

Nominet UK Dispute Resolution Service (DRS)

DRS Number 8765

Elite Licensing Company SA and another -v- James Fleming

Decision of Independent Expert

1. Parties

Complainant : Elite Licensing Company SA

15, route des Arsenaux

Fribourg

1700

Switzerland

2nd Complainant : Elite Model Management

21, avenue Montaigne

Paris

75008

France

Respondent : James Fleming

11 Kitchener Street

Woodlesford

Leeds

LS26 8ST

United Kingdom

2. Domain Name

elitemodelagency.co.uk (the "Domain Name")

3. Procedural Background

On 30th June 2010 the Complaint was lodged with Nominet UK Limited (“Nominet”). Nominet validated the Complaint on 1st July 2010 and it was sent to the Respondent giving him 15 working days within which to lodge a Response and which was to be on or before 22nd July 2010.

The Respondent responded on 22nd July 2010 and the Response was sent to the Complainants on the same day. The Complainants replied to the Response on 23rd July 2010 and the Reply was sent to the Respondent on 28th July 2010. Mediation documents were generated for the Complaint and mediation commenced on 2nd August 2010. The mediation was unsuccessful and concluded on 13th September 2010. On 15th September 2010 the Complainants paid the appropriate fee for a Decision by an Expert pursuant to paragraph 6 of Nominet’s Dispute Resolution Service (DRS) Policy (the “Policy”).

On 15th September 2010 Mr. Niall Lawless (“the Expert”) was selected and on 16th September 2010 appointed to act as Expert in this dispute, having confirmed that he knew of no reason why he could not properly accept the appointment and knew of no matters which ought to be drawn to the attention of the parties which might appear to call into question his impartiality and -/- or independence. He is required to give his Decision by 12th October 2010.

4. Outstanding Formal / Procedural Issues

There are no outstanding formal or procedural issues.

5. Factual background

The Lead Complainant Elite Licensing Company SA, a joint stock company registered under the laws of Switzerland (registration number CH-217-0138776-6) and the Second Complainant Elite Model Management a limited liability company registered under the laws of France (registration number 722.002.110) are part of the Elite Group of companies which own and run the model agency network ELITE. The ELITE agency is famous worldwide and discovered many iconic models such as Claudia Schiffer, Cindy Crawford, Karen Mulder, Nastassja Kinski, Naomi Campbell and others.

Over the last decade the Elite Licensing Company SA has developed an expanded family of ELITE trademarks and the ELITE brand extends beyond modeling into many other areas such as bags, beachwear, cosmetics, mobile phones, perfumes, shoes, sunglasses and watches.

The Complainants own several trademarks including :-

- French national trademark ELITE Elite Model Management (semi-figurative) No. 1.662.492, registered since September 25, 1978 in Classes 35, 41 and 42;
- International registration ELITE Elite Model Management (semi-figurative) No. 442.385, registered since December 6, 1978 in Classes 35, 41 and 42, with effect in Benelux, Spain and Italy;
- Community trademark ELITE MODEL LOOK (semi-figurative) No. 383.109, filed on October 23, 1996 and registered since December 20, 1999 in Class 41;
- Community trademark ELITE MODELS FASHION (semi-figurative) No. 345.926, filed on August 7, 1996 and registered since June 27, 2002 in Classes 3, 14, 16, 18, 25, 28 and 40.

The Respondent first registered elitemodelagency.co.uk on 1st October 2004 and the registration was last updated on 5th December 2008. The renewal date was 1st October 2010.

The Complainants seek transfer of the Domain Name.

6. The Parties' contentions

The Complainants

The Complainants say that the Domain Name (elitemodelagency.co.uk) controlled by the Respondent is an Abusive Registration under Nominet's DRS Policy. They say that the Domain Name is an Abusive Registration because :-

- The Respondent cannot demonstrate that he has registered the Domain Name on the basis of any legitimate right or interest.
- Although the Domain Name was registered by the Respondent as an individual it has been used for commercial purpose, in favour of a commercial entity.

- The Domain Name is confusingly similar to the ELITE trademarks and trade and company names.
- The Domain Name is likely to lead the public to believe that it is affiliated or linked with the Complainants' trademarks and trade name.
- Registration of the Domain Name and the use of the ELITE trademarks has not been authorised by them.
- The Respondent has used the Domain Name in a way which has confused or was likely to confuse people or businesses into believing that the Domain Name and any website to which it resolves is affiliated, connected or linked to, endorsed by or operated by the Complainants.
- The Respondent has been using the Domain Name for infringing activities such as directing traffic to the website of a competing model agency.
- The Domain Name was registered or otherwise acquired in a manner which at the time of the registration took unfair advantage of and has been unfairly detrimental to the Complainants' rights.
- The Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the Complainants' business and to unfairly compete with the Complainants.

The Respondent

The Respondent says that the Domain Name was purchased in good faith on behalf of a client company which is no longer trading. He says that the Domain Name was not purchased to "pass off" and that it resolves to a holding page and not to a website. The Respondent says that he undertakes that the Domain Name will not point to anywhere except a holding page as is currently the situation. He says that there are numerous variants of this domain name which link to a model agency not linked to the Complainants.

7. Discussions and Findings

7.1 General

Nominet's DRS Policy requires that for a Complaint to succeed the Complainants must prove to the Expert on the balance of probabilities that :-

- i. The Complainants have 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.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainants must prove that the Domain Name either :-

- i. At the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainants' Rights; or
- ii. Has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainants' Rights.

The Complainants are required to prove to the Expert that the Complainants have Rights and that the Domain Name in the hands of the Respondent is an Abusive Registration; both elements must be present.

7.2 Complainants' Rights

The Complainants have obtained international trademark protection consisting in or comprising the term ELITE and it is in essence the main part of the company names Elite Licensing Company SA and Elite Model Management.

As the dominant part of the Domain Name is the same as the Complainants' trademark and the addition of the terms "model" and "agency" describe the services offered by the Complainants to their customers, I decide that the Complainants have Rights in respect of a name or mark which is similar to the Domain Name.

7.3 Abusive Registration

The Complainants say that the Domain Name (elitemodelagency.co.uk) controlled by the Respondent is an Abusive Registration under Nominet's DRS Policy, but they do not state under which part of the Policy. Under Nominet's DRS Policy Section 3 Evidence of Abusive Registration guidance is given as to what factors may evidence that the Domain Name is an Abusive Registration.

A non-exhaustive list of factors which may evidence that the Domain Name is an Abusive Registration is as follows :-

3(a)(i). Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily :-

3(a)(i)(A). for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainants or to a competitor of the Complainants, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

3(a)(i)(B). as a blocking registration against a name or mark in which the Complainants have Rights.

3(a)(i)(C). or the purpose of unfairly disrupting the business of the Complainants;

3(a)(ii). 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 Complainants.

Registration of the Domain Name

Nominet operates a "first-come, first-served" system of domain name registration and there is no requirement for the Respondent to show that he has Rights in the name (unlike the Complainants who must prove that). However, it can help the Respondent's case if he can show that he has rights in the name as it suggests that the registration (and possibly use) of the name is not abusive.

The Complainants say that the Respondent cannot demonstrate that he has registered the Domain Name on the basis of any legitimate right or interest; however it is not necessary for him to do so.

Inaccurate Registration Information

The Complainants say that although the Domain Name was registered by the Respondent as an individual it has been used for commercial purposes in favour of a commercial entity. The Respondent says that the Domain Name was purchased in good faith on behalf of a client company which is no longer trading.

Nominet's WHOIS is a system which provides public information about domain names. Consumers are allowed to opt out but all other types of registrant using a domain name commercially such as "pay per click" are required to display an address in WHOIS.

The Domain Name registration information must be correct and Nominet's Terms and Conditions of Domain Name Registration provide that *"the information must be good enough to allow us to contact you quickly at any reasonable time without having to get information from anywhere else, must not be deceptive, and (if possible for that type of information) must clearly identify you. For your name this also means that the information must be detailed enough that we can tell exactly who you are (in legal terms, exactly which legal entity we have this contract with)"*.

The Respondent who is the current registrant has not opted out, he is clearly identified and the information provided by him is good enough to allow contact quickly at any reasonable time without having to get information from anywhere else.

Using the Domain Name to Confuse

The Complainants say that the Domain Name has been used in a way which has confused or was likely to confuse people or businesses into believing that the Domain Name and any website it resolves to, to be affiliated, connected or linked to, endorsed by or operated by them.

I accept that on 29th March 2010 the Domain Name resolved to a competing model agency called Gloss Model Management (www.glossmodels.co.uk) and that at the time of the Complaint being prepared on 29th June 2010 the Domain Name resolved to a website containing sponsored links, pointing amongst others to websites belonging to competitors of the Complainants.

Currently the Domain Name is resolving to a more innocuous webpage of 123-reg.co.uk controlled by Webfusion Ltd and in respect of this the Respondent says that that he undertakes that the Domain Name will not point to anywhere except a holding page, as is currently the situation.

The Respondent has used 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 authorized by, or otherwise connected with the Complainant.

It was only upon receipt of the Complainants' 29th March 2010 *"cease and desist"* letter that the Respondent changed the use of the Domain Name as set out above and I decide under the test in Nominet's DRS Policy 3(a)(ii) that in the control of the Respondent the Domain Name is an Abusive Registration.

Unfairly Disrupting the Complainants' Business

The Complainants say that the Respondent has been using the Domain Name for infringing activities such as directing traffic to the website of a competing model agency.

The Respondent's use of the Domain Name in this way unfairly disrupts the Complainants' Business and is evidence of circumstances falling within paragraph 3(a)(i)(C) of Nominet's DRS Policy. However, the test under Nominet's DRS Policy 3(a)(i)(C) is not that the Domain Name is unfairly disrupting the Complainants' Business, but that it was acquired for that purpose.

To help me decide if the Domain Name was acquired for that purpose, I have to consider the prominence of the Complainants' brand and reputation as it would have existed on 1st October 2004. I have little doubt that the Complainants which established their ELITE agency in 1972, were operating on five continents and in their words the "*undisputed world leader in the modeling agency business*" would have been manifestly visible to the Respondent.

When that is linked with the Respondent's subsequent use of the Domain Name resolving to a competing model agency Gloss Model Management, I decide on the balance of probabilities that the Domain Name was acquired to unfairly disrupt the Complainants' business and under the test in Nominet's DRS Policy 3(a)(i)(C) that in the control of the Respondent the Domain Name is an Abusive Registration.

Trademark infringement

The Complainants say that the Domain Name is confusingly similar to the ELITE trademarks and trade and company names and the Domain Name is likely to lead the public to believe that it is affiliated or linked with the Complainants' trademarks and trade name. I accept that the Complainants have a substantial investment in having extensively used and promoted their ELITE names and marks.

However, whether or not the Respondent's activities amount to trademark infringement, Expert Decisions are to be determined by reference to Nominet's DRS Policy and not the law in respect of trade-mark infringement, for example as decided in *Deutsche Telekom AG v Lammtara Multiserve Limited* Appeal Decision (DRS 05856).

7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainants have Rights in respect of a name identical or similar to the Domain Name and that the Complainants have proved, on the balance of probabilities, that the Domain Name in the control of the Respondent is an Abusive Registration.

8. Decision

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name is transferred to the Lead Complainant Elite Licensing Company SA. 15, route des Arsenaux, Fribourg, 1700, Switzerland.



Niall Lawless, Nominet Expert

12th October 2010