

DISPUTE RESOLUTION SERVICE

D00021573

Decision of Independent Expert

Ultimate Languages Ltd

and

Webcertain Group Ltd

1. The Parties:

Complainant:
Ultimate Languages Ltd
47 Park Drive
Harrogate
North Yorkshire
HG2 9AX
United Kingdom

Respondent:
Webcertain Group Ltd
Blackthorn House
Northminster Business Park, Po
York
North Yorkshire
YO26 6QW
United Kingdom

2. The Domain Name:

ultimatelanguages.co.uk

3. Procedural History and Procedural Matters:

- 3.1 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.

3.2 Timeline

The dispute was received by Nominet on 2 July 2019. On 4 July 2019, the Complaint was validated and notification of the complaint was sent to the Parties. On 23 July 2019, a response reminder was sent to the Respondent. The Respondent failed to submit a response within the prescribed timeframe under the Policy and so on 1 August 2019, a notification of no response was sent to the Parties. On 1 August 2019, payment for an Expert decision was received.

On 2 August 2019, the CEO of the Respondent sent an email to Nominet asking how submissions could be made to the Expert. Nominet responded on the same day explaining how the Respondent could submit a Further Statement in line with section 17 of the Policy. The Expert, Ravi Mohindra, was appointed on 6 August 2019, and as at the date of the Decision, no Further Statement has been received.

4. **Factual Background**

- 4.1 The Complainant was incorporated on 10 April 2018 and is a company that provides translation services.
- 4.2 The sole director and shareholder of the Complainant, Ms Morgan, was employed by a company within the Respondent's group of companies, namely Webcertain Translates Limited, until 31 March 2018.
- 4.3 Webcertain Translates Limited also provides translation services.
- 4.4 The Complainant is the owner of a UK trade mark registration for a combined device and word mark, where the word comprises the term 'ULTIMATE LANGUAGES'. The mark was registered on 7 March 2019 in class 41 for translation services.
- 4.5 The Domain Name was registered by the Respondent on 5 June 2018. The Domain Name resolves to a website under the domain name <www.webcertain.com>. This website promotes the services of the Webcertain Group, including reference to translation services on the home page.
- 4.6 As stated above, the Respondent did not file a response and while it enquired about making submissions to the Expert after the deadline for the response, no such submissions were received.

5. **Parties' Contentions**

- 5.1 A summary of the Complainant's contentions is set out below.

Rights

- 5.2 The Complainant asserts that it been trading since the date of its

incorporation on 10 April 2018. Some evidence of trading activity under the 'ULTIMATE LANGUAGES' name and expenditure relating to advertising of the Complainant's services since April 2018 has been provided by the Complainant, including invoices issued by and to it, business cards for its employees which bear the 'ULTIMATE LANGUAGES' name, and its social media presence on the Facebook, Twitter and LinkedIn platforms. In addition, the Complainant owns the UK trade mark registration detailed above.

- 5.3 Further, the Complainant says that on 5 April 2018 it caused the domain name <www.ultimatelanguages.com> to be registered on its behalf. The website to which this domain name resolved displayed a generic landing page from June 2018 until 23 October 2018 which is when the website officially went live. This website details the Complainant's translation services offering.
- 5.4 The Complainant asserts that it is a recognised brand in its industry as a result of its marketing and branding endeavours together with the fact that, since its incorporation, another of Webcertain Translate Limited's employees, Ms Ballanti, has joined the Complainant and both Ms Morgan and Ms Ballanti are well known in the translation services industry.
- 5.5 The Complainant submits that the Domain Name incorporates its ULTIMATE LANGUAGES name in its entirety and it is therefore identical or similar to a name in which it has Rights.

Abusive Registration

- 5.6 The Complainant says that the Domain Name currently resolves to a website at <www.webcertain.com> and that the Complainant and the Respondent are competitors providing translation services.
- 5.7 The Complainant asserts that it has expended time and money on building a reputation in respect of its name and trade mark, and the Respondent has no reasonable justification for having registered the Domain Name other than for purposes of taking unfair advantage of and being unfairly detrimental to the Complainant's Rights.
- 5.8 The Complainant asserts that the Respondent was aware of the existence of the Complainant and its Rights at the time of registration of the Domain Name.
- 5.9 The Complainant alleges that the Respondent is disgruntled because a number of their employees have left (one of whom is Ms Morgan, sole director and shareholder of the Complainant which is a business which competes with the Respondent). As the Respondent has no legitimate interests in the 'ULTIMATE LANGUAGES' name, it registered the Domain Name with the primary purpose of preventing the Complainant from registering it and unfairly disrupting the Complainant's business

by virtue of (a) internet traffic (and subsequent business generation) being diverted to the Respondent's website instead of the Complainant's website, (b) the Complainant being unable to fully leverage the marketing potential of its website, and (c) the risk of initial interest confusion taking place.

The Respondent

- 5.10 As noted above, the Respondent did not file a response in this case nor did it file any Further Statement prior to the date of this decision despite Nominet explaining to it how to do so.

6. Discussions and Findings

General

- 6.1 For the Complainant to succeed with its Complaint it is required under section 2.2 of the Policy to prove to me, the Expert, on the balance of probabilities, that:
- I. the Complainant has Rights in respect of a name or mark which is 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 Section 1 of the Policy provides that 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*". Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.
- 6.3 Further, it is well accepted that the question of whether the Complainant has Rights falls to be considered at the time that the Complainant makes its Complaint and is a test with a low threshold to overcome.
- 6.4 The Complainant is the owner of a UK trade mark registration for a device and word mark, where the word comprises the term 'ULTIMATE LANGUAGES'.
- 6.5 Further, the Complainant has provided some evidence demonstrating trading activity under the ULTIMATE LANGUAGES brand name dating back to shortly after the Complainant's incorporation in April 2018.
- 6.6 I therefore find that the Complainant has Rights in respect of the name 'ULTIMATE LANGUAGES'.

- 6.7 The Domain Name incorporates the Complainant's ULTIMATE LANGUAGES name in its entirety and without adornment, excluding the generic .co.uk suffix.
- 6.8 I therefore find that the Complainant has established that it has Rights in respect of a name which is identical to the Domain Name and accordingly the Complainant has satisfied the first limb of the Policy.

Abusive Registration

- 6.9 Section 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 has been unfairly detrimental to the Complainant's Rights.*
- 6.10 Section 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that each of the Domain Names is an Abusive Registration. Section 8 of the Policy sets out a non-exhaustive list of factors which may be evidence that each of the Domain Names is not an Abusive Registration.
- 6.11 The Complainant relies on a number of the factors set out in section 5 of the Policy in order to make out its case on Abusive Registration, including those which relate to the original registration of the Domain Names and those which relate to subsequent use. The Complainant also submits that the Respondent has no legitimate interests in the 'ULTIMATE LANGUAGES' name in which the Complainant has Rights.
- 6.12 In the absence of a Response, it is not possible to state with certainty what the motives of the Respondent were when it registered the Domain Name.
- 6.13 The Respondent is using the Domain Name to resolve to a website at <www.webcertain.com>. There is nothing in this domain name, nor at the site to which this domain name resolves, to indicate that the Respondent has made any legitimate use of, or stakes any claim to, the 'ULTIMATE LANGUAGES' name, in respect of the services that it provides.
- 6.14 While this name comprises two generic English words, the use of them in combination is not descriptive of the translation services that the Respondent promotes on its website.

- 6.15 The Complainant has also provided evidence to show that it incorporated a limited company under the 'ULTIMATE LANGUAGES' name in April 2018 and that it has traded under this name since that time.
- 6.16 The Domain Name incorporates the Complainant's name in its entirety and the Respondent has failed to provide any explanation as to why it chose to register this Domain Name, some two months after the Complainant's incorporation.
- 6.17 Given that (i) the Complainant and the Respondent are competitors, (ii) Ms Morgan of the Complainant, was, at the date of registration of the Domain Name, a previous employee of the Respondent, and (iii) there is no evidence before me of any use by the Respondent of the 'ULTIMATE LANGUAGES' name prior to the date of registration of the Domain Name, I accept that it is more likely than not that the Respondent was aware of the Complainant and its 'ULTIMATE LANGUAGES' name when it registered the Domain Name, and that the Respondent had the Complainant's Rights in mind at the time of registration of the Domain Name.
- 6.18 I also accept that there is a real risk that an internet user guessing the URL for the Complainant's website will type in the Domain Name into his or her browser, in the hope and expectation that the website which appears is a website operated or authorised by, or otherwise connected with, the Complainant.
- 6.19 Further, as the Domain Name corresponds entirely with the Complainant's Rights (excluding the generic .co.uk suffix), I find it improbable that the Domain Name was chosen and registered by the Respondent for any reason other than to unfairly disrupt the business of the Complainant.
- 6.20 Finally, and for completeness, I have considered the non-exhaustive list of factors set out in section 8 of the Policy which may be evidence that a Domain Name is not an Abusive Registration. These relate to the Respondent's prior knowledge, or lack of the same, of the Complainant's cause for complaint and the possibility of the Respondent making fair use of the Complainant's name. On the evidence before me and the arguments presented by the Complainant, I take the view that none of the provisions of section 8 of the Policy can assist the Respondent.
- 6.21 In these circumstances I find that the Domain Name (i) was registered in a manner which, at the time when the relevant registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights, and (ii) has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

7. Decision

- 7.1 I find that the Complainant has proved that it has Rights in a name which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I therefore direct that the Domain Name be transferred to the Complainant.

Signed Ravi Mohindra

Dated 21 August 2019