

# DISPUTE RESOLUTION SERVICE

**D00020457**

## Decision of Independent Expert

- ShopStyle, Inc. -

and

Jamie Dickinson

### **1. The Parties:**

Lead Complainant: ShopStyle, Inc.  
800 Concar Drive, Suite 175  
San Mateo  
California  
94402  
United States

Complainant: ShopStyle UK Limited  
Hanover House  
14 Hanover Square  
London  
W1S 1HP  
United Kingdom

Respondent: Mr Jamie Dickinson  
Highway House  
Froyle Road  
Upper Froyle  
Alton  
Hampshire  
GU34 4NR  
United Kingdom

## **2. The Domain Name:**

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

27 July 2018	Dispute received
30 July 2018	Complaint validated
30 July 2018	Notification of Complaint sent to parties
06 August 2018	Response received
06 August 2018	Notification of Response sent to parties
09 August 2018	Reply reminder sent
13 August 2018	Reply received
14 August 2018	Notification of Reply sent to parties
17 August 2018	Mediator appointed
20 August 2018	Mediation started
05 September 2018	Mediation failed
05 September 2018	Close of mediation documents sent
12 September 2018	Expert decision payment received

## **4. Factual Background**

The Lead Complainant, ShopStyle, Inc. ('Inc') is a Delaware company which was incorporated on 15 June 2006. It is the registered proprietor of EU Trade Mark Registration No. 6824395 for SHOPSTYLE filed on 10 April 2008, published on 7 July 2008 and with a registration date of 21 January 2009. ShopStyle UK Limited ('ShopStyle UK') is the registrant of the domain name <shopstyle.co.uk> registered on 27 April 2006, as well as the domain name <shopstyle.com>. ShopStyle UK is solely owned by Inc. and was incorporated in the UK on 27 January 2017. ShopStyle UK and Inc will be referred to collectively as the 'Complainant'.

The Domain Name was registered by the Respondent on 8 March 2009.

## **5. Parties' Contentions**

The following is a summary of the main contentions of the Complainant and a verbatim account of the Respondent's answer to the Complaint.

## Complaint

### *Rights*

As well as registered rights, the Complainant also enjoys unregistered rights in the SHOPSTYLE mark throughout the United Kingdom since 2008.

The Complainant launched in the UK in 2008. Whilst ShopStyle UK was not incorporated until 27 January 2017, it began prominent, nationwide use of the SHOPSTYLE mark in the United Kingdom that year i.e. before incorporation. The website at [www.shopstyle.co.uk](http://www.shopstyle.co.uk) was launched in September 2008.

The Complainant's aim was to become the UK's number one fashion destination by changing the way women shop online.

The Complainant markets clothing and accessory products of a wide range of partner fashion brands. It provides a one stop shop platform for consumers to search and view a number of products from a variety of fashion brands.

The Complainant has made extensive and prominent use of the SHOPSTYLE brand. It is one of the most well-known online search engines in the fashion industry, with gross retail sales to partners of approximately \$1 billion and over 3 million searches per month. The Complainant receives 630,000 visitors a month to its website at [www.shopstyle.co.uk](http://www.shopstyle.co.uk), of which 450,000 visitors are located in the UK. It receives approximately 520,000 visitors a month from the UK to its US website at [www.shopstyle.com](http://www.shopstyle.com). The Complainant has established enormous goodwill and reputation in the UK and worldwide, and estimates that in 2018 it will spend approximately \$1.5million on marketing for ShopStyle UK.

The Complainant vigorously defends and protects its brand worldwide and, as a result, its customers believe that any domain name incorporating its SHOPSTYLE mark is controlled, approved, endorsed and/or operated by the Complainant, and that any websites accessed via such domain names are sites controlled, approved or endorsed and/or operated by the Complainant.

The Domain Name was registered by the Respondent on 8 March 2009, which post-dates the registration date of the SHOPSTYLE mark (EUTM Registration No. 6824395) and <shopstyle.co.uk> domain name, the incorporation of Inc. and the date the Complainant started trading.

### *Similarity*

The Domain Name is extremely similar to the SHOPSTYLE mark – it is the Domain Name's dominant element, combined with the inherently non-distinctive and descriptive letter 'i', which carries little or no meaning with consumers other than to identify an online or

'internet' dimension to the service provided by the entity whose name follows. Since the Complainant's business has been an internet business from the outset, the addition of the 'i' prefix does nothing to differentiate the Domain Name from the Complainant's SHOPSTYLE mark.

### *Abusive Registration*

It is highly likely that the Domain Name has been registered with the intention of taking unfair advantage of the Complainant's rights.

The Complainant owns the goodwill and reputation in the SHOPSTYLE mark in the UK and beyond, and its use within the Domain Name is therefore likely to confuse consumers and/or constitute a misrepresentation that the Respondent is connected with the Complainant and its goodwill and reputation in the SHOPSTYLE mark and brand generally. Such confusion and/or misrepresentation is likely to cause the Complainant damage as a result of a change in the economic behaviour of its customers and potential customers. Tarnishment or dilution of its goodwill and reputation in the SHOPSTYLE mark may arise. There may also be a diversion of the benefit of the Complainant's goodwill and reputation in the SHOPSTYLE mark to the benefit of the Respondent and its competing business.

In April 2009, the Respondent launched a fashion retailer business selling designer clothes from fashion partners which very obviously sought to clone the SHOPSTYLE brand and business idea of the Complainant.

The Domain Name is not only very similar to the domain names of the Complainant, but the content of the website once associated with the Domain Name contained closely competing and similar retail products. In these circumstances, there can be little doubt that the Domain Name has been adopted in bad faith with a view to abusively taking advantage of the Complainant's goodwill, brand and business idea.

Whilst the Domain Name does not currently point to a website, this may change. In any event, this matters not to the issue of whether the registration of the Domain Name was an Abusive Registration. In any event, there are good reasons for the Complainant to believe that the Respondent's intention is to use the Domain Name to market and sell retail products that directly compete with those of the Complainant. Thus the Complainant's business is currently burdened because resource is required to monitor the Domain Name.

The Complainant also refers to the High Court judgment of *Global Projects Management Ltd v. Citigroup and others* [2005] EWHC 2663 in which it was held that the mere registration and maintenance of a domain name which may lead people to believe that there is a connection between the holder of the domain name and the owner of a brand is sufficient to make such domain names potential 'instruments of fraud' amounting to passing off.

The Complainant submits that the Domain Name was clearly registered abusively and has been used abusively to create consumer confusion and take unfair advantage of the Complainant's goodwill and other rights, by associating the Respondent's services with those of the Complainant.

### Response

The Respondent's answer to the Complaint is short and can conveniently be set out in full:

*'The complainant in this case has no basis for their rights or claim as an abusive registration. The alleged infringing website has been in existence for over 10 years and has never caused any confusion in the past.*

*Is Hop Style has a completely different concept to the SHOPSTYLE platform (which was previous [sic] unknown to the registrant).*

*The domain and website would not cause any confusion to visitors of either Is Hop Style or SHOPSTYLE, nor cause them in any way to believe that the 2 sites are in any way connected.'*

Reference is also made to the website to which the Domain Name points.

### Reply (to the Response)

The claim that the 'infringing website' has been in existence for over 10 years is wrong as the Domain Name was registered on 8 March 2009, i.e. 9 years ago. In any event, the Complainant's rights and domain name registration pre-date registration of the Domain Name.

The Complainant was notified of the existence of the Domain Name by a third party on 16 May 2017, and thereafter instructed its solicitors to write to the Respondent on 3 November 2017. A further letter was sent on 12 April 2018.

Unfair conduct can arise at any point and coexistence for a time does not prevent a complainant filing a complaint.

As to the Respondent's suggestion that '*Is Hop Style has a completely different concept to the SHOPSTYLE platform (which was previous [sic] unknown to the registrant)*', the Complainant says this is wrong too, given that letters had been sent to the Respondent on 3 November 2017 and 12 April 2018, i.e. before the Complaint was filed and such letters had outlined the SHOPSTYLE business, and associated trade mark and domain name registrations. Accordingly, the Complainant's 'SHOPSTYLE Platform' could not have been 'unknown to the Registrant' at the latest, by 3 November 2017.

Moreover, the Complainant has made prominent and nationwide use of the ShopStyle domain and SHOPSTYLE mark since 2008, and the SHOPSTYLE brand is one of the most widely known and recognised brands in the world for fashion search engines. The Complainant has established enormous goodwill and reputation in the UK and worldwide, and it is unlikely that before 3 November 2017, the Complainant's platform was unknown to the Respondent.

The Respondent has not always had a 'completely different concept' to the Complainant. When the Complainant first discovered the Respondent's website on 16 May 2017, it operated as an online designer outlet store under the Domain Name. The Complainant exhibits evidence of such use (as well as social media use of "iShopStyle") by the Respondent as at 22 September 2017.

Following the letter sent on the Complainant's behalf on 3 November 2017, the Respondent linked its website to a different online address and as at 4 April 2018, it was to be found at [www.finalclearance.co.uk](http://www.finalclearance.co.uk) (still a fashion retailer website operating in direct conflict with the Complainant's activities). Thereafter, the Domain Name did not point to a live website.

The Response states that the Respondent is trading as 'Is Hop Style'. However, the Respondent has only recently changed its name to Is Hop Style (since the Complaint was submitted on 27 July 2018). The Respondent's assertion that it trades as 'IS HOP STYLE' may be seen as a reaction to the Complaint in an attempt to differentiate his business from that of the Complainant, so that it is not considered an 'abusive registration'.

In order for the Respondent to show that registration of the Domain Name was not abusive, he would need to show that he has made preparations to use the Domain Name for a legitimate business. This is not the case in this instance as the Is Hop Style business does not appear to be active, and the Domain Name merely links to a holding page. The business can therefore not be considered 'legitimate'. In any event, the change to 'Is Hop Style' occurred after the Complaint was filed.

The Domain Name takes unfair advantage of and/or is unfairly detrimental to the Complainant's rights now as well as at the time of registration on 8 March 2009. The Domain Name has been used in a manner which takes unfair advantage of, or is unfairly detrimental to the Complainant's rights, and there exists a danger that the current content of the website could be changed to the fashion retail business that was live at the point of registration, and which was created for the purposes of disrupting the Complainant's business.

There has been no peaceful co-existence in the run up to this Complaint and when the Complainant became aware of the Respondent, it took active steps against the abusive registration. Whilst there has been a change of behaviour by the Respondent, the Domain Name had been used in a way that was likely to confuse people or businesses into believing

that it was registered to, operated or authorised by, or otherwise connected with the Complainant.

## **6. Discussions and Findings**

Under the provisions of the DRS Policy, for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

### *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'*.

The Complainant has a registered trade mark for SHOPSTYLE and no doubt enjoys unregistered rights in that mark too by virtue of its extensive use (and marketing spend in relation to the SHOPSTYLE brand) over a number of years. It is clear that the Complainant enjoys rights in the SHOPSTYLE mark.

### *Similarity*

The Domain Name contains the Complainant's SHOPSTYLE mark but also the letter 'i' which precedes it. The letter 'i' is a common prefix which can be taken as having many meanings, including 'Internet'. Whatever the prefix was intended to indicate, the SHOPSTYLE mark is clearly identifiable within the Domain Name and is its dominant element. The 'i' prefix makes it no less identifiable and distinctive. In fact, to the extent the prefix indicates an Internet presence, the dominance of the SHOPSTYLE element of the Domain Name may only be enhanced (to the extent possible), given that the SHOPSTYLE brand is associated with the Complainant's *online* business. The Complainant's SHOPSTYLE mark and Domain Name are clearly similar.

The Expert is satisfied that the Complainant has Rights in a name or mark which is similar to the Domain Name for the purposes of the DRS Policy. The Expert must now therefore consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

### *Abusive Registration*

Paragraph 1 of the DRS Policy defines Abusive Registration as a domain name which was either *'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 which *'is being or has been used in a manner which has taken*

*unfair advantage of or was unfairly detrimental to the Complainant's Rights;*

A non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration is set out in paragraph 5 of the DRS Policy. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name *primarily* as a blocking registration against a name or mark in which the Complainant has rights (para 5.1.1.2), or for the purpose of unfairly disrupting the business of the Complainant (para 5.1.1.3).

Other factors suggesting an Abusive Registration include the Respondent 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 (para 5.1.2).

If the domain name is an exact match for the name or mark in which the complainant has rights, the complainant's mark has a reputation and the respondent has no reasonable justification for the registration, that too may evidence an Abusive Registration (para 5.1.6).

A non-exhaustive list of countervailing factors is set out in paragraph 8 of the DRS Policy i.e. factors which may indicate that the Domain Name is not an Abusive Registration. Included are circumstances suggesting that before being aware of the complainant's cause for complaint, the respondent has used or made demonstrable preparations to use the domain name in connection with a genuine offering of goods or services (para 8.1.1.1). A respondent being commonly known by a name or legitimately connected with a mark which is identical or similar to the domain name (para 8.1.1.2), or having made legitimate non-commercial or fair use of the domain name (para 8.1.1.3), will also be indicative of a registration that is not abusive. If the domain name is generic or descriptive and the respondent is making fair use of it, that too may indicate that it is not an Abusive Registration (para 8.1.2).

### *Discussion on Abusive Registration*

A domain name which incorporates a well-known trade mark, even if combined with generic or descriptive terms, may cause confusion as to the identity of the entity behind the Domain Name. This is particularly so if one or more of the generic or descriptive terms is indicative or reminiscent of the trade mark owner's products or business. However, it does not follow that in such circumstances, a finding of Abusive Registration for the purposes of the DRS Policy must always be made. Unfairness in the object or effect of the respondent's behaviour must be established.

Turning to the present circumstances, it may be helpful to set out a brief chronology of some of the key events as alleged in the Complainant's statements of case (and supported, in many cases, by evidence).



27 April 2006: <shopstyle.co.uk> registered  
 15 June 2006: 'Inc' incorporated  
 10 April 2008: EU Trade Mark Registration No. 6824395 for SHOPSTYLE filed  
 7 July 2008: Application published  
 Early 2008: SHOPSTYLE brand launched in UK  
 September 2008: Website at www.shopstyle.co.uk launched  
 21 January 2009: SHOPSTYLE trade mark registered  
 8 March 2009: Domain Name registered  
 April 2009: Respondent launches fashion retailer business selling designer clothes from fashion partners  
  
 27 January 2017: ShopStyle UK incorporated in the UK  
 16 May 2017: Complainant notified of the Domain Name  
 16 May 2017: Domain Name pointing to an online designer outlet of the Respondent  
 22 September 2017: Evidence of social media use of 'ishopstyle' by Respondent (Facebook, Twitter etc.)  
 3 November 2017: Letter sent to Respondent  
 12 April 2018: Further letter to Respondent  
 April 2018: Respondent's website linked to [www.finalclearance.co.uk](http://www.finalclearance.co.uk)  
 Domain Name no longer points to a live website  
 27 July 2018: Complaint filed

Whilst there is supporting evidence for many of the assertions of the Complainant, what is not entirely clear is the nature of the fashion retail business the Respondent is said to have launched in April 2009. However, given the assertion in the Complaint that the Domain Name is not only very similar to the domain names of the Complainant, but that the content of the Respondent's website contained closely competing and similar retail products, the Expert infers that it is suggested that the business set up under the Domain Name in April 2009 was an *online* competing business (as it was in May 2017). In any event, there is clear evidence that as at September 2017 the Respondent was using the Domain Name to point to an online business similar to, and which competed with, that of the Complainant.

The Respondent has chosen not to deal with his early use of the Domain Name (or the reason he chose the Domain Name), instead simply saying that his present business is different to that of the Complainant. He also says that there has been no confusion over the past 10 years, an assertion that (despite the period of time being inaccurate) may well be true given that the Complainant only found out about the Domain Name in May 2017. However, just as evidence of confusion may not be determinative of an Abusive Registration, the lack of such evidence is not an end to the matter. As indicated earlier, the DRS Policy provides many examples of what might constitute an Abusive Registration and not all involve confusion. In any event, the examples are just that – a non-exhaustive list of the kinds of circumstances indicative of an Abusive Registration.

The Domain Name is as close a match to the SHOPSTYLE mark as one could get, the difference being one letter, the prefix, 'i', which is likely only to support a suggestion of association between Domain Name and mark (to the extent the prefix indicates an Internet presence). Registration of the Domain Name followed shortly after the Complainant's launch of the SHOPSTYLE brand in the UK and, given there is no reason to doubt the assertions of the Complainant, the Domain Name was used in connection with a similar business to that of the Complainant more or less from the outset. In these circumstances, and in the absence of any attempt to answer the Complaint in any detail, it can readily be assumed that the Respondent knew of the Complainant, its products and brand at the time of registration of the Domain Name and sought to take unfair advantage of the goodwill and reputation the Complainant had established in its SHOPSTYLE brand.

It is surprising that the Complainant only found out about the Domain Name in May 2017 and that there have been no instances of actual confusion coming to its attention. That, however, does not mean that there can be no *likelihood* of confusion. Clearly there could be, regardless of the present use/non-use of the Domain Name given the similarity between mark and Domain Name (and the prefix 'i' to the extent indicative of an online business).

As to the issue of the Respondent's changed use (and without in any way suggesting that the Respondent's present (non) use, could escape a finding of Abusive Registration), it cannot be right, if a respondent has at one time acted in a way that took unfair advantage of, or was unfairly detrimental to the Complainant's Rights, that it can avoid an adverse finding by simply changing its use, such that once the complaint had been dismissed, it could switch back to its earlier allegedly wrongful use.

The Expert need not consider in any detail what the Respondent says about his present business save to say that referring to it as '*Is Hop Style*' rather than '*iShopStyle*', the format adopted in the past on the website to which the Domain Name once pointed, appears to be a clumsy attempt to disguise his true purpose in registering the Domain Name in the first place i.e. to take unfair advantage of the Complainant's Rights.

The Complainant has made out a case of Abusive Registration in that it has demonstrated that there are circumstances suggesting that the Respondent has acted in a manner which has taken unfair advantage of the Complainant's Rights. Whilst the Respondent has filed a Response, it has been brief and has not answered many of the assertions of the Complainant. His attempt at disguising his true purpose in choosing the Domain Name by now referring to his business as '*Is Hop Style*' rather than '*iShopStyle*' when there is only evidence of him actively using the latter rather than the former name, only goes to support a finding of Abusive Registration. Whilst the holding page to which the Domain Name presently points refers to '*Is Hop Style?*' the Expert has little hesitation in treating that reference as no more than further evidence of an attempt to disguise the true reason for registration of the Domain Name.

In the circumstances, the use to which the Respondent has put the Domain Name could not be considered, for instance, *fair use* for the purposes of paragraph 8 of the DRS Policy (or, for that

matter, *legitimate non-commercial* use). Moreover, the Respondent's use could not be regarded as a *genuine offering of goods or services* – its offering took unfair advantage of the Complainant's SHOPSTYLE mark. Moreover, the Respondent did or should have known of the Complainant's cause for complaint at the outset, given its intention to take advantage of the reputation and goodwill of the Complainant.

In all the circumstances, the Expert concludes that the Domain Name was and is an Abusive Registration.

## **7. Decision**

The Expert finds that the Complainant has Rights in a name or mark that is similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name, <ishopstyle.co.uk> be transferred to the Complainant.

**Signed:** .....

**Jon Lang**

**Dated: 15 October 2018**