

# **DISPUTE RESOLUTION SERVICE**

**D00020227**

## **Decision of Independent Expert**

The Little Runners Sports In Schools Limited

and

Little Runners Ltd

**1. The Parties:**

Lead Complainant: The Little Runners Sports In Schools Limited  
Jhetam Building  
38 High Road  
Woodford  
London  
E18 2QL  
United Kingdom

Respondent: Little Runners Ltd  
22 Park Way  
Ruislip  
HA4 8NY  
United Kingdom

**2. The Domain Name:**

littlerunners.co.uk

**3. Procedural History:**

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 into question my independence in the eyes of one or both of the parties.

August 30, 2018	Dispute received
August 30, 2018	Complaint validated
August 30, 2018	Notification of complaint sent to parties
September 10, 2018	Response reminder sent
September 18, 2018	Response received
September 18, 2018	Notification of response sent to parties
September 21, 2018	Reply reminder sent
September 21, 2018	Reply received
September 21, 2018	Notification of reply sent to parties
September 26, 2018	Mediator appointed
September 26, 2018	Mediation started
October 17, 2018	Mediation failed
October 17, 2018	Close of mediation documents sent
October 29, 2018	Complainant full fee reminder sent
October 31, 2018	Expert decision payment received

#### **4. Factual Background**

The factual background is taken from the Complaint and the Response.

The Complainant was registered at Companies House on December 22, 2009. The Complainant holds trademarks registered at the United Kingdom Intellectual Property Office on December 21, 2017 for THELITTLERUNNERS and LITTLERUNNERS, registration number 3278802 in classes 35, 41 and 43.

The Complainant's business, based in London, is to provide schools with certain outsourced ancillary services. The Complainant uses for its business the domain name thelittlerunners.co.uk, which was registered on June 11, 2009, and which resolves to a website setting out the services offered. According to the screen capture of the website, these services particularly include the provision and supervision of a range of sporting activities during both term time and half-term holidays for children aged 5-11.

The Respondent's business, based in west London and family run, is registered with Ofsted [Office for Standards in Education, Children's Services and Skills, United Kingdom] and offers childcare for children aged 4-11. The Respondent offers, presently in two west London schools, what it describes as basically a nursery for older school aged children. If required, the Respondent manages a school's extra-curricular clubs programmes, including for example photography, cooking, gymnastics, computer coding, multi skills and other activities.

The disputed Domain Name was registered on March 8, 2017, and is apparently used as the Respondent's primary website.

#### **5. Parties' Contentions**

##### **Complainant**

##### **Complainant's Rights**

The Complainant has submitted documentary evidence that it has held the UK registered trademarks THELITTLERUNNERS and LITTLERUNNERS since December 21, 2017, and

has been the registered holder of the company name “The Little Runners Sports In Schools Limited” since December 22, 2009. It says it is generally known as “The Little Runners”.

### **Abusive Registration**

The Complainant says the Respondent appeared in 2015 in the same industry and is causing confusion and a conflict of interest, resulting in the diversion of prospective clients from the Complainant to the Respondent. The Complainant has invested in marketing and brand development but is losing income because some prospects and schools go to the Respondent instead.

The Complainant says parents have been confused about who they are dealing with. Actual confusion has happened because the Complainant has received many calls from across London from people wishing to speak to the Respondent.

The Complainant says the Respondent has been uncooperative in attempts to resolve the conflict.

The Complainant requests the transfer of the Domain Name.

### **Respondent**

The Respondent denies the Complaint.

The Respondent says its registration on the Ofsted Early Years childcare register is important. The standards required are high and the Respondent is subject to checks from time to time. The Complainant cannot offer this level of childcare. The Respondent is not a sports company, but is more, and is strictly monitored and regulated.

The Respondent says it works in individual schools, of which it has two, and that the director of the Respondent is a teacher at one of them.

The Respondent seeks to distinguish itself from the Complainant by saying it does not offer PPA [planning, preparation and assessment] cover to schools, or coaches for school physical education lessons, and does not provide sports coaches to schools.

As well as providing childcare, the Respondent manages the schools’ extra-curricular club programmes if that is what they request. The Respondent works with a specialist gymnastics company to run gym sessions. Parents pay for this and the Respondent pays the gymnastics company.

Because of these and other differences, the Respondent denies that it takes any business from the Complainant. The Respondent denies it has received calls intended for the Complainant.

The Respondent says its business is with parents at the schools where it operates, therefore it does not need to market itself externally.

### **Complainant’s Reply to the Response**

Insofar as new information is provided, the Complainant replies to the Response as follows.

The Complainant says the Respondent has not claimed to have rights and legitimate interests in the Domain Name.

The Complainant says the Respondent's website features the trademark LITTLE RUNNERS and is in competition with the Complainant. The Domain Name incorporates the trademark LITTLE RUNNERS in its entirety. The presence or absence of the word THE is of no consequence.

The Complainant says the Respondent's registration with Ofsted is irrelevant. The Respondent's services are similar or identical to the Complainant's because both provide care for children before or after school. The Respondent is offering sports activities and refers in its blog to the importance of physical activity and to helping children to be fit, healthy and active. The description of the Respondent in a Google search for "the little runners" is "a London based sports club for children at primary and secondary schools", which is the same as the Complainant's services.

Actual confusion with the Respondent has happened to the Complainant's knowledge when a school secretary opened the Respondent's website by mistake after a Google search and asked the Complainant whether it had changed its website.

The Complainant says the fact that the Respondent only works at two schools disregards the fact that the Respondent's website at the Domain Name is available to all on the Internet.

The Complainant says the Respondent would have been aware of the Complainant as it would have appeared on the Companies House search when the Respondent's limited company was registered. The Respondent would have been aware of the Complainant's domain name when registering the disputed Domain Name.

The Complainant says the Domain Name was registered with intent to divert clients to the Respondent's website by confusion by trading on the goodwill in the Complainant's trademark. The Respondent has not been authorised to use the Complainant's trademark.

## **6. Discussions and Findings**

Under paragraph 2.1 of the Policy the Complainant must prove, on the balance of probabilities, that:

“2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.”

### **Complainant's Rights**

In paragraph 1 of the Policy rights are defined as follows:

“Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

The Complainant has produced copies of documentation showing it to be the registrant of the UK trademarks THELITTLERUNNERS and LITTLERUNNERS. These were registered only recently, on December 21, 2017, which is later than the registration of the Domain Name by the Respondent on March 8, 2017. Nevertheless, paragraph 2.1.1 of the Policy is written in the present tense, requiring only that the Complainant “has” rights in respect of a name or mark, and the Domain Name is clearly identical to the Complainant’s trademark LITTLE RUNNERS.

The Complainant has produced evidence in the form of a copy of the relevant UK Companies House record showing it to be a private limited company incorporated on December 22, 2009 under the name “The Little Runners Sports In Schools Limited”.

The registration of a company name is not necessarily regarded as sufficient to create rights in the name under the Policy. More than mere registration is required. The Complainant has not substantiated its trading history well but on an overview of the Complaint and the Reply to the Response it does appear that in the period of more than seven years between formation of the Complainant’s company in 2009 and the registration of the Domain Name in 2017, the Complainant has been actively in business. It claims, without evidence but uncontested, to have invested in “flyers, booklets, brochures and also PPC campaigns on the internet as well as hiring of social media marketing company to create brand awareness”. It claims similarly to have “invested money into illustrations and clothing for the potential goal of merchandising and we constantly work with schools”.

The Expert is satisfied, on the balance of probabilities, that the Complainant has rights in its company name, including, for example, the right to protection against passing off, that are sufficient to satisfy the requirements of paragraph 2.1.1 of the Policy.

Of the Complainant’s entire name “The Little Runners Sports In Schools Limited”, the Expert finds the distinctive words and the identifier of the Complainant’s business to be “Little Runners”, with the words “Sports in Schools” being descriptive and the article “The” being inconsequential. The Domain Name extension “.co.uk” may be disregarded in the determination of identity or similarity. Accordingly the Domain Name littlerunners.co.uk is found to be similar to the Complainant’s name under paragraph 2.1.1 of the Policy.

### **Abusive Registration**

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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. is being used or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.”

Paragraph 5.1 of the Policy provides non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration, including:

- 5.1.2 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 8 of the Policy sets out how the Respondent may demonstrate in its Response that the Domain Name is not an Abusive Registration, the initial part of which reads:

8.1 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

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

8.1.1.1 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;

8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or

(.....)

The Complainant has produced in evidence three screen captures of the website to which the Domain Name resolves. Each is prominently headed with the stylised words "Little Runners" in red and black respectively, in logo form with silhouettes of three running children. The first page (/blog-2-column-2) is the start of a blog. The second page (/fitness/twitter/) is subheaded "Physical Activity Guidelines for Young Children", with paragraphs referring to physical activity, muscles and exercise. The third page (/timetable/) names the two schools at which the Respondent presently operates and also states that it is "Open for Bookings". The Complainant submits that the Respondent's website offers the same services as the Complainant.

The Respondent has sought to distance itself from the Complainant by claiming to be not in the same line of business. The Respondent points to its Ofsted registration; however this has no bearing on whether use of the Domain Name is likely to cause confusion with the Complainant. The Respondent says it is not a sports company but is "basically a nursery for older school aged children". This is not borne out by an examination of the Respondent's website, with its clear references to physical activity. The first (blog) page, under "Read More", references "Physical Activity Guidelines for Young Children". The /fitness/twitter/ page is not only titled "Physical Activity Guidelines for Young Children", but has an opening paragraph to that effect, then paragraphs headed "What are the physical activity guidelines for children aged 5-18 years old?", "Which muscle strengthening exercises are suitable for children?", "How can I help my child build strong bones?", "Exercise can help the mind too", and "Improving the mood", which last begins "After a great exercise session...".

Furthermore, a screen capture of a Google search for "the little runners" made by the Complainant shows the Domain Name in second place (which, because search results take account of the searcher, would not necessarily happen to every searcher), and featuring the Respondent's own description, "Need a breakfast Club? London based sports club for children at primary and secondary schools".

Paragraph 18.1 of the Policy empowers the Expert, in their entire discretion, to check "any material which is generally available in the public domain". In fairness to the Respondent, which had not substantiated the point, a few seconds were spent checking whether the Respondent was listed on the Companies House website. In so doing it was noted that the Respondent, incorporated on October 29, 2015 gave its "Nature of business" as "Child day-care activities" and "Activities of sport clubs".

On the evidence, and on the balance of probabilities, the Expert finds sufficient similarity between the Respondent's activities and those of the Complainant, which registered its business name nearly six years earlier (and its own domain name, thelittlerunners.co.uk, more than six years earlier) that there is a high likelihood of potential or existing clients being confused into believing erroneously that the Domain Name belongs to the Complainant, amounting to Abusive Registration within the contemplation of paragraph 5.1.2 of the Policy.

The Expert further finds that the Respondent cannot succeed in the potential defences provided under paragraph 8.1.1 of the Policy. Irrespective of the extent to which it might believe it had used the Domain Name for an offering of goods or services, or had been commonly known by that name, the Respondent ought reasonably to have been aware, or to have made itself aware, of the Complainant of similar registered name and in similar business already operating across London, and thereby been aware that the Complainant's cause for complaint arose at the time the Domain Name was registered. As reviewed in the DRS Experts' Overview, Version 3, "The circumstances set out in paragraph 8.1.1 of the Policy are only likely to constitute satisfactory answers to the Complaint if they commenced when the Respondent was unaware of the Complainant's name or mark forming the basis for the Complaint".

The Expert finds Abusive Registration and use of the Domain Name in the hands of the Respondent under paragraphs 1(i) and 1(ii) of the policy.

### **Decision**

The Expert finds that the Complainant has Rights in respect of a name or mark identical to the Domain Name littlerunners.co.uk and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Domain Name littlerunners.co.uk is ordered to be transferred to the Complainant.

**Signed** Clive Trotman

**Dated** November 20, 2018