

DISPUTE RESOLUTION SERVICE

D00021760

Decision of Independent Expert

C & J Clark International Limited

and

COCO

1. The Parties:

Complainant: C & J Clark International Limited
40 High Street
Street
Somerset
BA16 0EQ
United Kingdom

Respondent: coco
Super Privacy Service LTD c/o Dynadot
PO Box 701
San Mateo
California
94401
United States

2. The Domain Name(s):

clarkssalecheaps.co.uk

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 any that could arise in the foreseeable future, that need to be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

16 August 2019 15:46 Dispute received

19 August 2019 13:26 Complaint validated

19 August 2019 13:35 Notification of complaint sent to parties

06 September 2019 02:30 Response reminder sent

11 September 2019 09:40 No Response Received

11 September 2019 09:41 Notification of no response sent to parties

12 September 2019 10:16 Expert decision payment received

4. Factual Background

I find the following facts proved for the purposes of this Decision as being based on the Complainant's submissions and accompanying evidence:

- i. The Complainant first established a business in the early nineteenth century specialising in leather goods, before soon turning to shoe production and sale.
- ii. Since then, it has established itself as a leading brand in footwear under the mark "CLARKS", trading internationally.
- iii. The Complainant is the owner of a number of trade marks for "CLARKS" as disclosed in Annex D to its application.
- iv. The Complainant is also responsible for trading actively in its products under the mark "CLARKS" as disclosed in Annexes A, B, C, E, G and H to its application.
- v. The Complainant also maintains an online presence using domain names incorporating the "CLARKS" name and is a user of social media for the same purpose.
- vi. The Respondent registered the Domain Name on 27 August 2018 and appeared to be operating a website similar in design to that of the Complainant for the ostensible purpose of trading in the Complainant's footwear: at the time of writing this Decision (24 September 2019) the Domain Name resolved to a blank page simply stating at the top in small print, "Copyright 2019 Privacy Policy".

5. Parties' Contentions

The Complainant made the following submissions:

- i. The Complainant refers to its establishment in 1825 and its long history of producing fashionable and, in some cases, innovative items of footwear, which it has produced and traded in for a considerable period of time (nearly 200 years).
- ii. To prove its entitlement to Rights under the DRS Policy, the Complainant points to the evidence establishing its ownership of various trade marks incorporating the name "CLARKS", and also to various items showing its marketing efforts under that name as well its online presence and use of social media.
- iii. The Complainant asserts that, in consequence, it has considerable goodwill and reputation in the name "CLARKS".
- iv. The Complainant argues that its Rights in "CLARKS" are sufficiently similar to the Domain Name if the additional words of "salecheaps" and the .co.uk suffix are ignored, as it says they should be.
- v. The Complainant says that the Respondent's registration of the Domain Name is an Abusive Registration because:
 - a. The name "CLARKS" is so well known and must have been known to the Respondent at the time of registration;
 - b. The Respondent deliberately created a website at the Domain Name confusingly similar to the Complainant's such that consumers would be confused into thinking that the Domain Name was in some way registered to, operated or authorised by the Complainant;
 - c. There is no evidence of any attempt to make demonstrable preparations to use the Domain Name for a genuine offering of goods or services;
 - d. The Respondent has used a privacy service to protect its identity when this is not necessary; and
 - e. It is highly probable that the Respondent is operating by a linked website a fraudulent service by which it deceives consumers into paying for goods it does not provide.

The Respondent made no submissions and provided no evidence.

6. Discussions and Findings

Rights

The Complainant must show that it has Rights, which are defined 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*".

Having reviewed the materials provided by the Complainant in the Annexes to its application, I am satisfied that the Complainant has sufficient Rights for the purposes of the DRS Policy both by virtue of its trade marks and also by virtue of the goodwill it has amassed by its marketing of footwear over the course of many years.

Those Rights must, by virtue of paragraph 2.1 of the DRS Policy, be *“in respect of a name or mark which is identical or similar to the Domain Name”*. I discount the .co.uk suffix in line with the practice of other Experts. If I disregard the addition of the words *“salecheaps”*, the Complainant’s Rights have been directly incorporated into the Domain Name. I would not go so far as to say that all additional words following the words constituting the Rights must be disregarded in every such case, as the Complainant suggests in its application, but the meaning of the words is such that it clearly suggests the possibility of buying the Complainant’s products at a bargain price. It might, for example, be a different matter if the following words referred to something completely separate such as *“clarksholidays”* or *“clarksflowers”*. In the case of the Domain Name, the following words do nothing to separate the Domain Name from the Complainant’s Rights and line of business and I find therefore that the Complainant’s Rights are, for the purposes of the DRS Policy, sufficiently similar to the Domain Name.

Abusive Registration

The Complainant must then show that the Domain Name is an Abusive Registration in the Respondent’s hands. The DRS 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. *is being 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 DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The Complainant has invoked a number of these and I will examine them in order.

Paragraph 5.1.1.3

This refers to *“circumstances indicating that the Respondent has registered ... the Domain Name ... 5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant”*.

I take account of the following factors. I am satisfied that the initial use made of the website at the Domain Name was to mimic as closely as possible the appearance of the Complainant’s website. In this, I take account of the overall look and feel, the font, layout and ostensible function of that website. Taking all these factors into account, I find that the Respondent had the intention of registering the Domain Name incorporating the Complainant’s Rights precisely so that they could produce such a website. I therefore find that the Domain Name was an Abusive Registration at the time of its registration.

Paragraph 5.1.2

This refers to “[c]ircumstances 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”.

For essentially the same reason as given above, I find this ground made out. The website under the Domain Name can have no purpose other than to mimic the Complainant’s legitimate website and is highly likely to have confused consumers into thinking that it was in some way registered to, operated or authorised by or connected with the Complainant. It is true that the email address given for support is of a different domain (support@jdonline.info) but this is not in a prominent position and would not be obvious to the average consumer: it is not sufficient to prevent the overall impression being given that the Respondent’s website is in some way connected with the Complainant. As the Complainant observes in its application, there are no disclaimers on the Respondent’s website.

Other factors

The Complainant has pointed to the Respondent’s use of secrecy in the details of registration. I take no account of this: in these days, many people are worried about privacy and I cannot make assumptions based on this.

The Complainant also points to some evidence which makes it “highly likely” that the Respondent is operating some sort of fraudulent operation. Having considered this evidence, I have decided not to take account of it: without hearing anything from the Respondent, it would be unfair to make a finding of fraud or dishonesty and it is not necessary for the outcome of this Decision.

Possible countervailing factors

The Complainant discounts any possible countervailing factors in its application observing that nothing in paragraph 8 of the DRS Policy applies.

Especially in a case where the Respondent has not made any submissions or provided any evidence, I feel it is necessary to consider carefully whether there might be any factors which militate against a finding of an Abusive Registration. Paragraph 8 provides a non-exhaustive list of such factors. The Complainant asserts that there is no evidence of the Respondent making demonstrable preparation to use the Domain Name in connection with a genuine offering of good or services and I accept this: it seems unlikely given that the Respondent’s website so closely resembles that of the Complainant.

It is possibly true that the Domain Name is descriptive – the obvious meaning is that it is purporting to offer the Complainant’s shoes at a cheap price in a sale. However, I find that the Respondent is not making a fair use of it essentially for the reasons given above, namely, that the Respondent’s website was so closely mimicking the

Complainant's without making any serious effort to provide a clear disclaimer or make any other distinction. I cannot accept that the Respondent's website could be said to be "fair use" of the Domain Name in such circumstances.

Having considered all the factors in paragraph 8 and also generally, I have concluded that there are no factors indicating that the Domain Name is not an Abusive Registration.

7. Decision

I therefore decide that the Complainant has Rights in a mark similar to the Domain Name and that the Domain Name in the Respondent's hands is an Abusive Registration.

I therefore direct that the Domain Name be transferred to the Complainant.

Signed Richard Stephens

Dated 4 October 2019