



DISPUTE RESOLUTION SERVICE

D00016820

Decision of Independent Expert

Scottish Power Energy Retail Limited

and

Umar Hayyat

1. The Parties:

Lead Complainant: Scottish Power Energy Retail Limited
c/o Pinsent Masons LLP
141 Bothwell Street
Glasgow
G2 7EQ
United Kingdom

Respondent: Umar Hayyat
7 Cedar Drive
CHESHAM
Buckinghamshire
HP5 2GW
United Kingdom

2. The Domain Name(s):

scottishpower-sme.co.uk (the “Disputed Domain”)

3. Procedural History:

I can 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.

30 November 2015 19:34 Dispute received
01 December 2015 09:43 Complaint validated
01 December 2015 09:52 Notification of complaint sent to parties
18 December 2015 01:30 Response reminder sent
23 December 2015 10:22 No Response Received
23 December 2015 10:22 Notification of no response sent to parties
07 January 2016 01:30 Summary/full fee reminder sent
08 January 2016 12:45 Expert decision payment received

4. Factual Background

4.1 This is an unusual case in that the respondent has not responded to the complaint but the complainant has sought a full decision. In the circumstances, I can act only on the facts and arguments presented by the complainant, drawing such inferences as are appropriate from the facts presented.

4.2 The complainant is the well-known Scottish energy supply company. It has traded under and by reference to the name Scottish Power for many years. It is one of the UK's major energy providers and supplies gas and electricity to over five million customers in the UK. It has become widely recognised under that name.

4.3 The complainant is the proprietor of a number of trade mark registrations covering the name SCOTTISH POWER including UK registration 1 493 255 registered with effect from 4 March 1992 for a variety of services in Classes 35, 37, 39, 40 and 42. The registered services include the promotion and advertising and supply of electricity and gas and associated services. It is not necessary to refer to any of the complainant's further registrations for the purposes of this decision.

4.4 The complainant is also the registrant of a variety of domains including the name Scottish Power, including scottishpower.co.uk which was registered on 24 August 1996.

4.5 The Disputed Domain was registered by the respondent on 21 October 2015. The Disputed Domain comprises a term identical to the complainant's name and registered mark to which is added the designation "-sme". The usual signification for that combination of letters in a commercial context is "small and medium-sized enterprise[s]".

4.6 The Disputed Domain currently redirects internet traffic to the complainant's website at www.scottishpower.co.uk. The complainant has not given the respondent permission to do this.

5. Parties' Contentions

5.1 I will summarise here the complainant's contentions, there being no competing contentions from the respondent.

5.2 The complainant says that the respondent is not making a legitimate non-commercial use of the Disputed Domain. It asserts that there can be no such legitimate use as the Disputed Domain consists of the complainant's trade mark and will thus inevitably be associated by the public with the complainant.

5.3 The complainant asserts that the Disputed Domain has been registered primarily for the purpose of blocking the complainant's acquisition of a domain name which corresponds to its registered marks. It goes on to say that the respondent must have been aware of the complainant and that, by registering a domain name containing the complainant's well-known mark, he must have appreciated that he was misappropriating the complainant's goodwill. It says that the use of the Disputed Domain is an infringement of the complainant's trade mark rights under section 10(1) of the Trade Marks Act 1994, constituting the use of an identical sign for the services for which the complainant's mark is registered.

5.4 The complainant says that it anticipates that the Disputed Domain will be used to unfairly disrupt the complainant's business. It says that the use currently being made of the Disputed Domain (redirection of traffic to the complainant's website) reinforces the impression that there is an association or connection between the Disputed Domain and the complainant. It says that this gives rise to potentially fraudulent use of the Disputed Domain. It does not give any express examples but it is in my view obvious that, if the Disputed Domain is used by significant numbers of people as a route to the complainant's website, then a change in the function of the Disputed Domain, for example by directing to a site which appears to be but is not in fact connected to the complainant, could indeed be so used.

5.5 The complainant's representatives, Pinsent Masons LLP, wrote to the respondent on 4 November 2015 requesting the transfer of the Disputed Domain to the complainant. The respondent did not reply to that communication and the operation of the Disputed Domain has not changed following the sending (and presumably receipt) of that letter. The complainant says that the respondent's conduct demonstrates that the Disputed Domain was not registered in good faith and that it is consequently an Abusive Registration as defined in the DRS Policy.

5.6 Finally, the complainant says that it is highly likely that members of the public will access the Disputed Domain believing it to be associated with the complainant and that this will give rise to confusion. Such confusion of course gives rise to the risk set out in paragraph 5.4 above.

6. Discussions and Findings

6.1 The version of the DRS Policy relevant to the present dispute is version 3 which relates to complaints lodged after 29 July 2008. Paragraph 1 of that policy defines an 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”

6.2 Paragraph 1 of the DRS Policy defines “Rights” for the purposes of this procedure 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.”

6.3 Under Paragraph 2 of the DRS Policy a complainant must show on the balance of probabilities

- (a) that it has Rights in a name or mark identical or similar to the Domain Name; and
- (b) that the Domain Name in the hands of the Respondent is an Abusive Registration.

6.4 Paragraph 3 of the DRS Policy identifies a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The relevant factors for the purposes of the present case are

“(a)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;

C. for the purpose of unfairly disrupting the Business of the Complainant;

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;

...

The remaining factors are not relevant in the present case. I have accordingly taken the above factors into account in reaching my conclusions.

6.5 Paragraph 4 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. These include the following which are relevant to the present case:

“(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 commercially known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

...

6.6 The first question in any DRS complaint is whether the complainant has Rights. As the DRS Policy definition makes clear Rights are limited to rights which are enforceable by the complainant whether under English law or not: see also paragraph 1.10 of the Expert Overview. Equally, as has been said in many cases, the requirement to establish Rights sets a low threshold test.

6.7 In this case it is clear that the complainant has rights. It has an extensive trading history under the name which appears in the Disputed Domain, trade mark registrations and domain name registrations which are used by it in the course of its business. It is consequently the owner of a substantial goodwill amongst members of the public in the UK under the name SCOTTISH POWER. The complainant therefore passes the threshold test with ease.

6.8 I agree with the complainant that the respondent must have been aware of it when he registered the Disputed Domain. The complainant’s name is extremely well-known by the public in the UK and it advertises its services widely. Unless the respondent eschews all contact with the commercial world, he registered the Disputed Domain in the knowledge that it contained the name and trade mark of the complainant.

6.9 I can think of no obvious legitimate use by the respondent for the Disputed Domain. It is not a variation on the complainant’s name appropriate either to a tribute site or to a criticism site related to the services provided by the complainant. On the contrary, it appears at first blush to be appropriate for a commercial application of the complainant’s name to small and medium-sized businesses. Such activities can, of course, only be carried on with the complainant’s consent and that has not been given and clearly will not be in the circumstances set out in section 5 above.

6.10 The nature of the Disputed Domain is such that it seems to me that members of the public will associate it with the complainant leading to confusion. Indeed, the current use of the Disputed Domain must cause members of the public to believe that it is associated with the complainant because it directs them to the complainant’s website. It has accordingly been used and will be used in a manner likely to deceive or cause confusion amongst members of the public.

6.11 It also seems to me that the potential for subsequent fraudulent redirection of internet users to a different site which appears to be but is not in fact connected with the complainant is self-evident.

6.12 In these circumstances I have no hesitation in concluding that the Disputed Domain is an Abusive Registration under Paragraph 1 of the DRS Policy. In

particular it is in breach of paragraph 3(a)(ii) of the Policy having been used and threatened to be used in a way which is likely to confuse people into thinking that it is registered to or operated or authorised by or otherwise connected with the complainant.

6.13 In the light of this conclusion I do not need to decide whether the Disputed Domain was registered primarily as a blocking domain. Given the use that is currently being made of it, that may well not be the case but it does not matter.

6.14 Nor do I need to rely upon the respondent's failure to reply to the communication from the complainant's representative. In this instance, it does seem to me that one is entitled to draw the inference that the respondent was not acting in good faith when he registered the Disputed Domain. Had he had a legitimate reason for doing so, the natural response to a complaint from the complainant would be to write back explaining what that reason was. His failure to do so leads to the opposite inference. That provides an additional reason for concluding that the Disputed Domain is an Abusive Registration.

7. Decision

7.1 I determine that the Disputed Domain, scottishpower-sme.co.uk, is an Abusive Registration and I direct that it be transferred to the complainant.

Signed Michael Silverleaf

Dated 26 January 2016