



DISPUTE RESOLUTION SERVICE

D00019381

Decision of Independent Expert

Trade The News, Inc.

and

James Mills Ltd

1. The Parties:

Lead Complainant: Trade The News, Inc.
427 North Tatnall Street
Suite 9465
Wilmington
Delaware
19801-2230
United States

Respondent: James Mills Ltd
103 Hawdraw Green
Offeron
SK2 5LG
United Kingdom

2. The Domain Name:

tradethenews.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.

05 October 2017 17:27 Dispute received
09 October 2017 12:52 Complaint validated
09 October 2017 13:00 Notification of complaint sent to parties
09 October 2017 15:12 Response received
09 October 2017 15:12 Notification of response sent to parties
12 October 2017 02:30 Reply reminder sent
17 October 2017 11:12 Reply received
17 October 2017 11:31 Notification of reply sent to parties
17 October 2017 11:32 Mediator appointed
23 October 2017 09:46 Mediation started
21 December 2017 14:17 Mediation failed
21 December 2017 14:17 Close of mediation documents sent
04 January 2018 01:30 Complainant full fee reminder sent
05 January 2018 11:13 Expert decision payment received

4. Factual Background

The Complainant's business is the provision of information, news and data concerning finance, financial markets, stock markets, securities, commodities markets, futures trading and foreign exchange (Forex). The Complainant has since 2000 operated mainly through a website at the domain name tradethenews.com, which now broadcasts 24 hours a day. Since 2014 the Complainant has conducted its operations in conjunction with an affiliated entity TTN Global Operations Limited ("TTN Global") and the website has been operated through another affiliated entity, TTN Operations Ireland Limited ("TTNO").

The Complainant is the owner of the European Community trademark TRADE THE NEWS, filed on February 10, 2016, granted registration on August 11, 2016, registration number 15097223, in classes 36, 41 and 42.

The Complainant has also used the name "Trade The News" as its business name in the USA since 1997 and in the UK since 2004.

The Respondent registered the disputed Domain Name on July 15, 2015. It is used for a website focused on Forex trading.

5. Parties' Contentions

Complainant

Complainant's Rights

The Complainant says it has rights in the registered trademark TRADE THE NEWS and has produced a copy of online documentation showing the trademark to be registered under the Complainant's name and address.

The Complainant also contends that it has built significant goodwill and has common law rights in the unregistered trademark TRADE THE NEWS, which it says it has used in the USA since 1997 and in the UK since 2004. The Complainant says that evidence in the form of 11 screen captures made

between 2000 and 2017 of its website located at tradethenews.com, shows its continuous prior use of the unregistered trademark TRADE THE NEWS.

The Complainant says that its business is international and substantial. Its clients include 289 institutional subscribers in London alone, comprising many more individual users, together with major international financial institutions and banks, some with multiple users. The Complainant also has a highly active presence on social media.

The Complainant says the Domain Name is identical to the trademark in which it has rights, and that the technical elements of the Domain Name such as the ccTLD “.UK” are not distinguishing.

Abusive Registration

The Complainant contends that the Domain Name is an abusive registration in the hands of the Respondent. The Respondent is acting in bad faith by using the Complainant's trademark, embodied in the Domain Name, for a website that offers Forex signalling data as a membership service to its customers. This service provides foreign exchange data and analysis identical to and overlapping with services provided by the Complainant. The Respondent's use of the Domain Name in this way constitutes a confusing misrepresentation that the Respondent is associated in some way with the Complainant and is likely to cause damage to the Complainant.

The Complainant wrote a cease and desist letter to the Respondent on March 17, 2017, followed by a reminder on April 10, 2017, setting out its trademark rights and the detailed basis of its complaints against the Respondent. The Respondent did not reply but continued to operate its business. The Complainant's cease and desist letter reproduced certain images extracted from portions of the Respondent's website and asserted, among other things, that the Respondent had also incorporated the Complainant's trademark in the email addresses signals@tradethenews.co.uk and tradethenewsuk@gmail.com.

The Complainant says confusion between the Respondent's Domain Name and the Complainant has actually occurred and has disrupted the Complainant's business. In at least two instances, customers of the Respondent have mistakenly contacted the Complainant to ask for their monthly subscription payments to be cancelled. The Complainant has produced emails in evidence of one such misunderstanding. The Complainant says that the Respondent, by registering and using the Domain Name, is trading on the Complainant's reputation in order to confuse Internet users, and is doing so for commercial gain.

The Complainant also contends that the Respondent's failure to engage in correspondence with the Complainant or to agree to transfer the Domain Name, having been made aware of the Complainant's rights, is evidence of a blocking registration.

The Complainant requests the transfer of the Domain Name.

Respondent

The Respondent denies the Complaint.

The Respondent contends that its website is completely different from the Complainant's because the Respondent's website is focused on Forex trading and does not offer a news platform.

The Respondent says the Domain Name was registered on July 15, 2015, whereas the Complainant's trademark was registered on February 10, 2016 in only classes 36,41 & 42, which are unrelated to the Respondent's service.

Complainant's Reply to the Response

The Complainant refutes the assertion that the Respondent's website does not offer a news platform and says that the website provides newsworthy events that may be predictive of future foreign currency values. This is similar to the Complainant's comprehensive service offering extensive continuous news, announcements and analysis that may affect a wide variety of financial markets. The Complainant has produced in evidence a screen capture of its own Credit/FX/Futures News service.

The Complainant's Reply also reiterated some points made in the Complaint.

6. Discussions and Findings

Identity of the Complainant

The Lead Complainant, Trade The News, Inc., states that since 2014 it has conducted various of its operations through its affiliates TTN Global and TTNO. The Complainant in its cease and desist letter of March 17, 2017 to the Respondent, refers to Trade the News, Inc., and TTNO as "collectively, "Trade The News"". The Expert is satisfied that the three affiliated entities, Trade The News, Inc., TTN Global and TTNO are sufficiently inter-related that they may be referred to without distinction as the Complainant in this proceeding.

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

Paragraph 1 of the Policy defines rights 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 Domain Name incorporates the extension ".co.uk", which need not necessarily be considered in the determination of similarity to the Complainant's trademarks. What remains is "tradethenews", which is easily read as Trade The News.

The Complainant claims it had common law rights in the name TRADE THE NEWS as a trademark prior to its registration. A mere assertion of rights is not sufficient. The Complainant must demonstrate sufficient substance in a claim to have earned common law rights in a trademark.

The Complainant has produced in evidence screen captures of its own website located at the domain name tradethenews.com, made by the Wayback Machine (archive.org) on 8 dates roughly biennially between December 10, 2000 and March 31, 2015, and 3 pages captured by the Complainant's representative on October 5, 2017. The websites are mainly different, projecting professional design and portraying an evolving business concerned with the provision of international investment information, data and analysis at a professional level to paying subscribers.

The Complainant has said in the Complaint, uncontested by the Respondent, that the majority of the Complainant's clients are major international financial and banking institutions including 289 institutional subscribers (many with multiple individual users) in London alone.

Some evidence has been produced of advertising by the Complainant, including in Trader Monthly (Ask The Desk) and on Twitter.

Other evidence produced in support of the Complainant's usage of its name or trademark is so heavily redacted as to have obscured its connection with the Complainant, including its claimed Google AdWords settings and LinkedIn vacancy postings.

On the totality of the evidence, however, and having reviewed the Dispute Resolution Service - Experts' Overview (version 3) on the matter at section 2.2, the Expert finds the extent and duration of the Complainant's use of its name, its advertising, and the fact that its name, comprising generic words, has been accepted as a trademark at the European Union Intellectual Property Office, to be sufficient for the purposes of this proceeding for the Complainant to have the required rights in its name or trademark defined under paragraph 1 of the Policy. Paragraph 2.1.1 of the Policy is in any case written in the present tense and the Complainant presently has rights in what is now the registered trademark TRADE THE NEWS.

The Expert further finds the disputed domain name, omitting the ccTLD and second level domain, to be identical to the name or trademark in which the Complainant has rights 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 of the Policy lists factors, without limitation, that may be evidence of 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".

The Complainant has not produced a screen capture of the entire website to which the Domain Name has resolved. It has stated, however, uncontested by the Respondent, that the corresponding website has been used to offer to the Respondent's subscribers information, data and analysis relevant to Forex markets similarly to or overlapping with the Complainant's offering of such services. The Complainant has also produced in evidence its cease and desist letter to the Respondent, which reproduces in colour certain selected elements of the Respondent's website. These include: a block comprising a histogram icon and the words TRADE THE NEWS; and a stylised block reading TRADE THE NEWS™, *i.e.*, incorporating the abbreviation TM in the superscript convention used to signify a trademark. The cease and desist letter also reproduces a block similar to the histogram icon with TRADE THE NEWS but incorporating the line "Your subscription to our list has been confirmed", which the Complainant says appears on emails from the Respondent's mailing list sent from signals@tradethenews.co.uk and tradethenewsuk@gmail.com.

The Complainant has produced redacted email correspondence (initiated *via* the Complainant's website contact facility) from a person complaining they had tried but failed to cancel their £25.00 per month subscription and had accordingly cancelled their direct debit authority. The complaining person had uploaded to the Complainant a screen capture of their American Express account showing an

outgoing payment of £25.00 on August 23, 2017 identified as “TRADETHENEWS 1 MONTH STOCKPORT”, with reference to the next payment being due on September 20, 2017. The Respondent’s address of record has a Stockport postcode and the Complainant sent its cease and desist letters additionally to the address it has obtained for Forex Signals at another Stockport address and postcode. Thus it may reasonably be concluded that the complaining person, as a subscriber to the Respondent’s service, the Domain Name of which is registered to a Stockport area address, was confused into believing they were subscribing to the Complainant’s service, which is not based in Stockport. The Complainant says, without further evidence, this has happened at least twice.

The Complainant, in its Reply to the Response, annexed a website page in illustration of part of its own service. The page, marked Credit/FX/Futures View, for October 13, 2017, shows a running series of news items of potential relevance to foreign exchange values, updated frequently (10:00. 10:00, 10:15, 10:19, 10:23 ...), accompanied by a continuous chart over time of the Euro versus US\$ exchange rate. The Respondent pleads that its website is “completely different” from the Complainant’s and is “focused on Forex trading ...”. The Expert, on the evidence, finds no such distinction. On the contrary, on the evidence and on the balance of probabilities, the Expert finds that the Respondent’s primary use of the Domain Name has been for a website with the intention of causing persons or businesses to associate it with the Complainant by confusion within the meaning of paragraph 5.1.2 of the Policy. The block on the Respondent’s website proclaiming TRADE THE NEWS™, in particular, represents a misleading claim by the Respondent to have rights in, and an attempt to trade off, a trademark that it did not and does not own.

The Domain Name is found to have been used abusively in the terms of paragraph 1(ii) of the Policy and to have been registered for the same abusive purpose in the terms of paragraph 1(i) of the Policy, either being sufficient for a finding of Abusive Registration. Accordingly the Complainant has proved Abusive Registration of the Domain Name by the Respondent as required under paragraph 2.1 of the Policy.

7. Decision

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

Signed Clive Trotman

Dated January 24, 2018