

DISPUTE RESOLUTION SERVICE**D00022677****Decision of Independent Expert**

COREFORCE LTD

and

Harvey Ross

1. The Parties

Complainant: COREFORCE LTD
Arch. Makariou Avenue,
22 Makaria Center,
4th floor, Office 403
Larnaca
Cyprus

Respondent: Harvey Ross
Caledon
Canada

2. The Domain Name

essaytigers.co.uk

3. Procedural History

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 On 1 June 2020 the dispute was received, the complaint validated and notification of it sent to the parties. On 18 June 2020 a response reminder was sent. On 23 June 2020 the response was received and notification of it sent to the parties. On 26 June 2020 a reply reminder was sent. On 30 June 2020 the reply was received and notification of it sent to the parties. On 3 July 2020 the mediator was appointed and on 7 July 2020 the mediation started. On 10 July 2020 the mediation failed and close of mediation documents were sent. On 13 July 2020 the Expert decision payment was received.

4. Factual Background

4.1 The Complainant is a Cypriot company incorporated on 30 September 2016. Pursuant to a Website Purchase Agreement made on 5 October 2016 (**Website Purchase Agreement**) the Complainant purchased from a Panama company, Grand Fortuna Business, Inc (**Grand Fortuna**), all Grand Fortuna's rights in the essaytigers.com domain name, the web site at this domain name and the content of this site (amongst other things, see paragraph 6.9). The Complainant is now the registrant of essaytigers.com and uses this domain for a web site offering academic essay writing services.

- 4.2 A Scottish company, Diletix LP (**Diletix**), is the owner of US registered trade mark number 6,032,409 for ESSAYTIGERS registered in Class 41 on 14 April 2020. Under the terms of a Trademark Licence Agreement made on 15 April 2020, Diletix has exclusively licensed the Complainant to use this registered mark worldwide in relation to online academic writing and editing services. By letter dated 21 May 2020, Diletix has confirmed that the Complainant is entitled to file UK Dispute Resolution Service proceedings in order to protect the US trade mark and gives its consent for any disputed domain names within the proceedings to be transferred to the Complainant.
- 4.3 The Respondent registered the Domain Name on 5 January 2015. He uses the Domain Name for a web site offering academic essay writing services.

5. Parties' Contentions

- 5.1 I set out below a summary of what I consider to be the main contentions of the parties.

Complainant's complaint

- 5.2 The Complainant asserts the following Rights:
- (a) The Complainant relies on the US registered trade mark for ESSAYTIGERS (see paragraph 4.2).
 - (b) The Complainant asserts that the ESSAYTIGERS mark is protected by unregistered trade mark rights. It says that pursuant to the assignment in the Website Purchase Agreement it owns the common law trade mark rights in ESSAYTIGERS built up before the Complainant's incorporation. In the complaint the assignee in the Website Purchase Agreement is referred to as the Complainant when reference is made to the use of the mark prior to the assignment.
 - (c) The Complainant states that the ESSAYTIGERS mark has been in use since at least 2012, that essaytigers.com was registered on 4 October 2012 and that essay writing services have been offered at this domain name since 31 December 2012.
 - (d) The Complainant asserts that ESSAYTIGERS identifies its services and does not have a dictionary meaning. It says that this mark is an important part of its business, has value to it and essaytigers.com is its primary means of communicating with prospective customers.
 - (e) The Complainant states that it has invested considerable time, effort and money in advertising, promoting, and selling services in connection with the ESSAYTIGERS mark. It says feedback is primarily positive which signals goodwill in its sector, at least among commercial writing consumers and professionals offering identical or similar services. The Complainant contends that the distinctiveness acquired by its trade mark is the reason the Respondent targeted its mark.
 - (f) The Complainant says ESSAYTIGERS has become a distinctive identifier which consumers associate with its services.
 - (g) The Complainant argues that the Domain Name is identical to its ESSAYTIGERS mark and to essaytigers.com.
- 5.3 The Complainant asserts that the Domain Name is an Abusive Registration for the following reasons:
- (a) The Complainant states that the Respondent registered the Domain Name without its consent and with full knowledge of the Complainant's common law rights.
 - (b) The Complainant says that the Respondent first offered writing services from the Domain Name on 25 January 2015. It contends that the Respondent adopted the Domain Name with the intent to exploit the Complainant's goodwill in its mark.
 - (c) The Complainant states that the Respondent is using 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 says that it is associated with the services offered at essaytigers.com and is commonly known by the ESSAYTIGERS name.

- (d) The Complainant states that the site at the Domain Name offers similar writing services to those at essaytigers.com, uses a similar logo to the Complainant's logo and has a similar visual design to the Complainant's site. The Complainant says that the Respondent is not identified on the site at the Domain Name. It contends that the Respondent implies that his services are provided by the Complainant and that he intends to conduct business under the Complainant's name. The Complainant argues that there is no bona fide offering of services or fair use or legitimate non-commercial use of the Domain Name. The Complainant contends that the Respondent's intent is to misleadingly divert consumers to take commercial advantage of the potential for confusion.
- (e) The Complainant states that it has not granted the Respondent any right or consent to use the ESSAYTIGERS mark. The Complainant says it is unaware of and has not been notified of any rights that have been or may be granted to the Respondent in this mark. The Complainant states that the Respondent is not commonly known by the ESSAYTIGERS name and that it has no relationship with the Respondent.
- (f) The Complainant states that the Respondent is a direct competitor in the same geographical location, namely English-speaking countries. It contends that it is inconceivable the Respondent was unaware of the ESSAYTIGERS online business at the time the Domain Name was registered. It relies on the following in support:
 - (i) the Complainant's web site being commonly known as ESSAYTIGERS in December 2012;
 - (ii) Internet use of the ESSAYTIGERS mark since at least 2013;
 - (iii) the Complainant and the Respondent operating in the same market;
 - (iv) the nature of the business and their (assumed to mean the Respondent's) highly specific targeting of the ESSAYTIGERS brand using SEO (Search Engine Optimisation) techniques;
 - (v) the Respondent calling itself ESSAYTIGERS;
 - (vi) the Domain Name being an exact match of the ESSAYTIGERS mark;
 - (vii) the similarity of the visual design and style of the Respondent's web site to the Complainant's site; and
 - (viii) the 2013 copyright date on the Respondent's site which the Complainant says creates a likelihood of confusion and is misleading.
- (g) The Complainant states that Google indicates the existence of its long-term activity under the ESSAYTIGERS mark.
- (h) The Complainant is concerned that the Respondent is charging fees for writing services that Internet users might never receive or of poor quality. The Complainant argues that the Respondent is trying to divert Internet users for commercial gain by attracting them to his web site through a likelihood of confusion with the Complainant's mark. It says this is conclusive evidence of Abusive Registration and use of the Domain Name. The Complainant relies on its unregistered rights in the ESSAYTIGERS mark which it says had accrued when the Domain Name was registered and contends that the Respondent registered the Domain Name to unfairly capitalise on the Complainant's then nascent (not yet registered) trade mark rights.

The Respondent's response

- 5.4 The response is short and is set out in full below. The Respondent is an individual but uses the terms “we” and “our” in the response.

“What defense are we making?”

1) Our domain essaytigers.co.uk was formed in 2015 and at that time Complainant, COREFORCE LTD essaytigers.com was not so popular or we were also unaware of this domain. It is a mere coincidence that our domain and the Complainant operates within the same industry.

2) At the time of essaytigers.co.uk registration, there was no proof or sign of any US trademark registration that essaytigers.com registered sometime back. If we knew the trademark registration we would have never bought the domain in 2015.

3) This notice from essaytigers.com is a clear indication that they want to take advantage of our domain by taking hold of them. If they were so serious in their business they would have bought all the extensions at the time of registering essaytigers.com so individuals and companies like us may have not made any mistake intentionally or unintentionally.

4) Asking for transferring the domain is absolutely unjustified as we have spent a lot of time in running our brand essaytigers.co.uk and also a lot of money has already been spent on various activities such as marketing and advertising.

5) Complainant Facebook and other marketing links does not reflect that we are trying to capture essaytigers.com customers as our marketing team has never mentioned it anywhere that we are trying to capture essaytigers.com customers.

Our Domain name is not abusive.

1) Essaytigers.co.uk logo and prices are completely different from essaytigers.com so we are 100% guaranteed that any customer would never confuse on which brand he or she is ordering from. We use different chat support software, our numbers are different and our target audience is Europe only as this is a UK domain.

2) We are fair in our business practices and we have never mentioned on our website that our domain essaytigers.co.uk is a part of essaytigers.com. Our customers are all literate and they can understand from which website they are ordering from.

3)Essaytigers.com business region is mainly US and our business region is UK. Our services are also mentioned with other names. If someone ever wanted to copy essaytigers.com , they would have exactly copied each and everything from the site to make it the same. This is not the case with essaytigers.co.uk.

4) Having a domain name registered in .com and a brand name registration does not qualify someone of being the owner of the .co.uk domains as well. They must register all domain extensions to avoid any conflict with other parties.

5) There is no evidence which proves that our services are low quality and essaytigers.com is getting affected by it.

How would you like this complaint to be resolved?

Continue in doing the business using the same domain extension essaytigers.co.uk.”

The Complainant’s reply

- 5.5 The Complainant states that the essaytigers.com site was launched in 2012 and in 2013 was referred to in independent review web sites. It says that given the narrow focus of the Internet business, the Respondent would have known of the Complainant’s business and rights when the Domain Name was registered.
- 5.6 The Complainant relies on its unregistered trade mark rights in ESSAYTIGERS that it says arose prior to registration of the Domain Name. It argues that the absence of a registered trade mark does not give competitors the right to copy its brand.
- 5.7 The Complainant says it is not reasonable or possible to buy all the domain name extensions for a brand name when starting an online business. The Complainant says

that it owns all the main gTLD extensions for essaytigers (I presume this should refer to essaytigers).

- 5.8 The Complainant says that the Respondent has not provided any evidence of its marketing and advertising costs. It states that the site at the Domain Name received no traffic as at the end of June 2020 and best recorded traffic of 1,653 in January 2016.
- 5.9 The Complainant asserts that the Respondent has tried to capture essaytigers.com customers by creating a likelihood of confusion with the Complainant's mark.
- 5.10 The Complainant acknowledges that the Respondent's prices and numbers are different but says this does not affect the similarity of the Respondent's web site to that of the Complainant's.
- 5.11 The Complainant argues that as the Respondent is not commonly known by the ESSAYTIGERS name and as there is no identifying information on his web site, customers who visit the Respondent's site may believe that they are dealing with the Complainant.
- 5.12 The Complainant states that its web site and that of the Respondent are directed at English-speaking consumers and markets. The Complainant contends that the Respondent is taking unfair advantage of its Rights.
- 5.13 The Complainant argues that the Respondent cannot register and use a domain name in breach of the Nominet Dispute Resolution Service Policy (**the Policy**) and third party trade mark rights. The Complainant says it has the right to defend itself from an Abusive Registration made by a competitor.

6. Discussions and Findings

- 6.1 Paragraph 2.2 of the Policy sets out that the Complainant is required to prove to the Expert that both of the following elements are present on the balance of probabilities:

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

- 6.2 Under paragraph 1 of the Policy, 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.*" It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.
- 6.3 I am satisfied on the basis of the Complainant's exclusive licence under the US trade mark for ESSAYTIGERS that the Complainant has Rights in this mark (see paragraph 4.2). I consider the ESSAYTIGERS mark to be identical to the Domain Name (disregarding the .uk suffix which it is common to ignore when making a comparison between the mark and the Domain Name). I deal with whether there are any unregistered rights by virtue of the use of this mark in relation to essay writing services in the discussion below.
- 6.4 I therefore find that the Complainant has Rights in the name or mark, ESSAYTIGERS, which is identical to the Domain Name.

Abusive Registration

- 6.5 Under paragraph 1 of the Policy, Abusive Registration means 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.*

It is sufficient to satisfy either of these limbs for there to be a finding of an Abusive Registration.

- 6.6 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is set out at paragraph 5 of the Policy. They include the following:
- 5.1.1 *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
- 5.1.1.3 *for the purpose of unfairly disrupting the business of the Complainant.*
- 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.*
- 6.7 Paragraph 5.1.1 of the Policy relates to the Respondent's motives at the time of registration of the Domain Name. For there to be an Abusive Registration under paragraph 1.i. of the Policy it must be established that the Respondent knew of (or in some cases should have known of) the Complainant and/or its Rights at the time of registration of the Domain Name.
- 6.8 In this case the Domain Name was registered on 5 January 2015 prior to the Complainant's incorporation and prior to the US trade mark registration for ESSAYTIGERS. The Respondent would not therefore have known of the Complainant and/or its Rights at the time of registration of the Domain Name. However, the Complainant asserts that the ESSAYTIGERS mark has been in use since 2012, that there were unregistered rights by virtue of the use of this mark when the Domain Name was registered and that the Complainant owns these rights pursuant to the assignment in the Website Purchase Agreement.
- 6.9 I deal below with the use of the ESSAYTIGERS mark at the time when the Domain Name was registered. However, I am satisfied that under the Website Purchase Agreement the Complainant acquired from Grand Fortuna any unregistered rights built up by 5 October 2016 by virtue of the use of this mark (including any subsisting at the time of the Domain Name registration). Under the Website Purchase Agreement Grand Fortuna transferred to the Complainant all its "*rights, title and interest in and to the Website and Domain Name essaytigers.com and all of its respective contents (the "Website"), and any other rights associated with the Website and any goodwill symbolized thereby, including, without limitation, any Intellectual Property rights (including common law trademark rights), all related domains, logos, customer lists, email lists, passwords, associated software used in building the Website, usernames and trade names; and all of the related social media accounts including but not limited to Twitter, Facebook at Closing and associated other rights identified on Exhibit "A" hereto....*" Exhibit A includes in the purchased assets Intellectual Property and Goodwill. Intellectual Property is defined as including trade names (including "essaytigers.com"), trademarks (including common law trademarks), service marks, logos, assumed names, brand names and all registrations and applications therefor together with the goodwill of the business symbolized thereby. I interpret the transfer from Grand Fortuna to the Complainant to include any unregistered rights subsisting in the ESSAYTIGERS mark by virtue of its use in connection with the essaytigers.com online business.
- 6.10 The Complainant argues that it is inconceivable the Respondent was unaware of the essaytigers.com business at the time the Domain Name was registered. The Respondent states the following in relation to his knowledge: "*Complainant, COREFORCE LTD essaytigers.com was not so popular or we were also unaware of this domain.*" The Respondent appears to be denying that he knew of the essaytigers.com business at the time of registration of the Domain Name as well as contending that it was not popular.
- 6.11 I will therefore consider the evidence in relation to the use of the ESSAYTIGERS mark at the time of registration of the Domain Name which is relevant both to whether there

were unregistered rights in this mark at that time and whether the Respondent knew of the mark when he registered the Domain Name.

- 6.12 The Complainant's evidence shows that the essaytigers.com site was set up in late 2012 (although it is unclear whether it was active at this time) and that Facebook and Twitter pages were set up in 2013¹. However, it has provided limited information on the extent of the essaytigers.com business when the Domain Name was registered. For example, it has not provided any information on turnover, number of users or any marketing activities nor has it provided any information on the background to its purchase of the essaytigers.com site in October 2016. The purchase price paid for the site, which could have given some insight as to the extent of the essaytigers.com business at least as at 5 October 2016, has also been redacted in the evidence.
- 6.13 The Complainant has provided a report on traffic at essaytigers.com. This broadly shows no to limited traffic from January 2012 up until around mid-2014 (it is difficult to be precise on dates from the time line in the report); increased traffic from around mid-2014 to around January 2015; and a decrease thereafter to no or limited traffic until late 2018 when traffic starts increasing. Based on this evidence, I consider that the business operating from essaytigers.com was very limited at the time of registration of the Domain Name.
- 6.14 The ESSAYTIGERS mark is a combination of the dictionary words 'essay' and 'tigers'. I regard this mark to be distinctive, rather than descriptive, of academic essay writing services. In particular 'tigers' would not ordinarily be associated with essay writing services. Taking into account the nature of the ESSAYTIGERS mark, I consider that there were unregistered rights in this mark at the time of registration of the Domain Name by reason of its use in connection with the essaytigers.com business, notwithstanding the limited extent of that business at that time. For the reasons set out in paragraph 6.9 the Complainant is the owner of these unregistered Rights. However, it is feasible that the Respondent was unaware of the essaytigers.com business when he registered the Domain Name given its limited extent at that time.
- 6.15 The Complainant relies on similarities in January 2015 between the Respondent's site at the Domain Name and the essaytigers.com site as evidence in support of the Respondent's knowledge of the site. However, this evidence is based on the Wayback machine which can be unreliable and, in my view, there are also differences between the two sites. I have therefore placed limited reliance on this evidence.
- 6.16 I consider it to be of more significance that the Respondent has not given any explanation as to why he chose the Domain Name or provided any background to the setting up of his business under the Domain Name at around the time when traffic to essaytigers.com had increased. In the absence of any explanation from the Respondent as to why he registered the Domain Name, I do not regard it to be a mere coincidence, as the Respondent suggests, that the Domain Name is used for the same services as those offered at essaytigers.com. If the Respondent was using a descriptive name for his services that may have been a credible suggestion but, as set out above, in my view, ESSAYTIGERS is distinctive of academic essay writing services.
- 6.17 Having weighed the evidence I therefore find, on the balance of probabilities, that the Respondent was aware of the essaytigers.com business when he registered the Domain Name. Accordingly, given such knowledge, the Respondent's motives for registering the Domain Name have to be considered.
- 6.18 Under paragraph 5.1.1.3 of the Policy, if the Respondent registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant by attracting users to the Respondent's site who were looking for the Complainant and once there potentially diverting users into placing business with the Respondent, this may be evidence of an Abusive Registration under paragraph 1.i. of the Policy. In this case, even though the Complainant was not in existence when the Domain Name was registered, in light of my findings at paragraph 6.9 that the Complainant acquired from Grand Fortuna its unregistered Rights in the ESSAYTIGERS mark, I consider that the

¹ In some of the Complainant's evidence Essay Tigers rather than EssayTigers is used but I do not consider this to be of significance.

Complainant can rely on paragraph 1.i. and paragraph 5.1.1.3 of the Policy (with references to the Complainant replaced by Grand Fortuna).

- 6.19 The Complainant's evidence shows that essaytigers.com was attracting Internet traffic (albeit limited) prior to the Domain Name registration and is currently attracting traffic. I consider that there is a real risk that Internet users, particularly those based in the UK looking for Grand Fortuna and, after 5 October 2016, the Complainant, who guess the URL will visit the Respondent's site. I also consider there is a real risk that Internet users will visit the Respondent's site in response to a search engine request looking for Grand Fortuna and, after 5 October 2016, the Complainant. Once at the Respondent's site Internet users may be potentially diverted into buying the Respondent's competing services.
- 6.20 In my view the Respondent registered the Domain Name with knowledge of the essaytigers.com business, for the purposes of unfairly disrupting that business by taking unfair advantage of the likely confusion of Internet users to divert traffic to the Respondent's site where users may potentially be diverted into buying its competing services. This is evidence that the Domain Name is an Abusive Registration under paragraph 1.i of the Policy.
- 6.21 Under paragraph 5.1.2 of the Policy if 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, this may be evidence of an Abusive Registration under paragraph 1.ii of the Policy. As set out above I consider there is a real risk of internet users being initially confused into visiting the Respondent's site in the expectation of finding the Complainant. Even if internet users become aware that they have not found the Complainant when they reach the Respondent's site (which I regard as unlikely), the Respondent has still used the Domain Name in a way to cause initial interest confusion that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. This is evidence that the Domain Name is an Abusive Registration under paragraph 1.ii. of the Policy.
- 6.22 I do not consider that any of the factors which may be evidence that the Domain Name is not an Abusive Registration under paragraph 8 of the Policy apply.
- 6.23 Accordingly I conclude that the Domain Name is an Abusive Registration under paragraphs 1.i. and 1.ii. of the Policy.

7. Decision

- 7.1 I find that the Complainant has Rights in a name or mark 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 direct that the Domain Name be transferred to the Complainant.

Signed Patricia Jones

Dated 3 August 2020