopping and Classifieds - Appliances and Electronics industry.
- 4.4 The Complainant (or a related company, Maplin Electronics Plc) is the owner of certain trade marks as follows: a US trade mark for MAPLIN registered on 5 May 2009 (in classes 6,7,8,9,11,12,14,16,20,28); a UK trade mark for maplin.co.uk, maplin.com and maplin.eu registered on 22 February 2002 (in classes 9,11,12,42); a Community trade mark for MAPLIN registered on 19 January 2001 (in classes 6,7,8,9,11,12,14,15,16,20,28,42); and a UK trademark for MAPLIN/maplin registered on 11 March 1994 (in classes 6,7,8,9,11,12,16,20,28,42).
- 4.5 The Respondent is a company based in Saint Kitts and Nevis. It is the owner of about 2000 .uk domain names. The Respondent registered the Domain Name on 9 December 2010. On the same day the Respondent also registered the domain names set out in the Table below which has been extracted from the complaint. The Complainant has provided evidence (the results of 'who is' queries) of the registration of the domain names in the Table. At paragraph 6.12 below I comment on the 'relates to example mark' column of the Table.

Domain Name	Domain name registration date	Relates to example mark	Mark details
airelingus.co.uk	09-Dec-10	Aer Lingus	Mark no: 1431784 Jurisdiction: UK Proprietor: Aer Lingus Limited Filing date: 15 June 1990
autotrander.co.uk	09-Dec-10	Auto Trader	Mark no: E2410298 Jurisdiction: CTM Proprietor: Trader Publishing Limited Filing date: 15 October 2001
bankofscotland.co.uk	09-Dec-10	Bank of Scotland	Mark no: 1559587 Jurisdiction: UK Proprietor: Bank of Scotland Plc Filing date: 20 January 1994
denemhams.co.uk	09-Dec-10	Debenhams	Mark no: E66720 Jurisdiction: CTM

			Proprietor: Debenhams Retail PLC Filing date: 01 April 1996
halfoeds.co.uk	09-Dec-10	Halfords	Mark no: 884758 Jurisdiction: UK Proprietor: Halfords Limited Filing date: 25 September 1965
hsanuel.co.uk	09-Dec-10	H Samuel	Mark no: 1264152 Jurisdiction: UK Proprietor: H. Samuel Limited Filing date: 05 April 1986
jomebase.co.uk	09-Dec-10	Homebase	Mark no: E1551712 Jurisdiction: CTM Proprietor: Homebase Limited Filing date: 10 March 2000
mercedes-benz.co.uk	09-Dec-10	Mercedes Benz	Mark no: 756389 Jurisdiction: UK Proprietor: Daimler AG Filing date: 08 August 1956
mohercare.co.uk	09-Dec-10	Mothercare	Mark no: 860200 Jurisdiction: UK Proprietor: Mothercare UK Limited Filing date: 13 February 1964
scottishwidows.co.uk	09-Dec-10	Scottish Widows	Mark no: 1278553 Jurisdiction: UK Proprietor: Scottish Widows plc Filing Date: 1 October 1986
tebaker.co.uk	09-Dec-10	Ted Baker	Mark no: 2069425 Jurisdiction: UK Proprietor: No Ordinary Designer Label Limited t/a Ted Baker Filing date: 23 April 1996
thontons.co.uk	09-Dec-10	Thorntons	Mark no: 1021096 Jurisdiction: UK Proprietor: Thorntons Plc Filing date: 21 November 1973
virgintrains.co.uk	09-Dec-10	Virgin Trains	Mark no: 2153076 Jurisdiction: UK Proprietor: Virgin Enterprises Limited Filing date: 10 December 1997

- 4.6 On 28 March 2011 the Complainant wrote to the Respondent to request an explanation for the registration of the Domain Name and/or seeking agreement to the transfer of the Domain Name. No response was received to this letter. The Domain Name currently resolves to a site with links to cameras, computers and associated components and global positioning systems which are being sold by the Complainant's competitors. These products are also sold by the Complainant.

5 Parties' Contentions

5.1 The Complainant contends that the Domain Name is confusingly similar to its famous MAPLIN mark and was specifically selected by the Respondent as a typographical variant of it. The Complainant supports this contention as follows:

- (a) MAPLON is not a term found in the English language;
- (b) The Domain Name is used to display pay per click advertising which relates directly to the Complainant's business rather than being put to an unrelated purpose; and
- (c) The Respondent's other typographical registrations as set out in the Table above.

The Complainant considers that it is reasonable to infer that the Respondent chose the Domain Name as a typographical variant of the Complainant's mark, rather than for any other use.

5.2 The Complainant relies on paragraph 3(a)(i)(c) of the Nominet Dispute Resolution Service Policy ("the Policy") and contends that the Domain Name is an Abusive Registration because it is unfairly disrupting the business of the Complainant as it resolves to pay per click advertising and is a typographical variant of the Complainant's famous mark.

5.3 The Complainant asserts that when users arrive at the Respondent's website they may click on the advertising links and be diverted to a competitor of the Complainant, with the Respondent earning a commission on each click. The Complainant contends that the links displayed on the Respondent's website were selected or configured by the Respondent specifically to match products sold by the Complainant, further increasing the confusion to web users and increasing the Respondent's pay per click revenue. The Complainant states that while difficult to objectively quantify, it is reasonable to note that the display of pay per click advertising on the Respondent's web site will have misdirected traffic intended for the Complainant to the websites of its competitors. This will have unfairly disrupted the business of Complainant, while benefitting the Respondent by increasing its revenue through the pay per click advertising.

5.4 The Complainant contends that the use of a typographical variant of the Complainant's famous mark within the Domain Name to attract traffic to a website is abusive. The Complainant relies on the expert decision in DRS 07789 (*Mamas and Papas Ltd. v D. Amiee*), a complaint by Mamas and Papas Limited in relation to mamasandpappas.co.uk. In that decision the expert stated in connection with paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using the domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant, "*given that the domain name is so similar to the complainant's brand, domain name and trade marks, I am satisfied that initial interest confusion is likely between the domain name and the complainant.*" The Complainant contends that the Domain Name was specifically selected by the Respondent to benefit from initial interest confusion so as to drive

traffic to the Respondent's website and to generate revenue through the pay per click advertising. The Complainant further contends that as the website comprises advertisements for products and services which relate to the Complainant's business, this initial confusion will be compounded by further confusion when web users view the site content.

5.5 The Complainant contends that there is a pattern of abusive registrations under paragraph 3(a)(iii) of the Policy, namely 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 asserts that a significant number of the Respondent's about 2000 domain names relate to third party marks in which the Respondent does not appear to have rights and relies, in particular, on the domain names set out in the Table above. The Complainant states that the Domain Name is part of the same pattern of abusive registrations in that:

- (a) The domain names set out in the Table and the Domain Name were registered on the same date;
- (b) Like the Domain Name, the domain names in the Table are typographical variations of well known trade marks;
- (c) Like the Domain Name, the domain names in the Table resolve to pay per click advertising; and
- (d) Like the Domain Name, the Respondent does not appear to be authorised or permitted to use the registered third party marks in its domain name portfolio.

5.6 Therefore, the Complainant contends that the registration of a typographic variant of the Complainant's famous mark and its use to display pay per click advertising which relates to the Complainant's business is abusive under the Policy.

5.7 The Respondent has not responded to the complaint.

6 Discussions and Findings

6.1 Before I consider the requirements for an Abusive Registration under the Policy, I will consider the service of the complaint given that there has been no response from the Respondent. Under paragraph 4a of the Nominet Dispute Resolution Service Procedure ("the Procedure") the complaint is to be forwarded to the Respondent within 3 days of receipt, which happened in this case. Under paragraph 2 of the Procedure the complaint may be sent by any of: first class post, fax or e-mail to the Respondent at the contact details shown as the registrant or other contacts in the domain name register database entry for the Domain Name; sending the complaint in electronic format to postmaster@<the Domain Name> or to any e-mail address or e-mail links on the webpage at the Domain Name; or sending the complaint to any addresses provided by the Complainant for the Respondent in its complaint so far as practicable. Taking into account paragraph 3.1 above I am satisfied that Nominet has served the complaint in accordance with the Procedure. Given that notification of the complaint appears to have been received at one of the

Respondent's e-mail addresses and given that it also appears to have been received by special delivery post (the letter has not been returned), I consider that it can reasonably be concluded that the Respondent has received notification of the complaint and chosen not to respond to it.

6.2 I will now turn to the requirements for an Abusive Registration under the Policy. Paragraph 2 of the Policy sets out that for a Complainant's complaint to succeed it must prove to the Expert that:

- 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.

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

Complainant's Rights

6.4 Under Paragraph 1 of the Policy, Rights is defined as "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning." It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint. It is also well accepted that the question of Rights is a test with a low threshold to overcome.

6.5 The Complainant (or a related company) is the owner of various registered trade marks for MAPLIN, which all pre-date the registration of the Domain Name. The Complainant has also provided substantive evidence of its extensive trade under MAPLIN, including details of its sales figures, its stores, its website and various independent rankings. On that basis I am satisfied that the Complainant has built up significant goodwill and reputation in MAPLIN and has unregistered rights in that mark.

6.6 I regard the mark MAPLIN to be similar to the Domain Name (disregarding the .co.uk suffix). I also regard the Complainant's trade mark maplin.co.uk to be similar to the Domain Name. In this respect, I consider that maplon is a close typographical variant of maplin, noting that 'i' and 'o' are adjacent to each other on the keyboard. I also consider that there is a degree of visual similarity between the two marks and also a degree of phonetic similarity (when they are read aloud).

6.7 Accordingly, on the basis of the trade mark registrations and its unregistered rights through the ownership of goodwill, I find that the Complainant has Rights in a name or mark, MAPLIN, which is identical or similar to the Domain Name.

Abusive Registration

6.8 It therefore has to be considered whether the Domain Name, in the hands of the Respondent, 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.
- 6.9 It is sufficient to satisfy either of the limbs for there to be a finding of an Abusive Registration.
- 6.10 Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under Paragraph 1(i) of the Policy as follows:
 - i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. 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. for the purpose of unfairly disrupting the business of the Complainant.
- 6.11 The Complainant relies on Paragraph 3(a)(i)C of the Policy in its complaint. It is important to bear in mind when considering Paragraph 3(a)(i) of the Policy that it relates to the Respondent's motives at the time of registration of the Domain Name. It is an intrinsic part of this that for there to be an Abusive Registration under paragraph 1(i) of the Policy, it must be established that the Respondent had knowledge of the Complainant and/or its rights at the time of registration of the Domain Name.
- 6.12 In this respect I consider it relevant that at the same time as registering the Domain Name, the Respondent registered the domain names in the Table above. I further consider that the Complainant has correctly related the domain names in the Table to well known third party marks. It is apparent that the Respondent registered the domain names in the Table as typographical variants of well known third party marks and also registered the Domain Name on that basis. In my view, the Respondent clearly had the Complainant in mind when it registered the Domain Name and had knowledge of the Complainant and/or its rights at the time of registration of the Domain Name.
- 6.13 I do not consider that the Respondent had any legitimate reason for registering the Domain Name. In this respect I note that the Respondent has not answered the complaint or provided any explanation as to its motives for registering the Domain Name. In my view the Respondent registered the Domain Name for the purpose of setting up a site which would attract internet users looking for the Complainant and generate click per view revenue.
- 6.14 In this respect I consider it likely that there will be internet users who will find the Respondent's site when they are looking for the Complainant because they misspell

or make a typographical error when inputting the Complainant's domain name into their browser. There is also a risk in view of the high degree of similarity between the Domain Name and MAPLIN that users will find the Respondent's site in response to a search engine request looking for the Complainant. Once at the Respondent's site users will be exposed to advertising links for products being sold by the Complainant's competitors and users may click on them, thereby generating revenue for the Respondent. I consider that it was for this purpose of setting up a site which would attract internet users looking for the Complainant and generating click per view revenue for which the Domain Name was registered. I am supported in this conclusion by the fact that I regard the Domain Name to be part of a pattern of domain names set out in the Table above which were registered on the same day as typographical variants of well-known marks in which the Respondent has no apparent rights which the Complainant states are also being used for pay per click advertising.

- 6.15 I therefore consider that the Domain Name was registered for the purpose of unfairly benefitting from the Complainant's business and thereby unfairly disrupting the business of the Complainant. In reaching this conclusion I have taken into account Paragraph 4e of the Policy. This provides that sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy, however, the Expert will take into account the nature of the Domain Name, the nature of the advertising links on any parking page associated with the Domain Name and that the use of the Domain Name is ultimately the Respondent's responsibility. In this case given that the Domain Name is a typographical variant of the Complainant's mark, was registered with the Complainant in mind and the fact that the advertising links are to the Complainant's competitors in relation to products sold by the Complainant I consider that this constitutes unfair disruption of the Complainant's business.
- 6.16 I therefore find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraph 1(i) of the Policy as the Respondent registered the Domain Name for the purpose of unfairly benefitting from the Complainant's business and thereby unfairly disrupting the business of the Complainant.
- 6.17 Whilst I do not need to go any further than my finding above, I also find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraph 1(ii) of the Policy. In this respect Paragraph 3(a)(ii) of the Policy sets out one of the factors which may be evidence that the Domain Name is an Abusive Registration namely that the Respondent is using or threatening to use the Domain Name in a way 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. As set out at paragraph 6.14 above I consider that there is a likelihood of internet users being initially confused into visiting the Respondent's website in the expectation of finding the Complainant. Even if such users appreciate that they have not found the Complainant when they reach the Respondent's site, the Respondent has still used the Domain Name in a way to cause initial interest confusion that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant.

7. Decision

- 7.1 I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

7.2 For the reasons set out above I find that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7.3 I direct that the Domain Name be transferred to the Complainant.

Dr Patricia Jones

Dated 20 June 2011