

DISPUTE RESOLUTION SERVICE

D00012322

Decision of Independent Expert

Pertemps Limited

and

quick pertemps

1. The Parties:

Lead Complainant: Pertemps Limited
Meriden Hall
Main Road
Meriden
Coventry
CV7 7PT
United Kingdom

Respondent: quick pertemps
Suite 208, Legacy Centre
Hanworth Trading Estate
Hampton Road
West Feltham
London
TW13 6DH
United Kingdom

2. The Domain Name(s):

quickpertemps.co.uk

3. Procedural History:

08 January 2013 13:20 Dispute received
09 January 2013 12:07 Complaint validated
09 January 2013 12:14 Notification of complaint sent to parties
28 January 2013 01:30 Response reminder sent
31 January 2013 10:53 No Response Received
31 January 2013 10:53 Notification of no response sent to parties
04 February 2013 15:05 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is a company offering a recruitment agency service, which has traded under the Pertemps name since 1961.
- 4.2 The Respondent operates a website at the Domain Name, which offers a broad range of recruiting services. It registered the Domain Name on 5 August 2012. Its registration details give its name as “quickpertemps” which is described as being an “Other UK Entity”.
- 4.3 Solicitors acting on behalf of the Complainant wrote to the Respondent on 3 October 2012, complaining about trade mark infringement, and passing off because of the use of the Domain Name for the Respondent’s website. They sent a further letter on 19 October 2012, but have not received a response to either.
- 4.4 A complaint was filed with Nominet on 21 November 2012. However, as the Complainant did not pay the fee for an expert decision in relation to that complaint within the deadline set by Nominet, that complaint was treated as withdrawn, and this complaint is a re-filed complaint.
- 4.5 Despite being given an opportunity to respond to both complaints, the Respondent has not done so.

5. Parties’ Contentions

Complainant’s Submissions

Rights

- 5.1 The Complainant relies upon its extensive trading since 1961 under the Pertemps name, its significant goodwill and reputation in the area of recruitment, awards won throughout the last 50 years, registration of trade marks within the UK (including the registration of the name PERTEMPS in classes 9, 16, 35 and 41) and its use of the domain name pertemps.co.uk

for its website (although that domain name is registered in the name of a group company, not the Complainant itself).

Abusive Registration

- 5.2 The Complainant suspects that the Domain Name is being used to redirect internet traffic intended for the Complainant away from the Complainant and to the Respondent's website. The Respondent is attempting to promote identical services to those provided by the Complainant.
- 5.3 Further, the Complainant submits that the Respondent is not making fair use of the Domain Name, as there is a significant risk of the Domain Name being used to redirect internet traffic away from the Complainant and the Respondent must have known that it is likely to attract interest from internet users who are searching for the Complainant. The Complainant therefore anticipates that the purpose of the registration must have been for selling or renting the Domain Name to the Complainant, or to a competitor of the Complainant at a cost which is greater than the costs incurred by the Respondent in registering the Domain Name. The Complainant also anticipates that the use of the Domain Name will unfairly disrupt the Complainant's business, given the use of the word PERTEMPS in the Domain Name.
- 5.4 The Complainant says that the Respondent has no connection with the Complainant, and has never been given permission to use its trade mark. Given the widespread use and reputation of the PERTEMPS mark, the Respondent must have been aware that in registering the Domain Name, it was misappropriating the Complainant's intellectual property.
- 5.5 The Complainant submits that the Respondent's registration of the Domain Name has also prevented it from registering a Domain Name which corresponds to its own trade mark(s), should it wish to do so.
- 5.6 The Complainant contends that the Respondent will never be capable of using the Domain Name for a legitimate purpose, as any unauthorised use of the Complainant's registered trade marks for a commercial purpose which is recruitment related and/or for advisory or consultancy services relating to recruitment services, as any such use would amount to trade mark infringement.

The Respondent's submissions

- 5.7 The Respondent has not replied.

6. Discussions and Findings

6.1 In order to succeed in these proceedings, paragraph 2.b of the Nominet DRS Policy (“the Policy”) requires the Complainant to prove on the balance of probabilities that both elements of the test set out in paragraph 2.a are present, namely that:

- (i) The Complainant has Rights in respect of names or marks which are 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

6.2 Although the Domain Name is not identical to the Complainant’s mark PERTEMPS, it is clear that the Complainant has significant accrued goodwill in the mark PERTEMPS itself. The addition of “quick” to that widely recognised brand name is unlikely to override the initial impression, which is that the Domain Name is similar to the Complainant’s marks. In the Expert’s view, the word “quick” is essentially a descriptive one, and does not prevent the Domain Name as a whole being similar to the Complainant’s mark “PERTEMPS”. Therefore the Expert finds that the Complainant has Rights in the name or mark PERTEMPS which is similar to the Domain Name.

Abusive Registration

6.3 The Policy contains, at paragraph 3.a, a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The most relevant factor would appear to be that set out in paragraph 3.a.ii; “Circumstances indicating that the Respondent is using or is 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”.

6.4 Paragraph 4.a of the Policy contains a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. Those other factors include, in paragraph 4.a.i.C: “before being aware of the Complainant’s cause for complaint... the Respondent has...made non-commercial or fair use of the Domain Name”.

6.5 Although the Complaint advances a number of possible arguments on behalf of the Complainant, in essence the Complainant here is arguing that the Respondent has used a name which is very similar to its own mark, in connection with a website which advertises services which are apparently identical, or at least very similar, to the Complainant’s own. Given the

extent of its reputation within the industry, the Complainant says that the Respondent must have known of it, and therefore must have intended to divert traffic intended for the Complainant, to the Respondent's website, 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.

- 6.6 The Respondent has chosen not to reply to this Complaint. Paragraph 15.c of the Procedure provides that "If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure ... the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate". Although it is for the Complainant to prove its case on the balance of probabilities, the obvious inference which is likely to be drawn by visitors to the Respondent's website is that a website which advertises "Quick Pertemps" (and not the slightly mis-spelled name of the Respondent itself – Quick Pertempts) will have some commercial association with the Complainant. At first sight, the Respondent's website appears to be one which is offering a broad range of recruiting services (and not merely a "front"). Also, no attempt is made to identify clearly who is behind the website. Therefore, there is likely to be both "initial interest" confusion, and actual confusion following a visit to the site.
- 6.7 The Complainant has argued that the Respondent intended to sell the Domain Name to the Complainant or to a competitor, but it has provided no relevant evidence. The Complainant also argues that the Domain Name is a blocking registration, but does not explain why it might itself have wanted to register a domain name containing "quick pertemps", which would appear unlikely. The Expert is not, therefore, convinced by either of those arguments on the Complainant's behalf.
- 6.8 However, the Complainant's case based upon confusion seems to be clearly made out and the Expert cannot see that the use by the Respondent can be in any way "fair" (and the Respondent has not sought to justify its choice of the name). Therefore, the Expert finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration within the meaning of the Policy.
- 6.9 This Complaint is a re-filing, with only minor amendments, of an earlier complaint. Although there was no response to the earlier complaint, Nominet nevertheless allowed the requisite period of time for the Respondent to reply to the re-filed Complaint, which the Respondent again chose not to do. In the Expert's view, this is not a case where there is any suggestion of *res judicata*, or reconsideration of an earlier decision. Therefore, the rationale behind the objection to the re-filing of such complaints discussed in the Appeal Panel's decision in DRS 01295 *bravissimo.co.uk* does not apply. The wording of paragraph 10.e of the Policy only applies where complaints have "reached the Decision stage on a previous occasion". As the earlier Complaint had not reached that stage, there was no bar to re-filing the Complaint.

7 Decision

The Expert finds that the Complainant has Rights in the mark PERTEMPS 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 should be transferred to the Complainant.

Signed Bob Elliott

Dated 14 February 2013