

DISPUTE RESOLUTION SERVICE

D00016763

Decision of Independent Expert

Welfare Call (LAC) LTD

and

ecare Solutions

1. The Parties:

Complainant: Welfare Call (LAC) LTD
BBIC, Snyderdale Road
Cudworth
Barnsley
South Yorkshire
S72 8RP
United Kingdom

Respondent: ecare Solutions
Gary Daniels
Flat 1-15, 37
Brunswick Square
Hove
East Sussex
BN3 1ED
United Kingdom

2. The Domain Name:

welfarecall.co.uk

3. Procedural History:

12 November 2015 16:08 Dispute received
13 November 2015 12:10 Complaint validated
13 November 2015 12:50 Notification of complaint sent to parties
02 December 2015 01:30 Response reminder sent
07 December 2015 11:44 Response received
07 December 2015 11:45 Notification of response sent to parties
08 December 2015 15:14 Reply received
15 December 2015 13:15 Notification of reply sent to parties
15 December 2015 13:15 Mediator appointed
18 December 2015 10:56 Mediation started
07 January 2016 09:24 Mediation failed
07 January 2016 09:24 Close of mediation documents sent
19 January 2016 01:30 Complainant full fee reminder sent
19 January 2016 12:14 Expert decision payment received
27 January 2016 Keith Gymer appointed as Expert w.e.f. 1 February 2016

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant, Welfare Call (LAC) LTD, provides support services for Local Authorities, Education and Social Services for collection and analysis of attendance and attainment data for looked-after children. The Complainant was established as a limited company in 2009. The Complainant operates a website at www.welfarecall.com.

The Complainant has a UK Registered Trade Mark 3104111 for the mark WELFARE CALL for such support services. Its trade mark application was filed on 15 April 2015 and registration was granted on 17 July 2015.

According to the Nominet WHOIS records, the Respondent registered the Domain Name <welfarecall.co.uk> under the name of “ecare Solutions” as Registrant. According to the current Nominet WHOIS record, this is recorded as an “UK Individual” and “a non-trading individual who has opted to have their address omitted from the WHOIS service.”

The website address www.welfarecall.co.uk is set up to redirect to a website at www.epep.tv, which relates to an electronic Personal Education Plan (“ePEP”) for looked-after children. This site is operated in the name of eGov Digital Limited (UK Co. Reg. No. 8945929), which also claims to provide attainment and attendance monitoring and related services to “over 40 local authorities”. The

site includes endorsements of Gary Daniels, whom Nominet identifies as the registrant contact for the disputed Domain Name.

5. Parties' Contentions

Complainant

The Complainant asserts rights in "Welfare Call" having traded under this name since 2009, using its domain name <welfarecall.com>, and having registered WELFARE CALL as a trade mark under an application filed on 15 April 2015, all prior to the date of registration of the Domain Name by the Respondent.

According to the Complainant, the Domain Name in the hands of the Respondent is an abusive registration for the following reasons:

- it has been registered to stop the Complainant obtaining the Domain Name;
- it has also been registered to unfairly disrupt the Complainant's business, as the Complainant's primary domain name is <welfarecall.com>, it could be used to catch accidental typos for ".com" where people enter ".co.uk", and to gain confidential information via emails or people trying to access the Complainant's site;
- the Respondent is trying to pass-off by using the Complainant's WELFARE CALL name. The Respondent's website has been used to confuse people into thinking it is associated with or approved of by the Complainant, and hold themselves out as "Official" using "eGov Digital team" although the Respondent's business is not a government agency.

Remedy:

The Complainant seeks transfer of the Domain Name.

Respondent

The Respondent replied briefly, stating only that:

"My company eGov Digital Ltd provide the same services to over 40 local authorities within the UK. We are the Market leader for ePEP (the Electronic Personal Education Plan for looked after children.

However I would be happy to enter into negotiations with Welfarecall Ltd regards to www.welfarecall.co.uk."

This Response was signed by Gary Daniels, as Managing Director of eGov Digital Ltd.

Complainant's Reply

The Complainant notes that the Respondent has acknowledged that it provides the same services in competition with the Complainant.

As the words "WELFARE CALL" do not feature on the Respondent's website as part of an offered service, the Complainant assumes that the Respondent is trying to gain unfair commercial advantage by trading off the Complainant's reputation or that they have intended to intercept traffic from the Complainant's clients or potential clients who are unaware that the Domain Name and the Complainant's <welfarecall.com> domain are not both owned by the Complainant.

The Complainant has used the trade mark and the company name WELFARE CALL since long before the Respondent registered the Domain Name and the Respondent has been aware of this. The Complainant maintains its assertion that this is an abusive registration.

The Complainant also indicated that it would accept a proposal for the Complainant to take control of the Domain Name and would offer to cover the registration costs (only) incurred by the Respondent in relation to the Domain Name from the registration date of the 7 June, 2015 on presentation of official paperwork confirming the original costs of that registration.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

Complainant's Rights

The Complainant has effectively asserted claims to registered and common-law rights in the name and mark WELFARE CALL.

It has provided evidence of on-going trading under that name and the mark and of its UK trade mark registration, which has a filing date predating the Respondent's registration of the Domain Name.

The Domain Name differs only by addition of the domain suffix ".co.uk" and by the absence of a space in "welfarecall". However, spaces are not permitted in domain names, and it will be obvious to ordinary English readers that the Domain Name is to be read as "welfare call".

Consequently, the Expert finds that the Complainant has Rights in respect of a name or mark, which is identical or similar to the Domain Name, and that the conditions of Paragraph 2a.i. of the Policy are met.

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 a Domain Name is an Abusive Registration is set out in Paragraph 3a of the Policy.

From the Complainant’s submissions, the following examples appear to be principally applicable in this case:

3a.i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

...

- 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;

a.ii. Circumstances indicating 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;

Paragraph 4 of the Policy additionally provides observations on “How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration”, of which the following may be considered pertinent to the present Complaint:

4.a.i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

- A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
- B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
- C. made legitimate non-commercial or fair use of the Domain Name;...

The factors listed in Paragraphs 3 and 4 of the Policy are only intended to be exemplary and indicative. They are not definitive either way. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

In accordance with the Policy Paragraph 2b, it is for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration.

In the present case, the Domain Name is essentially identical to the Complainant's WELFARE CALL name and mark and (apart from the domain suffix) to the <welfarecall.com> domain name, which has been in established use by the Complainant, and which will therefore be familiar to the Complainant's clients.

The Respondent's business is a direct competitor of the Complainant. The Respondent has used the Domain Name to redirect online browsers to its own website at www.epep.tv. Thus, clients or potential clients of the Complainant, who inadvertently enter the website address www.welfarecall.co.uk instead of ".com" will be diverted without warning to the site of a competitive business, with no connection with the Complainant. The Respondent does not use or reference "WELFARE CALL" in connection with its own services. The Respondent is not known as "WELFARE CALL". The Complainant's concerns regarding the likely interception of misaddressed emails intended for the Complainant, but misdirected to the ".co.uk" domain are clearly justified in these circumstances.

The Respondent registered the Domain Name claiming to be a non-trading individual. That is clearly false. The reality is that Mr Daniels, as Director of the competing eGov Digital Limited, registered the Domain Name under another trading style (i.e. as the Respondent, ecare Solutions). It is very improbable that Mr Daniels did not know that WELFARE CALL was the name and mark of the Complainant, which was a longer established competitor in the same field.

Knowingly registering the unadorned trade mark of a competitor as a domain name, and employing that domain name as a masquerade, to mislead and divert Internet users seeking the Complainant's site to the Respondent's site, cannot be considered a legitimate or fair use.

In the Expert's view, such actions are consistent with the circumstances envisioned under Paragraphs 3.a.i and 3.a.ii of the Policy, as cited above, and indicative of an Abusive Registration.

The Respondent's registration and use of the Domain Name falsely suggests a commercial connection with the Complainant. The presumption expected of ordinary Internet users when the Domain Name is connected to the Respondent's website, or used in an email address, will be that they are operated or authorised by the Complainant in connection with its "WELFARE CALL" trade mark and services.

The Expert is satisfied that the Complainant has justified its Complaint on the balance of probabilities; finds that the registration and use of the Domain Name by the Respondent has taken unfair advantage of, and been unfairly detrimental to, the Complainant's Rights; that the Domain Name is therefore an Abusive Registration; and that the conditions of Paragraph 2a.ii. of the Policy are met.

7. Decision

Having found that the Complainant has Rights, and that the Domain Name is an Abusive Registration in the hands of the Respondent, the Expert orders that the Domain Name <welfarecall.co.uk> be transferred to the Complainant.

Signed: Keith Gymer

Dated 17 February, 2016