

DISPUTE RESOLUTION SERVICE

D00020437

Decision of Independent Expert

Mutha Hood Limited

and

James Connolly

1. The Parties:

Complainant: Mutha Hood Limited
Kingfisher House
Hurstwood Lane
Haywards Heath
RH17 7QX
United Kingdom

Respondent: James Connolly
Liverpool
United Kingdom

2. The Domain Name:

stronggirlsclub.co.uk (the "Domain Name")

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

The procedural history is as follows:

23 July 2018 15:40 Dispute received
23 July 2018 16:54 Complaint validated
23 July 2018 17:00 Notification of complaint sent to parties
08 August 2018 16:40 Response received
08 August 2018 16:40 Notification of response sent to parties
13 August 2018 02:30 Reply reminder sent
15 August 2018 14:40 Reply received
15 August 2018 14:41 Notification of reply sent to parties
15 August 2018 14:43 Mediator appointed
22 August 2018 15:32 Mediation started
09 October 2018 12:18 Mediation failed
09 October 2018 12:19 Close of mediation documents sent
19 October 2018 02:30 Complainant full fee reminder sent
19 October 2018 10:45 Expert decision payment received

4. Factual Background

The Complainant, whose business was started by its owner as sole trader in 2016, is an online fashion retailer, selling goods including clothing, jewellery, bags, and mugs under the name “Mutha.Hood”, some of which bear the slogan: “Strong Girls Club”. The first such product was sold on 6 May 2017.

On 24 August 2017, a Gemma Metcalfe-Beckers applied for a UK trade mark under application no. 3252338 for “Strong Girls Club” in class 25. This was withdrawn on 12 September 2017.

On 10 February 2018, a person who the Complainant says is connected with the Respondent (see section 6 below) placed the first of three orders on the Complainant’s website for “Strong Girls Club” branded products.

On 22 May 2018, the Respondent registered the Domain Name.

On 25 May 2018, the Respondent filed a UK trade mark trade mark application no. 3313535 for a logo comprising the words “STRONG GIRLS CLUB” arranged vertically (with minor graphical elements) in class 42. This application has been opposed by the Complainant and is still pending.

On 6 and 27 June 2018, the Complainant applied for two UK trade marks for its own logo consisting of the words “STRONG GIRLS CLUB” arranged vertically, covering classes 14, 18, 21 and 35. These applications were both registered on 5 October 2018 (i.e. after the Complaint was filed) under numbers 3315932 and 3320784 respectively.

On 5 July 2018, the Complainant sent a cease and desist letter to the Respondent. There was no response.

At around that time the Respondent was using the Domain Name for a website branded with the Respondent's "STRONG GIRLS CLUB" logo and whose home page stated:

"Strong Girls Club Apparel

Strong Girl Club Gym Clothes

We have a full range of Strong Girl Club t-shirts, hoodies, vests, crop tops, sweatshirts and leggings all in stock!

Our Strong Girl Club range is aimed at all the girls, women and ladies of all ages and backgrounds who are lifting weights and looking, keeping and staying strong!"

5. Parties' Contentions

Complaint

The following is a summary of the Complaint:

The Complainant owns unregistered rights in the mark "Strong Girls Club" based on sales of products branded with that name exceeding £250,000, social media activity by reference to that brand - including over 100,000 likes on Instagram and shares by "social media influencers" with over 1 million followers collectively - as well as significant press coverage. This amounts to significant goodwill.

The Complainant's rights predate registration of the Domain Name by over a year.

The Domain Name is effectively identical to the Complainant's mark.

The Respondent has used the Domain Name to create a likelihood of confusion in accordance with paragraph 5.1.2 of the DRS Policy. The Domain Name constitutes initial interest confusion, as it is identical to the Complainant's mark.

The Domain Name is a blocking registration per paragraph 5.1.1.2. The fact that a person connected with the Respondent placed orders on the Complainant's website shows that the Respondent was aware of the Complainant. The shipping and billing address used for the order is the same as the trading address of another company owned by the Respondent's father. That company's registered address is also used by the Respondent on his trade mark application. The Respondent therefore knew of the Complainant's brand and obtained the Domain Name to prevent its use by the Complainant.

Paragraph 5.1.6 of the Policy also applies. The Domain Name is an exact match for the Complainant's mark, which has a reputation, and the Respondent has no reasonable justification for having registered the Domain Name.

Response

The Response is short and is reproduced below in its entirety:

"The use of this domain name is for my own website that sells gym apparel. We have a trade mark pending for o[u]r logo. This logo carries the same words as my domain name.

The person making the complaint has tried to register the trade mark logo with the same words some time after I have applied for my registration.

The person making the complaint has no granted trademark or copyright for these three simple words!

We do not offer our products to the same market as the person making the complaint and o[u]r logo is completely different to the words they use. They have only tried to apply for their logo with these words after our own application.

The person making the complaint had every opportunity to purchase this domain name and failed to do so. Now I own it they are trying to make things difficult."

Reply

The following is a summary of the Reply:

The Respondent sells a large array of goods. While some of the Respondent's goods could be categorised as gym apparel, they could also be categorised as clothing and accessories. The Respondent's t-shirts featuring the mark "STRONG GIRLS CLUB" conflict directly with similar t-shirts sold by the Complainant.

The Complainant intends to oppose the Respondent's pending application for a logo trade mark. (The Complainant has since filed an opposition.)

The Complainant began selling goods under the mark long before the Respondent's trade mark application. The Complainant previously applied to register the words "Strong Girls Club" but this was withdrawn prematurely due to poor legal advice.

In any case, it is inaccurate to infer that the Complainant started using the mark after the Respondent. The Respondent was fully aware of the Complainant's goods before registering the Domain Name.

While the Respondent claims to be trading in a different market with a different logo, the Respondent's goods are identical or highly similar to those of the Complainant and both target women and children.

Visual differences between the logos are not relevant where both use the same words. In any case, conceptually the logos are highly similar and phonetically they are identical.

6. Discussions and Findings

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has "Rights" (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an "Abusive Registration" (as defined in paragraph 1 of the DRS Policy).

Complainant's Rights

The meaning of "rights" is defined in the DRS Policy 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"

Having consulted the website of the UK Intellectual Property Office (as I am entitled to do – see paragraph 5.10 of the DRS Expert's Overview, version 3, on Nominet's website), I have established that the Complainant's two applications for its "STRONG GIRLS CLUB" logo have now been registered.

While the registrations occurred after the date of filing of the Complaint - the point at which rights are assessed - they are treated as having taken effect retrospectively as of the dates they were filed, which predate the Complaint. Accordingly, both trade marks were deemed to be in force at when the Complaint was filed and, in my view, they suffice to constitute Rights under the Policy.

These trade marks are undoubtedly similar to the Domain Name as they consist of the barely-stylised words "STRONG GIRLS CLUB".

The Complainant also relies on unregistered rights in the term "Strong Girls Club" but it has produced little evidence in support of this claim, in particular to demonstrate that it used the term in a trade mark sense, i.e. as "a designation of origin", rather than simply as a slogan placed on products which did not denote their trade source.

However, while the Respondent contests various aspects of the Complaint, he does not specifically dispute the Complainant's claim to unregistered rights, or the Complainant's assertions as to the high level of social media traction generated by the name – which indicates that it has likely moved beyond a free-standing slogan to the point where it has become associated with the Complainant as a designation of origin. Furthermore, it is well-established that Rights is a low threshold test.

For these reasons, I consider that the Complainant has established unregistered rights in the term "Strong Girls Club".

Accordingly, I am satisfied that the Complainant has established rights in a name or mark which is similar / identical to the Domain Name.

Abusive Registration

Does the Domain Name constitute an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS 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."*

The Respondent does not deny the Complainant's assertion that he registered the Domain Name with knowledge of the Complainant's mark, which claim is based partly on the purchase of some of the Complainant's products by someone associated with the Respondent before he registered the Domain Name.

Furthermore, the Respondent has adopted a logo which is reasonably similar to that of the Complainant, in that both use the capitalised words "STRONG GIRLS CLUB" arranged vertically with minimal stylisation. And the Complainant has provided evidence that the Respondent has applied the logo to a white t-shirt in a red font, with an overall effect which is strikingly similar to one of the Complainant's products.

In these circumstances, it is difficult to resist the conclusion that the Respondent has used the Domain Name in a way which is likely to confuse the public into believing that the Domain Name is connected with the Complainant – in accordance with paragraph 5.1.2 of the Policy.

The Respondent relies on his pending trade mark application for his logo. However, not only has that application not yet been registered, it was filed only three days after registration of the Domain Name. This indicates that its main purpose was to justify the Respondent's registration of the Domain Name and to help defend a proceeding such as this, rather than for an independent legitimate purpose. Accordingly, it does not assist the Respondent.

The Respondent is right to say that the Complainant's own logo trade mark applications were filed after the Respondent's application. But, again, nothing turns on this because, as mentioned above, the Complainant has established unregistered rights which significantly predate the Respondent's trade mark application and, indeed, that the Respondent was aware of those rights.

The Respondent's assertion that that the Complainant has no registered trade mark for "these three simple words" has now been overtaken by the Complainant's subsequent trade mark registrations. In any case, the Complainant's unregistered rights suffice to found the Complaint. It is worth adding that, while the mark does of course consist of three dictionary words, the combination of the terms is unusual and distinctive.

The Respondent seeks to distinguish its target market from that of the Complainant, presumably on the basis that his focus is on gym clothing. However, as the Complainant observes, the Respondent's products could also be categorised simply as "clothing and accessories", many of which could readily be worn outside the gym. And, indeed, some of the Respondent's products directly overlap with those of the Complainant, such as t-shirts.

The Respondent observes that the Complainant could have bought the Domain Name itself but did not do so. However, the Complainant was under no obligation to register any particular domain name, even one which exactly reflected its mark. The fact that the Complainant failed to register the Domain Name for whatever reason does not of itself justify the Respondent doing so in the circumstances of this case.

For the above reasons, I conclude that the Domain Name was registered and/or used in a manner which took unfair advantage of and/or was unfairly detrimental to the Complainant's rights.

7. Decision

I find that the Complainant has Rights in a mark which is similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration. I therefore direct that the Domain Name <stronggirlsclub.co.uk> be transferred to the Complainant.

Signed Adam Taylor

Dated 12 November 2018